



1999

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Recommended Citation

Jeffrey J. Look, *The Virtual Wild, Wild West (www): Intellectual Property Issues in Cyberspace—Trademarks, Service Marks, Copyrights, and Domain Names*, 22 U. ARK. LITTLE ROCK L. REV. 49 (1999).

Available at: <https://lawrepository.ualr.edu/lawreview/vol22/iss1/4>

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THE VIRTUAL WILD, WILD WEST (WWW): INTELLECTUAL PROPERTY ISSUES IN CYBERSPACE—TRADEMARKS, SERVICE MARKS, COPYRIGHTS, AND DOMAIN NAMES

*Jeffrey J. Look**

I. INTELLECTUAL PROPERTY ISSUES IN CYBERSPACE—THE VIRTUAL LAND RUSH

The virtual world we know as the “Internet”¹ has often been described as “Cyberspace”² or the “information superhighway,”³ terms which match the high-tech aspect of a new tool that has become common in our homes, schools, and businesses. The Internet is opening up many new opportunities for people and is changing the way all of us do our jobs, transact business, educate ourselves, communicate with others, access entertainment, and keep ourselves informed of news and world events. All of this is now available at our finger-tips. It is truly a new, virtual frontier. However computers and the Internet are presenting new and challenging legal questions which may take many years to become well-settled points of law. One area of the law which has been dramatically affected by computer technology is in the field of intellectual property, i.e. trademarks, copyrights, patents, and unfair competition.

The Internet today is really not unlike the Old West of 125 years ago. Some of the challenges and disputes involving intellectual property on the Internet are not too different from the great range wars of the 19th century. Then the western states were basically wide open expanses of land from Mexico to Canada. There were the cattle ranchers and barons who saw this wide open space as essentially a highway that they should have free use over

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1. Matisse Enzer, *Glossary of Internet Terms* (visited May 30, 1999) <www.matisse.net/files/glossary.html>. The term “Internet” refers to a vast collection of interconnected computer networks which use the TCP/IP protocol and which evolved from the ARPANET in the 1960s.

2. *Id.* The term “Cyberspace” is credited to William Gibson, who originated the term in his novel *Neuromancer*. Cyberspace currently refers to the whole range of information resources available through computer networks.

3. MICROSOFT ENCARTA 98 ENCYCLOPEDIA, *Information Superhighway* (1997). The term “information superhighway” popularly refers to the availability and use of advanced information services by means of a variety of high-capacity data transport facilities, especially computers and computer networks. The term was coined to convey an image of a national infrastructure that would provide abundant information at high capacities to the general public. It was made popular by United States Vice President Albert Gore to emphasize the importance of such an infrastructure.

to run cattle from the ranches in the south to the lush pastures and rail heads in the north. They did not want to have to pay anybody, ask permission, or detour around. If somebody got in their way, sometimes they just ran through them. On the other hand, there was the homesteader or farmer who saw space for crops. They saw the land as something which was their domain, their property. They wanted control over who came on their property and they did not want cattle trampling down or eating their crops. This often led to violent confrontations between those who saw the land as a public thoroughfare and those who wanted to fence off and protect their property against unauthorized intrusions by others. Then there were the Native Americans who had traditionally occupied the land and who saw the homesteaders and cattle ranchers as intruders.⁴ Today, the Internet is that wide open expanse of land. There are some who believe that everything about the Internet should be free for all to use and exploit for personal gain—the modern day cattle barons.⁵ There are others however, who would like some degree of control over how their intellectual property rights are used in this virtual world. They want the right to tell someone “no, you can’t use my property at all” or “you can use my property if you ask for my permission first or pay me a royalty.” Hopefully, these conflicting ideologies about the Internet will not erupt into bloodshed. However, conflicts are arising which are being waged in courtrooms across the country involving damage to intellectual property which is no less damaging than a heard of longhorns trampling down a farmer’s corn crop.

