

# FIFTEEN YEARS OF FAME: THE DECLINING RELEVANCE OF DOMAIN NAMES IN THE ENDURING CONFLICT BETWEEN TRADEMARK AND FREE SPEECH RIGHTS

*Jude A. Thomas*<sup>a1</sup>

## ABSTRACT

Domain name disputes have been the subject of substantial litigation, legislative action, and scholarly debate over the course of the past fifteen years. Much of the debate is the product of disagreement concerning whether trademark rights naturally extend into the domain name space and to what extent those rights are limited by principles of free speech. Gripe sites are paradigmatic examples of this debate. Society's investment in defining these rights continues to grow, even as the relevance of domain names may be declining, due to: (1) changes in the way users locate content on the Internet; (2) the growth of social media and its consequent de-emphasis on top level domain names; and (3) the dilution of the domain name space.

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a1. Intellectual property attorney and LL.M. candidate at the University of Akron School of Law. The author would like to thank Professors William D. Rich and Jeffrey M. Samuels for their invaluable guidance.

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DISPUTES IN THE ENDURING STRUGGLE BETWEEN TRADEMARK AND FREE  
SPEECH RIGHTS

*Jude A. Thomas*

*[T]he lightning speed development of the Internet poses challenges for the common-law adjudicative process – a process which, ideally while grounded in the past, governs the present and offers direction for the future based on understandings of current circumstances. Mindful of the often unforeseeable impact of rapid technological change, we are wary of making legal pronouncements based on highly fluid circumstances, which almost certainly will give way to tomorrow's new realities.<sup>1</sup>*

INTRODUCTION

Imagine, if you will, a vast expanse of untouched and highly-accessible land that has recently been made available for development. We will call this fictional land “New Domainia.” The potential of this unique and virginal tract of land is enormous and its value is recognized by several parties with competing interests. First, there are those who wish to erect forums for cultivating free speech. They argue that the land should be open for use by all members of the public, because its accessibility provides an enormous opportunity for the exchange of ideas. These are the “Activists.” A second group seeks to use the land for private commercial interests that will render profits and increase the public’s access to its goods and services. This group argues that it has a right to use the new property because it provides a natural and obvious zone of expansion for its adjoining commercial developments. We will refer to these as the “Commercialists.” Finally, a third group consists of those who have no desire to make use of the land in any manner that is beneficial to the public; rather, they seek to monetize it, primarily by

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1. Name.Space, Inc. v. Network Solutions, Inc., 202 F.3d 573, 584 (2d Cir. 2000).

reselling the property to the highest bidder or by diverting traffic away from the Commercialists' nearby businesses. We will label these the "Squatters."

The property is uniquely suited for use by all three groups and the legislature soon realizes that its existing zoning laws are not adaptable to development and regulation of property of this nature. Lawmakers hasten to draft novel zoning laws for New Domainia, but in the interim, the agency charged with subdividing and distributing the land has already begun to sell tracts at very low prices. Many of the early adopters are the Squatters, who engage in a kind of land rush. This is particularly vexing to the Commercialists, especially when parcels directly adjacent to their own commercial properties are sold to the Squatters. Likewise, some Activists who are opposed to the Commercialists' views or practices obtain parcels of land immediately adjacent to the Commercialists' holdings, which they use as venues to protest the Commercialists. In doing so, the Activists easily attract the attention of potential consumers of the nearby Commercialists' goods and services.

Land in New Domainia continues to be divided and sold inexpensively to thousands of purchasers. The resulting tension among competing interests leads to substantial litigation. Eventually, the legislature does enact laws designed to protect the business goals of the Commercialists and the free speech goals of the Activists, while preventing the Squatters from using the land in a manner that is bereft of benefit to the public. For the most part, the laws are effective in accomplishing these goals, but they also spawn several new difficulties. Foremost, the new laws are broadly articulated and tribunals sometimes have difficulty distinguishing between the Activists' legitimate free speech objectives and the more nefarious goals pursued by the Squatters. As a result, many Activists are mislabeled as Squatters and their land is confiscated under the new legislation. Further, the new zoning laws are not the sole legal

framework applicable to the distribution of the land. Due to the unique geographic nature of New Domainia, which stretches across international borders, disputes over ownership are also brought before an international arbitration forum. This forum is highly streamlined and its panels provide expedited decisions in New Domainian land disputes, but these decisions are not always in harmony with the growing precedent built upon the local zoning laws. For that matter, the arbitration forum's decisions are often inconsistent from one panel to the next.

Ultimately, the streamlined nature of the arbitration forum, the rapidly growing appreciation for the value of land in New Domainia, and the legal uncertainty over ownership rights combine to yield even more litigation. The number of disputes decided by tribunals increases every year and this persists for a dozen or so years. The parties who walk away from these disputes are often disgruntled. The Activists frequently cannot afford the cost of defending their rights to own land in New Domainia and consequently they simply capitulate when confronted with lawsuits. The Commercialists are better funded, but they often find themselves the victims of delay in failing to capitalize upon opportunities for expansion into the new realm. Finally, the Squatters are bluntly forced out of the equation under the new legislation.

New Domainia has proven to be a valuable resource for all three competing interests, but at substantial cost. It is ultimately divided in a manner that is somewhat haphazard and critics argue that despite the best intentions of the legislature, the result is a *mélange* of property interests that are not well-defined or ideally utilized. This is particularly frustrating to the public at large, who encounter uncertainty in seeking out establishments in New Domainia.

And then an interesting thing happens. While the skirmishes are happening in New Domainia, parallel tracts of land are gradually being developed nearby. These new developments, located outside of New Domainia, are governed by a different model, largely

managed by private interests rather than the legislature. The zoning laws and dispute resolution process enacted to govern disputes in New Domainia does not extend to the new territories. Commercialists, Activists, and Squatters continue to purchase, utilize, and squabble over land in New Domainia, but the public increasingly shifts its attention to the new privately-managed territories, which appear to provide a more predictable gateway. This shift is encouraged by the developers of the new territories, who seek to capture revenue by diverting the public – and correspondingly those entities that compete for the public’s attention – to the newer realms. In response, Commercialists and Activists begin to focus their resources on expansion and visibility outside of New Domainia. In less than two decades, New Domainia has transitioned from an untouched land of seemingly limitless opportunities to realm troubled by litigation, uncertainty, and declining relevance.

This rather lengthy analogy serves to illustrate the past, present, and likely near-future of domain name disputes. With the rapid growth of the Internet and the World Wide Web in the 1990's came a new medium in which users found opportunities for both commercial enterprise and the exercise of free speech. Businesses discovered a new market through which to promote and sell their goods and services, while speech advocates recognized the Internet as a new and powerful tool through which to assert their First Amendment rights. Like New Domainia, the Internet provided an enormously valuable new territory for these groups.<sup>2</sup> To businesses, it was a previously unimagined retail tool of instantaneous global reach. To speech advocates, it was an inexpensive and easily-accessible platform for expressing views to a vast audience, placing activists essentially on par with corporations, governments, and other well-funded entities in the

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2. See, e.g., *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1168 (C.D. Cal. 1998) (stating the Internet “is an efficient means for business to disseminate information, but it also affords critics of those businesses an equally efficient means of disseminating commentary”).

advocacy arena. To both, domain names became critical gateways to the content that they posted on the Internet, because they provided a simple means for Internet users to locate that content.

From the beginning, the registration of domain names provided early entrepreneurs with an opportunity to make virtual land grabs. This virtual land rush has been likened to the rapid settlement of land that accompanied the Homestead Act.<sup>3</sup> Under the Act, any person could claim up to 160 acres of public land, provided that they settled the land and occupied it continuously for five years.<sup>4</sup> Apart from the costs associated with improving and protecting the land, homesteaders were required to pay only a nominal filing fee to acquire rights to settle the land.<sup>5</sup> This resulted in the conversion of millions of acres of prairie land into prosperous farm land and unified the nation through the integration of remote territories into states.<sup>6</sup> However, the Homestead Act suffered from many failings as well, among them its abuse by large corporate entities which used it to increase the size of their holdings at the expense of other, less well-funded entities that might have benefitted from the use of the land.<sup>7</sup>

In a similar fashion, the adoption of domain names has helped the Internet proliferate and unify, but the associated low-cost virtual land rush has been vulnerable to abuse. Corporate entities have sought to control premium domain spaces in their own economic interests, sometimes at the expense of others with legitimate and arguably more altruistic intentions. At the same time, bad faith registrants have obtained domain names as a means to trade upon the good will of trademark owners. One manner in which this has been accomplished is through the

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3. Homestead Act, ch. 75, 12 Stat. 392 (expired 1986). See Ned Snow, *The Constitutional Failing of the Anticybersquatting Act*, 41 WILLAMETTE L. REV. 1, 54-55 (2005); Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715, 763 (2003); Alfred C. Yen, *Western Frontier or Feudal Society?: Metaphors and Perceptions of Cyberspace*, 17 BERKELEY TECH. L.J. 1207, 1225-32 (2002).

4. WILLARD WESLEY COCHRANE, *THE DEVELOPMENT OF AMERICAN AGRICULTURE: A HISTORICAL ANALYSIS* 81 (2d ed. 1993)

5. *Id.*

6. See JASON PORTERFIELD, *THE HOMESTEAD ACT OF 1862: A PRIMARY SOURCE HISTORY OF THE SETTLEMENT OF THE AMERICAN HEARTLAND IN THE LATE 19TH CENTURY* 5 (2005).

7. COCHRANE, *supra* note 4, at 82.

registration of domain names identical or confusingly similar to the trademarks of others. Such domain names can be used to divert consumer traffic to commercial websites not affiliated with the owners of those trademarks. In addition, domain names of this nature have been registered and leveraged as means to extort money from interested trademark owners, a phenomenon commonly known as cybersquatting.<sup>8</sup>

The real property analogy is not perfect, however. The distinction between real property disputes and domain name disputes is one of ownership compared to entitlement. Generally, real property lines are readily ascertainable. Moreover, real property disputes are rarely concerned with the entitlement to possess or use real property, except where eminent domain issues and zoning regulations are concerned. In contrast, domain name rights are mitigated by both trademark rights and by the First Amendment. Consequently, rights to possess domain names yield to issues of entitlement and correspondingly virtual property rights are far less absolute. The interplay between trademark rights and the First Amendment presents particular challenges in determining where such entitlement lies.

One product of the evolution in speech that arrived with the World Wide Web was the emergence of Internet gripe sites. Legitimate Internet gripe sites are websites that are utilized to criticize others, express controversial opinions, and raise awareness of matters of public interest. The practice of utilizing domain names for this purpose is sometimes referred to as cybergripping. The targets of gripe sites are most often corporations and recognizable public figures. Despite

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8. See *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 204 (6th Cir.2004) (stating "cybersquatting occurs when a person other than the trademark holder registers the domain name of a well-known trademark and then attempts to profit from this by either ransoming the domain name back to the trademark holder or by using the domain name to divert business from the trademark holder to the domain name holder").

the propensity of critical speech to raise the ire of its target, it is nevertheless entitled to the full protection of the First Amendment.<sup>9</sup>

Trademark owners (Commercialists), cybergrippers (Activists), and cybersquatters (Squatters) have all sought to make use of domain names as a form of valuable real estate in cyberspace. Disputes over domain names have been the cause of much consternation for judicial and arbitral bodies and a great deal of criticism has been leveled at inconsistent regulation in this realm.<sup>10</sup> At the most fundamental level, cybergripping is a legitimate unauthorized use of trademarks for the purpose of conveying critical speech. In contrast, cybersquatting is simply the misuse of trademarks for personal gain. The devil is in the details, however, as distinctions between the two sometimes prove to be elusive.

This difficulty has been the cause of substantial debate concerning the appropriate balance between trademark rights and free speech rights in the context of domain name disputes, much of which has centered upon interpretation of the statutory language that has been adopted to address these disputes. New national and international legal frameworks were drafted in the 1990's to attempt to curtail cybersquatting and strike a fair balance between free speech and trademark rights. Today, enforcement under those frameworks remains very active, but tribunals often render decisions that are inconsistent.

Some fifteen years of furious litigation and scholarly debate have passed since the first domain name disputes. Despite the legal and economic significance of this period, disputes over domain names may ultimately amount to an ephemeral phase in the evolution of the law in

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9. See *Cohen v. California*, 403 U.S. 15, 25 (1971); see also *Bose Corp. v. Consumers Union*, 466 U.S. 485 (1984).

10. See Jacqueline D. Lipton, *Bad Faith in Cyberspace: Grounding Domain Name Theory in Trademark, Property, and Restitution*, 23 HARV. J.L. & TECH. 447, 457-62 (2010); see also Adam Goldstein, Note, *ICANNsucks.biz (And Why You Can't Say That): How Fair Use of Trademarks in Domain Names is Being Restrained*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1151, 1165 (2002); see also Jonathan Band & Matthew Schruers, *Toward a Bright-Line Approach to [Trademark]sucks.com*, 20 COMPUTER & INTERNET LAWYER 1, 1 (2003).

response to the growth of an ever-evolving Internet, an effect largely attributable to the gradual attenuation of the importance of domain names to the public. There are several phenomena that may contribute to this effect. First, technological spaces on the Internet continue to emerge and broaden. These spaces, which include blogs and other social media like Facebook and Twitter, fall outside of the scope of the current legislation available to govern domain name disputes, providing new outlets for exploitation by trademark owners, cybergrippers, and cybersquatters. Second, the nature of search on the Internet is evolving in a manner that diminishes the relevance of domain names as tools to locate content on the World Wide Web. This is largely attributable to the expanding number of domain names that are in use and to the explosive growth of Google's search services as an alternative means to locating content. Finally, a recent mandate to add a broad new component arm to the current domain name system will potentially introduce thousands of new organization-specific domain names. In turn, this may lead to a kind of dilution of the domain name system that is ultimately more frustrating than useful to the public.

This article traces the path of domain name disputes over the past fifteen years, with a particular focus on the conflict between free speech and trademark rights. It then considers changes that are underway in the manner in which domain names are employed and how this may affect their use or disuse in the future. Part I of the article provides an overview of the domain name system and the technical nature of gripe sites. Part II briefly surveys the tension between trademark rights and free speech rights. Part III examines the legal frameworks that have been used to balance these rights in the context of domain name disputes, while Part IV analyzes the difficulties judicial and arbitral bodies have experienced in reaching determinations in such disputes when free speech is a factor. Part V considers several factors that may contribute to a lessening of the significance of domain names to the public. Finally, Part VI

offers some predictions about the impact that these factors may have upon free speech and trademark rights.

## I. TECHNICAL BACKGROUND

### A. *The Domain Name System*

In the broadest sense, the domain name system is simply a hierarchical naming system. Every computer connected to the Internet is assigned a unique numerical identifier known as an internet protocol (IP) address.<sup>11</sup> IP addresses serve to identify individual computers and make it possible for computers to locate one another on the internet. These addresses consist of four numeric strings ranging from 0 to 255, separated by periods, for example, 72.32.89.241. A portion of each IP address represents the network that the computer utilizes, and the remaining portion identifies the individual server machine where the hosted web content resides.

Because it would be difficult to remember the numeric addresses which computers utilize to locate one another via the Internet, an addressing system known as the Domain Name System (DNS) was developed to associate IP addresses with more memorable domain name addresses consisting of alphanumeric text.<sup>12</sup> When an Internet user types a domain name into the address box of a web browser, a request is sent to a remote domain name server to query the IP address associated with that domain name. The name server then reports the IP address to the browser and the browser attempts to make a connection to the computer located at that numeric address. In this sense, a name server acts as a sort of automated phone book for Internet users. Once the domain name is translated into an IP address and the connection is made, web content stored on the remote computer is sent to the user's browser and a web page appears.

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11. For a more detailed overview of the domain name system, see PRESTON GRALLA, HOW THE INTERNET WORKS 29-33 (Stephanie J. McComb, Kevin Howard, et al. eds., Que Publishing 2007) (1998).

12. See *Id.* at 29-33.

In the above example, the IP address 72.32.89.241 is the location of a computer that hosts content located at <www.law.com>. Thus, if a user types <www.law.com> into a browser address box, the user's browser will report <law.com> to a name server and request the associated IP address, and it will be informed that the user's desired content is located on a server located at 72.32.89.241.<sup>13</sup> The user's browser then requests and is provided with content including html code, images, etc., which are integrated by the user's browser to render the Law.com web page.

The significance of domain names in this context is obvious: users rely on domain names to guide them to websites easily and website creators, in turn, register memorable domain names that they hope will serve as gateways to their content.

### *B. The Structure of Domain Names*

Domain names may be broken into two primary segments: a top level domain (TLD) and a second level domain (SLD). For example, in the address <BMW.com>, the top level domain is .com, while the second level domain is BMW. The most common TLDs are generic TLDs (gTLDs), which include .com, .net, and .org, among others.<sup>14</sup> Together, the TLD and SLD form the most frequently-recognized segment of a web page address. A full web page address is also commonly referred to as a URL, short for uniform resource locator, which might appear as <http://www.BMW.com>.

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13. Most, if not all, browsers will also recognize an IP address entered directly. Thus, if a user enters 72.32.89.241 into a browser address box, the browser will access and load content from Law.com's server immediately without first performing a DNS query.

14. Some additional generic top level domains include .edu, .biz, .gov, .info, and .aero. Non-generic top level domains include the country code top level domains (ccTLDs) such as .ru (Russia) and .it (Italy) and the internationalized top level domains (iTLDs), which contain special characters, such as the Cyrillic alphabet characters ф and И. This discussion will focus primarily on gTLD's, as these are typically the subject of gripe site disputes.

Third level domains, also referred to as subdomains, exist as well. For example, the term "corporate" is a subdomain in the following URL: <http://corporate.BMW.com>. Finally, a complete website address may also contain a "path" or "resource path," which provides direction to a specific resource located on the given server.<sup>15</sup> In the following fictitious URL, "owners-manual.pdf" is the resource path: <http://www.BMW.com/owners-manual.pdf>.<sup>16</sup> For purposes of this article, the use of the phrase "domain name" will refer solely to the commonly-recognized combination of a top level domain and second level domain, e.g., <BMW.com>.

### *C. The Nature of Gripe Sites*

When domain name disputes arise and free speech is a central concern, gripe sites are often the subject of such disputes. Most broadly defined, a gripe site is any Internet website that is used as a platform for critical speech. Both informal consumer complaint clearinghouse websites like <www.ripoffreport.com><sup>17</sup> and long-established consumer review sites like <consumerreports.org> could be considered gripe sites, since these sites contain comments of public interest about products and services. The web contents of such sites – that is, the text and media that appear on the pages of those sites – necessarily include the trademarks of others, in order to identify the entity that is the subject of the site's criticism. This alone is a common cause for concern for trademark owners who closely guard the use of their marks.

More often, however, the term gripe site is used to refer to a website that not only contains content concerning the target of its criticism, but also makes use of the target's name

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15. Some panels and courts have also referred to resource paths as "post-domains," in reference to the fact that this portion of the URL occurs to the right of the domain name. *See, e.g., Romantic Tours, Inc. v. Whois Privacy Protection Service, Inc.*, NAF Claim No. FA1003001316557 (April 28, 2010).

16. Dies ist eine Seite nicht gefunden.

17. Notably, several attempts to shut down the website <www.ripoffreport.com> have failed. *MCW, Inc. v. Badbusinessbureau.com, LLC*, 2004 WL 833595 (N.D. Tex. 2004); *Hy Cite Corp. v. Badbusinessbureau.com, LLC*, 418 F. Supp. 2d 1142 (D. Ariz. 2005); *Global Royalties, Ltd. v. Xcentric Ventures, LLC*, 2007 WL 2949002 (D. Ariz. 2007); *GW Equity, LLC v. Xcentric Ventures, LLC*, 2009 WL 62173 (N.D. Tex. 2009).

within the domain name that is associated with the gripe site, e.g., <walmart-sucks.com>.<sup>18</sup> Such use is the most frequent basis for gripe site domain name disputes asserted by trademark owners. For purposes of this discussion, gripe site domain names that incorporate some variation of a trademark may be referred to as incorporative gripe site domains. Such domain names typically appear in four forms, one of the most common and most disputed forms being the trademark-identical or <trademark.com> variety, in which the second level domain is identical to the trademark owned by the target of the gripe site, e.g., <pepsicola.com>. Both cybergrippers and cybersquatters usually succeed in registering domain names of this variety by acquiring them before the trademark owner commences to obtain the domain itself (the land rush approach), or through the use of a parallel top level domain like .net or .org., e.g., <pepsi.net> (the alternate TLD approach). Upon encountering a <trademark.com> gripe site domain, an otherwise-unaware Internet user may assume that it is affiliated with or endorsed by a trademark owner whose mark it is identical to, at least until that user views the associated gripe site content. Websites utilizing the <trademark.com> format typically attract a high volume of traffic, particularly when the corresponding trademark is well-known.

