1. **IANA Trademarks and trademark registrations**

ICANN currently owns the following trademarks associated with IANA: INTERNET ASSIGNED NUMBERS AUTHORITY, IANA INTERNET ASSIGNED NUMBERS AUTHORITY (the “IANA Logo”) and IANA (collectively, the “IANA Trademarks”). ICANN owns one United States trademark registration for each of the IANA Trademarks, as set forth in the table be3low. There may be registrations in other jurisdictions. ICANN was the original applicant for these three registrations.

| **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. **How did ICANN come to own the IANA and INTERNET ASSIGNED NUMBERS AUTHORITY trademarks?**

ICANN and the University of Southern California (USC) entered into an agreement entitled “USC/ICANN Transition Agreement” (undated, “Effective Date” February 9, 2000).[[1]](#footnote-1) Pursuant to the Transition Agreement, USC agreed to assign to ICANN the marks INTERNET ASSIGNED NUMBERS AUTHORITY and IANA and the IANA Logo upon the Effective Date. USC executed an assignment, dated February 9, 2000, to ICANN 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. Details of these registrations[[2]](#footnote-2) 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 |

The Transition Agreement states, among other things: “The Internet Assigned Numbers Authority ("IANA") coordinates the Internet's address allocation, domain names, and protocol parameter assignment, and plays a central role in the management of the Internet's root server system. … The [NTIA] has authorized IANA to transition from its current status [as a research project] under USC/ISI to a nonprofit corporation. ICANN has been formed as a nonprofit corporation … to assume the functions previously performed by USC's IANA project. The NTIA has accepted a proposal pursuant to which ICANN will assume the IANA functions.”[[3]](#footnote-3)

1. **How does ICANN currently use the IANA Trademarks? [THIS SECTION UNFINISHED]**

ICANN acts as the “IANA Functions Operator” and performs a number of functions relating to the Internet’s naming, numbering and protocol parameters systems. A cogent description may be found in SAC067: Overview and History of the IANA Functions (15 August 2014), prepared by ICANN’s Security and Stability Advisory Committee.[[4]](#footnote-4) SAC067 cites to RFC 2860,[[5]](#footnote-5) the “Memorandum of Understanding Concerning the Technical Work of the Internet Assigned Numbers Authority” for its definition of IANA:

IANA - Internet Assigned Numbers Authority (a traditional name, used here to refer to the technical team making and publishing the assignments of Internet protocol technical parameters). The IANA technical team is now part of ICANN.

SAC067 goes on to state:

As described in the current IANA Functions contract between ICANN and NTIA, 6 the IANA Functions are: 1) Domain Name System (DNS) Root Zone Management; 2) Internet Numbers Registry Management; 3) Protocol Parameter Registry Management, including management of the “Address and Routing Parameter Area” (.ARPA) TLD; and 4) Management of the “INTernational treaty organizations” (.INT) top-level domain.[[6]](#footnote-6)

1. <https://www.icann.org/resources/unthemed-pages/usc-icann-transition-2012-02-25-en>. [↑](#footnote-ref-1)
2. 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 these registrations were allowed to become cancelled because the registrations had various issues, which were then resolved in the newer 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. [↑](#footnote-ref-2)
3. Transition Agreement, Recitals. [↑](#footnote-ref-3)
4. <https://www.icann.org/en/system/files/files/sac-067-en.pdf>. [↑](#footnote-ref-4)
5. <http://tools.ietf.org/html/rfc2860>. [↑](#footnote-ref-5)
6. SAC067, page 5. [↑](#footnote-ref-6)