II. TRADEMARKS AND DOMAIN NAMES COMPARED AND CONTRASTED

A good definition of trademarks and service marks can be found in Section 45 of the Lanham Act.⁶ Unlike trademarks, domain names are used

4. See MICROSOFT ENCARTA 98 ENCYCLOPEDIA, *Westerward Movement*, American (1997).

5. See Chris Tucker, *Electronic Pirates*, SOUTHWEST AIRLINES SPIRIT, Apr. 1999, at 40. Such persons nowadays are often called “cyberlibertarians.” Their credo is “information wants to be free.” *Id.*

6. See 15 U.S.C. § 1127 (1998). The statutory definition of a trademark under the Lanham Act is as follows:

[A]ny word, name, symbol or device or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate [their source].

Id. The Lanham Act defines a service mark in essentially the same way, except that a service mark is designed to “identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.” *Id.*

primarily to identify a *single location* on the World Wide Web.⁷ Typically, a domain name is prefaced by the abbreviation “WWW.” followed by a word or words, followed by a period and one of several top level domain abbreviations, i.e. .COM, .ORG, .NET, .GOV, .EDU, .INT, and .MIL. Many use or want to use their trademarks and service marks as domain names because when people search the web for a particular company’s web site, they will logically and instinctively use the company’s name, trademarks, or service marks run the search.

One essential requirement of a trademark or service mark is that it be used to identify a product or service. If a trademark or service mark is never used to identify and distinguish goods and services from those of others, it is not a trademark or service mark under the federal Lanham Act,⁸ the Arkansas state trademark act,⁹ or even at common law.¹⁰ If a trademark or service mark owner ceases to use a mark, it is abandoned and becomes free to anyone else to use as a mark.¹¹ Domain names can be registered without actually being used at all or they can be used in a very minimal fashion, like a door to an empty room.

III. TRADEMARKS, SERVICE MARKS, AND DOMAIN NAME REGISTRATION

The United States Patent and Trademark Office (PTO) registers trademarks and service marks. In order for a mark to be registered, it must meet several statutory and regulatory requirements.

A. Prohibition of Confusingly Similar Marks

One of the biggest obstacles is that trademarks and service marks cannot be confusingly similar to another federally registered mark.¹² What is “confusingly similar” involves the application of a multi-factor balancing test.¹³ There is no mathematically precise formula for applying these factors,

7. See *High Tech Dictionary* (visited May 30, 1999) <www.currents.net/resources/dictionary/definition.phtml>. The “World Wide Web” is a reference to a hypermedia-based system for browsing Internet sites. It is a “web” of many sites linked together which users can access by clicking on hyperlinks. *Id.*

8. See 15 U.S.C. § 1127.

9. See ARK. CODE ANN. § 4-71-201(8), (10) (Michie Supp. 1997).

10. See *United Drug v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916), *superseded by statute as stated in* *Foxtrap, Inc. v. Foxtrap, Inc.*, 671 F.2d 636 (D.C. Cir. 1982); *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311 (1871).

11. See MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17.1 (4th ed. 1997).

12. See 15 U.S.C. § 1052(d) (1998).

13. See *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Because the trademark office is subject to the Court of Appeals for the Federal Circuit and the decisions

nor is it necessary for a plaintiff to offer evidence relevant to each factor to prevail in an infringement case. The test, as applied by the PTO, essentially weighs the similarity in the overall commercial impression of the marks in terms of sound, appearance, and meaning against the similarity of the goods or services; the similarity in the channels of trade or overlap in the prospective purchasers of the goods or services of the applicant and registrant; and the sophistication of the purchasers (i.e. are they people who would casually purchase something relatively inexpensive like a loaf of bread, or highly trained and educated corporate purchasers who are purchasing a jumbo jet). Sophisticated purchasers are less likely to be confused.¹⁴ Therefore, since the likelihood of, not the actuality of, consumer confusion is a necessary element to support a refusal to register based on Section 2(d), if there is no likelihood of confusion, then highly similar or identical words and names can and often are registered as trademarks and service marks for goods and services which are unrelated.¹⁵

of its predecessor court, the Court of Customs and Patent Appeals, the PTO follows the test announced in *E.I. duPont*. See *id.* The elements of the *duPont* test include the following: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (5) The fame of the prior mark (sales, advertising, length of use); (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) The variety of goods on which a mark is used or is not used (house mark, "family" mark, product mark); (10) The market interface between the applicant and the owner of a prior mark []; (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; (12) The extent of potential confusion, i.e. whether *de minimis* or substantial; (13) Any other established fact probative of the effect of use. See *id.*