The second category of incorporative gripe site domain names appear in the form <trademark+pejorative.com>, for example <walmart-sucks.com> and <stopBP.com>. These are often referred to simply as <trademark-sucks.com> domain names. Critical speech is inherent and immediately recognizable in this form: the pejorative term strongly implies a link to a site expressing discontent. Users who view such domains are less likely to believe that the domain name is affiliated with or endorsed by the targeted trademark owner when they encounter them.

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18. By their very nature, gripe sites and Internet content as a whole tend to be ephemeral. It is likely that by the time this article is published and disseminated, some of the references provided here as examples will have passed into the cyber-ether.

A third and related category are those gripe site domain names that appear in the form <trademark+modifier.com>, in which the modifier is a term that is not clearly pejorative. Initially, it is more difficult for an Internet user to determine whether a domain name of this nature is being used as a source indicator by a trademark owner or as a gateway to speech about the trademark owner. For example, <walmartwatch.com> suggests equal possibilities for endorsement by or critical comment concerning Wal-Mart,<sup>19</sup> as does <askwalmart.com>.<sup>20</sup>

Finally, gripe site domain names may appear in typosquatted format, whereby the domain name is an intentional close misspelling of the target trademark owner's mark. Examples might include <generalelectric.com>, <google.com>, and <wwwsears.com> (note the missing dot in the third example). The practice of typosquatting, more commonly utilized by cybersquatters, has occasionally been adopted by cybergrippers as a means to attract a larger audience to their speech.<sup>21</sup>

It is worth noting that while this discussion focuses on gripe sites, gripe sites have close cousins in parody sites and fan/enthusiast sites. Parody sites largely form a sort of subcategory of gripe sites, with subtle differences in the approach employed by their creators. Fan sites, by contrast, are usually created to pay homage to celebrities, authors, artists, and products, although there is sometimes a commercial motive as well. The latter typically contain information and media related to the well-known person or group and may include creations inspired by their work. These sites, and often the domain names at which they are hosted, incorporate the trademarks of the artist or author. The intended expression inherent in parody sites, gripe sites,

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19. As it happens, <walmartwatch.com> falls into the latter category. It is part of a “campaign to challenge the world’s largest retailer, Wal-Mart, to become a better employer, neighbor, and corporate citizen.” See About Wal-Mart Watch, <http://walmartwatch.com/pages/about> (last visited December 24, 2010).

20. Likewise, <askwalmart.com> was created by “Concerned New Yorkers Asking Questions and Demanding the Truth from Walmart.”

21. See, e.g., *Lamparello v. Falwell*, 420 F.3d 309, 316 (4th Cir. 2005) (gripe site operator registered <fallwell.com>, an intentional misspelling of Reverend Jerry Falwell’s name and website <falwell.com>).

and fan sites is different, but the manner of use of domain names in association with such sites is often identical. Consequently, domain name disputes concerning parody sites and fan sites tend to involve legal arguments and judicial treatment that is similar to gripe site domain name disputes.<sup>22</sup>

The focus of this article on gripe sites is partly for simplicity, but also due in part to the greater attention that gripe sites tend to receive as the subject of mainstream litigation. This effect is likely due to the heightened protections that this form of speech – critical speech – receives under the First Amendment and the substantial harm that such speech may cause trademark owners.

## II. THE TENSION BETWEEN TRADEMARK AND FREE SPEECH RIGHTS

### *A. Historical Context*

On a fundamental level, trademark rights and free speech rights have enjoyed a rocky relationship. The First Amendment protects the expression of speech, while trademark law provides a restraint on the expression of speech by granting trademark owners limited exclusive rights to the use of words and symbols.

Our founding fathers included an express provision in the Constitution for the protection of free speech, which is as succinct as it is eloquent. The First Amendment decrees: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; *or abridging the freedom of speech*, or of the press; or the right of the people peaceably

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22. See, e.g., *Kevin Spacey v John Zuccarini*, NAF Claim No. FA0103000096937 (May 8, 2001) (ordering transfer of <kevinspacey.com> to actor Kevin Spacey); *Estate of Gary Jennings and Joyce O. Servis v. Submachine and Joe Ross*, WIPO Case No. D2001-1042 (Oct. 25, 2001) (denying transfer of <garyjennings.com> to the owners of deceased author’s intellectual property); *Utah Lighthouse Ministry v. Foundation for Apologetic Information & Research*, 527 F.3d 1045 (10th Cir. 2008) (affirming that the safe harbor provision of the Anticybersquatting Consumer Protection Act protected Defendants’ parody site).

to assemble, and to petition the government for a redress of grievances.”<sup>23</sup> Though concise, this provision stands on the shoulders of thousands of years of democratic ideology dating at least as far back as ancient Greece. Perhaps because of this, disputes concerning the extent and nature of the right to engage in free speech tend to be as much philosophical as they are political.

Justifications for free speech may be said to include: (1) promoting the search for truth; (2) encouraging individual autonomy through self-expression or self-realization; and (3) enabling democratic self-rule.<sup>24</sup> Critical speech fits squarely within these theories. Specifically, the search for truth has been said to include the need to protect dissident speech and promote adversarial dialogue.<sup>25</sup> Essentially, individuals cannot test societal conventions without the freedom to express ideas contrary to those conventions. This approach has sometimes been characterized as the marketplace for ideas.<sup>26</sup> Similarly, the quest for individual autonomy relies upon freedom from the restraint of one’s opinion. Autonomy is the product of self-development through the exercise of an inherent human right: the right to express oneself.<sup>27</sup> Expression, by definition, includes opinion, and opinion necessarily includes criticism. Finally, the protection of critical speech, particularly speech critical of government, may be viewed an essential component of democracy. However, scholars disagree as to the breadth of this third theory: some attribute an expansive definition, concluding that all speech concerning issues of public interest must be permitted for effective self-government in a democracy; others argue that only speech explicitly concerned with political matters is protected by the First Amendment under this theory.<sup>28</sup>

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23. U.S. CONST. amend. I (emphasis added).

24. See KEITH WERHAN, FREEDOM OF SPEECH: A REFERENCE GUIDE TO THE UNITED STATES CONSTITUTION 28-38 (Praeger Publishers 2004).

25. *Id.* at 32-34.

26. *Id.* at 35.

27. *Id.* at 35-37.

28. *Id.* at 29-31.

In any event, only the narrowest justifications among theories supporting the protection of free speech could be said to arguably exclude critical speech. Correspondingly, American jurisprudence has historically been firmly protective of those who engage in speech that is of a critical nature.<sup>29</sup> Such protection has been particularly generous in those instances in which the target of the criticism is a business or public figure.<sup>30</sup>

Legitimate gripe sites are paradigmatic for protected critical speech: they provide an easily-accessible and widely distributed forum for identifying issues concerning people and enterprises that are of interest to the public. Typically, the targets of gripe site criticism are businesses and recognized public figures.

In contrast to free speech rights, trademark rights are not explicitly referenced in a provision of the U.S. Constitution. The Progress Clause<sup>31</sup> of the Constitution has been interpreted to grant Congress the power to regulate other forms of intellectual property rights, namely copyrights and patents, but the Supreme Court has held that there is no similar grant of authority in this clause permitting Congress to regulate trademarks, because they do not qualify as "the fruits of intellectual labor . . . ."<sup>32</sup>

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29. See *Whitney v. California*, 274 U.S. 357, 377 (1927) (stating "[i]f there be time to expose through discussion the falsehood and fallacies, to avert the evil by the process of education, the remedy to be applied is more speech, not enforced silence"); *SNA, Inc. v. Array*, 51 F. Supp. 2d 554, 565 (E.D. Pa. 1999) (injunction against defendant's criticism of plaintiff's product denied because "the public interest favors robust criticism of plaintiffs' [product]"); *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (stating "just because speech is critical of a corporation and its business practices is not a sufficient reason to enjoin the speech"); *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003) (stating "the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business"); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir.1987) (stating that if a statute could "enjoin the use of [a] mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct").

30. Even speech that is false and defamatory has been granted limited protection under the First Amendment, when it involves a public official or public figure. See, e.g., *New York Times v. Sullivan*, 376 U.S. 254, 279-280 (1964); *Curtis Publishing Co. v. Butts*, 388 U.S. 130 (1967).

31. Progress Clause, U.S. CONST. art. 1, § 8, cl. 8.

32. *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

However, in the late 1800's, Congress narrowed existing U.S. trademark law by adding a provision that limited the federal government's power to regulate only those trademarks which are used in interstate commerce.<sup>33</sup> This added requirement placed trademark regulation squarely within the scope of the Commerce Clause, which allows Congress "[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes."<sup>34</sup> The derivation of authority from this clause remains the basis for trademark rights today: the "use in commerce" requirement fundamental to securing and maintaining trademark registrations has survived all subsequent revisions of U.S. trademark law and it persists in the current statute.<sup>35</sup>

Like free speech rights, the justifications for trademark rights are also grounded in differing philosophies. One view suggests that trademark law exists to protect consumers from confusion and deception by providing reliable indicators of the sources of goods and services in the marketplace.<sup>36</sup> Others hold that trademark law should protect the producers of those goods and services from the misappropriation of the goodwill that they have worked to create.<sup>37</sup> Most contemporary theorists agree that these goals, by necessity, function in harmony.<sup>38</sup> The Supreme Court has espoused this view as well:

In principle, trademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions,' for it quickly and easily assures a potential customer that this item – the item with this mark – is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will

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33. This requirement was first included in the Trademark Protection Act of 1881, ch. 138, 21 Stat. 502 (repealed in part and amended in part by Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (1905)).

34. Commerce Clause, U.S. CONST. art. 1, § 8, cl. 3.

35. See 15 U.S.C. § 1051 (2006) (stating that registration may be sought for marks "used in commerce"); 15 U.S.C. 1127 (2006) (defining commerce to mean "all commerce which may lawfully be regulated by Congress").

36. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 2:1 (4th ed. 2000) [hereinafter MCCARTHY].

37. *Id.*

38. *Id.*; see also Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. Rev. 547, 560-61 (2006).

reap the financial, reputation-related rewards associated with a desirable product.<sup>39</sup>

In any case, the protection of trademarks has proven to be of enormous value to society. Trademarks have been shown to encourage competition, a fundamental component of a system of free enterprise.<sup>40</sup> Trademarks may also be said to have economic value, in the sense that they reduce the costs of consumer searching by providing simpler means of identifying the nature and quality of goods.<sup>41</sup> Finally, there are social justifications for protecting those trademarks that serve as cultural icons: society initially responds to the source-identifying value of a trademark, but in some cases, it transcends that value by expanding the meaning of a trademark to something greater.<sup>42</sup> This is evident in marks akin to ELVIS, BARBIE, and COCA-COLA.<sup>43</sup>

Of course, trademark law is also the regulation of speech, specifically commercial speech. Commercial speech has been defined as speech that proposes a commercial transaction,<sup>44</sup> and trademarks may be said to fit within this description. In essence, then, the tension between trademark rights and free speech rights is a kind of property dispute, in the sense that parties on both sides wish to assert dominion over speech for different and sometimes competing purposes. In particular, trademark owners seek to create a distinctive and inalienable association between speech and their commercial products and services, while free speech advocates seek to use the same or similar speech to convey commentary. Like the hypothetical land in New Domainia, when platforms for such speech are

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39. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 163-64 (1995) (quoting 1 J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01 (3d ed. 1994)).

40. KENNETH L. PORT, TRADEMARK LAW AND POLICY 29-30 (2d ed. 2008).

41. *Id.* at 30-32.

42. *Id.* at 32-33.

43. *See, e.g.,* *Mattel v. MCA Records*, 296 F.3d 894 (9th Cir. 2002); *Elvis Presley Enterprises, Inc. v. Capece*, 950 F. Supp 783 (1998); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1186 (E.D.N.Y. 1972).

44. *See* *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001) (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)).

inexpensively obtained and highly accessible to the public, their value to both parties increases proportionally.

### *B. Tension in Domain Name Disputes*

Tension between free speech and trademark rights in the context of domain name disputes exists on two levels. On one level, a cybergriper who registers an incorporative domain name may argue that the use of another's trademark in its domain name is appropriate because it is merely being used as a kind of gateway to web content that constitutes protected critical speech describing the target trademark owner. Speech advocates view this approach as a form of fair use, since the domain name does indeed guide Internet users to content describing the target. The opposing view is that this is an abuse of the exclusive rights obtained by trademark owners through commercial use of their marks, since it may lead to consumer confusion and weaken the distinctiveness of the owner's trademark.

On a second level, a cybergriper may assert that the domain name itself comprises expressive speech, particularly when the incorporative domain is of the <trademark+pejorative.com> variety, for example, <ford-sucks.com>. Most American courts have held that such pejorative domain names constitute a form of expressive speech and are therefore subject to the protections of fair use and the First Amendment.<sup>45</sup> Where expressive speech is not clear, as in <trademark+modifier.com> domain names, or where

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45. See *Name.Space*, 202 F.3d at 585-86 (2d Cir. 2000) (holding that domain names that express a message may be protected); *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003) (holding that <taubmansucks.com> was purely an exhibition of protected free speech).

such speech is absent altogether, as in <trademark.com> domain names, tribunals have been more reluctant to extend these protections.<sup>46</sup>

### III. LEGAL FRAMEWORKS THAT BALANCE TRADEMARK RIGHTS AND FREE SPEECH RIGHTS IN DOMAIN NAME DISPUTES

#### *A. State Remedies and the Early Lanham Act*

Prior to the mid-1990's, the trademark infringement provisions of the Lanham Act were the sole source of federal law available to aggrieved trademark owners engaged in domain name disputes.<sup>47</sup> Trademark owners also relied upon state law claims for trademark dilution, unfair competition, and defamation. However, these provisions often proved to be an awkward fit, because they were ill-adapted to deal with the mechanics of trademark use in the modern context of domain name disputes.

Trademark infringement and unfair competition laws in the United States require a plaintiff to make a showing of likely consumer confusion, the sine qua non of trademark infringement.<sup>48</sup> This is based upon the premise that trademarks are meant to serve as source indicators. If the unauthorized use of a mark in association with a product is not likely to result in consumer confusion as to the source of a product, there can be no infringement.<sup>49</sup> With

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46. See *Sunlight Saunas, Inc. v. Sundance Sauna, Inc.*, 427 F. Supp. 2d 1032, 1065 (D. Kan. 2006) (holding that <www.sunlightsaunas-exposed.com> was not unequivocally communicative in nature); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 197-98 (W.D.N.Y. 2000) (holding that Defendant's domain name <www.thebuffalonews.com> was not protected under the First Amendment, because "[u]se of another's trademark is entitled to First Amendment protection only when the use of that mark is part of a communicative message, not when it is used merely to identify the source of a product"); *Morrison & Foerster, LLP v. Wick*, 94 F. Supp. 2d 1125, 1135 (D. Colo. 2000) (holding that the First Amendment could not be invoked to protect Defendant's incorporative domain names because they lacked a communicative message).

47. The Lanham Act, also known as the Trademark Act of 1946, is codified at 15 U.S.C. §1051 et seq.

48. 15 U.S.C. § 1114(1)(2000); 15 U.S.C. § 1125(a)(1)(2000). The former relates to the protection of federally registered trademarks; the latter protects unregistered trademarks.

49. In assessing the possibility of trademark infringement through likelihood of consumer confusion, courts consider a multitude of factors. Factors commonly cited include the degree of similarity between the infringing mark and the trademark owner's protected mark, the degree of similarity of the infringing goods to the trademark owner's goods, the sophistication of the consumers who are likely to purchase the goods, and the channels of trade in

respect to gripe site cases, consumers are rarely confused into believing that a website that contains disparaging remarks about a trademark owner is actually endorsed by or affiliated with that owner, even if the site is accessible at a domain name of the <trademark.com> variety. Hence, the likelihood of confusion element in gripe site cases is frequently absent and a trademark owner's infringement claim will correspondingly fail.<sup>50</sup>

In addition, there are safe harbor provisions included in the Lanham Act that provide protection against the abrogation of free speech. The protections set forth to balance the potential monopoly on speech that a trademark provides are subtle, but they can be read into the Lanham Act through the enumerated fair use defenses, which are inexorably intertwined with free speech. For example, the Lanham Act provides a defense to trademark infringement when an alleged infringer makes fair use of another's trademark in a non-trademark capacity to describe its own product.<sup>51</sup> Thus, a candy manufacturer that advertises that its own product contains NutraSweet can claim the defense of classic fair use of the NUTRASWEET trademark.<sup>52</sup>

More often, fair use in the context of gripe site domain name disputes is of a nominative, rather than descriptive, nature. Nominative fair use occurs when an alleged infringer makes unauthorized use of another's trademark to refer to the trademark owner's own product, but does so solely for the purpose of comparison, criticism, parody, or the like. This transpires when the only practical way to refer to something is to use the trademarked term; for example, when an

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which the respective parties operate, among others. *See* *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *Polaroid Corp. v. Polaroid Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

50. *See, e.g.*, *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1163-66 (C.D. Cal. 1998) (holding that Defendant's use of the word "sucks" adjacent to Plaintiff's mark would diminish the likelihood that any that any "reasonably prudent user would . . . mistake [Defendant's] site for Bally's official site"); *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 294 (2d Cir. 2000) (holding that the registrant's domain name "sportys.com" was not likely to cause confusion in the market with the opposing party's SPORTY'S trademark, because the parties operated completely unrelated businesses).

51. 15 U.S.C. § 1115(b)(4).

52. Classic fair use is also sometimes referred to as descriptive fair use.

independent automobile mechanic specializing in the repair of Volkswagen automobiles advertises his services, he may properly use the VOLKSWAGEN trademark to describe that which he repairs.<sup>53</sup>

State trademark dilution laws in the mid-1990's were also poor instruments for addressing domain name disputes. Only twenty-five states had enacted such statutes and these were widely inconsistent, although most were based upon some version of the practice of protecting trademarks from the gradual whittling away of their distinctiveness through the unauthorized use of similar marks by third parties.<sup>54</sup> Further, many jurisdictions were reluctant to grant "nationwide injunctions for violation of state law where half of the states [had] no dilution law."<sup>55</sup> Many state dilution statutes did share one commonality, however: a claim for dilution required the plaintiff trademark owner to prove that its mark was being used in a commercial context, a condition that is often unmet in domain name disputes. In most gripe site cases, the commercial element is absent because legitimate gripe sites contain only critical speech, which is noncommercial in nature. In both cybergripping and cybersquatting cases, the commercial element is absent when a defendant has beaten the trademark owner to the registration of a trademark-identical domain name, but has not yet posted any content at a website associated with that domain name.

Finally, defamation law in the United States is substantially limited by the protections afforded by the First Amendment. States laws are largely protective of opinions or statements that the author reasonably believes to be true; hence, most gripe sites will be protected from

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53. See *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 307 (9th Cir. 1992) (citing *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir.1969)); see also *Bumble Bee Seafoods, L.L.C. v. UFS Indus. Inc.*, 71 USPQ2d 1684 (S.D.N.Y. 2004) (permitting the use of the BUMBLEE BEE TUNA trademark on a tuna salad package label because the tuna was made with Bumble Bee brand tuna).

54. See Jacqueline R. Knapp, *The Federal Trademark Dilution Act: The Circuit Split Makes A Desperate Call to the Supreme Court for Uniformity*, 19 GA. ST. U. L. REV. 853, 853-54 (2003).

