

## Trademarks Online

Domain names and beyond

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## Classic TM infringement



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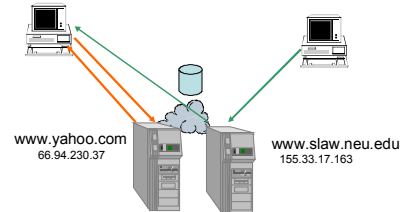
## Traditional Trademark

- 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!

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## Domain Names

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



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## What's the problem?

- 1994, Joshua Quittner registers **mcdonalds.com**
- If there's a problem, how should law address it?
- When should we do something?
  - On registration
  - On use

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## Sources of TM "Law" Online

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

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## 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

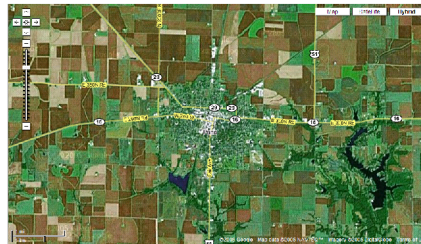
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## Infringement?

- panavision.com

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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."

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## Beyond Infringement

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

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## Dilution § 1125(c)

- (c) Dilution by blurring; dilution by tarnishment.
  - (1) Injunctive relief. Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

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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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## 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

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