The Eighth Circuit test for determining likelihood of confusion includes the following factors: (1) the strength of the trademark; (2) the similarity between the parties' marks; (3) the competitive proximity of the parties' products; (4) the alleged infringer's intent to confuse; (5) evidence of actual confusion; (6) the degree of care reasonably expected of potential consumers. See *Duluth News-Tribune v. Mesabi Publishing Co., Inc.*, 84 F.3d 1093 (8th Cir. 1996); *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994).

14. See *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384 (2d Cir. 1995); *Sunbeam Lighting Co. v. Sunbeam Corp.*, 183 F.2d 969 (9th Cir. 1950); *Save-A-Stop, Inc. v. Sav-A-Stop, Inc.*, 230 Ark. 319, 322 S.W.2d 454 (1959) (holding that professional buyers "should be capable of a reasonable degree of discrimination").

15. Attached in the appendix is a list of various federal trademark registrations for the marks APPLE, MERCURY, and DELTA. The list shows the owner and a brief description of the goods and services. Not all of the federal registrations for these marks are listed. As can be seen, fanciful and arbitrary marks can co-exist on the Principal Trademark Register and can be used in commerce without likelihood of consumer confusion.

B. Other Statutory Prohibitions

Just because a mark may not be confusingly similar to another mark does not necessarily entitle the mark to be registered on the Principal Register. Other major statutory prohibitions to federal registration include prohibitions on merely descriptive or deceptively misdescriptive marks; geographically descriptive wording; geographically deceptively misdescriptive marks; surnames; scandalous, false, deceptive, and disparaging marks; generic terms; and use of service marks without some connection to a service.¹⁶

1. *Merely Descriptive or Deceptively Misdescriptive Marks*

To register a merely descriptive or deceptively misdescriptive mark requires a showing of “acquired distinctiveness” and “secondary meaning.”¹⁷ A merely descriptive mark immediately and forthwith conveys to the consumer important or key information about a function, purpose, quality, characteristic, or use of the goods and services.¹⁸ Deceptively misdescriptive terms are false, but plausible, terms which would otherwise be merely descriptive.¹⁹ To acquire distinctiveness, a mark must have widespread, continuous, and exclusive use in commerce for at least five years.²⁰ However, widespread promotion or advertising by a single source over a shorter period of time may sometimes result in acquired distinctiveness.

2. *Geographically Descriptive Wording*

Geographically descriptive marks cannot be registered without a showing of acquired distinctiveness.²¹ The test for determining whether a mark is primarily geographically descriptive is: (1) the primary significance is geographic; (2) purchasers would likely think that the goods or services originate from the place named in the mark; (3) the mark identifies the

16. See 15 U.S.C. § 1052 (1998).

17. 15 U.S.C. § 1052(f) (1998). See also *Armstrong Paint & Varnishworks v. Nu-Enamel Corp.*, 305 U.S. 315 (1938); *Zatarains, Inc., v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

18. See *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987). See also *In re Bed and Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986).

19. See *In re Woodward & Lothrop, Inc.*, 4 U.S.P.Q.2d (BNA) 1412 (TTAB 1987); *In re Quady Winery*, 221 U.S.P.Q. (BNA) 1213 (TTAB 1984); PATENT AND TRADEMARK OFFICE, U.S. DEPT. OF COMMERCE TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.03 (2d ed., last revised April 1997).

20. See 15 U.S.C. § 1052(f) (1998); 37 C.F.R. § 2.41.

21. See 15 U.S.C. § 1052(e)(2) (1998).

geographic origin of the goods or services.²² An example of such a mark would be ARKANSAS PIZZA for a pizza restaurant based in Arkansas.

