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## Generic Domain Names: Unprotectable Yet Invaluable

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For those keeping score at home, various courts and tribunals have previously held the following domain names to be generic in connection with the listed goods or services:

- **BLINDSANDDRAPERY.COM** for wholesale and retail services "featuring blinds, draperies and other wall coverings"
- **BONDS.COM** for "providing information regarding financial products and services"
- **CONTAINER.COM** for "rental of metal shipping containers"
- **HOTELS.COM** for "providing information to others about temporary lodging"
- **LAWYERS.COM** for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"
- **MATTRESS.COM** for "online retail store services in the field of mattresses, beds and bedding"
- **SPORTSBETTING.COM** for "provision of contests and sweepstakes on and through a global computer network"

To this list, we may soon be adding ADVERTISING.COM for use in connection with a host of online advertising-related services, thanks to the [United States Court of Appeals for the Ninth Circuit](#), which issued [its opinion](#) this week in *Advertise.com, Inc. v. AOL Advertising, Inc.* Because the appeal only relates to a preliminary injunction, the court's opinion has not definitively held that ADVERTISING.COM is generic for online advertising services--further litigation may determine that issue. But the court did make a strong case that, as things stand right now, AOL faces an uphill battle to show that ADVERTISING.COM is not generic for online ad services. Along the way, the court distinguished AOL's ADVERTISING.COM domain name from, for instance, STEELBUILDING.COM, which has been held not generic in connection with "computerized on-line retail store services in the field of pre-engineered steel buildings and roofing systems."

What makes the ADVERTISING.COM case particularly interesting is that, unlike the seven domain names in the above list that did not survive the registration process before the U.S. Trademark Office, AOL actually owns U.S. registrations for its ADVERTISING.COM trademark, albeit in stylized forms. In the process, AOL actually succeeded in arguing to the Trademark Office that the words "ADVERTISING.COM" were not descriptive (much less generic) for many of the services it offers under the marks.



There are a number of interesting lessons from this case even at its preliminary stage, and perhaps more to come, but the most interesting one can be seen by looking at the larger picture: the value of a generic domain name. Even if it cannot be entirely protected from a trademark standpoint, or protected as a trademark when used in connection with the most obvious goods or services, it remains a unique identifier, which, at bottom, is really what trademark protection is all about.

P.S. To see some of what is at issue in the lawsuit, go check out [Advertise.com](http://Advertise.com) and compare it to [Advertising.com](http://Advertising.com).



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