



IP NEWS QUARTERLY



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DOMAIN NAMES

“A word used as a domain name identifies an address or place on the internet where a “home page” or “web site” can be located.” *McCarthy on Trademarks and Unfair Competition Section 25A:10 (4th ed.)*

In general, a domain name is a second-level domain, a “dot,” and a top-level domain (“TLD”). The wording to the left of the “dot” is the second-level domain. A TLD is the string of letters that follows the last “.” or “dot”.

Example: If the domain name is “XYZ.com,” the term “XYZ” is a second-level domain and the term “com” is a TLD.

Generic TLDs. If a TLD has three or more characters, it is known as a “generic top-level domain” or “gTLD.”

Generally, when a trademark, service mark, collective mark, or certification mark is wholly or in part, of a domain name, neither the beginning of the Uniform Resource Locator (“URL”), e.g., <http://www.>, nor the gTLD, has any source-indicating, or trademark, significance. See Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1038, 1044, 50 U.S.P.Q.2d 1545, 1549 (9th Cir. 1999). Instead, those designations are merely devices that every internet site provider must use as part of its address. Advertisements for all types of products and services routinely include a URL, and the average person familiar with the Internet recognizes the format for a domain name and understands that “http,” “www,” and a gTLD are a part of every URL.

Please contact this office with any questions you may have regarding domain names.

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Did you know?

Survey of Top 5 Patents for 2014 “profiling best inventions for the past year”

Source: IPWatchdog.com

#1: Damage Reduction Control for Humanoid Robot Fall
U.S. Patent No. 8880221

#2: Anti-TSG101 Antibodies and Their Uses for Treatment of Viral Infections
U.S. Patent No. 8796423

#3: Clustering Devices in an Internet of Things (‘IoT’)
U.S. Patent No. 8671099

#4: Aerial Display System With Marionettes Articulated and Supported by Airborne Devices
U.S. Patent No. 8876571

#5: Foreign Currency Solution
U.S. Patent No. 8818868

IS IT POSSIBLE TO PROMOTE A COMPANY'S BRAND THROUGH SENSES? THE ANSWER IS YES!

The Lanham Act defines “trademark” in broad terms. Under Lanham Act § 45, 15 U.S.C. § 1127, a trademark is “any word, name, symbol, or device, or any combination thereof” used to “identify and distinguish [a person’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Further, it defines a “service mark” to mean “any word, name, symbol, or device, or any combination thereof ... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown....”

As defined, a trademark can be anything that can be identified by sight, smell, taste, sound or touch, as long as it is used to identify a source of goods or services. The U.S. Supreme Court has confirmed this broad interpretation, stating “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes.” *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164 (1995).

Although federal registration of a mark is not mandatory, it has several advantages, including notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, and the right to use the mark on or in connection with the goods/services listed in the registration. www.USPTO.gov *Basic Facts 2015-Protecting Your Trademark*. Although word and design marks are the most traditional and recognizable types of trademarks, nontraditional trademarks that address the other senses do exist, and can serve as valuable brand identification.

Sound: A number of well-known sounds have been registered in the USPTO as trademarks:

- The Looney Tunes Theme Song: “The mark consists of the Looney Tunes Theme Song which consists of eighteen (18) musical notes comprising the notes, E4, D4, C4, D4, E4, EFlat4, E4, C4, D4, D4, D4, D4, C4, AFlat3, A3, D4, E4 and G4.” (U.S. Reg. No. 2,469,364).
- The sound of Darth Vader breathing: “The mark consists of the sound of rhythmic mechanical human breathing created by breathing through a scuba tank regulator.” (U.S. Reg. No. 3,618,322).

Smell: Scents or fragrances of products which are primarily sold for their scent, such as perfumes, colognes and scented household products, cannot be trademarked on the grounds that those scents are functional.[1] But scents that can otherwise identify a source of goods or services can be, and have been, registered:

- A cherry scent for synthetic lubricants: “The mark consists of a cherry scent.” (U.S. Reg. No. 2,463,044).

Touch: Registered trademarks which are defined solely by touch are rare, but do exist:

- Braille: a mark containing raised Braille characters, to be used on custom jewelry (U.S. Reg. No. 2,058,394). In 2008, Stevie Wonder registered marks for his apparel depicted in Braille (U.S. Reg. Nos. 3,512,464, 3,512,465, 3,495,229, and 3,741,784).

IS IT POSSIBLE TO PROMOTE A COMPANY'S BRAND THROUGH SENSES? THE ANSWER IS YES! *Cont'd*

Taste: Attempts have been made to trademark a flavor, but so far the USPTO has refused all such attempts on the ground of functionality. For example, in 2013 an application was denied to trademark the flavor of peppermint for a nitro-glycerin medication applied orally by a spray bottle to treat chest pain. *In re Pohl-Boskamp GmbH & Co.*, 106 U.S.P.Q.2d 1042, 2013 WL 1234849 (T.T.A.B. 2013).

Companies and people seeking to expand and further distinguish their brand may explore ways to interact with consumers by appealing to all senses.

Please contact this office with any questions you may have regarding trademarks.



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