55. *V Secret Catalogue, Inc. v. Moseley*, 259 F.3d 464, 468 (6th Cir. 2001) rev'd, 537 U.S. 418 (2003) (citing 1996 U.S.C.C.A.N. 1029, 1032 (Nov. 30, 1995)).

defamation claims, except in rare instances in which knowingly fabricated site content results in perceptible injury to the plaintiff trademark holder.<sup>56</sup> Further, such sites may be protected by the Communications Decency Act of 1996 (CDA), which contains provisions that appear to immunize some parties from tort liability. While the speakers themselves may not be immunized under the CDA, site owners, Internet service providers, and other intermediaries very likely are.<sup>57</sup> This presents an additional hurdle to aggrieved trademark owners, particularly when gripe sites contain content posted by anonymous third party users.

## *B. Trademark Dilution Legislation*

### *1. The Federal Trademark Dilution Act of 1995*

In the mid-1990's, new federal legislation began to appear that included some provisions designed to address the difficulties that judicial bodies confronted in attempting to adapt the law to adjudicate domain name disputes. The first such move toward addressing domain name registration concerns was the enactment of federal trademark dilution laws. Congress' initial attempt to create a federal body of dilution law was the Federal Trademark Dilution Act of 1995 ("FTDA").<sup>58</sup> Among its reasons for drafting the FTDA, Congress specifically set out to address the trademark issues surrounding domain name registrations.<sup>59</sup> However, the FTDA proved to

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56. See, e.g., *Intellect Art Multimedia, Inc. v. Milewski*, 899 N.Y.S.2d 60 (N.Y. Sup. Ct. 2009) (dismissing defamation claim against Defendant cybergriper because his comments were merely statements of personal opinion, that were "susceptible to ambiguous meanings" and "subjective expressions of consumer dissatisfaction with plaintiff"); *USA Technologies, Inc. v. Doe*, 713 F. Supp. 2d 901, 908-09 (N.D. Cal. 2010) (holding that scathing comments about Plaintiff's corporate officer were not defamatory, because they were accompanied by "exaggerated speech and broad generalities, all indicia of opinion"); *Cornelius v. DeLuca*, 38 Media L. Rep. 1818 (D. Idaho April 26, 2010) (dismissing Plaintiff's defamation claim because Defendant cybergriper's statements concerning Plaintiff's products appeared to be mere opinion).

57. See Shari Claire Lewis, *Alleged Defamation on 'Gripe' Sites Challenges Businesses*, 11/3/2009 NYLJ 5, (col. 1), Nov. 3, 2009.

58. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. § 1125(c) (2006)).

59. See 104 CONG. REC. S19312 (daily ed. Dec. 29, 1995) (statement of Sen. Leahy) (stating "it is my hope that this antidilution statute can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others").

be an unwieldy tool. For ordinary trademark suits, this was attributable, in part, to the difficulty that courts encountered in settling upon a uniform definition of dilution, which the statute failed to provide. In addition, the statute and its legislative history offered a paucity of guidance with respect to whether a plaintiff must make a showing of actual dilution, or a simpler showing of a mere likelihood of dilution.<sup>60</sup> Finally, the FTDA applied only to “famous” trademarks, but it was not clear whether this included only marks that were widely recognized by the American public, or also marks that held market-niche fame or fame in limited geographic regions.<sup>61</sup>

In domain name disputes, the FTDA was even more difficult to apply. In addition to the aforementioned challenges, the federal statute resembled its state predecessors in that it required a plaintiff to make a showing of commercial use. The legislative intent behind the inclusion of this provision was clear: the FTDA was narrowly circumscribed to prevent the unauthorized commercial use of trademarks that could be harmful to the distinctiveness of those marks; it was not meant to limit criticism or commentary.<sup>62</sup> In the most blatant cybersquatting cases, this hurdle was not particularly difficult to overcome: the commercial element was easy to identify when opportunists registered trademark-identical domain names and established commercial

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60. In 2003, a unanimous United States Supreme Court held that the FTDA standard for dilution required a plaintiff to prove that another trademark caused actual dilution of the distinctive quality of a famous mark. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003). However, this pronouncement proved to be ephemeral, as the decision was overturned with the subsequent enactment of new legislation.

61. Niche fame is fame among consumers in a local geographic area, or among consumers in a particular market. For example, the trademark THE SPORTING NEWS was not found to be famous among the general public, but it enjoyed niche fame within the market of readers of sports periodicals. *See Times Mirror Magazine, Inc. v. Las Vegas Sports News, LLC*, 212 F.3d 157 (3d Cir. 2000). Similarly, the owner of the LEXIS trademark was found to have niche fame among attorneys and accountants, but not the same degree of fame among the general public that Toyota’s LEXUS mark enjoyed. *See Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989). Geographic niche fame was found in the Wawa case, in which the Third Circuit affirmed that a convenience store located in only five states in the northeast United States enjoyed niche fame in its WAWA mark due to its extensive advertising over a period of nearly ninety years in that market. *See Wawa Dairy Farms v. Haaf*, CIV. A. 96-4313, 1996 WL 460083 (E.D. Pa. Aug. 7, 1996) *aff’d sub nom. Wawa Inc. v. Haaf*, 116 F.3d 471 (3d Cir. 1997).

62. *See, e.g.*, 141 CONG. REC. S19,312 (daily ed. Dec. 29, 1995) (statement of Sen. Leahy) (stating that First Amendment-protected speech would not be affected by the FTDA); H.R. REP. NO. 104-374, at 8 (1995) (stating that the proposed Act “adequately addresses legitimate First Amendment concerns” and “will not prohibit or threaten ‘noncommercial’ expression”).

websites accessible at those domain names. However, as previously noted, cybergrippers often omit commercial content from their websites. Further, both cybergrippers and cybersquatters who register incorporative domain names may not initially make use of them, eliminating the commercial element, yet the sting is still felt by trademark owners with a desire to make use of the domain names that contain their marks. In this regard, the majority of courts have held that the mere registration of a domain name does not itself constitute commercial use, although some have attempted to extend the statute beyond its boundaries to find dilution in this manner.<sup>63</sup>

Ultimately, the FTDA proved to be a clumsy piece of legislation for trademark owners and it was particularly difficult to apply to domain name disputes. Consequently, substantial lobbying led to the further revision of federal trademark dilution law, as well as the creation of new legal frameworks specifically targeted to address domain name disputes.

## *2. The Trademark Dilution Revision Act of 2006*

The FTDA was largely supplanted by the Trademark Dilution Revision Act of 2006 (“TDRA”), the current dilution statute.<sup>64</sup> In enacting the TDRA, Congress set out to clarify some of the earlier language of the FTDA and to add certainty for tribunals and litigants. Dilution was more clearly defined to include both dilution by blurring<sup>65</sup> and dilution by tarnishment.<sup>66</sup> Further, under the TDRA, a plaintiff need only make a showing of likely dilution, rather than

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63. *See, e.g.*, *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1325 (9th Cir. 1998) (finding that Defendant traded upon the value of Plaintiff trademark owner’s marks by possessing domain name registrations that “curtailed [Plaintiff’s] exploitation of the value of its trademarks on the Internet”).

64. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (2006).

65. Dilution by blurring occurs when a famous mark loses its distinctiveness due to the use of a similar mark or trade name. 15 U.S.C. § 1125(c)(2)(B) (2006). It has sometimes been described as “death by a thousand small cuts,” a metaphor for the idea that the effect of a single instance of dilution may be perceived as small, but multiple acts have a cumulative effect which may be fatal to the distinctiveness of the trademark over time. *See* 4 McCarthy § 24:120.

66. Tarnishment is the acquired association between a famous mark and a similar mark (or trade name) of another, which has the effect of creating negative associations with the famous mark. 15 U.S.C. § 1125(c)(2)(C).

actual dilution,<sup>67</sup> and niche fame was eliminated as a basis for the cause of action.<sup>68</sup> Arguably, these changes created greater certainty for trademark owners by more readily defining the boundaries of dilution. However, some critics have suggested that the TDRA requires further clarification with respect to the plaintiff's burden in demonstrating the fame of its mark, the requisite similarity between the plaintiff's mark and the defendant's mark, and the evidence necessary to prove a likelihood of dilution by blurring.<sup>69</sup> Others have argued that the TDRA generates an overly-broad dilution remedy that cannot be justified upon policy grounds.<sup>70</sup>

In any event, the commercial use requirement included in previous permutations of dilution law was maintained in the TDRA,<sup>71</sup> as were the safe harbor provisions for noncommercial use: the current version of the statute states that dilution will not be found when a trademark is being fairly used in connection with parody, criticism, or comment concerning the famous mark owner.<sup>72</sup> These safe harbor provisions are particularly pertinent to gripe site disputes, which typically make use of language of this nature.

### *C. Targeted Anticybersquatting Legislation*

#### *1. The Anticybersquatting Consumer Protection Act*

The combination of the forgoing elements generated numerous hurdles for trademark owners who sought to prevent both cybersquatters and cybergrippers from registering and utilizing incorporative domain names. The requirements of confusion and commercial use in such disputes are often lacking and the protections of the First Amendment shield cybersquatters

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67. *Id.* at § 1125(c)(1).

68. *Id.* at § 1125(c)(2)(A).

69. Perla M. Kuhn, *Trademarks as Competitive Tools-Obtaining and Protecting Them*, ASPATORE, 2009 WL 534745, at \*9.

70. Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INT. PROP. L. BULL. 187, 194 (2007).

71. 15 U.S.C. § 1125(c)(3)(C).

72. *Id.* at § 1125(c)(3)(A)-(C).

and cybergrippers indiscriminately. Congress was well aware of these difficulties when it began drafting new legislation specifically targeted to address cybersquatting.<sup>73</sup> The Anticybersquatting Consumer Protection Act (“ACPA”) was born as amendments to the Lanham Act in an attempt to address these concerns.<sup>74</sup> In enacting the ACPA, Congress sought to:

protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks – a practice commonly referred to as “cybersquatting.”<sup>75</sup>

Broadly, the ACPA prohibits a person from registering or using a domain name that is identical or confusingly similar to the distinctive or famous trademark of another, when such acts are done in bad faith.<sup>76</sup> Unlike its statutory predecessors, there is no per se commercial use requirement in the ACPA; rather, the plaintiff must only show evidence that the defendant manifested a bad faith intent to profit from its actions.<sup>77</sup>

Further, in contrast to the “likelihood of confusion” standard that must be met in traditional trademark infringement actions, the “confusingly similar” standard set forth under the ACPA is more easily satisfied.<sup>78</sup> In addition, in contrast to the dilution statutes, actual use of a

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73. See S. Rep. No. 106-140, at 7 (1999) (noting “cybersquatters have become increasingly sophisticated as the case law has developed and now take the necessary precautions to insulate themselves from liability. For example, many cybersquatters are now careful to no longer offer the domain name for sale in any manner that could implicate liability under existing trademark dilution case law”).

74. Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1536 (codified at 15 U.S.C. § 1125(d) (2006)).

75. S. Rep. No. 106-140, at 4.

76. *Id.* at § 1125(d)(1).

77. See *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 778 (8th Cir. 2004) (stating “[t]he use of a domain name in connection with a site that makes a noncommercial or fair use of the mark does not necessarily mean that the domain name registrant lacked bad faith”); see also *E. & J. Gallo Winery v. Spider Webs Ltd.*, 129 F. Supp. 2d 1033, 1047-48 (S. D. Tex. 2001), *aff’d*, 286 F.3d 270 (5th Cir. 2002) (“As reflected by the language of the ACPA and the case law interpreting it, there is no requirement . . . that the ‘use’ be a commercial use to run afoul of the ACPA”).

78. See, e.g., *Harrods Ltd. v. Sixty Internet Domain Names*, 157 F. Supp. 2d 658, 677 (E.D. Va. 2001) (finding domains consisting of the word “harrods” confusingly similar to plaintiff’s HARROD trademark); *Morrison & Foerster*, 94 F. Supp. 2d. 1125, 1130 (holding that domain names which contained various obvious misspellings of MORRISON & FOERSTER were confusingly similar). *But see Lucent Techs. Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000) (noting that <lucentSucks.com> is not confusingly

domain name is not required to show bad faith under the ACPA; mere registration of the domain name will suffice, provided that the bad faith intent requirement is met.<sup>79</sup>

Bad faith can be shown through an analysis of nine factors enumerated in a non-exhaustive list provided by the statute.<sup>80</sup> These factors center largely around the manner in which the domain name is used by the defendant, the intent of the defendant in registering or using the domain name, and the defendant's past history, if any, of registering identical or confusingly similar domain names.<sup>81</sup>

In addition, the ACPA provides plaintiffs with in rem jurisdiction in domain name disputes when the trademark owner is unable to acquire in personam jurisdiction over the defendant, or when the trademark owner is unable to determine the identity of the appropriate defendant.<sup>82</sup> Further, the ACPA expands the potential damages available to a plaintiff to include injunctive relief,<sup>83</sup> transfer or cancellation of the domain name in dispute,<sup>84</sup> actual damages,<sup>85</sup> statutory damages of \$1,000 to \$100,000 per domain name,<sup>86</sup> and in some cases, attorney's fees.<sup>87</sup>

Congress included a savings clause in the ACPA to protect the legitimate fair use of domains names that contain the trademarks of others. The statute proclaims, rather vaguely, that "[b]ad faith intent . . . shall not be found in any case in which the court determines that the

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similar to Plaintiff's LUCENT mark because consumers would recognize the parody inherent in the domain name and therefore there could be no confusion).

79. 15 U.S.C. § 1125(d)(1)(A)(i). *See also* *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 680 (9th Cir. 2005) (stating "[t]he ACPA makes it clear that 'use' is only one possible way to violate the Act ('registers, traffics in, or uses'). Allowing a cybersquatter to register the domain name with a bad faith intent to profit but get around the law by making noncommercial use of the mark would run counter to the purpose of the Act").

80. 15 U.S.C. § 1125(d)(1)(B)(i).

81. *Id.*

82. *Id.* at § 1125(d)(2)

83. *Id.* at § 1116(a).

84. *Id.* at § 1125(d)(1)(C).

85. *Id.* at § 1117(a).

86. *Id.* at § 1117(d).

87. *Id.* at § 1117(a) (but only in cases deemed "exceptional" by the court).

person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.”<sup>88</sup> This provision was incorporated to protect “the rights of Internet users and the interests of all Americans in free speech and protected uses of trademarked names for such things as parody, comment, criticism, comparative advertising, news reporting, etc.”<sup>89</sup>

Congress also anticipated that cybersquatters might seek to avoid liability under the ACPA by availing themselves of the savings clause in a spurious fashion.<sup>90</sup> Accordingly, the courts have been sensitive to this potential loophole: in those instances in which cybersquatters have plainly attempted to cloak their bad faith use of another's trademark in the mantle of a gripe site, tribunals have held almost uniformly against protecting the domain name registrant's speech.<sup>91</sup>

In United States federal courts, the provisions of the ACPA have become the statutory vehicle of choice for trademark owners who seek redress in domain name disputes, due to the targeted nature of the statute. Despite this, the ACPA has enjoyed only moderate use in the courts, having been cited as a cause of action in a little over two hundred cases since its enactment in 1999.<sup>92</sup> Of those, 58% have resulted in a finding of cybersquatting, approximately

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88. *Id.* at § 1125(d)(1)(B)(ii).

89. S. Rep. No. 106-140, at 8.

90. *See* H.R. REP. NO. 106-412, at 11 (stating “the use of a domain name for purposes of comparative advertising, comment, criticism, parody, news reporting, etc., even where done for profit, would not alone satisfy the bad-faith intent requirement . . . [the safe harbor provision] is not intended to create a loophole that otherwise might swallow the bill, however, by allowing a domain name registrant to evade application of the Act by merely putting up a noninfringing site under an infringing domain name”).

91. *See* *Shields v. Zuccarini*, 254 F.3d 476, 485-86 (3d Cir. 2001) (holding that Defendant could not avail himself of the safe harbor provision of the ACPA when Defendant admitted to replacing the purely commercial content on his alleged gripe site with a protest page mere hours after being served with Plaintiff's complaint); *E. & J. Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 272 (5th Cir. 2002) (holding that defendant's use of its domain name in association with a website that was critical of alcohol, corporate America, and the litigation lodged against it six months after the litigation ensued did not immunize Defendant); *Sunlight Saunas, Inc. v. Sundance Sauna, Inc.*, 427 F. Supp. 2d 1032, 1057-58 (D. Kan. 2006) (Defendant posted advertisements for Plaintiff's competitors services on his alleged gripe site); *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 789 (8th Cir. 2004) (Defendant created anti-abortion speech websites using domain names confusingly similar to a multitude of famous trademarks).

92. *See* Finnegan, Internet Trademark Case Summaries, <http://www.finnegan.com/publications/updatenewsletters/itsc> (last visited Dec. 24, 2010).

30% have found no cybersquatting, and a little over 10% have been resolved for procedural reasons.<sup>93</sup> The modest number of cases relying upon the ACPA is likely attributable to the substantial cost and time consuming nature of federal litigation.

## 2. *The Uniform Domain Name Dispute Resolution Policy*

At about the same time the ACPA was enacted, the Internet Corporation for Assigned Names and Numbers (“ICANN”) was formed as a non-profit organization charged with the oversight of the administration of domain name registrations.<sup>94</sup> ICANN soon adopted the Uniform Domain Name Dispute Resolution Policy (“UDRP”),<sup>95</sup> an international policy designed to settle disputes between domain name registrants and trademark owners via arbitration.<sup>96</sup> The authority of the UDRP is grounded in the fact that its terms are incorporated into all domain name registration agreements and its acceptance by registrants is mandatory in order to secure a domain name.<sup>97</sup> One provision of the UDRP requires domain name registrants to submit to an administrative proceeding – commonly referred to as a UDRP proceeding – in the event of a domain name dispute.<sup>98</sup> These proceedings are managed by appointed dispute resolution providers, the largest of which are the World Intellectual Property Organization (“WIPO”), based in Geneva, Switzerland, and the National Arbitration Forum, based in the United States.<sup>99</sup>

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93. *Id.*

94. Internet Corporation for Assigned Names and Numbers, About ICANN, <http://www.icann.org/en/about> (last visited Dec. 24, 2010).

95. INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (1999), <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm>.

96. In the strictest sense of the word, a UDRP proceeding is not truly an arbitration. The parties in conflict participate only to the extent that each party submits a brief, following which a panel of one to three members renders a decision. There is no option for the parties to agree upon an impartial referee and the parties have the right to later challenge and overturn the panel’s decision in court. However, a UDRP proceeding does take place entirely outside of the courts, much like a traditional arbitration, and hence it is often referred to in this manner.

97. UDRP, *supra* note 95, at ¶ 1.

98. *Id.* at ¶ 4.

99. Other current providers include the Asian Domain Name Dispute Resolution Centre and the Czech Arbitration Court Arbitration Center for Internet Disputes. See ICANN, List of Approved Dispute Resolution Service Providers, <http://www.icann.org/en/dndr/udrp/approved-providers.htm> (last visited Dec. 24, 2010).

Through these providers, UDRP proceedings are managed and decided through a compulsory private dispute resolution process. Such proceedings are decided by panels consisting of one or three members, depending upon the preferences of the parties in opposition.

To prevail in a UDRP proceeding, the complaining party must prove: (1) that the domain name in question is identical or confusingly similar to the complainant's trademark; (2) that the domain name registrant does not have any rights or legitimate interests in the domain name; and (3) that the domain name has been registered and is being used in bad faith.<sup>100</sup> ICANN has also provided a list of model evidence of bad faith, in a manner similar to the ACPA.<sup>101</sup> Like the bad faith factors enumerated in the ACPA, ICANN's list is not exhaustive. It includes: (1) whether the registrant registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark; (2) whether the registrant registered the domain name to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, if the domain name owner has engaged in a pattern of such conduct; and (3) whether the registrant registered the domain name primarily for the purpose of disrupting the business of a competitor; or (4) whether by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, internet users to the registrant's website, by creating a likelihood of confusion with the complainant's mark.<sup>102</sup>

In contrast to the ACPA, the UDRP has been held to require that the registrant acted in bad faith both in registering and in using the domain name;<sup>103</sup> bad faith does not exist solely

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100. *Id.* at ¶ 4(a).

