

MEDIA MENTION

David Weslow Discusses "Alternate Root" Registry's Legal Claims Against ICANN

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David E. Weslow, a partner in Wiley Rein's Intellectual Property Practice, was quoted by *Bloomberg BNA* in a March 12 article about a trademark dispute between Name.Space—an "alternate root" domain name registry—and the Internet Corporation for Assigned Names and Numbers (ICANN).

During oral arguments before the Ninth Circuit on March 6, Name.Space told the court that ICANN violated the Lanham Act when it announced that it would make available for sale generic top-level domains (TLDs) that match alternate root TLDs operated by Name.Space, such as .berlin, .club, and .nyc, according to the article.

Mr. Weslow told BNA's *Electronic Commerce & Law Report* that Name.Space would face an uphill battle in asserting that its alternate root TLDs qualified as protectable trademarks. He noted that the United States Patent and Trademark Office only recently started considering TLD-based applications for trademarks and has ruled out registering TLDs not recognized by ICANN—so Name.Space has not been able to register any marks and would lose out on the favorable presumptions a trademark registration provides.

Name.Space's customers, however, might have a better case, according to Mr. Weslow. "It's long-standing precedent that a second-level name can be a source identifier for valid trademark rights," he said, citing Amazon.com as an example. But he added that it is unclear whether any alternate root domain name registrants have sufficiently established their domain names as source identifiers to successfully prosecute a claim.

Related Professionals

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Practice Areas

Intellectual Property
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