

## **.Brand TLD Designation Application for .GMAIL**

Internet Corporation for Assigned Names and Numbers ("ICANN")  
12025 Waterfront Drive, Suite 300  
Los Angeles, California 90094  
Attention: New gTLD Program Staff

RE: Application for .Brand TLD Designation

Charleston Road Registry Inc. ("Registry Operator"), in connection with the execution of the Registry Agreement for the .GMAIL TLD (the "Registry Agreement"), hereby applies for the .GMAIL TLD [REDACTED] to be qualified by ICANN as a .Brand TLD.

Registry Operator confirms and represents to ICANN that the TLD meets each of the criteria for the TLD to be qualified as a .Brand TLD, as described in the .Brand TLD Application Process and Specification 13 attached thereto, and that all supplemental material accompanying this application is accurate and not misleading in any respect. Registry Operator also represents that the trademark registration attached hereto as Exhibit A and the registration policies attached hereto as Exhibit B are complete and accurate copies of the official trademark registration and Registry Operator's registration policies for the TLD, respectively.

Registry Operator also submits detailed information, including particular evidence, attached hereto as Exhibits C-D, supporting the TLD's satisfaction of the .Brand TLD criteria set forth below.

- i. **TLD and Trademark Identity.** The .GMAIL TLD string is identical to the textual elements protected by United States Trademark Registration for GMAIL (Reg. [REDACTED] (the "GMAIL mark"). See Exhibit A. In the United States, standard character marks consist only of words, letters, numbers, or combination thereof without claim to any particular font style, size, or color and thus consist only of textual elements, which in this case is GMAIL. [REDACTED]
- a. **Trademark Clearinghouse Entry.** Registry Operator's Affiliate Google Inc. owns and recorded the GMAIL mark including proof of use with the Trademark Clearinghouse, and such proof of use was verified by the Trademark Clearinghouse. A copy of the Signed Mark Data file (ID No. [REDACTED] issued by the Trademark Clearinghouse for the GMAIL mark is attached hereto as Exhibit C.
- b. **Trademark Ownership.** As detailed in its new gTLD application for the .GMAIL TLD, the statements and representations of which were expressly warranted as true and accurate by Registry Operator by submitting its application under the Top-Level Domain Application Terms and Conditions, Registry Operator is a wholly-owned subsidiary of Google Inc. Under the

Registry Agreement, "Affiliate" means a person or entity that, directly or indirectly, through one or more intermediaries, or in combination with one or more other persons or entities, controls, is controlled by, or is under common control with, the person or entity specified, and (ii) "control" (including the terms "controlled by" and "under common control with") means the possession, directly or indirectly, of the power to direct or cause the direction of the management or policies of a person or entity, whether through the ownership of securities, as trustee or executor, by serving as an employee or a member of a board of directors or equivalent governing body, by contract, by credit arrangement or otherwise. As the owner of all shares of Registry Operator, Google Inc. has the power to directly control the Registry Operator. Google Inc. is thus an Affiliate of Registry Operator, and is the owner of the United States trademark registration for the GMAIL mark.

- c. **Registration Timing.** The trademark registration for the GMAIL mark was issued on December 11, 2007 (See Exhibit A), well before ICANN opened its new gTLD application window on January 12, 2012 and the Registry Operator submitted its TLD registry application.
  - d. **Continuous Trademark Use.** Registry Operator's Affiliate Google Inc. and its predecessors have continuously used the GMAIL mark in connection with all of the services identified in the submitted trademark registration since at least as early as 2004, and Registry Operator intends to maintain such use through the Term of the Registry Agreement. Specimens showing Google Inc.'s use of the mark for the services identified in the submitted trademark registration are attached hereto as Exhibit D.
  - e. **No Punctuation.** The GMAIL mark does not begin with a period or dot. See Exhibits A, D.
  - f. **Trademark Unrelated To Registry Services.** Registry Operator's Affiliate Google Inc. and its predecessors have continuously used the GMAIL mark in connection with all of the services identified in the submitted trademark registration since at least as early as 2004, and Registry Operator intends to maintain such use through the Term of the Registry Agreement. See Exhibits A, D. The services identified in the submitted trademark registration and supporting specimens do not reference the provision of any TLD Registry Service, as defined in Section 2.1 of Specification 6 of the Registry Agreement.
- ii. **Registrants and DNS Record Control.** As detailed in its Registration Policies (See Exhibit B), only Registry Operator, its Affiliates or its Trademark Licensees are eligible to be registrants of domain names in the TLD and control the DNS records associated with domain names at any level in the TLD.
  - iii. **Non-Generic String.** The applied-for TLD GMAIL is not a Generic String TLD as defined in Specification 11 of the Registry Agreement. As defined in Section 3(c)

of Specification 11 of the Registry Agreement, "Generic String" means a string consisting of a word or term that denominates or describes a general class of goods, services, groups, organizations or things, as opposed to distinguishing a specific brand of goods, services, groups, organizations or things from those of others. "Gmail" is not a general class of goods or services, but is a specific brand of goods or services offered by Google Inc. At the United States Patent & Trademark Office,

[REDACTED]

Operator's Affiliate, Google Inc., holds a presumptively valid United States trademark registration [REDACTED] for the GMAIL mark, meaning that it is the opinion of the United States Patent and Trademark Office that the word GMAIL is not generic, and that it distinguishes a specific brand of services from the services of others. Indeed, no court of law has ever held that GMAIL is a generic term for any class of goods or services.