101. *Id.* at ¶ 4(b).

102. *Id.*

103. *See A Nattermann & Cie GmbH v Watson Pharmaceuticals Inc.*, WIPO Case No. D2010-0800 (Aug. 31, 2010).

upon registration. In addition, the UDRP has no jurisdictional limits, because it applies wherever domain names are registered through ICANN-approved registrars.

In contrast to the provisions of the ACPA, the dispute resolution process created by the UDRP has been utilized heavily, largely due to its inexpensive and expeditious nature as compared to federal litigation. Typical fees associated with a UDRP case range from \$1,500 for the simplest cases to as much as \$6,000 for cases that involve multiple domain names and multiple panelists.<sup>104</sup> Most proceedings take as little as sixty days from the time the resolution provider receives the complaint.<sup>105</sup> As of March 1, 2010, all UDRP documents submitted by the parties to the dispute must be filed electronically, further streamlining resolution of UDRP proceedings and reducing costs.<sup>106</sup>

One of the general criticisms leveled at the UDRP is that it is arguably biased toward complainants. One WIPO report noted that in 2008, 85% of its decisions favored the complainant and only 15% favored the domain registration holder. These figures are partially attributable to the substantial number of domain name registrants who do not respond to the complaint of the trademark owner, either because they choose not to, or because the complaint never reaches them. A substantial portion of those registrants who choose not to respond to the complaint may do so because they cannot afford the costs associated with drafting a response to a UDRP complaint, in contrast to their sometimes better-funded opponents.

Further, the UDRP lacks the broad safe harbor provisions that are present in the ACPA. Fair use is mentioned only once among the provisions of the UDRP as a potential example of a

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104. See WIPO, Schedule of Fees under the UDRP, <http://www.wipo.int/amc/en/domains/fees> (last visited Dec. 24, 2010).

105. WIPO Guide to the Uniform Domain Name Dispute Resolution Policy, <http://www.wipo.int/amc/en/domains/guide/#b2> (last visited Dec. 24, 2010).

106. See ICANN, Rules for Uniform Domain Name Dispute Resolution Policy, *available at* <http://www.icann.org/en/dndr/udrp/uniform-rules.htm>.

manner in which a Respondent may demonstrate that it has a legitimate interest in the domain name. Specifically, a Respondent can buttress its claim of rights to the domain name by demonstrating that it is “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.”<sup>107</sup>

In any event, although UDRP proceedings are rapid and arguably biased toward complainants, the sole remedy that they provide is one of cancellation or transfer of the domain name in question. Further, these decisions have been held appealable in U.S. federal courts.<sup>108</sup> These considerations serve to potentially mitigate the impact of UDRP decisions.

#### IV. ADJUDICATORY INCONSISTENCIES IN DOMAIN NAME DISPUTES

The ACPA and UDRP have become the preferred instruments for adjudicating cybersquatting disputes and they have been generally effective in doing so. However, these legislative frameworks were narrowly drafted to address just that: cybersquatting. They were never intended to serve as tools for regulating the broader realm of domain name disputes as a whole,<sup>109</sup> a realm that includes, among other things, the use of domain names in association with Internet gripe sites. The legislative history is clear on this point, both nationally and internationally: the central purpose of the ACPA, according to Congress, was to combat "the practice of cybersquatters who register numerous domain names containing American trademarks or trade names only to hold them ransom in exchange for money."<sup>110</sup> Further, the ACPA was created "to provide clarity in the law for trademark owners by prohibiting the bad-

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107. UDRP, *supra* note 95, at ¶ 4(c)(iii).

108. *See Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 24-30 (1st Cir. 2001).

109. The narrow tailoring of the ACPA and the UDRP are likely attributable, at least in part, to the hesitation of lawmakers to overreach their jurisdictional authority in the domain space. *See Lipton, supra* note 10, at 448-49.

110. H.R. REP. NO. 106-412, at 6 (1999).

faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks..."<sup>111</sup> The provisions of the UDRP point to a similar goal: the aforementioned bad faith indicators delineated in the Policy are clearly targeted to curtail cybersquatting.<sup>112</sup>

In UDRP proceedings, one factor that serves to frustrate the consistency of panel decisions is the international nature of these proceedings. UDRP proceedings are decided "on the basis of the statements and documents submitted and in accordance with the Policy, [ICANN's] Rules and any rules and principles of law that [a panel] deems applicable."<sup>113</sup> Because UDRP proceedings are international, the principles of law that are applied vary from proceeding to proceeding, sometimes resulting in disparate decisions. This is particularly relevant to issues concerning free speech: while most nations recognize free speech, the degree to which it is upheld in reality differs substantially from nation to nation. Thus, in UDRP proceedings in which free speech is raised as a defense, the defense is given varying amounts of deference. WIPO is aware of this distinction, noting that "[i]n the event that a domain name identical or confusingly similar to a trademark is being used for a genuine noncommercial free speech website, there are two main views."<sup>114</sup> The view adopted by the majority of panelists in disputes between U.S. parties is generally highly protective of speech: "irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and

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111. S. REP. NO. 106-140, at 4 (1999).

112. See UDRP, *supra* note 95, at ¶ 4(b)(i)-(iii).

113. ICANN Rules, *supra* note 106, ¶ 15.

114. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, <http://www.wipo.int/amc/en/domains/search/overview> (last visited Dec. 24, 2010).

noncommercial.”<sup>115</sup> In decisions that involve panelists and parties of other nations, precedent is decidedly the opposite; such panels give far less credence to the right to criticize.

In a very direct sense, then, domain name disputes may be treated inconsistently when free speech is at issue, due to a sort of cultural bias. However, free speech is also treated disparately with respect to the interpretation of the existing statutory constructs. Cybergripping and cybersquatting cases often form a nexus that is difficult to divide and the more difficult cases fall close to the line. Most prominent among these are the disputes in which questions arise regarding consumer confusion, bad faith and fair use. Specifically, tribunals have struggled to scrutinize: (1) the registrant's underlying motives, divorced from its otherwise facially legitimate attempt to utilize a domain name as a vehicle for protected critical speech; and (2) the registrant's success in conveying the intended commentary, as opposed to merely generating confusion among consumers. The two are often inexorably intertwined, as bad faith is frequently presumed when a cybergriper's efforts lead to a likelihood of confusion among consumers.

### *A. Conflicts Regarding Consumer Confusion*

#### *1. Overview*

On the Internet, a website may be located via two primary methods: type-in search, or the use of a search engine. Historically, users have relied largely on type-in search,<sup>116</sup> which is the act of literally typing a domain name into the address box of a browser, a sort of guessing game in which a user not already aware of the URL associated with a specific website experimentally enters a domain name in a browser address box. For example, a user might enter

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115. *Id.*

116. *See Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 493 (2d Cir. 2000) (stating “[f]or consumers to buy things or gather information on the Internet, they need an easy way to find particular companies or brand names. The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com”).

<walmart.com> into a browser address box, guessing (correctly) that this is the address at which Wal-Mart's website can be found. In light of this, companies have a strong preference for the acquisition and use of domain names comprised of their own trademarks.<sup>117</sup>

Cybergrippers have availed themselves of the practice of type-in search by registering domain names that are confusingly similar or identical to their targets' trademarks. In this manner, cybergrippers cast a wider net by garnering the attention of those who set out to locate information provided by the trademark owner, rather than information critical of the trademark owner. It might be said that this is the digital equivalent of disgruntled consumers picketing in front of a merchant's place of business: the disgruntled party places itself in a position where it will be most visible to the relevant public, that is, to those who would avail themselves of the establishment's goods and services. Likewise, the picketer may carry a sign broadly displaying the trademark of the establishment owner, in connection with a message about the establishment's complained-about practices.

Moving closer to the New Domainia analogy, the issue is not whether the picketer may complain about the merchant's practices, but rather who has the right to make use of the property where the picketer stands. The merchant would argue that the property is a natural extension of its own territory and the picketer's presence there is illegal. The picketer would respond that it has as much right to use the property as anyone, and indeed, it is the most effective location for its protest.

The majority of gripe site decisions arise from disputes in which the cybergriper has registered a domain name that incorporates a close approximation of its target's trademark. Critical content hosted at incorporative domain names almost certainly raises the ire of trademark owners more quickly than identical content located on websites that do not employ the

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117. *See id.*; *see also* H.R. REP. NO. 106-412, at 5 (1999).

target's trademark within the associated domain name, even when the trademark owner's mark is used liberally in the content of the site.

If cybergrippers chose to post their criticism solely at informal consumer complaint clearinghouse sites like <www.ripoffreport.com> and at consumer review sites like <consumerreports.org>, rather than at gripe sites hosted at incorporative domains, there would almost certainly be less litigation surrounding them. For example, critical comments about the big box home improvement store Home Depot appear on the website <www.ripoffreport.com>. Although the comments on this site make liberal use of the HOME DEPOT trademark, Home Depot is probably less likely to pursue action against the site's owner or its contributors than it would if similar content was posted on sites hosted at incorporative domains like <homedepotsucks.com> or <homedepotopinions.com>.<sup>118</sup> Both incorporative domain gripe sites and non-incorporative domain gripe sites use the same trademarks in the content of their sites and both sites exist for the same purpose: to express critical speech concerning the trademark owner. In both cases, the trademark owner could theoretically pursue a remedy under libel law, if the veracity of the comments was questionable.

There are several possible explanations for this disparity. In part, this may be attributable to the fact that both the ACPA and UDRP have provided streamlined litigation for domain name disputes. Consequently, plaintiffs may simply view gripe sites hosted at incorporative domains as easier targets than those hosted at non-incorporative domains, which would not be within the reach of the ACPA or UDRP. The disparity may also stem from the dual use of the trademark in

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118. Indeed, Home Depot pursued action against the registrants of both of these domain names. *Homer TLC, Inc. v. GreenPeople*, NAF Claim No. FA0508000550345 (Oct. 25, 2005) (denying transfer of the domain name because "Respondent's use of the <homedepotsucks.com> domain name as a protest site is a legitimate noncommercial or fair use"); *Homer TLC, Inc. v. Unitedeuropa Consulting*, NAF Claim No. FA0711001110103 (February 8, 2008) (ordering transfer of the domain name <homedepotopinions.com> because Respondent was using the domain solely for monetization).

both the domain name and in the content of the gripe site, which may be particularly offensive to trademark owners. The most plausible explanation, however, is that trademark owners recognize that domain names have proven to be valuable search tools for locating content on the Internet. Hence, the goal of the trademark owner is to use domain names to push an uninterrupted stream of traffic to its commercial website. When a third party interrupts this stream, the potential detriment to the trademark owner is very high.

In this sense, confusion is not the issue, but rather diversion. There is a subtle distinction. A trademark owner that pursues legal action against the owner of a <trademark-sucks.com> domain name, for example, is not likely to fear that the domain name will generate genuine confusion as to source, sponsorship, or affiliation. Rather, the trademark owner is more likely concerned that Internet users who employ search engines to locate a trademark owner's website will be provided with a list of results, among them links to unaffiliated websites, including gripe sites. Such users may be diverted to competing commercial content, in the case of cybersquatters, or to noncommercial content that is critical of the trademark owner, posted by cybergrippers.

Legitimate cybergrippers have historically chosen incorporative domains for this very reason: they provide assurance that their critical speech will reach a wider audience by creating a greater likelihood that such sites will be more easily discovered by Internet users who seek information about the targeted entities. Buttressing site content that makes fair use of an entity's trademark with the use of that mark within an incorporative domain name will increase the likelihood that both interested and incidental viewers of the speech will find it. However, trademark owners are more likely to regard this as an attempt to sow confusion and they often object to this approach as an encroachment of their exclusive rights in the use of their

trademarks.<sup>119</sup> J. Thomas McCarthy, one of the leading authorities on trademark law, firmly supports this view:

gripe sites that use the target's trademark in the domain name either identically or in a confusingly similar format violate mainstream trademark policies. Such sites should not be immunized by free speech principles. Such Web sites rely on confusion to intercept the potential viewers of plaintiff's Web site and expose them to the message disseminated at the site identified by the accused domain name. Such Web sites rely on confusion caused by the domain name to convey their message, thereby negating any free speech defense.<sup>120</sup>

However, this approach does not account for the numerous legal actions taken against incorporative domains of the <trademark-sucks.com> variety, because <trademark-sucks.com> domain names do not use domain names in an identical or confusingly similar manner. McCarthy has asserted as much:

Based on the principle that trademark law cannot be used to suppress criticism of a company or product, it is not appropriate to use trademark law as a weapon against criticism of a company on the Internet, as with the use of the "yourcompanysucks" type of domain name for consumer Web sites devoted to criticizing the acts and policies of 'Your Company.'<sup>121</sup>

Further, there is a school of thought that is founded upon the broader belief that trademark owners' exclusive rights are narrowly proscribed and do not provide an absolute monopoly in the use of those marks that extends to domain names:

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119. See, e.g., Cabela's Incorporated v. Cupcake Patrol, NAF Claim No. FA0006000095080 (Aug. 29, 2000)(stating "[b]y using Complainant's marks in its domain names, Respondent makes it likely that Internet users entering "Cabelaís" into a search engine will find "CABELASSUCKS.COM" in addition to the Complainant's site <cabelas.com>. Respondent's domain name is sufficiently similar to Complainant's marks that the search engine results will confusingly list the Respondent's domain name when searching for Complainant's mark").

120. 4 MCCARTHY § 25:76. See also Planned Parenthood Federation of America, Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1441 (S.D.N.Y. 1997), aff'd, 152 F.3d 920 (2d Cir. 1998) (defendant's admitted purpose was to divert potential viewers of plaintiff's website and expose them his own contrary message); Jews For Jesus v. Brodsky, 993 F. Supp. 282 (D.N.J. 1998), judgment aff'd, 159 F.3d 1351 (3d Cir. 1998) (defendant hoped to divert Internet users from plaintiff's religious message "before they have a chance to see the obscene garbage on [plaintiff's] site").

121. 6 MCCARTHY § 31:148.

nothing in trademark law requires that title to domain names that incorporate trademarks or portions of trademarks be provided to trademark holders. To hold otherwise would create an immediate and indefinite monopoly to all famous mark holders on the Internet, by which they could lay claim to all.com domain names which are arguably ‘the same’ as their mark. . . . Trademark law does not support such a monopoly.<sup>122</sup>

Whether such use constitutes the kind of confusion that is proscribed by trademark law depends, in part, upon one’s view of the justification for trademark law. A consumer-centric approach suggests that trademark law should protect consumers from confusion and deception by providing reliable indicators of the source of goods and services in the marketplace. The use of the term “marketplace” may be significant here: it might be said that consumers should be protected from uncertainty created by competitors, rather than by speech advocates, who do not participate in the marketplace. Gripe sites, then, might be excused for causing momentary confusion, if that confusion leads consumers only to non-commercial commentary sites that are intended to convey free speech, rather than to sites promoting competing goods or services.

In contrast, a trademark owner-centric approach might suggest that trademark law should protect the producers of goods and services from the misappropriation of the goodwill that they have worked to create. Many definitions of goodwill in the context of trademark law have emerged over the years,<sup>123</sup> among them the broad view that goodwill is the “public confidence in the quality of the product and in the warranties made on behalf of the product, and the ‘name recognition’ of the product by the public that differentiates that product from others.”<sup>124</sup> The ability of a gripe site to diminish name recognition is probably low, particularly when used in a purely noncommercial sense; however, gripe sites do possess the capacity to reduce public

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122. *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 380 (E.D. Pa. 2001) (citations omitted); *accord* *Ford Motor Co. v. Greatdomains.Com, Inc.*, 177 F. Supp. 2d 635, 653 (E.D. Mich. 2001).

123. *See* 1 MCCARTHY §§ 2:17 - 2:20.

124. *Premier Dental Products Co. v. Darby Dental Supply Co., Inc.*, 794 F.2d 850, 860 (3d Cir. 1986), cert. denied, 479 U.S. 950 (1986), reh'g denied, 479 U.S. 1062 (1987).

confidence in the quality of a trademark owner's products and services. In this sense, it might be argued that the unauthorized use of another's mark in a gripe site domain name in a confusing manner might be said to offend the goals of trademark law.

In any event, the United States Supreme Court has left little doubt that some possibility of consumer confusion regarding the origin of goods or services may be nevertheless compatible with the unauthorized use of another's trademark, noting that "[t]he common law's tolerance of a certain degree of confusion on the part of consumers followed from . . . the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first."<sup>125</sup> In holding that a "mere risk of confusion will not rule out fair use,"<sup>126</sup> the Supreme Court placed the burden on the plaintiff to demonstrate that the risk of consumer confusion is great enough to outweigh its fair use.

The Internet provides enormous freedom for speakers to be heard, but in one sense, it is a victim of its own accessibility: it is essentially unlimited in both size and scope. Consequently, the challenge of standing out and being heard among the din is a trying endeavor. Those Internet users who seek out expressive speech of a particular nature on the Internet will almost surely find it, but those who do not are unlikely to encounter it, unless the speaker engages in some means to reach its target audience. Just as a speaker on a soapbox strives to reach both interested and initially disinterested listeners, so must a cybergriper attempt to reach an audience greater than those who seek out its advocacy. The use of incorporative domain names is one way to achieve this purpose, with varying degrees of confusion resulting.

## *2. Confusion in <trade-sucks.com> Disputes*

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125. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 121-22 (2004).

126. *Id.*

Domain name disputes concerned with <trademark-sucks.com> domain names present a particular area of uncertainty in regard to confusion. Logic would suggest that most consumers are unlikely to be confused into thinking that a website located at <walmart\_sucks.com> is in any way affiliated with or endorsed by the retail giant. While most U.S. federal courts have rejected the assertion that such domain names create confusion,<sup>127</sup> UDRP panels have been largely divided as to whether the addition of a pejorative term or phrase to a trademark will dispel the likelihood of confusion.

It has been suggested that the majority of UDRP panels favor the finding that such domain names are confusingly similar.<sup>128</sup> For example, with one member dissenting, a WIPO panel held that the <airfrancesucks.com> domain name was confusingly similar to the trademark AIR FRANCE, rationalizing that not all international consumers would recognize the pejorative nature of the term “sucks.”<sup>129</sup> Another WIPO panel found that <redbullsucks.com> was confusingly similar to the trademark RED BULL, asserting that “sucks” is merely a generic addition to the distinctive mark.<sup>130</sup> Other panels have concluded that <alamo-sucks.com> was confusingly similar to ALAMO<sup>131</sup>, <stopandshopsucks.com> was confusingly similar to STOP

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127. *Bally Total Fitness Holding Corp. v. Faber*, 29 F.Supp.2d 1161, 1165 n. 2 (C.D.Ca.1998) (noting in dicta that a reasonable user would not believe that Bally sponsored a website located at <Ballysucks.com>); *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F.Supp.2d 528 (E.D.Va.2000) (commenting that “the average consumer would not confuse lucentSucks.com with a web site sponsored by plaintiff [Lucent Technologies]”); *Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir.2003) (finding “no possibility of confusion” between Taubman and <taubmansucks.com> because inclusion of the term “sucks” removed any confusion as to the source); *Taylor Bldg. Corp. of Am. v. Benfield*, 507 F. Supp. 2d 832 (S.D. Ohio 2007) (stating that “[n]o one seeking Taylor’s website would think-even momentarily-that Taylor in fact sponsored a website that included the word ‘ripoff’ in its website address”).

128. *See Wachovia Corporation v. Alton Flanders*, WIPO Case No. D2003-0596 (Sept. 19, 2003) (discussing the split among panels).

129. *Société Air France v. Virtual Dates, Inc.*, WIPO Case No. D2005-0168 (May 24, 2005).

130. *Red Bull GmbH v. Carl Gamel*, WIPO Case No. D2008-0253 (Apr. 14, 2008).

131. *Vanguard Trademark Holdings USA, LLC v. European Travel Network*, WIPO Case No. D2008-1325 (Oct. 31, 2008).

