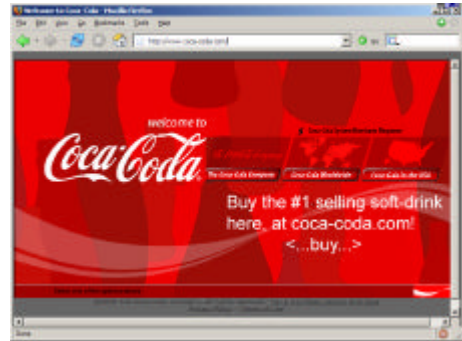


Trademarks Online

Domain names and beyond

Classic TM infringement



Traditional Trademark

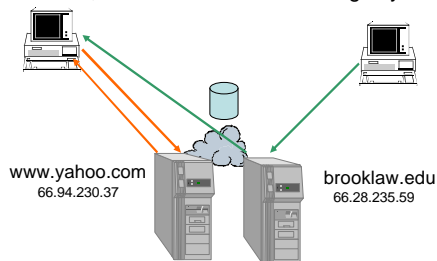
- Protection against likelihood of consumer confusion
 - Consumer protection: Help buyers to identify source of goods and services
 - Producer protection: Safeguard the goodwill that a producer builds by supplying quality goods or services
 - You can't sell similar goods with a similar name
- You'll 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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 - (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”?

Madonna.com

- Domain name pointing to “adult entertainment services”
 - “Madonna.com is not affiliated or endorsed by the Catholic Church, Madonna College, Madonna Hospital or Madonna the singer.”
- Gambling?
- Artistic depiction of the Virgin Mary?
- Madonna Rehabilitation Hospital?

ICANN's UDRP

- 4. Mandatory Administrative Proceeding.
- (a) Applicable Disputes. The complainant must prove:
 - (i) domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
 - (ii) no rights or legitimate interests in respect of the domain name; and
 - (iii) domain name has been registered *and* is being used in bad faith.
- (b) Evidence of Registration and Use in Bad Faith.
 - (i) registration / acquisition of domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant mark-owner or competitor; or
 - (ii) intent to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, with a pattern of such conduct; or
 - (iii) intent primarily to disrupt the business of a competitor; or
 - (iv) intent to confuse: attempt to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

ICANN's UDRP: Defenses

- 4. Mandatory Administrative Proceeding.
- (c) Demonstrate Your Rights to and Legitimate Interests in the Domain Name
 - (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
 - (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
 - (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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"?

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?
-

Beyond Infringement

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



What's the problem?

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 - ... and puts 'Domain4Sale' in the contact information
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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.org



ACPA: § 1125(d)

- 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.

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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



Alternatives

- Search engines
 - “Sponsored Results”?
 - Keyword sales to advertisers?
- Shared splash screen,
<http://www.scrabble.com/>
- Keywords (RealNames)

APPRAISEBAY.COM

- You have just been contacted by the owner of the domain name APPRAISEBAY.COM. Your new client has received a cease-and-desist letter from eBay, demanding that she cease use of the domain name. The letter, which claims trademark infringement and makes some pretty scary claims about what might happen if she doesn't comply.
- You don't currently see a website active at the domain name, and don't know what your client's plans are. What questions do you have before your first meeting with the client? What preliminary advice might you offer?

APPRAISEBAY

You meet with the client:

- She plans to offer to sell the domain to eBay
- She plans to use the domain for her real estate appraisal business, located in Buzzard's Bay, RI
- She plans to allow users to auction knick-knacks to other users
- She plans to offer her valuation services to appraise items offered for sale on eBay
- She plans to criticize eBay's privacy and anti-fraud policies

APPRAISEBAY

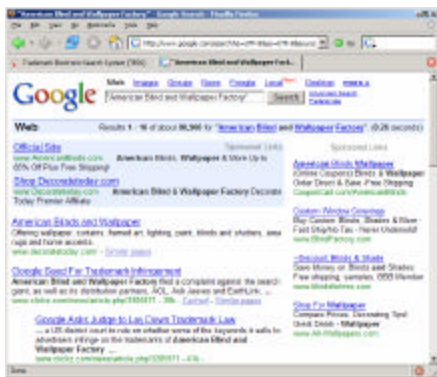
Switch hats and play counsel to eBay, which doesn't like the name *whatever* use (or non-use) it's put to.

- What would be your client's chances in a UDRP proceeding or Federal lawsuit right now, when there is no visible use of the name?

What next for trademark law?

Trademark

- **Infringement**
- Protect: Any TM
- Plaintiff must show:
 - D used in commerce
 - In connection with sale/etc.
 - Likely to cause consumer confusion
- Scope: class of goods or service, where use or likely expansion
- **Dilution**
- Protects: Famous marks
- Plaintiff must show
 - P has famous mark
 - P's mark is distinctive
 - D made "commercial use in commerce"
 - Began after P's mark became famous
 - Causes dilution of the distinctive quality of the mark
- Scope: all goods and services



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