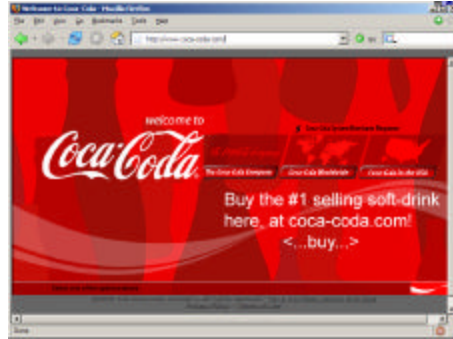


Trademarks Online

Domain names and beyond

Classic TM infringement



Traditional Trademark

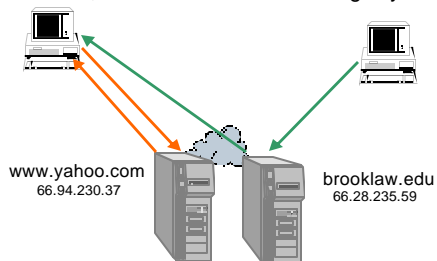
- Protection against likelihood of consumer confusion
 - Consumer protection: Help buyers to identify source of goods and services
 - Producer protection: Safeguard the goodwill that a producer builds by supplying quality goods or services
 - You can't sell similar goods with a similar name
- You'll get more detail in a trademark class!

TM Infringement

- TM owner must prove
 - It possesses a Mark
 - Defendant used the mark
 - ...in commerce
 - ...in connection with the sale, offering for sale, distribution, or advertising of goods or services
 - Use was likely to confuse consumers

Domain Names

- Mnemonic identifiers for computers on the Internet, maintained in a central registry



What's the problem?

- 1994, Joshua Quittner registers **mcdonalds.com**
 - ... and uses it to sell mail-order freeze-dried hamburgers
 - ... and uses it to criticize McDonald's for the unhealthy size of its portions
 - ... and puts 'Domain4Sale' in the contact information
 - ... and writes to both McDonald's and Burger King asking if they'd like to buy the name
 - ... if Burger King buys it and redirects it to bk.com
 - ... and does nothing at all
- If there's a problem, how should law address it?

Sources of TM “Law” Online

- Structure of the DNS
- UDRP
- National Trademark Law (U.S.)
 - Common Law
 - Lanham Act (infringement, unfair competition)
 - Federal Trademark Dilution Act
 - Anticybersquatting Consumer Protection Act



UDRP

- Arbitration-like proceeding, mandatory for domain name registrant if [¶ 4(a)]
 - (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
 - (ii) you have no rights or legitimate interests in respect of the domain name; and
 - (iii) your domain name has been registered and is being used in bad faith.

UDRP

- UDRP is relatively quick, cheap (~\$2,000)
- Complaining trademark owner files a complaint with dispute-resolution provider (WIPO, CPR, NAF, ADNDRC)
- Domain name registrant gets notice and opportunity to respond
- Panel (1 or 3 panelists) issues decision based entirely on written record: for complainant (usually transfer of domain name) or for respondent
- No appeal; If either party to a UDRP complaint is dissatisfied with the results, it can challenge the decision in court

UDRP

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 - (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
 - (ii) you have no rights or legitimate interests in respect of the domain name; and
 - (iii) your domain name has been registered and is being used in bad faith.
- Cara Mel registers **coca-coda.com**, intending to set up a website to sell her own sweetened fizzy drink.
- The Coca-Cola Company files a UDRP complaint.
- What happens if she has set up the website and accepted orders?
- If she has not yet posted anything at the site?
- If she has set up a site to “end dental decay”?

Beyond UDRP

- Trademark owner can go to court without ever going through the UDRP process
- Is UDRP congruent with federal trademark law?
 - Does it include all infringement/dilution?
 - Does it exclude all non-infringement/fair use?
- Do its panelists make the law correctly?
 - vivendiuniversalsucks.com “confusingly similar” to “Vivendi Universal”?

Beyond Infringement

- Dilution
 - “dilution of the distinctive quality” of a famous mark, even absent confusion
 - DUPONT shoes, BUICK aspirin, KODAK pianos
- Anti-Cybersquatting

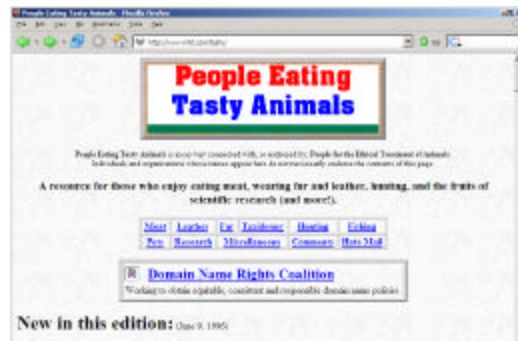
panavision.com



Dennis Toeppen:

“It was clear to me at the time that domain names were valuable, undeveloped virtual real estate.... It seemed to be an excellent opportunity to do the virtual equivalent of buying up property around a factory -- eventually the factory owner would realize that he needed the scarce resource which I possessed.”

peta.com



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terriwelles.com



```
META-TAGS: <title>Terri Welles Erotica</title>
<META NAME="description"
CONTENT="Playboy Playmate Of The Year
1981 Terri Welles website featuring erotic nude
photos, semi-nude photos, softcore and
exclusive Members Club"> <META
NAME="keywords" CONTENT="terri, welles,
playmate, playboy, model, models, nude, naked,
...
```

Nominative fair use

- Goods or services not readily identifiable without use of the trademark
- Defendant used only so much as is necessary
- Defendant did not suggest sponsorship or endorsement

fallwell.com



ACPA

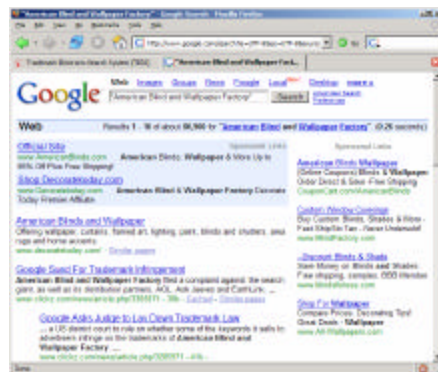
- Bad faith intent to profit by registration or use of
- Name identical or confusingly similar to distinctive mark or dilutive of famous mark
- 9 non-exhaustive bad faith factors, *but*
 - Bad faith intent ... shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

Trademark Dilution, ACPA

- Return to our friend Cara Mel and her domain **coca-coda.com**
- Coca-Cola skips UDRP and sues for infringement, dilution, and cybersquatting
 - What happens if she has set up the website and accepted orders?
 - If she has not yet posted anything at the site?
 - If she has set up a site to “end dental decay”?
 - If she makes fun of Coke’s ad campaigns?
-

whenu

- http://www.whenu.com/consumer_demo.html
- “SaveNow ads, which slide up in front of or behind your browser in a separate window, are always branded SaveNow and tell you they are coming from software - not websites. SaveNow ads are not endorsed or affiliated with anyone other than WhenU and may be competitive with some of the websites visited by you.”



What next for trademark law?