& SHOP,<sup>132</sup> and <michaelbloombergsucks.com> was confusingly similar to MICHAEL BLOOMBERG.<sup>133</sup>

Numerous UDRP panels have also supported the contrary premise, finding no confusing similarity in analogous cases.<sup>134</sup> One panel has suggested that the trend among UDRP panelists is shifting in this direction.”<sup>135</sup>

The disparity between the U.S. federal courts that hold consistently against a finding of confusion and those UDRP panels that hold otherwise is likely attributable, in part, to the differing standards applied by these tribunals. Federal courts applying traditional Lanham Act principles are likely to require a higher standard of confusion than panels that apply the UDRP requirement of “confusing similarity.” As one WIPO panel suggested, “the standard for finding confusingly similarity under the first element of the Policy, which is a rule specifically designed to address cybersquatting, is not the same standard as for finding trademark infringement.”<sup>136</sup> Even federal courts applying the arguably lower threshold “confusingly similar” standard demanded by the ACPA may be persuaded to adopt an approach to confusion that is more reminiscent of the traditional Lanham Act likelihood of confusion standard.

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132. The Stop & Shop Supermarket Company v. Ian Anderson, NAF Claim No. FA0211000133637 (Jan. 8, 2003).

133. Bloomberg L. P. v. Secaucus Group, NAF Claim No. FA0104000097077 (June 7, 2001) (declining to transfer the domain name on other grounds).

134. See, e.g., Asda Group Limited v. Mr. Paul Kilgour, WIPO Case No. D2002-0857 (Nov. 11, 2002) (declining to find confusing similarity and noting “by now the number of Internet users who do not appreciate the significance of the ‘-sucks’ suffix must be so small as to be de minimis and not worthy of consideration”); Lockheed Martin Corp. v. Parisi, WIPO Case No. D2000-1015 (Jan. 26, 2001) (finding that a domain name combining a trademark with the pejorative “sucks” or similar language clearly indicates that the domain name is not affiliated with the trademark owner); Morgan Stanley and Morgan Stanley Smith Barney Holdings LLC v. EnviroCitizen, LLC., NAF Claim No. FA1008001342402 (Nov. 26, 2010) (holding that the addition of the pejorative “screwed by” to the domain names in question eliminated any possibility of confusion); Jenny Solursh v. American European Marketing, NAF Claim No. FA0612000864749 (Jan. 15, 2007) (holding that Respondent’s <jennysolurshsucks.com> domain name was not confusingly similar to Complainant’s JENNY SOLURSH mark).

135. FMR Corp. v. Native American Warrior Society, Lamar Sneed, Lamar Sneed, WIPO Case No. D2004-0978 (Jan. 20, 2005).

136. Soci t  Air France v. Virtual Dates, Inc., WIPO Case No. D2005-0168 (May 24, 2005).

However, the disparity among UDRP panelists is more troubling. Absent a bright line rule, there is little to guidance for registrants, trademark owners, or the judicial bodies that decide such disputes. This places trademark owners and speech activists in an uncertain position with respect to the boundaries of permissible registration of such domain names. In particular, this uncertainty presents challenges to speech activists who might select <trademark-sucks.com> domain names as a good faith means of avoiding trademark misuse.

### *3. Initial Interest Confusion and Parody*

In domain name disputes, the traditional notion of confusion does not always fit well. In particular, when a legitimate gripe site is encountered by an Internet user, any confusion with the trademark target holder is likely ephemeral, because the user will soon realize that it has chanced upon a site that is critical of the trademark owner. Consequently, courts have been more preoccupied with initial interest confusion. In the context of domain name disputes, initial interest confusion derives from the unauthorized use of a trademark within a domain name to divert Internet traffic to the domain name holder's own site, thereby capitalizing on the trademark owner's goodwill.<sup>137</sup> In such cases, although the user's initial confusion is dispelled upon viewing the website, the confusion that causes the momentary diversion may be adequate to meet or support a finding of confusion.

The majority of federal circuits have adopted the initial interest confusion doctrine, some explicitly, others only implicitly.<sup>138</sup> Most federal courts require that a claim of initial interest confusion be accompanied by evidence of actual commercial use, i.e., the domain name

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137. Australian Gold, Inc. v. Hatfield, 436 F.3d 1228, 1239 (10th Cir. 2006).

138. See Jennifer E. Rothman, Initial Interest Confusion: Standing at the Crossroads of Trademark Law, 27 Cardozo L. Rev. 105, 108-09 (2005).

registrant is using its website to generate revenue. Where such use is absent, most courts have found no liability under the doctrine.<sup>139</sup> In contrast, when one business makes use of another's trademark specifically for its own financial gain in this manner, courts that have adopted the initial interest confusion doctrine have uniformly imposed liability.<sup>140</sup> UDRP panels have reached similar conclusions, recognizing the initial interest confusion doctrine and finding that such confusion may be adequate to meet the "identical or confusingly similar" prong set forth in the Policy, provided the associated website is being used commercially.<sup>141</sup>

Most tribunals that recognize the doctrine will not hold legitimate cybergrippers liable, since commercial use is not the purpose of their websites. However, initial interest confusion has been the basis for liability in some gripe site cases in which a commercial element was a small or incidental part of a site otherwise used to criticize others. For example, a New York district court held that a gripe site created actionable initial interest confusion, despite a disclaimer of affiliation posted prominently on the website.<sup>142</sup> In doing so, the district court determined that the cybergriper's site was commercial for three reasons: first, the site contained a single link to the cybergriper's own business website; second, the international nature of the internet was itself a kind of "use in commerce" and thus commercial in nature; and finally, the

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139. See, e.g., *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 683 (9th Cir. 2005) (stating "[b]ecause we hold that Kremer's use of Bosley's mark was noncommercial, we do not reach the issue of initial interest confusion"); *Taylor Bldg. Corp. of Am. v. Benfield*, 507 F. Supp. 2d 832, 846 (S.D. Ohio 2007) (denying Plaintiff's claim for initial interest confusion because the cybergriper's "site did not sell products or services or direct consumers to other vendors"); *Savannah College of Art and Design, Inc. v. Houeix*, 369 F. Supp. 2d 929 (S.D. Ohio Dec. 21, 2004) (gripe site did not create initial interest confusion because it did not meet the "purpose underlying the initial interest confusion doctrine: preventing competitors of a trademark holder from gaining an unfair financial or commercial advantage by luring unsuspecting users to their websites through use of the trademark").

140. See *PACAAR Inc. v. Telescan Techs., L.L.C.*, 319 F.3d 243, 253 (6th Cir. 2003); *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808, 812 (7th Cir. 2002); *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1055-56 (9th Cir. 1999).

141. See *AltaVista Co. v. AltaVisa*, NAF Claim No. FA0008000095480 (Oct. 31, 2000); *Rockwell Automation, Inc. v. Jose Hernandez*, NAF Claim No. FA1004001316859 (May 20, 2010); *Broan-Nutone, LLC v. Ready Set Sales*, WIPO Case No. D2010-0920 (July 27, 2010).

142. *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176 (W.D.N.Y. 2000).

cybergriper's use of the trademark owner's mark inhibited the plaintiff from itself using the mark, a kind of competitive commercial use.<sup>143</sup>

Initial interest confusion has also been found in some cases of pure cybergripping. In one such UDRP proceeding, a panel held that a purely critical, noncommercial website hosted at the trademark-identical domain name <dellorusso.info> was sufficient to cause initial interest confusion.<sup>144</sup> In so holding, the panel reasoning noted: "this reasoning in no way abridges Respondent's freedom to criticize Complainant. She is merely prevented from broadcasting her criticism from Complainant's soapbox, taking advantage of Complainant's mark to reach her intended audience."<sup>145</sup>

Several tribunals have reached determinations concerning free speech and trademark infringement in this context by divorcing the domain name at issue from the content of its associated website. Under this approach, if the domain name itself does not possess an expressive component, then it serves to create initial interest confusion, rather than expression, regardless of the content of the associated website. One such UDRP panel held that "[b]ecause Respondent's use of Complainant's mark in a domain name is not part of a communicative message, his use of Complainant's mark is not protected by the First Amendment."<sup>146</sup> Hence, "[w]hile the content of Respondent's website may enjoy First Amendment and fair use protection, those protections do not equate to rights or a legitimate interest with respect to a domain name which is confusingly similar to another's trademark."<sup>147</sup>

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143. *Id.* at 185-86.

144. Joseph Dello Russo M.D. v. Michelle Guillaumin, WIPO Case No. D2006-1627 (Apr. 27, 2007).

145. *Id.*

146. Annette A. Antoun d/b/a The Paxton Herald v. Stephen Millard, NAF Claim No. FA0207000114770 (Aug. 21, 2002).

147. *Id.*

Defendant registrants have sometimes sought to characterize their unauthorized use of another's trademark in a trademark-identical domain name as a form of parody, a carefully-guarded form of First Amendment speech that is well-recognized in American jurisprudence. However, the use of parody as a tool for commentary on the Internet has occasionally backfired. With respect to domain name disputes, this effect is tied to the fact that the legal criteria for a successful parody are narrow and well-established and the failure to adequately meet those criteria in the context of a parody-gripe site may sometimes provide a judicial shortcut to finding fault with the parody site. It has been held that for a parody to succeed, it must convey two contradictory messages simultaneously: it must suggest that it is the original – that is, the target of the parody – and it must at the same time suggest that it is poking fun at the original.<sup>148</sup> When it succeeds largely in accomplishing only the former, it fails as a parody and it is vulnerable to trademark law.<sup>149</sup> As Justice Souter has noted, “[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived.”<sup>150</sup>

In one celebrated and highly-controversial opinion by the Fourth Circuit Court of Appeals, the Court enjoined a cybergriper from the use of <peta.org>.<sup>151</sup> The parody-gripe site hosted at this domain name featured information about “People Eating Tasty Animals,” rather than the animal rights activism that is associated with the well-known organization PETA. Although the content of the site was clearly a parody, apparent to essentially anyone who viewed it, the Court looked solely at the domain name itself and arrived at the conclusion that <peta.org> did not convey a successful parody. The Fourth Circuit did not explicitly describe its analysis as

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148. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989).

149. *Id.*

150. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994).

151. *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001) (hereinafter PETA).

one that was grounded in initial interest confusion, but its analysis was consistent with the doctrine.

In a later decision, seemingly at odds with the PETA decision, the Fourth Circuit declined to enjoin a cybergriper's use of the domain name <fallwell.com>, which was an intentional misspelling of Reverend Jerry Falwell's name and website <falwell.com>.<sup>152</sup> In that case, the content hosted at the gripe site was not veiled in irony or parody as the content at <peta.org> had been; rather it was a more explicit criticism of Falwell's religious views. Although the domain name was essentially identical to the trademark, the Court looked beyond the domain name to the content of the associated website and found no offense. The Fourth Circuit recognized the apparent disparity between its decisions, but it suggested that its earlier "inquiry in PETA was limited to whether [the registrant's] use of the domain name "www.peta.org" constituted a successful enough parody."<sup>153</sup> In permitting the registrant's use of <fallwell.com> for its gripe site, the Fourth Circuit recognized the importance of reviewing the underlying site content in matters of alleged infringement, noting that "it has long been established that even when alleged infringers use the very marks at issue in titles, courts look to the underlying content to determine whether the titles create a likelihood of confusion as to source."<sup>154</sup>

These seemingly disparate decisions suggest that tribunals have met with difficulty in adapting existing statutory constructs to domain name disputes and they will sometimes avail themselves of the most convenient legal standard to reach the desired remedy. Had the registrant of <peta.org> avoided the use of a well-accepted form of criticism (parody), the Fourth Circuit might have been compelled to rely upon a different argument, or hold in the registrant's favor. Likewise, had Reverend Falwell's detractor chosen parody rather than express criticism, the

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152. *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005).

153. *Id.* at 316.

154. *Id.* at 322.

Court might have availed itself of this escape valve to reach a contrary decision. Other courts have similarly relied upon the failed parody of domain names divorced from their associated site content as a justification to enjoin their use.<sup>155</sup>

The initial interest confusion doctrine is a poor fit in domain name disputes as a whole and in particular, it is poorly adapted to gripe site disputes. The adoption of the doctrine in the cyber realm serves to create uncertainty for registrants, trademark owners, and ultimately the public. Within the World Wide Web, the elimination of initial interest confusion is almost immediate. As one UDRP panel opined:

any such confusion would, in the view of the majority of the Panel immediately be dispelled by the content on the Respondent's website. Second, and in any event, such a low level of confusion is, in the view of the majority of the Panel, a price worth paying to preserve the free exchange of ideas via the Internet. A user who stumbles upon the Respondent's site while looking for the Complainant's official site need only click the "back" button to return to his or her search.<sup>156</sup>

This argument is compelling. Even juxtaposed with a trademark-centric view, the justifications for extending trademark protection to domain names without consideration of the associated website content may be unnecessarily harsh, as users of the Internet are not so easily fooled:

It is clear that Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded, or unnerved when, after taking a stab at what they think is the most likely domain name for a particular web site guess wrong and bring up another's webpage [and further] nothing in trademark law requires that title to domain names that incorporate trademarks or portions of trademarks be provided to trademark holders.<sup>157</sup>

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155. *See, e.g.,* Pinehurst, Inc. v. Wick, 256 F. Supp. 2d 424, 429 (M.D.N.C. 2003) (stating “[l]ooking at Defendants' domain names alone, there is no suggestion of a parody”); Christian Dior Couture v. Christina Dior/Chris Vella, WIPO Case No. D2009-0032 (Feb. 27, 2009) (stating “[t]his Panel is of the view that where the parodical domain name does not sufficiently differentiate itself from the mark that it parodies . . . then the fact that a parody may be intended does not provide a right or legitimate interest for the purposes of the Policy”).

156. *Legal & General Group Plc v. Image Plus*, WIPO Case No. D2002-1019 (December 30, 2002).

157. *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377-80 (E.D. Pa. 2001).

Only the view that trademark rights grant absolute monopoly rights in words and symbols could substantiate the application of the initial interest confusion doctrine in domain name disputes, and this view is not consistent with U.S. trademark law.<sup>158</sup> The scope of legal protection for trademarks is limited to those instances where there is a genuine likelihood of confusion.<sup>159</sup>

In practice, the misdirection that a user experiences on the Internet when the user types in a domain name and finds something other than what was expected is not unusual. For example, a user may type <delta.com> into a browser address box, expecting to find a website about bathroom fixtures, but instead the user is directed to the website of a major airline. In such instances, there is momentary confusion that is immediately cleared up upon viewing the site content. Relying upon initial interest confusion as a means to satisfy the confusion requirement and/or the bad faith requirements of the Lanham Act, the ACPA, or the UDRP is contrary to the framework of established trademark law policy that prohibits such a monopoly on language.

Further, “where companies ‘are non-competitors, initial interest confusion does not have the same consequence, because there is no substituted product to buy from the junior user, and the senior user does not bear the prospect of harm.’”<sup>160</sup> This view is particularly compelling in the case of gripe sites that provide no competitive commercial offerings.

### *B. Conflicts Regarding Fair Use*

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158. See *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 133 (D. Mass. 1999) (stating “[h]olders of a famous mark are not automatically entitled to use that mark as their domain name; trademark law does not support such a monopoly”) *aff’d*, 232 F.3d 1 (1st Cir. 2000); *accord* *Chatam Int’l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 561 (E.D. Pa. 2001) *aff’d sub nom.* *Chatam Int’l Inc. v. Bodum, Inc.*, 40 F. App’x. 685 (3d Cir. 2002); *accord* *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 380 (E.D. Pa. 2001).

159. See 1 MCCARTHY §§ 2:10.

160. *Chatam Int’l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 558 (E.D. Pa. 2001) (citing *Checkpoint Systems*, 104 F.Supp.2d 427, 462 (D.N.J.2000)).

The fair use defense should provide immunity from liability for trademark misuse to essentially all genuine noncommercial gripe sites. After all, fair use is provided as a defense in the traditional provisions of the Lanham Act<sup>161</sup> as well as in the ACPA.<sup>162</sup> Fair use was clearly on the minds of the legislature in drafting anticybersquatting legislation, as it is mentioned in two separate provisions of the ACPA: in the explicit savings clause and also as one of the enumerated factors that can serve to refute a showing of bad faith.<sup>163</sup> Further, the legislative history indicates that the ACPA does not apply to any noncommercial uses of a trademark, including commentary, comparative advertising, criticism, parody, or news reporting.<sup>164</sup> Fair use is also given deference in the UDRP, where it serves as evidence that a registrant has legitimate rights to a domain name under the Policy.<sup>165</sup>

In addition, the Supreme Court's pronouncement in *KP Permanent Make-Up* leaves little doubt that the latitude afforded the fair use defense under U.S. law is substantial.<sup>166</sup> This would seem to suggest that there is little room for disagreement as to the legitimacy of gripe site domain names as a fair use of trademarks, provided that the associated websites do not violate other mainstream trademark policies, such as commercial use. However, there are two primary inconsistencies in the treatment of fair use among tribunals that reach determinations in gripe site cases: (1) the disagreement among the federal circuits over the appropriate standard, if any, for the nominative fair use defense; and (2) the treatment of fair use in the content of a gripe site as compared to within the domain name itself, especially by UDRP panels.

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161. 15 U.S.C. § 1115(b)(4).

162. 15 U.S.C. § 1125(d)(1)(B)(i)-(ii).

163. *Id.*

164. S. REP. NO. 106-140, at 14 (1999); 15 U.S.C. § 1125(d)(1)(B)(i)(IV).

165. UDRP, *supra* note 95, ¶ 4(c).

166. *KP Permanent Make-Up, Inc.* 543 U.S. at 121-22.

As noted previously, fair use in the domain name context may either be classic (descriptive) fair use, or nominative fair use.<sup>167</sup> In the context of gripe site domain names, fair use is more likely of the nominative variety, since gripe sites typically make unauthorized use of trademarks to refer to the trademark owner itself. Otherwise stated, the permissible use of another's trademark to identify, criticize, or compare the trademark owner itself is generally a necessary component of such sites. Where a domain name is being used to express speech directly, e.g., <walmart-sucks.com>, or to steer users to protected speech located on a website, nominative fair use would seem to provide a reasonable defense to claims of trademark misuse.

However, in the United States, the nominative fair use defense is largely exclusive to the Ninth and Third Circuits.<sup>168</sup> Other federal courts have been less willing to embrace this defense and some have expressly declined to adopt it.<sup>169</sup> The nominative fair use defense was first enunciated by the Ninth Circuit Court of Appeals in a non-cyberlaw context,<sup>170</sup> but that court has recently extended the doctrine to apply to domain names as well.<sup>171</sup> In contrast, the Sixth Circuit not only expressly refused to apply the defense; it did so in the context of a domain name dispute.<sup>172</sup> This inconsistency creates uncertainty in the sense that the use of domain names to

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167. Notably, following the United States Supreme Court's decision in *KP Permanent Make-Up*, the distinctions between nominative fair use and classic fair use may be less certain. See Carl Regelmann, *Trademark Nominative Fair Use: The Relevance of the "New Kids On The Block Factors" After the Supreme Court KP Permanent Make-Up v. Lasting Impression Decision*, 16 DEPAUL-LCA J. ART & ENT. L. 1 (2005) (arguing that the tests for nominative and classic fair use are now so similar, courts have difficulty determining which test to apply to a given fact pattern).

168. For a review of the circuit split on the issue of nominative fair use, see Lisa Williford Arthur, *EBay Becomes a Girl's New Best Friend as the Second Circuit Sidesteps the Nominative Fair Use Doctrine, Leaving Tiffany to Police Counterfeits in the Online Marketplace*, 12 N.C. J.L. & TECH. ON. 29, 35-40 (2010).

169. *Id.*

170. *New Kids on the Block*, 971 F.2d 302.

171. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010) (holding that Defendant automobile broker's use of Plaintiff's LEXUS trademark in their domain names was nominative fair use).

172. *PACCAR*, 319 F.3d 243 (stating the nominative fair use is "a defense allowed by the Ninth Circuit in cases where the defendant uses a trademark to describe the plaintiff's product rather than its own . . . [but] . . . [t]his circuit has never followed the nominative fair use analysis, always having applied the Frische's Restaurants test. We are not inclined to adopt the Ninth Circuit's analysis here").

express speech on the Internet is regulated by varying jurisdictional views. Hence, despite the global reach of the Internet, the availability of the defense will vary from circuit to circuit.