- iv. **Registration Certificate.** Registry Operator has provided ICANN with an accurate and complete copy of a United States trademark registration ([REDACTED]) for the GMAIL mark. See Exhibit A.

Registry Operator agrees that if Registry Operator makes any changes to its registration policies for the TLD (whether before or after this application has been approved) that may disqualify the TLD as a .Brand TLD, it will promptly provide ICANN with a complete and accurate copy of the revised registration policies. In addition, if Registry Operator fails to maintain the trademark registration underlying its .Brand TLD application, it shall promptly notify ICANN of such failure. Registry Operator also agrees to maintain the criteria required to qualify as a .Brand TLD and to immediately notify ICANN of any changes in circumstances that could alter the statements made, and supporting materials provide with, this application.

Registry Operator acknowledges and agrees that this letter is binding on Registry Operator and, if any of the foregoing representations and agreements becomes untrue or not complied with, it shall be deemed a breach of the Registry Agreement by Registry Operator, and ICANN may assert its rights under the Registry Agreement, including by determining that the TLD no longer qualifies as a .Brand TLD pursuant to the terms of Specification 13.

Questions about this request should be directed to [REDACTED]

Submitted by:  
Position:  
Dated:  
Email:

[REDACTED]

**Exhibit A**

**Trademark Registration**

Int. Cl.: 38

Prior U.S. Cls.: 100, 101, and 104

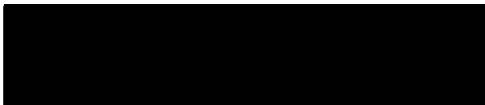
**United States Patent and Trademark Office**

Reg. No. 3,353,237

Registered Dec. 11, 2007

**SERVICE MARK  
PRINCIPAL REGISTER**

**GMAIL**



THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: ELECTRONIC MAIL SERVICES, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

SN 78-398,233, FILED 4-7-2004.

FIRST USE 4-1-2004; IN COMMERCE 4-1-2004.

GIANCARLO CASTRO, EXAMINING ATTORNEY

## **Exhibit B**

### **.Gmail TLD Registration Policies**

#### ***Mission***

The sole purpose of the proposed gTLD, .gmail, is to provide a dedicated Internet space where Google can continue to innovate on its Gmail offerings. The mission of the proposed gTLD is to provide a dedicated domain space in which to enact second-level domains that relate to a group of Gmail accounts associated with individuals or organizations. Second-level domains in the proposed gTLD, .gmail, will automatically be delegated to Google's DNS servers, which will in turn provide authoritative DNS responses pointing the user's web browsers and other communication software to Gmail's servers. The mission of the proposed gTLD is to simplify the Gmail user experience by facilitating the generation of new Gmail addresses, such as john@smith.gmail. This mission will enhance consumer choice by providing new availability in the second-level domain space, expanding Gmail's namespace, improving the Gmail user experience, and signaling the kind of communication services available to the owner of an @... Gmail account.

In addition, the .Gmail gTLD will clearly be differentiated from other gTLDs due to its purposefully limited scope. This differentiation includes:

- (1) a clear indicator that second-level domains within the gTLD offer a particular, targeted usage; and
- (2) because the gTLD will be associated with a Google offering, Internet users will immediately be able to rely on the quality of the product.

#### ***Registration Policies***

Registry Operator believes that the .Gmail gTLD will best add value to the gTLD space by remaining completely closed for use by Google. Second-level domain names within the proposed gTLD are intended for registration by Registry Operator, its affiliates and its trademark licensees.

Google's existing business and marketing decision-making channels will define policies and manage decisions, in accordance with the technical specifications in Registry Operator's agreement with ICANN, regarding the reservation, activation, allocation, registration and DNS Records of all domain names within the TLD. Once a name considered for reservation, activation, and/or registration has been reviewed and deemed in compliance with internal rules and procedures, the name will be approved by authorized employees of Google and submitted for reservation, activation, and/or registration through an ICANN-accredited registrar in accordance with the Registry Agreement. The registration and use of domain names in the gTLD will also be shaped by Registry Operator's:

- (1) Abuse prevention policy (available at <http://www.google.com/registry/policies/domainabuse/>); and
- (2) Privacy policy (available at <http://www.google.com/registry/privacy.html>).

If multiple parties affiliated with the Registry Operator express an interest in registering the same domain name, the designated personnel will make the decision regarding which party's registration and use of the domain name is a higher business priority.