

Trademark 5

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EXAM

- Thursday, Nov. 15 at 9 a.m.
- Open-book, open-notes, no online search
- Office Hours: This afternoon, any (reasonable) time Friday, or call/email: 914.374.0613 cell-phone
- If you're using a computer, do the SecurExam "practice exam" to test the software by tomorrow

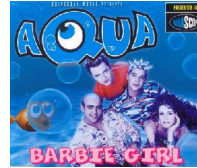
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Trademark

- **Infringement**
- Protects: 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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Mattel v. MCA Records (Speech-Zilla meets Trademark Kong)



- Infringement?
- Dilution?
- First Amendment

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Nominative and non-trademark use



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Tom Forsythe, Food Chain Barbie



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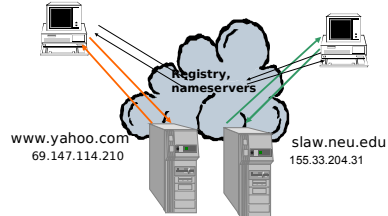
Domain Names and TM

- First, a quick look at domain names
 - neu.edu
 - whitehouse.gov
 - seltzer.org
 - yahoo.com
 - mta.info
 - del.icio.us
 - yahoo.fr

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Domain Names

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



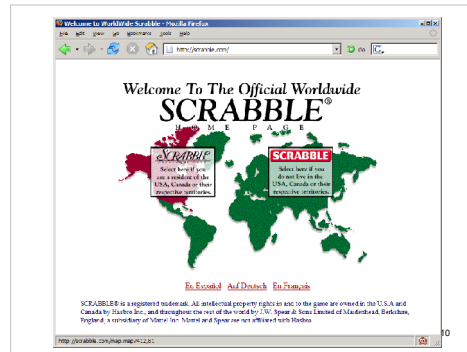
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What's the problem?

- 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?

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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."

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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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Bad Faith: § 1125(d)(1)(B)

(B) (i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

- (I) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
- (III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
- (IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
- (V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;
- (VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;
- (VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;
- (VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly

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Shields v. Zuccarini

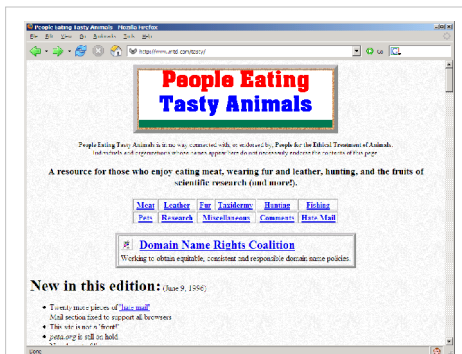
Shields:

- joecartoon.com

Zuccarini:

- joecartoon.com,
- joecartoon.com,
- joescartons.com,
- joescartoons.com and
- cartoonjoe.com
- This is a page of POLITICAL PROTEST
- Against the web site joecartoon.com
- joecartoon.com is a web site that depicts the mutilation and killing of animals in a shockwave based cartoon format – many children are lured to the web site, not knowing what is really there and then encouraged to join in the mutilation and killing through use of the shockwave cartoon presented to them.

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ACPA

- Qualified mark?
 - distinctive or famous
- Interference?
 - identical or confusingly similar to distinctive
 - or dilutive of famous
- Bad faith registration or use?

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