Several UDRP panels have also recognized nominative fair use. Among them, some have permitted the defense only when expressive speech is recognizable in the domain name itself, as in <nuvaringsideeffects.com>, in which a panel declined to transfer the domain name to the owner of the NUVA RING trademark because speech was inherent in the domain name.<sup>173</sup> Other panels have extended the doctrine and found nominative fair use even when the gripe site domain name is identical to the Complainant's trademark.<sup>174</sup> Still other panels have recognized nominative fair use only to the extent that it is a component of the content of the gripe site, but not when it is used in the domain name itself.<sup>175</sup> In one such proceeding, a panel held that the domain name <vivendiuniversalsucks.com> was not a fair use of Vivendi Universal's trademark, despite the inclusion of the word "sucks" in the domain name and the use of the mark solely for a website critical of Vivendi. Citing an earlier panel decision, the panel noted "the right to express

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173. N.V. Organon and Schering Plough Corporation v. Fields Law Firm and Stephen Fields, NAF Claim No. FA0904001259266 (June 16, 2009) (declining transfer and noting that respondent was "entitled to use the name of that product in his domain name, so long as the domain name, taken as a whole, is clear as to the purpose of the website and does not imply sponsorship or endorsement thereof by the proponents of that product"); *see also* Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall, WIPO Case No. D2009-1182 (Oct. 29, 2009) (finding fair use of the domain name <glennbeckrapedandmurderedayounggirlin1990.com> because Respondent's domain name used Complainant's trademark "in a manner that does not use more of the mark than is necessary and does not create confusion as to Complainant's sponsorship of Respondent's activities"); Newell Operating Company v. HostMonster.Com and Andrew Shalaby, WIPO Case No. D2008-1805 (Mar. 3, 2009) (declining to transfer <bernzomaticinjuries.com>, which was used in association with a gripe site describing issues with Complainant's Bernz O Matic products).

174. *See, e.g.*, Tom Papania v. Fraud Expose', Mr. George Adames, and Mr. Joe Baffa aka Rocky Scarfone, WIPO Case No. D2001-0978 (Oct. 4, 2001) (use by Respondent of Complainant's personal name as domain name found to be fair use when Respondent used the domain name to comment on Complainant's alleged criminal history); Frederick M. Nicholas, Administrator, The Sam Francis Estate v. Magidson Fine Art, Inc., WIPO Case No. D2000-0673 (Sept. 27, 2000) (declining to transfer <samfrancis.com> to Complainant the Estate of Sam Francis because it was being used to refer to the Respondent).

175. Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna, WIPO Case No. D2000-0869 (Sept. 25, 2000) (stating "Respondent could well have chosen to use a domain name that was not confusingly similar to Complainant's and/or in which Complainant had no rights; it intentionally chose not to do so . . . Respondent's free expression rights do not here give it a right or legitimate interest in the domain names at issue"); Six Continents Hotels, Inc. v. Georgetown Inc., WIPO Case No. D2003-0214 (May 18, 2003) (stating "[t]here is a difference between using a service mark such as Complainant's within the body of a website to distinguish hotel services of Complainant and those of other hotel service providers, on one hand, and using Complainant's mark as a domain name, on the other").

one's views is not the same as the right to use another's name to identify one's self as the source of those views."<sup>176</sup> In a similar decision, a WIPO panel held "[t]here is a difference between using a service mark such as Complainant's within the body of a website . . . on one hand, and using Complainant's mark as a domain name, on the other."<sup>177</sup>

Finally, some panels have circumvented the question altogether by simply resolving the remaining elements of the UDRP analysis. One panel that identified the inconsistency, but declined to take a position, seemed to indicate that the distinction may depend upon whether the speech is commercial or noncommercial:

Some would contend that Respondent does not need to use Complainant's name as a domain name to present the intended message because other alternatives are available . . . . Others would find this view an unwarranted restriction on free speech over the Internet, and would allow domain names to make a direct nominative reference to the subject of the message, just as the title of a biography may make direct reference to its subject . . . . This is an important and critical issue that may turn on the nature of the speech involved, so that the result could be different depending on whether the underlying use were commercial or noncommercial speech . . . . For the reasons discussed below, we do not need to resolve this difficult issue here.<sup>178</sup>

In any case, the application of the UDRP in this manner is counterintuitive. The UDRP was created to establish a framework for arbitration concerned with disputes over the registration and use of domain names, not website content.<sup>179</sup> In other words, the UDRP was designed to prevent cybersquatting upon domain names.<sup>180</sup> Any discussion of the application of the fair use defense solely to the content of the allegedly offending gripe site would appear to be nonsensical: the UDRP would be unnecessary if it were relegated to what is fair and not fair

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176. *Vivendi Universal v. Mr. Jay David Sallen and GO247.COM,INC.*, WIPO Case No. D2001-1121 (Nov. 7, 2001) (finding that Respondent had no legitimate interest in and ordering transfer of the domain name).

177. *Six Continents Hotels, Inc. v. Georgetown Inc.*, WIPO Case No. D2003-0214 (May 18, 2003).

178. *Jules I. Kendall v. Donald Mayer Re skipkendall.com*, WIPO Case No. D2000-0868 (Oct. 26, 2000) (declining to transfer <skipkendall.com> to Complainant because "this case involves alleged defamation, not cybersquatting. As such, it turns on issues that are outside the mandate of the Policy").

179. UDRP, *supra* note 95, ¶ 1.

180. *See Summit Industries, Inc. v. Jardine Performance Exhaust Inc.* WIPO Case No. D2001-1001 (October 15, 2001) (stating "The UDRP is designed to deal with simple cases of cybersquatting").

within the content of a website. But this is not the case; the UDRP, like the ACPA, was created to regulate the use of domain names. The provision of a fair use defense, if it applies at all, must apply to the fair use of trademarks within domain names. Indeed, the UDRP describes fair use as a means to show that the registrant has “rights to and legitimate interests in the domain name” in question.<sup>181</sup> As one panel noted, “Paragraph 4(c)(iii) . . . [of the Policy] . . . expressly addresses ‘fair use of the domain name’ and thus envisions that an entire domain name may be used in a nominative manner to describe a product.”<sup>182</sup>

To apply the UDRP otherwise essentially eviscerates the defense: domain name disputes are concerned with the registration and use of domain names, therefore the defense must also be applied to domain names; otherwise it has no place in the Policy. Panels that apply fair use inconsistently serve to muddy the waters of the mandate of the UDRP and make uncertain the scope of free expression that is available through the medium of domain names.

### *C. Conflicts Regarding Bad Faith*

Supreme Court Justice Elena Kagan once noted that “the application of First Amendment law is best understood and most readily explained as a kind of motive-hunting.”<sup>183</sup> Although Justice Kagan’s comment was iterated in a somewhat different context,<sup>184</sup> a corollary holds true in the context of Internet gripe site domain name disputes. Very often, it appears that the motive of the speaker, irrespective of the nature or value of the speech itself, is the focus of the dispute. At first, this seems reasonable: both the ACPA and the UDRP contain provisions indicating that

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181. UDRP, *supra* note 95, ¶ 4(c).

182. *Giddings & Lewis LLC v. Neal McKean d/b/a Machineworks, Inc. d/b/a IMachineTools.com*, WIPO Case No. D2000-1150 (Mar. 14, 2001).

183. Elena Kagan, *Private Speech, Public Purpose: The Role of Governmental Motive in First Amendment Doctrine*, 63 U. CHI. L. REV. 413, 414 (1996).

184. Justice Kagan proposed that governmental motives in limiting speech are often the real focus of First Amendment challenges. I propose that registrant motives in registering domain names are most commonly the real focus of the tribunals that decide gripe site disputes.

the registrant's intent is relevant to the inquiry. The ACPA explicitly lists the registrant's bad faith intent to profit as one of the three criteria that a trademark owner must demonstrate to succeed on its ACPA claim.<sup>185</sup> Similarly, the UDRP states that a complainant must demonstrate that the domain was registered and is being used in bad faith.<sup>186</sup> Among the examples listed in the UDRP, bad faith may be found where the registrant has "intentionally attempted to attract, for commercial gain, Internet users to [its] website or other on-line location, by creating a likelihood of confusion with the complainant's marks..."<sup>187</sup>

The drafters of these legal frameworks clearly viewed "intent" and the corresponding good/bad faith of the registrant as integral aspects of the cybersquatting inquiry.<sup>188</sup> In the case of true cybersquatting, this emphasis is not misplaced; damages in cybersquatting suits are often intangible and the best evidence of wrongdoing may be circumstantial evidence pointing to the intent of the registrant in implementing and/or registering the domain name. However, where a gripe site is the subject of the dispute, judicial bodies and UDRP panels may overstep their bounds in relying upon intent.

Arguably, the bad faith element present in the ACPA and UDRP are in conflict with the version of U.S. trademark law that existed prior to the enactment of those frameworks. There is substantial agreement among the Courts of Appeal that "the proper inquiry is not one of intent. In that sense, the Lanham Act is a strict liability statute. If consumers are confused by an infringing mark, the offender's motives are largely irrelevant."<sup>189</sup> If this is indeed the thrust of

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185. 15 U.S.C. § 1125(d)(1)(A)(i).

186. UDRP, *supra* note 95, ¶ 4(a)(iii).

187. *Id.* at ¶ 4(b)(v).

188. In fact, intent and good/bad faith appear in other areas of U.S. trademark law precedent as well. Among the Polaroid factors for determining the likelihood of confusion, the "defendant's good faith in adopting its own mark..." is included. *Polaroid Corp.*, 287 F.2d at 495. Likewise, additional damages are available for trademark dilution that is the product of "willful intent." 15 U.S.C. § 1125(c)(5)(B)(i)-(ii) (2006).

189. *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003) (citing *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 287 (6th Cir.1997); *Hard Rock Café Licensing Corp. v.*

U.S. trademark law, then it may be argued that the reverse should also be true: if consumers are *not* confused by the use of another's mark, then the offender's motives are largely irrelevant. Correspondingly, it could be said that if the restraint of free speech in the context of domain names is to be grounded in principles of trademark law, then it should not matter if a registrant acts with an ulterior motive in registering a domain name; it should only matter whether consumers are confused as to the source, sponsorship, or affiliation of that domain name and the associated website content.

This approach is probably harmonious with the regulation of legitimate gripe site disputes, which should not prove to confuse consumers, but it provides an obvious loophole for true cybersquatters who register domain names for the purpose of ransoming them back to interested trademark owners. In particular, when a cybersquatter registers a domain name, but does not post any content at an associated website, the possibility of confusion is essentially nonexistent, because the mark is not being used in association with anything. But if there is evidence that the registrant obtained the domain name with the intent to extort money from the interested trademark owner, tribunals have generally found bad faith and favored the trademark owner.<sup>190</sup>

The inquiry becomes more convoluted when a registrant is a direct competitor of the target of its gripe site. Facially, the content of the speech on the gripe site may appear to be

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Concession Servs., Inc., 955 F.2d 1143, 1152 n.6 (7th Cir.1992); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1188 (6th Cir.1988); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir.1986)).

190. *See, e.g.*, *E & J Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 270 (5th Cir.2002) (noting that defendant had made a business practice of selling domain names on eBay for no less than \$10,000); *Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316 (9th Cir.1998) (in which the defendant famously asked the plaintiff : “[w]hy do you want to fund your attorney's purchase of a new boat (or whatever) when you can facilitate the acquisition of ‘PanaVision.com’ cheaply and simply instead?”) *Id.* at 1319; *Ets Leobert, SARL v. Jeonggon Seo*, WIPO Case No. D2009-0004 (Apr. 8, 2009) (ordering transfer of the domain name and noting that “[i]t is well established that registering a domain name for the primary purpose of offering to sell, rent, or otherwise transfer the domain name for an amount in excess of the registration cost is evidence that a domain name was registered and being used in bad faith”); *adidas-Salomon AG v. Vincent Stipo*, WIPO Case No. D2001-0372 (May 14, 2001) (ordering transfer of the domain names in light of evidence that they “were registered primarily for the purpose of selling them to the Complainant or to a competitor of the Complainant for valuable consideration”).

purely noncommercial, First Amendment-protected critical speech, but the underlying motives of the competitor may be more nefarious: to destroy competition. However, they may not be; the right to voice criticism about an entity is not limited to those who are not in competition with that entity, and if such criticism serves the public good, it may be argued that it has merit, regardless of whether it also benefits the speaker. A speaker positioned thus may not act entirely altruistically, but this does fact not necessarily diminish the value of the speech. The Supreme Court, in its celebrated *Central Hudson* opinion, arrives at a similar conclusion, declaring: "[n]or should the economic motivation of a speaker qualify his constitutional protection; even Shakespeare may have been motivated by the prospect of pecuniary reward."<sup>191</sup>

Further, U.S. law is generally protective of noncommercial speech that may be harmful to the reputation of another. If the owner of a trademark could “enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.”<sup>192</sup>

Nevertheless, the UDRP specifically provides that circumstances indicating that a domain name registrant has “registered the domain name primarily for the purpose of disrupting the business of a competitor” may serve as evidence of bad faith.<sup>193</sup> Panels have correspondingly adopted this approach in reaching decisions. In one UDRP proceeding, a panel held that a gripe site registrant acted in bad faith when it registered the domain name <goldstashforcashsucks.com> and connected it to a website that criticized its competitor.<sup>194</sup> The panel reached this conclusion despite the absence of references or links to the Respondent’s own

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191. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 580 (1980).

192. *CPC Int’l., Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (quoting *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 33 (1st Cir. 1987))

193. UDRP, *supra* note 95, ¶ 4(b)(iii).

194. *HBT Investments, LLC d/b/a Valley Goldmine v. Christopher T. Bussing*, WIPO Case No. D2010-1326 (Sept. 24, 2010).

competing business.<sup>195</sup> In another decision, the panel was particularly offended by a dissatisfied customer's assertions on its gripe site and in correspondence stating that it would pursue its First Amendment rights vigorously, to the detriment of the trademark owner, if necessary.<sup>196</sup> The panel interpreted this as a bad faith attempt to disrupt the Complainant's business.<sup>197</sup>

In part, the bad faith inquiry is confounded by the arguably vague provisions included in the ACPA and the UDRP. The ACPA somewhat ambiguously mandates that bad faith "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."<sup>198</sup> Likewise, the non-exhaustive nature of the examples of bad faith enumerated in both the ACPA and the UDRP leave substantial room for interpretation.

The Eleventh Circuit has taken a broad stance on the ACPA's bad faith evidentiary requirement, noting that "[p]roving 'bad faith' is not enough. A defendant is liable only where a plaintiff can establish that the defendant had a 'bad faith intent to profit' . . . . We cannot read the words 'intent to profit' out of the statute."<sup>199</sup> No such language appears in the UDRP, however, lending itself to results inconsistent with U.S. law.

Further confusing the bad faith inquiry, at least one UDRP case suggests that if a domain name was registered in good faith, its later use in bad faith is not enough to satisfy the bad faith prong.<sup>200</sup> However, there are dissenting views among panelists on this point.<sup>201</sup>

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195. *Id.*

196. *See Reg Vardy Plc v. David Wilkinson*, WIPO Case No. D2001-0593 (July 3, 2001) (ordering transfer of several domain names from a dissatisfied customer who used them in association with a noncommercial consumer gripe site).

197. *Id.*

198. 15 U.S.C. § 1125 (d)(1)(B)(ii).

199. *S. Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009).

200. *See A Nattermann & Cie GmbH v Watson Pharmaceuticals Inc.*, WIPO Case D2010-0800 (Aug. 31, 2010).

201. *Id.* (dissenting opinion).

A few UDRP panels have recognized the difference between bad faith and criticism. One panel, in declining to transfer a cybergriper's disputed domain name, noted:

The UDRP has a narrow scope. It is meant to protect against trademark infringement, not to provide a general remedy for all misconduct involving domain names . . . The Respondent may be acting unfairly. He may be engaged in unwarranted disparagement. He may be acting childishly. He may be retaliating for having lost earlier Cybersquatting cases. But this does not necessarily mean that he may be forced to transfer the accused domain name to the complainant under the UDRP.<sup>202</sup>

The ACPA and the UDRP were designed to proscribe the act of cybersquatting, not to limit critical speech. Trademark law in the United States prior to the enactment of the ACPA and implementation of the UDRP was designed in large part to balance the interests of trademark owners with the need to allow others to use trademarks freely in the context of non-commercial speech.

Setting aside the volumes of litigation, legislation, legislative intent, judicial precedent, and scholarly opinion, the central argument behind gripe site domain name disputes can be distilled to one central point of disagreement: whether trademark owners have superior rights to domain names that are evocative of their trademarks, vis-à-vis cybergrippers who have already registered those domain names for the purpose of conveying speech. Confusion, fair use, and bad faith are all simply elements that tribunals apply in an attempt to determine who has superior rights. When precedent is inconsistent, tribunals can apply these principles in a manner that is sometimes preordained. Otherwise stated, the ACPA, the UDRP, and other legislative frameworks are relied upon to reach determinations in gripe site domain name disputes, but the tribunals that decide those disputes often find themselves working with muddled precedent and

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202. Wal-Mart Stores, Inc. v. wallmartcanadasucks.com and Kenneth J. Harvey, WIPO Case No. D2000-1104 (Nov. 23, 2000).

multiple sources of law; consequently, those tribunals can usually adapt some grain of precedent to reach a desired conclusion.

This, of course, only leads to greater inconsistency. Such inconsistency serves to confuse the parties who participate in the domain name space: trademark owners, cybergrippers, and by extension, the public. Ultimately, this may serve as a growing disincentive for these parties to depend upon domain names as reliable gateways to Internet content.

## V. THE DIMINISHING RELEVANCE OF DOMAIN NAMES

Gripe site dispute resolution inconsistencies are the growing pains inherent in implementing a framework to address the legal issues that emerge in conjunction with the arrival of new technology. The Internet presents particularly difficult challenges for the law: it is a tool of extraordinarily broad scope and its evolution has been rapid and continuous. In the tug-of-war between intellectual property rights and free speech, the Internet provides enormous opportunities for speakers to disseminate their views instantaneously to the world, and at the same time, it provides a swift and dangerous tool for would-be infringers of intellectual property.

Legislation designed to address the exploitation of the Internet necessarily faces the heavy burden of harmonizing laws with previously unforeseen technology, while remaining relevant as that technology evolves. Confronted with such a moving target, such legislation runs the risk of becoming quickly irrelevant.

### *A. The Evolution of Technological Spaces: Blogs and Other Social Media*

The ACPA and UDRP were implemented specifically to resolve issues concerning domain name rights and the scope of each has been narrowly construed in this manner. For

example, courts have held that the reach of the ACPA does not extend to subdomains or to the resource paths of given URLs, because these are not part of the domain name as it is identified by the statute. The Court of Appeals for the Sixth Circuit has advocated this view, focusing on the source-indicating power of a domain name and the relatively weaker ability of a resource path to indicate source for trademark purposes.<sup>203</sup> Other courts have reached similar conclusions, some relying on the weak source-indicating capacity of resource paths and others centering on the definition of the term “domain name” as it is used in the text of the ACPA.<sup>204</sup>

This approach appears to be reasonable: consumers commonly view the domain name portion of a URL as the central, most important segment of the address, since this is the minimum (and typically default) portion of a URL that a user is required to input in a web browser address box in order to reach a given website. In this sense, the likelihood of confusion is attenuated when a mark is used in some less prominent portion of the URL. For example, an Internet user viewing the URL <http://www.allaboutwatches.com/us/timex> is far less likely to presume that the domain name owner or website owner is affiliated with or endorsed by Timex than the same user viewing <http://www.timex.com>.

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203. *Interactive Products Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 696-97 (6th Cir. 2003) (citations omitted); *see also Patmont Motor Werks, Inc. v. Gateway Marine, Inc.*, No. C96-2703, 1997 WL 811770, at \*4 n.6 (N.D.Cal. Dec.18, 1997); *PACCAR, Inc. v. Telescan Tech. LLC*, 115 F.Supp.2d 772, 780 (E.D.Mich.2000).

