1. **IANA Trademarks and Trademark Registrations**

ICANN currently owns three trademarks associated with IANA, with one United States trademark registration for each IANA Trademark. ICANN was the original applicant for these three registrations. As described in more detail below, the University of Southern California (USC) assigned these three marks to ICANN, along with earlier registrations for two of the marks (the logo was not covered by a registration or application at that time). The registrations acquired from USC were essentially replaced by the current registrations (which are broader and more protective than the USC registrations), and the USC registrations were then allowed to lapse.

| **MARK** | **GOODS AND SERVICES** | **APP. NO. & DATE** | **REG. NO. & DATE** |
| --- | --- | --- | --- |
| INTERNET ASSIGNED NUMBERS AUTHORITY | IC 035. US 100 101 102. G & S: Administration, management, and coordination of parameters and guidelines for facilitating Internet communications; and the administration, management, and coordination of top-level domain names or addresses on the Internet. FIRST USE: 19890101. FIRST USE IN COMMERCE: 19890101  IC 042. US 100 101. G & S: providing information in the field of standards and guidelines for the Internet and domain name registration; domain name registry services in the nature of creation of, establishing provisions for and development and maintenance of parameters and guidelines for facilitating Internet communications; and the creation of, establishing provisions for and monitoring and maintenance of top-level domain names or addresses on the Internet. FIRST USE: 19890101. FIRST USE IN COMMERCE: 19890101 | 76481499  Jan 10, 2003 | 2764089  Sep 16, 2003 |
| Mark Image | IC 035. US 100 101 102. G & S: administration, management, and coordination of parameters and guidelines for facilitating Internet communications; and the administration, management, and coordination of top-level domain names or addresses on the Internet. FIRST USE: 19971222. FIRST USE IN COMMERCE: 19971222  IC 042. US 100 101. G & S: providing information in the field of standards and guidelines for the Internet and domain name registration; domain name registry services in the nature of creation of, establishing provisions for and development and maintenance of parameters and guidelines for facilitating Internet communications; and the creation of, establishing provisions for and monitoring and maintenance of top-level domain names or addresses on the Internet. FIRST USE: 19971222. FIRST USE IN COMMERCE: 19971222 | 76247587  Apr 27, 2001 | 2620519  Sep 17, 2002 |
| IANA | IC 035. US 100 101 102. G & S: Administration, management, and coordination of parameters and guidelines for facilitating Internet communications; and the administration, management, and coordination of domain names or addresses on the internet. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200  IC 042. US 100 101. G & S: Providing information via the internet in the field of technical standards and guidelines for global computer information networks; creation of and establishing provisions for and development and maintenance of technical parameters and guidelines for facilitating Internet communications; and the creation of, establishing technical provisions for and monitoring and maintenance of domain names or addresses on the Internet. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200 | 77310518  Oct 22, 2007 | 3536171  Nov 25, 2008 |

1. **USC Registrations of IANA and INTERNET ASSIGNED NUMBERS AUTHORITY trademarks**

USC applied for and received two trademark registrations related to IANA, which were later assigned to ICANN. Details of these registrations follow.

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| --- | --- | --- | --- |
| **MARK** | **GOODS AND SERVICES** | **APP. NO. & DATE** | **REG. NO. & DATE** |
| INTERNET ASSIGNED NUMBERS AUTHORITY | IC 035. US 100 101 102. G & S: creation, administration, management, coordination, establishing provisions for and maintenance of parameters and guidelines for facilitating global network communications; and the creation, administration, management, coordination, establishing provisions for and maintenance of top-level domain names or addresses on global computer information networks. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200 | 75261385  Mar 21, 1997 | 2217978 (Supplemental Register)  Jan 12, 1999  (Cancelled Oct 15, 2005) |
| IANA | IC 042. US 100 101. G & S: Electronic transfer and dissemination of information in the field of standards and guidelines for global computer information networks and domain name registration; domain name registry services in the nature of creation, administration, coordination, establishing provisions for and development of parameters and guidelines for facilitating global network communications; and the creation, administration, coordination, establishing provisions for and monitoring of top-level domain names or addresses on global computer information networks. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200 | 75261386  Mar 21, 1997 | 2277028  Sep 14, 1999  (Cancelled June 24, 2006 |

1. **Assignment from USC to ICANN; Status of the USC Registrations**

ICANN and USC entered into an agreement entitled “USC/ICANN Transition Agreement” (undated, “Effective Date” February 9, 2000),[[1]](#footnote-1) in which USC agreed to assign the marks to ICANN on the Effective Date. Pursuant to the Transition Agreement, USC executed an assignment to ICANN, dated February 9, 2000, of USC’s “entire right, title and interest” in and to the following trademarks and trademark registrations: (i) Reg. No. 2,277,028 for IANA, (ii) Reg. No. 2,217978 for INTERNET ASSIGNED NUMBERS AUTHORITY, and (iii) the common law trademark rights to the IANA Logo.

After the existing registrations issued, these earlier registrations were cancelled by the US Patent & Trademark Office because ICANN did not file “Affidavits of Continued Use.” It is likely (but could be confirmed with ICANN or its outside counsel) that the earlier registrations were allowed to become cancelled because these earlier registrations had various limitations, which were then resolved in the current registrations. Specifically, the registration for INTERNET ASSIGNED NUMBERS AUTHORITY was on the Supplemental Register, which does not convey the full rights accorded to most trademark registrations (which are on the Principal Register). Also, the descriptions of goods and services were different from each other, and each covered more limited services than the descriptions used in the newer registrations. Finally, one of the newer registrations claims an earlier first use date than in the original registrations.

1. <https://www.icann.org/resources/unthemed-pages/usc-icann-transition-2012-02-25-en>. [↑](#footnote-ref-1)