



212.979.0642 <https://namespace.us>

July 31, 2012

Barbara Lederman
Agency Chief Contract Officer
New York City Department of Information Technology
& Telecommunications
255 Greenwich Street, 9th Floor
New York, New York 10007

Re: **name.space**

Dear Ms. Lederman:

We are in receipt of your July 20, 2012 letter to City Council Member Rosie Mendez responding to her July 10 letter concerning **name.space**. We are disappointed that the Department of Information Technology and Telecommunications is taking an incorrect view of **name.space**. The Department's position hurts a New York company that would otherwise bring substantial benefits to the City. More importantly, it violates our legal rights.

First, contrary to the Department's assertions that "Mr. Garrin chooses to ignore the law," **name.space** is on firm legal footing in reserving its trademark rights to its catalog of top-level domains ("TLDs"), including .nyc. While the U.S. Patent and Trademark Office ("USPTO") regards TLDs as *generally* serving no source-indicating function, the USPTO has recognized that "[a]s the number of available TLDs is increased by the Internet Corporation for Assigned Names and Numbers ("ICANN"), or if the nature of new TLDs changes, the examining attorney must consider any potential source-indicating function of the TLD and introduce evidence as to the significance of the TLD." TMEP § 1209.03(m) (8th ed. Oct. 2011). Thus, the USPTO has explicitly recognized that TLDs could, in fact, serve source-indicating functions. *See id.*; TMEP § 1215.08(a).¹ Indeed, **name.space** has owned and operated the .nyc TLD in commerce continuously since 1996, and its services are recognized in connection with that TLD. As you are no doubt aware, registration with the USPTO is not a prerequisite to an action for infringement of a common law trademark.

¹ **name.space** is aware that the USPTO currently takes the position that "a mark [that] is composed solely of a TLD for 'domain name registry services'" is not entitled to registration, but **name.space** provides services beyond mere domain name registry services, such as searching, hosting and content delivery services. Moreover, this limitation only applies to U.S. federally registered trademarks, and is not applicable to common law trademarks or foreign registered trademarks.

Second, name.space is not simply an operator in an “alternate root zone,” as you claim, but is an independent TLD owner and operator that is the originator of the gTLD in question (and many others). **name.space** has been actively seeking inclusion into the “sanctioned” root since our inception, before the creation of ICANN or any formal process for adding TLDs to the ROOT. **name.space** was in fact cited in the NTIA’s 1998 “White Paper” as a contributor to the process of developing a “sanctioned” root. Indeed, **name.space** participated as a stakeholder in the NTIA’s IFWP process that led to the formation of ICANN, and had participated in the 2000 gTLD Application Round with an application that included .nyc and 117 other TLDs. That application was selected for inclusion among the top ten for consideration out of 44 applicants. The U.S. Government and elected officials are fully aware of **name.space**, and we are operating entirely within the law, whether recognized by ICANN or not.

In any event, the Department’s citation to *Online Design, Inc. v Core Assocs.*, 120 F. Supp 2d 870 (C.D. Cal. 2000) for the proposition that “U.S. courts have held that operating in an alternate root zone does not give the operator any rights to a particular name space or TLD” is without merit. The court in that case addressed the question of whether the plaintiff, who operated the TLD .web on an alternate root, had legally-recognizable trademark rights to the TLD .web. That the plaintiff operated .web on an alternate root was not a factor in the court’s decision. Rather, the court’s reasoning implied that, if .web was eligible for trademark protection under accepted legal principles at the time, the plaintiff could assert a claim to the mark, regardless of whether the plaintiff operated .web on an alternate root.

Third, the Department vastly overstates ICANN’s role as the “entity authorized to grant rights to TLDs.” As the Department notes, ICANN’s authority is derived from a contractual relationship with the U.S. Government. That contract, however, does not vest in ICANN the exclusive power to recognize intellectual property rights in TLDs. Because of its limited power, ICANN cannot award registry contracts in a manner that infringes upon the intellectual property rights of other companies. That is exactly what is at stake here should Neustar operate the .nyc TLD, which **name.space** originated and has operated continuously since 1996.

name.space had hoped to work cooperatively with the City in this matter. That is still our hope. We regret that we are forced into a position to determine whether to pursue enforcement of our rights and claims against the City and the Department, all of which are expressly reserved.

Sincerely,

Paul Garrin,
Founder, **name.space**