204. *See Patmont Motor Werks, Inc. v. Gateway Marine, Inc.*, C 96-2703 TEH, 1997 WL 811770 (N.D. Cal. Dec. 18, 1997) (holding that the presence of Plaintiff's trademark in the path of Defendant's URL could not constitute a trademark violation due the unlikelihood that the resource path would be viewed as an indication of source); *Gregerson v. Vilana Fin., Inc.*, 2007 WL 2509718, at \*6 (D. Minn. Aug. 31, 2007) (holding that the URL <http://www.cgstock.com/essays/vilana.html>, which contained Plaintiff's VILANA trademark, was not subject to scrutiny under the ACPA because the dictionary definition of "URL" described a "domain name" as being separate and apart from a resource path); *Goforit Entertainment LLC v. Digimedia.com LP*, 2010 WL 4602549, at \*6 (N.D. Tex. Oct. 25, 2010) (concluding that "[u]nder the statute, the term 'domain name' means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet . . . . The only part of a web address that must be registered is the second level domain. Establishing a third level domain does not require registration with or assignment by a domain name registration authority").

It is also clear that resource paths and subdomains are beyond the scope of the UDRP. In its guidelines, WIPO has indicated that "the UDRP Administrative Procedure is only available for disputes concerning an alleged abusive *registration* of a domain name."<sup>205</sup> Because subdomains and resource paths cannot be registered, they are not within the reach of the UDRP; this is consistent with the legal basis of the UDRP, since the Policy is binding upon a party only once that party specifically registers a domain name. WIPO and NAF panel decisions have offered explicit support for this position as well.<sup>206</sup>

In the most basic sense, this seems logical. One could imagine that a URL with a subdomain like <http://timex.allaboutwatches.com> would present a reasonably low likelihood of consumer confusion, because most consumers accustomed to domain names would focus on the domain itself as a source indicator, rather than the subdomain. However, changing the nature of the URL could present a different impression. For example, consider the following hypothetical: a party registers the generic domain name <motorcycles.com> and uses it to sell an assortment of aftermarket motorcycle parts. The user decides to employ subdomains to categorize the items available through its website, relative to the manufacturer of the various motorcycles for which parts are available. One subdomain points to parts for Harley Davidson motorcycles, another to parts for Suzuki motorcycles, and so on. The corresponding URLs might include <http://harley.motorcycles.com> and <http://suzuki.motorcycles.com>.

Here, the potential for consumer confusion is likely greater. Even those consumers accustomed to attributing source solely to the domain name itself rather than to the subdomain

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205. See WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), <http://www.wipo.int/amc/en/domains/guide/#a3> (emphasis added).

206. See *Romantic Tours, Inc. v. Whois Privacy Protection Service, Inc.*, NAF Claim No. FA1003001316557 (April 28, 2010) ("[t]he Panelist notes that the UDRP does not offer relief for infringements via use of registered trademarks in post-domains and that the proceedings under the UDRP may be applied only to domain names"); *Kosmea Pty Limited v. Carmel Krpan*, WIPO Case No. D2000-0948 (October 3, 2000) ("[t]he Panel does not necessarily regard use of 'kosmea' as a directory name (as part of the URL path) as objectionable. It is only use as a domain name that creates an issue").

might be persuaded to read these URLs more literally as "Harley Motorcycles" and "Suzuki Motorcycles." And indeed, trademark owners may unintentionally encourage this kind of consumer impression by creating their own subdomain-domain combinations in this precise fashion, e.g., <shop.elizabetharden.com>.<sup>207</sup>

The inapplicability of the ACPA and UDRP to subdomains and resource paths seems trivial in the grand scheme of domain name disputes, until one considers the expansive use of this format in online blogs<sup>208</sup> and other social media like Facebook and Twitter. In particular, many user blogs are hosted on third party platforms like Blogger, TypePad, and WordPress, and these platforms frequently rely upon subdomains to create unique URLs for their users.<sup>209</sup> For example, the URL format for TypePad-hosted blogs is <x.typepad.com>, where "x" is the title that the user has chosen for the blog. Likewise, WordPress-hosted blogs appear as <x.wordpress.com> and Blogger-hosted blogs appear as <x.blogspot.com>. The sole element of the URL that changes from user to user within a given blogging platform's URL is the blog title, which constitutes the subdomain; the domain name itself remains constant. Because of this domain name uniformity, Internet users may ignore the domain name and instead regard the subdomain as a more likely indicator of the source of the blog's content.

In addition, the significance of the subdomain in the context of blogs may increase the subdomain's value in search engine algorithms, making it more likely that a user searching for a term will see results connected to blog subdomains rather than to domain names per se. For example, a user searching for a blog published by Wal-Mart might perform an Internet search for the terms "walmart" and "blog." Among the search results, the user might be presented with

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207. This URL resolves directly to the home page of beauty product retailer Elizabeth Arden, Inc.

208. A blog is "a Web site that contains an online personal journal with reflections, comments, and often hyperlinks provided by the writer." MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 133 (11th ed. 2005).

209. See TypePad, <http://www.typepad.com>; Google Blogger, <http://www.blogger.com>; and WordPress, <http://wordpress.org> (last visited Dec. 24, 2010).

links to blogs accessible at <walmartsucksorg.blogspot.com>, <walmartwatch.blogspot.com>, and <alwayslowprices.blogspot.com>. The first of these three URLs strongly suggests a critical site in light of the inclusion of the pejorative term "sucks" in the blog name. The second is less certain; "walmartwatch" may suggest a site endorsed by someone other than Wal-Mart or a site endorsed by the retailer itself. The third URL, which employs a popular Wal-Mart slogan, is arguably even less certain.<sup>210</sup> The user in search of a blog hosted by the retail giant would have to follow the links in order to determine whether they are endorsed by or critical of the trademark owner. Confusion, particularly in the case of the last blog, is likely, at least initially.

Because the use of a trademark in a subdomain is beyond the reach of the ACPA and the UDRP, trademark owners are equipped with fewer tools to combat cybersquatting in the context of blogs. Correspondingly, critical commentators whose genuine First Amendment speech has been consigned to relative obscurity may have a viable medium in which to voice their criticism without apprehension that it will be suppressed through overly-aggressive use of the streamlined ACPA or UDRP.

Blogging platforms, of course, typically employ user agreements that prohibit users from engaging in overt acts of intellectual property infringement, including acts akin to cybersquatting. These agreements typically require users to submit to terms of service that include prohibitions against trading on another party's trademark or identity, sometimes referred to as "name squatting." For instance, WordPress requires bloggers to agree to the following provision: "your blog is not named in a manner that misleads your readers into thinking that you are another person or company. For example, your blog's URL or name is not the name of a person other than yourself or company other than your own."<sup>211</sup> Hence, while the use of

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210. In fact, all three URLs lead to blogs that contain commentary critical of Wal-Mart.

211. WordPress Terms of Service, <http://en.wordpress.com/tos> (last visited Dec. 24, 2010).

another's trademark within a blog subdomain falls outside the scope of the ACPA and UDRP, such use may be governed instead by private entities with their own interests.

The implications of this arrangement are readily illustrated by the regulation of name squatting in newer forms of social media like Facebook and the micro-blogging client Twitter. These clients insert usernames in the resource path of each user's unique page.<sup>212</sup> For example, user John Doe's Twitter feed might appear at <<http://www.twitter.com/johndoe>>; the same user might also choose "John Doe" as his Facebook username, resulting in the URL <<http://www.facebook.com/johndoe>>. Name squatters take advantage of this configuration by registering usernames that are similar or identical to the trademarks of well-known entities, in the hope of somehow monetizing the traffic drawn to that account through the suggested association with the mark. Searching for a Twitter or Facebook username will generate search results that are similar to that username, including usernames that are synonymous with trademarks. For example, entering the term "walmart" in Twitter's native user search engine reveals a long list of Twitter user accounts incorporating the Wal-Mart trademark, less than half of which are legitimately connected to the retail giant itself. These accounts are used for everything from noncommercial critical speech to pure commercial use. One such account, labeled "wakeup\_walmart," bills itself as "America's Campaign to Change Wal-Mart," seemingly a forum for protected critical speech.<sup>213</sup> Another search result includes "WalmartReview," which

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212. Facebook did not initially employ this approach. Instead, Facebook assigned a random number to each Facebook user's URL, e.g., <<http://www.facebook.com/profile.php?id=59856925>>. In 2009, Facebook changed this policy to allow users to select a username to appear in their unique URL. Notably, Facebook offered a "sunrise" period prior to this, during which trademark owners could register their names in order to limit name squatting. See Blaise DiPersia, *Coming Soon: Facebook Usernames* (June 9, 2009) <http://blog.facebook.com/blog.php?post=90316352130>; see also Dan Kelly, *Time to Defend your Rights on Facebook* (June 12, 2009), <http://www.duetsblog.com/2009/06/articles/domain-names/time-to-defend-your-rights-on-facebook>.

213. Located at [http://twitter.com#!/wakeup\\_walmart](http://twitter.com#!/wakeup_walmart).

redirects users to <<http://twitter.com/walmartreview>>, where the user has posted only two comments:

Buy this powerful Twitter site right now for \$125 and start a massive newsletter to get the message out #Walmart

What would it take for your [sic] to obtain this site right now and start one of the strongest newsletters ever? Help #Walmart ...Only \$125<sup>214</sup>

The user who created the "WalmartReview" Twitter account has implemented strategy borrowed from domain name cybersquatting by relying upon confusion to attract users who search for "Wal-Mart" in Twitter's user account database. The intention is clear, as well: the user has created the free account in the hope that someone will recognize its value and purchase it. The user also appears to portray its intentions as an innocent opportunity to create speech ("get the message out"). Finally, the user has employed the use of a hash tag to promote visibility, if not confusion: the inclusion of "#walmart" in each of its tweets has the effect of grouping "WalmartReview" with other results that contain the same hash tag when a user searches the Twitter database for "Wal-Mart."

Other accounts that appear in the "Wal-Mart" Twitter database search results include "StopHtsWalMart" and "People of Walmart." The former contains tweets protesting the planned development of a Wal-Mart in the Houston Heights community of Houston, Texas. Both the Twitter feed, located at <<http://twitter.com/StopHtsWalMart>> and the affiliated website located at <<http://stopheightswalmart.org>> make liberal use of the Wal-Mart trademark in a nominative fashion and neither contain commercial content or links thereto. All of the content is positioned to protest the proposed retail store and the initiative that sponsors the site is, reportedly, a non-

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214. See Twitter User Account Walmartreview, <http://twitter.com/walmartreview> (last visited Dec. 24, 2010).

profit organization established to support local businesses.<sup>215</sup> Analogous content is hosted on Facebook's servers at <<http://www.facebook.com/StopHeightsWalMart>> and, like its Twitter equivalent, the "Stop the Heights Wal-Mart!" Facebook page is discoverable upon searching Facebook's native search engine for the term "walmart."

In contrast, "People of Walmart" is a commercial site masquerading as satire. The account holder uses the Wal-Mart trademark in its account name and within its Twitter feed and Facebook page to redirect attention to its website located at <[www.peopleofwalmart.com](http://www.peopleofwalmart.com)>. This website, which hosts user-submitted, awkward photos of Wal-Mart shoppers, is a self-described "satirical social commentary of the extraordinary sights found at America's favorite store."<sup>216</sup> However, the website also features a robust online retail store selling "People of Walmart"-branded products. Further, the site contains banner ads and click-through advertising to other online merchants, some of which feature the same products that are sold at Wal-Mart. While it is clear that the content located at the <[www.peopleofwalmart.com](http://www.peopleofwalmart.com)> website is at least partially satirical, it is doubtful that the domain name would survive traditional Lanham Act, ACPA, or UDRP scrutiny, because the site contains both non-commercial and commercial elements and the domain name itself is not unmistakably pejorative.

In a culture of ephemeral web content, Facebook and Twitter are part of the technology of the moment. Facebook currently features more than 500 million active users who spend over 700 billion minutes per month perusing its pages,<sup>217</sup> while Twitter boasts more than 145 million users of its own.<sup>218</sup> The potential to leverage these clients as a platform for speech is enormous.

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215. See RUDH Local Business Coalition, <http://stopheightswalmart.org/rudh-local-business-coalition> (last visited Dec. 24, 2010).

216. See About People of Walmart, [http://www.peopleofwalmart.com/?page\\_id=12](http://www.peopleofwalmart.com/?page_id=12) (last visited Dec. 24, 2010).

217. Facebook Press Room, <http://www.facebook.com/press/info.php?statistics> (last visited Dec. 24, 2010).

218. Twitter Blog, The Evolving Ecosystem (Sept. 2, 2010), <http://blog.twitter.com/2010/09/evolving-ecosystem.html>.

In contrast to the World Wide Web as a whole, social networks specifically drive connectivity between users, increasing the likelihood that users will view and recycle content by creating both search-based results and feed-driven results. For example, a user may encounter speech about the initiative to stop the development of a Wal-Mart retail store in Houston by searching Facebook or Twitter for the term "walmart"; but a user may also encounter the same speech when it is reposted by other people familiar to the user. The latter scenario serves to propagate speech rapidly, as users sympathetic to one another are likely to share content through the streamlined medium of social networks.

Like blogging platforms, the terms of service to which a user must agree in order to establish a Twitter or Facebook account contain express prohibitions against the unauthorized use of others' trademarks and provide remedies for alleged infringement of this nature.<sup>219</sup> Both Facebook<sup>220</sup> and Twitter<sup>221</sup> explicitly prohibit "username squatting." Twitter offers a list of factors that it identifies as suggestive of username squatting.<sup>222</sup> Some familiar indicators appear in this list, including the number of accounts created by a given user and the creation of such accounts "for the purpose of selling those accounts."<sup>223</sup>

At the same time, Twitter permits users to create parody, commentary, and fan accounts. Accounts of this nature are allowable as long as they do not "try to deceive or mislead others"

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219. See Twitter Trademark Policy (Jan. 14, 2009), <http://twitter.zendesk.com/forums/26257/entries/18367>; Facebook Terms of Service (Oct. 4, 2010), <http://www.facebook.com/terms.php> (stating "[i]f you select a username for your account we reserve the right to remove or reclaim it if we believe appropriate . . . such as when a trademark owner complains about a username that does not closely relate to a user's actual name").

220. Facebook Help Center, <http://www.facebook.com/help/?page=897> (last visited Dec. 24, 2010).

221. Twitter Name Squatting Policy, <http://support.twitter.com/forums/26257/entries/18370> (last visited Dec. 24, 2010).

222. See Twitter Help Center, The Twitter Rules, <http://support.twitter.com/articles/18311-the-twitter-rules> (last visited Dec. 24, 2010).

223. *Id.*

about the account user's identity and as long as the username is not "the exact name of the subject of the parody, commentary, or fandom."<sup>224</sup>

These policies are clearly borrowed from cybersquatting legal frameworks like the ACPA and the UDRP, but because username squatting falls outside the legal of these frameworks, policing it is largely in the hands of the social media service providers. Service providers like Twitter and Facebook may be sympathetic to trademark owners, particularly when they are business partners who advertise with the service provider, but at the same time, they have a financial incentive to respect the interests of their users in order to maintain goodwill. In this sense, speech advocates may have better footing vis-à-vis trademark holders than they do in the domain name space, because they are initially subject to private rather than judicial scrutiny.

### *B. The Evolving Nature of Search*

The manner in which Internet users search for content on the World Wide Web is in a constant state of evolution. Through the growth of the Internet and the explosion of its use by businesses as a retail and marketing tool, consumers have become increasingly aware that typing a domain name directly into the address box of an Internet browser may yield a result other than that which was sought. Such users typically turn to search engine queries instead. For example, an Internet user interested in finding a website associated with Dove Chocolate bars may anticipate that entering <dove.com> into the browser address box is just as likely to lead to the website of the well-known Dove company that sells soap and other bath products. Likewise, a consumer who has typed <delta.com> into a browser address box in the past in search of Delta Faucets or Delta Dental Insurance may recall that that the domain resolved instead to Delta

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224. Twitter Parody, Commentary, and Fan Accounts Policy, <http://support.twitter.com/articles/106373-parody-commentary-and-fan-accounts-policy> (last visited December 24, 2010).

Airlines. In such cases, the consumer may opt to perform a search for "delta faucets" or "delta dental" in a search engine, knowing that this will quickly yield a list of search results, among which the desired site will be apparent.

The same logic may apply to users who seek websites affiliated with companies that have commonly misspelled names, e.g. Oscar Mayer (frequently misspelled Oscar Meyer) and Volkswagen (often misspelled Volkswagon). Users who are unsure of the exact spelling may decline to experiment with entering domain names in a browser address box when they know that a search query will quickly yield a spell-corrected list of results.

The increasing reliance by users upon search engines to locate websites has gained momentum through the efforts of search engine developers like Google and Microsoft, which market the speed and accuracy of their services. Google has experienced unqualified financial success by inserting itself between the user and the Internet as a kind of gateway to content. In doing so, entities like Google become intermediaries in the user's Internet search. This is significant for a number of reasons. First, search engine providers choose how search results will be displayed. Most search engines display a list of results and each result in the list is subdivided into three parts: (1) the website title is featured prominently; (2) beneath the title appears a "snippet" of the site's content, i.e., a short abstract or sample of content that appears on the site; and (3) beneath the snippet appears the actual website address, which contains the domain name. In Google and Bing search results, the domain name itself is always listed at the bottom of each result and it appears in a font substantially smaller than the title.

Eye tracking experiments have revealed that the majority of users who view such search results spend little or no time looking at the site address portion of each search result; rather, users tend to scan from title to title and snippet to snippet in an abbreviated fashion before

clicking on one of the results.<sup>225</sup> In attempting to determine whether a result is consistent with the information a user seeks, the user typically ignores the website address.<sup>226</sup> Further, when a user clicks on a result and is directed to a website, the user is likely to focus his or her attention immediately on the content of the site itself, without noting the website address that appears in the address bar. In this manner, search engine providers deemphasize the relevance of domain names by diminishing the part that they play in guiding a user to content.

Further, the line between type-in traffic and search traffic has begun to blur. In recent years, most browsers have featured both an address box, where the user can enter a website address, and a search box, where the user can enter a search term to query. By contrast, Google's Chrome browser, which was introduced in 2008 and has gained a steadily increasing share of the browser market,<sup>227</sup> features the "Omnibox," which combines the functionality of both a traditional address bar and a search box. Hence, users searching for Wal-Mart on the Internet can type "walmart.com" into the Omnibox and they will be directed to the website located at <www.walmart.com>, or they can simply type "walmart" into the Omnibox, in which case they will be directed to a search results page relevant to their query. Users who become accustomed to using the Omnibox for both purposes may be more likely to refrain from typing a syntax-sensitive URL (e.g. <http://www.mitsubishicars.com>) in deference to simply typing an approximation of what they seek ("mitsubishi").

The foregoing factors tend to lessen the importance of domain names to users and they may affect free speech and trademark rights in the context of the Internet in several ways. First,

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225. See Mari-Carmen Marcos & Cristina González-Caro, *Comportamiento de los Usuarios en la Página de Resultados de los Buscadores. Un Estudio Basado en Eye Tracking*, 19 EL PROFESIONAL DE LA INFORMACIÓN 348 (2010), translation available at <http://dynamical.biz/blog/web-analytics/serps-user-behaviour-eye-tracking-study-32.html>.

226. *Id.*

227. See PC World, *Internet Explorer Browser Share Dips As Chrome Rises* (Oct. 5, 2010), [http://www.pcworld.com/businesscenter/article/207000/internet\\_explorer\\_browser\\_share\\_dips\\_as\\_chrome\\_rises.html](http://www.pcworld.com/businesscenter/article/207000/internet_explorer_browser_share_dips_as_chrome_rises.html).

search engines have the ability to reduce consumer confusion in the trademark sense. As users transition away from type-in search, the likelihood of their confusion should also decrease, as they elect to choose from among a list of detailed search results, rather than relying upon simple trial and error. This has not escaped the attention of at least one WIPO panel, which noted:

in the early days of the Internet, users would routinely type in a URL incorporating a mark, expecting to find the site of the trademark owner. Nowadays search engines are frequently used instead to display numerous links generated by the search term used. Users select the link to a site without the same expectation of finding the site of the trademark owner and, upon reaching a site they immediately perceive to be the wrong one, they return to their search engine to find the site they want. Hence, today there may be less likelihood of confusion.<sup>228</sup>

For example, an Internet user who employs Google's search engine to search for "walmart" will be provided with a list of search results consisting of many pages. Whether the gripe site located at <www.peopleofwalmart.com> is listed near the top of those search results will depend upon a calculation by Google's search algorithm. Correspondingly, the position of this gripe site in the search results will have some effect on whether users believe, at least initially, that <www.peopleofwalmart.com> is sponsored, affiliated with, or endorsed by Wal-Mart. If it appears close to the top of the search results, there is probably more likelihood of confusion, at least of the initial interest variety. If it appears lower, the likelihood is correspondingly lower.

The use of search engines inserts entities like Google into the conflict between free speech and trademark rights in cyberspace. In designing, refining, and utilizing their complex search algorithms, search engine providers position themselves as active participants in determining the nature of the content that users are likely to see as they interact with the Internet. Google's current search algorithm is a technologically enormous leap forward from the early

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228. Gnarls Barkley, L.L.C. v. Pax Stereo, NAF Claim No. FA0808001221421 (Oct. 12, 2008) (ordering transfer of <gnarlsbarkley.tv> to multiple-Grammy-award-winning musical group Gnarls Barkley).

days of the World Wide Web, when search engines could be very easily manipulated by clever website creators to divert traffic to their websites.<sup>229</sup> And while it is still vulnerable to a certain degree of manipulation, the Google search algorithm was designed to produce accurate results and it does this extraordinarily well. However, there is an argument that Google and other search engine providers may do this too well. Specifically, search algorithms that tweak a user's experience to fit the individual user's search criteria and search habits create a kind of filter through which the user's Internet experience passes. Google has done this by increasingly relying upon its users' search history to provide results that are better tailored to each user's interests.<sup>230</sup> Arguably, this limits the information that a user encounters and it effectively diminishes the likelihood that a user will be exposed to speech that might challenge or expand the user's ideological framework. In effect, highly accurate search engine results neutralize the classic soapbox effect that has been a vehicle for disseminating speech throughout history.

Trademark owners might argue that this effect is a necessary consequence of preventing confusion on the Internet that might otherwise diminish the value of their marks. Speech advocates would likely offer the view that the cost is too high to the public: the shift to reliance upon search engines substantially attenuates the communicative nature of the Internet, diminishing the flow of information.

### *C. The Dilution of the Domain Name System*

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229. Google's trade secret-protected search algorithm is said to consider more than 200 "signals" in analyzing and ranking web pages. See Saul Hansell, *Google Keeps Tweaking Its Search Engine*, THE NEW YORK TIMES, June 3, 2007, available at <http://www.nytimes.com/2007/06/03/business/yourmoney/03google.html>

230. The Register, Google 'personalizes' one in five searches [http://www.theregister.co.uk/2010/03/03/google\\_personalized\\_search\\_explained](http://www.theregister.co.uk/2010/03/03/google_personalized_search_explained) (Mar. 3, 2010); see also Google, What is a Custom Search Engine?, <http://www.google.com/support/customsearch/bin/answer.py?hl=en&answer=70308> (last visited Dec. 24, 2010).

As companies like Google slowly pull users away from domain names as search instruments in favor of their own search tools, ICANN may be inadvertently nudging users in the same direction. New domain name hierarchy protocols are on the near horizon which will expand the domain name space to “allow for a greater degree of innovation and choice.”<sup>231</sup> However, it may be argued that this expansion will only push Internet users closer to relying upon search engines to locate content on the Internet.

At present, .com domain names account for a disproportionately high 75% of all generic TLDs registered.<sup>232</sup> The remaining 25% are comprised of .net, .org, and eighteen other lesser-used generic TLDs.<sup>233</sup> The number of businesses (as opposed to the general public) using the .com TLD rather than one of the other generic TLDs is almost certainly even higher. Because of this, consumers who search for websites on the Internet via the type-in approach typically default to .com as their TLD of choice; i.e., a type-in user searching for Wal-Mart's website on the Internet will most likely attempt <walmart.com> first. In addition, most Internet browsers append .com by default to any keyword entered into a browser address box if the user types simply the keyword and then strikes the CTRL + ENTER keys.

Recognizing that the narrow use of existing generic TLDs and over-reliance on the .com TLD may be detrimental to innovation and to the ability of entities to create digital identities, ICANN introduced a new initiative in 2008 to explore the possibility of expanding the number of TLDs, potentially by the thousands.<sup>234</sup> ICANN's program is currently nearing implementation, and it will differ from the current registration process in several respects. At present, if a person

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231. ICANN, New gTLD Program, <http://www.icann.org/en/topics/new-gtld-program.htm> (last visited Dec. 24, 2010).

232. See WebHosting.Info, Global Domain Registry Statistics, <http://www.webhosting.info/registries> (last visited December 24, 2010).

233. See *Id.*

234. ICANN, New gTLDs — Frequently Asked Questions (Oct. 24, 2008), <http://icann.org/en/topics/new-gtlds/strategy-faq.htm>.

or entity wishes to acquire a domain name, the name can simply be purchased through any of the multitude of existing domain name registrars, as long as the desired second level domain is available. ICANN's new approach will allow any organization to apply to become the registrar of its own proposed generic TLD, ranging in length from 3-63 characters.<sup>235</sup> For example, the well-known camera equipment manufacturer Canon will be able to apply to administer a new .canon TLD.<sup>236</sup> Canon would then be able to use its TLD to create domains like <my.canon>, <support.canon>, <products.canon>, and so on. In effect, a new TLD registrar could arrange to have *any* second level domain name used in combination with its TLD redirect users to a valid web page. For example, a user who types <[x].canon> into its browser address box, where “x” is any combination of letters and numbers, could be redirected to an active Canon web page such as <home.canon>.

The application process will be both lengthy<sup>237</sup> and expensive,<sup>238</sup> but if approved, an organization will be able to administer its own TLD and generate an essentially infinite number of domain names under that TLD. Approval will be limited to organizations; individuals and sole proprietors will not be permitted to obtain new TLDs, ostensibly due to the “complexity and

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235. These domains will fall into a wide range of categories, including cities (e.g., .nyc and .paris), regions (.africa, .bay), communities (.gay, .eco), ethnicities (.zulu, .kurd), specialized interests (.money, .videos), and branded domains (.canon, .deloitte).

236. In fact, Canon has announced its intention to do so. *See* Press Release, Canon, Inc., Canon to Begin Acquisition of the ".canon" Top-Level Domain Name (Mar. 16, 2010), *available at* <http://www.canon.com/news/2010/mar16e.html>. Other companies have made similar announcements. *See* Navin Ganeshan, *Beyond .Dot .Com— The New Wild Wild West for Business Identity*, Dec. 17, 2010, <http://www.networksolutions.com/blog/2010/beyond-dot-com-the-new-wild-wild-west-for-business-identity>.

237. ICANN has estimated that the approval process to obtain a new gTLD will require 8-18 months. *See* ICANN, *New gTLDs - FAQs*, *supra* note 234.

238. ICANN has proposed an application fee of US \$185,000 per gTLD and an additional \$25,000 per year for each successful new gTLD operator. *See* ICANN, *How to Apply for a New Generic Top-Level Domain*, <http://www.icann.org/en/announcements/announcement-2-23oct08-en.htm> (last visited Dec. 24, 2010); *see also* Carolyn Duffy Marsan, *ICANN: New Domains Coming in 2010* (June 24, 2009), <http://www.networkworld.com/news/2009/062409-icann-new-domains.html>.

required resources involved.”<sup>239</sup> Further, approval will be preceded by an application and evaluation phase, following which proposed TLDs will be published for opposition by the public, much the way U.S. trademark applications are published for opposition prior to final allowance.<sup>240</sup>

ICANN’s current plan to introduce new gTLDs differs markedly from the approach it has employed in the past to enlarge the domain name space. Specifically, ICANN has previously attempted to relieve some of the demand for .com domain names by expanding gTLDs to include .biz, .info, .name, .museum, and others, through the same approach used to register .com, .net, and .org domain names. Despite this, the popularity of .com as the gTLD of choice has been affected very little by the introduction of new domain names, as consumers continue to default to .com as the most likely location for the content they seek.<sup>241</sup> However, ICANN’s new approach may affect Internet users differently.

Assuming that the opposition process is rigorous, ICANN’s new gTLD registration process would appear to show a strong preference for trademark owners vis-à-vis cybersquatters and cybergrippers. From the trademark owner’s standpoint, acquisition and use of a TLD similar to one’s trademark will likely be desirable, because it will provide the owner with a monopoly on the full breadth of domain names that incorporate its TLD.<sup>242</sup> Trademark owners may deem this approach valuable because cybersquatters and cybergrippers will presumably be prevented from making use of the new TLDs, due to the opposition period, the prohibitive cost, and the

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239. See ICANN, Application & Evaluation Process (Oct. 24, 2008), <http://icann.org/en/topics/new-gtlds/strategy-faq.htm#application>.

240. *Id.*

241. The .biz TLD, for example, presently accounts for only about 1.7% of all TLDs registered, as compared to .com, which holds a 74.3% market share. See Global Domain Registry Statistics, <http://webhosting.info/registries> (last visited December 24, 2010).

242. ICANN has suggested as much: "brand holders and organizations seeking to manage their own name as a top-level domain may have an interest in securing these rights in the early phases of the new gTLD program for future branding purposes. With the limited availability of .com domain names, some companies may opt to become early adopters of new TLDs to satisfy their marketing needs." ICANN, New gTLDs - FAQs, *supra* note 234.

additional requirement that applications must originate from organizations, rather than from individuals.

As the breadth of potential domain names widens almost infinitely, there is theoretically more room for all parties to engage in the use of domain names as tools for both commerce and speech. However, individuals and small entities may be placed at a disadvantage in the new TLD framework, since they will be unable to register such domains. This, of course, includes cybergrippers, who are most often individuals or small groups. Certainly, cybergrippers will still be free to register and use traditional second level domain names that are identical or confusingly similar to their targets' trademarks, subject to the scrutiny of the ACPA and the UDRP. Likewise, cybergrippers will always be able to post critical speech at consumer complaint clearinghouse websites like <www.ripoffreport.com> and <consumerreports.org>. But if cybergrippers are indeed left out of the new TLD acquisition process, they will be relegated to traditional second level domains as gateways for critical speech and this may diminish their capacity to be heard. If both companies and consumers embrace the new TLDs, an eventual division between the domain names used commercially and those used non-commercially may occur, as was previously envisioned when the .com and .org domain names were first created. Cybergrippers will no longer be able to rely upon the likelihood that consumers seeking information about the targets of their criticism will encounter their gripe sites, reducing their ability to reach an audience greater than those who directly seek their advocacy.

Despite ICANN's best intentions, the creation of new TLDs may not only curtail free speech, it may also ultimately result in diminished consumer reliance upon domain names as search tools. The introduction of hundreds or thousands of new top level domain names will provide trademark owners with greater assurance that they will have exclusive control over

domain names corresponding to their marks, but it will likely also generate uncertainty among consumers. Specifically, if companies embrace the new system, consumers will initially be at a loss as to whether to locate a particular company via its .com address or at a proprietary TLD like .ibm. While most large companies will simply seek to obtain both a .com domain and a new TLD, the uncertainty that consumers experience in deciding where to locate such companies on the Internet may lead to a whittling away of the value of domain names as a whole. If this theory is correct, domain names will diminish in their capacity to serve a distinguishing role and consequently consumers will rely more heavily upon search engines as the default tools to locate content on the Internet. This again places the moderation of free speech vis-à-vis trademark rights in the hands of private entities like Google and outside of the reach of the UDRP and the ACPA.

## VI. THE FUTURE OF DOMAIN NAME DISPUTES

In a practical sense, the impact of this shift is only beginning to be felt. A user interested in locating information about Red Lobster on the Internet will most likely continue to type <redlobster.com> into a browser address box, at least in the near term. The rate at which domain names are being registered continues to grow and there is no indication that this trend will change in the immediate future.<sup>243</sup> Likewise, the number of domain name disputes decided by tribunals has steadily increased.<sup>244</sup> A review of WIPO and NAF statistics reveals that, aside

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243. Zoonic, History of gTLD Domain Name Growth, <http://www.zooknic.com/Domains/counts.html> (last visited December 24, 2010); *see also* VeriSign, The Domain Name Industry Brief (Nov. 2010), *available at* [http://www.verisigninc.com/assets/Verisign\\_DNIB\\_Nov2010\\_WEB.pdf](http://www.verisigninc.com/assets/Verisign_DNIB_Nov2010_WEB.pdf).

244. *See* WIPO – Total Number of Cases Per Year, <http://www.wipo.int/amc/en/domains/statistics/cases.jsp> (last visited Dec. 24, 2010); NATIONAL ARBITRATION FORUM, FAST FACTS: DOMAIN NAME DISPUTE RESOLUTION (2010), <http://domains.nationalarbitrationforum.org/rcontrol/resources/DomainNameDisputeResolution-FactSheet.pdf>.

from a single low-point in 2003, the number of UDRP proceedings has increased every year.<sup>245</sup> This data would seem to suggest that domain names are still regarded as highly-valued virtual property.

There is a counter argument, however: at least one commentator has suggested that proportionally fewer UDRP proceedings are being instituted, as compared to the rate at which domain name registrations are increasing.<sup>246</sup> Otherwise stated, the increase in UDRP proceedings is not in step with the even greater concurrent increase in domain name registrations, hence the percentage of disputes has actually decreased over time. If this is indeed the case, there are several possible explanations for the proportional decrease in the number of disputes that are being filed. On the one hand, this phenomenon may simply be attributable to the increasing ability of targeted cybersquatting legislation to serve as a deterrent to cybersquatters and cybergrippers. It may also represent a natural distillation of domain names that contain trademarks over the past fifteen years; that is to say, over time, many of the largest trademark owners have gradually acquired domain names that evoke their trademarks, leaving fewer opportunities for disputes.

Conversely, it may be argued that this effect is the product of a growing tendency among trademark owners to defer from seeking resolution of domain name disputes through UDRP proceedings and federal litigation. This tendency could be explained by the uncertainty that trademark owners experience with respect to the outcome of such proceedings. If trademark owners have indeed become jaded, they will be less likely to avail themselves of domain name dispute remedies in all but the most egregious cases.

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245. *Id.*

246. See Antony Van Couvering, WIPO Cybersquatting Report Ignores Real Cybersquatting Trends (Mar. 18, 2009), [http://www.circleid.com/posts/20090318\\_wipo\\_cybersquatting\\_report\\_ignores\\_real\\_udrp\\_trends](http://www.circleid.com/posts/20090318_wipo_cybersquatting_report_ignores_real_udrp_trends) (last visited Dec. 24, 2010).

Whatever the explanation, there is a real possibility that the relative number of domain name disputes is diminishing and at least part of this effect may be attributed to the perception that domain names are less critical tools than they once were. In practice, most marketing professionals would likely disagree with this premise, but ultimately the public will decide whether it relies upon domain names for direction to Internet content, and marketers will follow suit. The foregoing factors – new technological spaces like Facebook, decreased type-in search, and the expansion of the domain name space to deemphasize the value of .com domain names – may coalesce to divert the public interest away from domain names. If domain names do indeed give way to other technological spaces as the preferred tools for driving traffic to commercial and critical speech on the Internet, the relevance of the ACPA and UDRP will diminish as well.

Some signs of this may already exist. For example, meta tags<sup>247</sup> have become increasingly the subject of disputes between trademark owners and speech advocates.<sup>248</sup> Because meta tags are among the favored tools utilized by website creators to drive traffic to their sites via search engines, their value will increase as trademark owners, cybergrippers, and cybersquatters rely upon search engines. Several federal courts have already held that the unauthorized use of another's trademark in the meta tags of commercial websites could cause consumer confusion leading to trademark infringement.<sup>249</sup> Other courts have asserted that such use is permissible if it is fair use; that is, when trademarks are used in meta tags solely to refer to

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247. Meta tags are elements included in the HTML code that is the basis of websites. These elements are noted by web crawling programs that review the source code of websites as they scour the Internet. Such tags include, among other things, keywords and descriptions that the creator of the web content believes to be relevant to the site content. Search engine algorithms assign varying degrees of value to these elements as they perform calculations to generate search results.

248. A partial list of meta tag disputes compiled by Professor Eric Goldman can be found at <http://www.ericgoldman.org/Resources/iicasesummary.htm> (last visited Dec. 24, 2010).

249. *Full House Productions, Inc. v. Showcase Productions, Inc.*, 2005 WL 3237729 (N.D. Ill. 2005); *Australian Gold*, 436 F.3d 1239-40; *Tdata Inc. v. Aircraft Technical Publishers*, 411 F. Supp. 2d 901, 907 (S.D. Ohio 2006); *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1222-24 (11th Cir. 2008); *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036 (9th Cir. 2003).

the trademark owner and to describe the content of the website itself.<sup>250</sup> At least one court has noted that the authority of the ACPA does not extend to meta tags<sup>251</sup> – nor would the UDRP have any authority to regulate in this realm.

As search engines grow in importance relative to domain names, trademark owners and speech advocates will divert greater attention to optimizing their websites to better appeal to search engine algorithms. This reliance on the practice of search engine optimization (SEO)<sup>252</sup> is not new, but its value will likely continue to grow proportionally to the diminishing value of domain names as search tools.

The impact of these changes may be a change in the manner that Activists, Commercialists, and Squatters utilize the Internet. If domain names become the less-desirable virtual property of yesterday, the competing parties who utilize them will increasingly shift their focus on competing in other spaces. Search engines may provide greater clarity and less confusion among Internet users, an effect that will likely impact claims of infringement in the future. In turn, trademark and free speech rights will be defined by different legislation, either through the revision of existing statutes or the enactment of new legislation designed to meet the evolving technical landscape. And so the cycle will repeat itself: trademark owners will necessarily persist in defending their online investments in the goodwill associated with their marks and in the reputation of their enterprises; speech advocates will continue to avail

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250. *Faegre & Benson, LLP v. Purdy*, 447 F. Supp. 2d 1008, 1017 (D. Minn. 2006).

251. *See Bihari v. Gross*, 119 F. Supp. 2d 309, 316 (S.D.N.Y. 2000) (stating “[a]lthough no court has expressly stated that the ACPA does not apply to metatags, the plain meaning of the statute and its legislative history make this conclusion apparent”).

252. At its core, SEO is a web marketing strategy designed to boost the ranking of a web page in search engine results and increase the quality of traffic that is directed to that page. For the most part, this may be achieved by means of three central approaches: (1) modification of the viewable content of each target page to make the page more attractive to search engines; (2) modification of the transparent elements of the source code behind each target page to make the page more attractive to search engines; and (3) monitoring and developing relationships with related websites that may direct Internet traffic to the target page. A useful introduction to SEO may be found at SEOMOZ, *Beginner’s Guide to SEO*, <http://guides.seomoz.org/beginners-guide-to-search-engine-optimization#1> (last visited December 24, 2010).

themselves of the world's most advanced communication tool – the Internet – to exercise their democratic rights to inform the public at large; and cybersquatters will look for opportunities to monetize the Internet. It is a wrestling match in cyberspace that will last as long as the Internet is relevant, which is likely to be a very long time.

It is difficult to say whether the evolution of the still-young Internet and the manner in which users interact with it will lead to more certainty or less for mark owners and critical speakers. The expanding Internet provides an increasing spectrum of opportunities for both sides and its regulation will almost certainly change as users avail themselves of those opportunities. Disagreements regarding the manner in which that regulation is implemented will likely be the subject of policy disputes for the foreseeable future.

Perhaps the long view is to regard skirmishes over domain names as a natural distillation that must occur in the judiciary and the legislature in order to cultivate a stable system of jurisprudence in response to societal changes, including those changes that are the products of emerging technology. The ACPA and the UDRP are, in that sense, merely transitional legislation put in place to combat inequities that were previously unforeseeable. In this period of tremendous growth of the Internet, the relevance of such legislation may well prove to be ephemeral.