3. *Geographically Deceptively Misdescriptive Marks*

These types of marks cannot be registered at all unless they acquired distinctiveness prior to the enactment of the North American Free Trade Agreement (NAFTA) on December 8, 1993.²³ The test for determining whether a mark is primarily geographically deceptively misdescriptive is: (1) the primary significance of the mark is geographic; (2) purchasers would likely think the goods or services originate from the geographic place named in the mark; (3) the goods or services do not originate from the place named in the mark.²⁴ An example is use of the name ARKANSAS PIZZA for a pizza restaurant based in Texas.

4. *Surnames*

Words which are primarily merely surnames cannot be registered unless they have acquired distinctiveness.²⁵ Not all surnames, however, are primarily merely surnames. Basically, if a surname has any other significant connotation or meaning which is not merely a surname or if a surname is displayed in a stylized form or used with other, non-generic wording, then they can be registered.²⁶ Types of surnames which would not be primarily merely surnames would be: LOOK, BROWN, PATRICK. Types of names would be primarily merely surnames: JONES, SMITH, LOPEZ.

5. *Scandalous, False, Deceptive and Disparaging Marks*

Marks which are immoral or scandalous, or deceptive, or which suggest a false connection to someone or some organization or institution, or which may disparage someone or bring someone or a company or institution into disrepute, cannot be registered no matter how distinctive they may otherwise be.²⁷

22. PATENT & TRADEMARK OFFICE, *supra* note 19, § 1210.05.

23. *See* 15 U.S.C. § 1052(e)(3).

24. PATENT & TRADEMARK OFFICE, *supra* note 19, § 1210.06.

25. *See* 15 U.S.C. § 1052(e)(4).

26. *See* PATENT AND TRADEMARK OFFICE, *supra* note 19, § 1211.

27. *See* 15 U.S.C. § 1052(a). *See also In re Perry Mfg. Co.*, 12 U.S.P.Q.2d 1751 (TTAB 1989) (holding that false designations of geographic origin which materially influence the purchasing decision are deceptive where the geographic term "New York" was used for clothing goods not made in New York); *In re Budge Mfg. Co., Inc.*, 857 F.2d 773 (Fed. Cir. 1988)

6. *Generic terms*

A trademark or service mark cannot be a generic term for the goods or services, that is, it cannot describe a particular genus of goods and services.²⁸

7. *Service Marks*

One particular wrinkle with service marks is their requisite use in connection with a service rather than simply an activity performed by a business. The PTO defines a service as something which is a real activity performed primarily for the benefit of a someone else and which is not ancillary or incidental to the performance of the larger business of the applicant.²⁹ The most common examples of activities which are not considered services are advertising and marketing a business's own goods and services, even to the public, and the act of selling goods and services. Retail stores and mail order catalogs may get around this problem because the nature of the service they provide is the bringing together of a wide variety of goods and services, typically made by others, into one location for convenient display and access for the consumer. However, it is not the act of selling which allows a retail store to claim that it is providing a service.

IV. REGISTRATION OF DOMAIN NAMES

Computer domain names are not registered by the Patent and Trademark Office but are registered in this country one of several authorized domain name registries.³⁰ All of the requirements discussed previously in connection

(finding statements as to the material composition of the goods were deceptive); *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) (including obscene or indecent terms or depictions). In addition, marks which allude to or suggest a possible, but false, connection to another source, institution, or person are prohibited. *See, e.g.,* *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. (BNA) 428 (TTAB 1985) (holding that a restaurant's use of the mark MARGARITAVILLE falsely suggested a connection to singer Jimmy Buffett); *In re Sauer*, 27 U.S.P.Q.2d (BNA)1073 (TTAB 1993) (holding that a depiction of a football with baseball lacing and the words "BO BALL" falsely suggested a connection to dual professional baseball/football player Bo Jackson). *But see* *University of Notre Dame v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372 (Fed. Cir. 1983) (finding that cheese sold under the name "Notre Dame" was not a false association with Notre Dame University because the university was not known for cheese making, nor did the term Notre Dame point uniquely or exclusively to Notre Dame University).

28. *See* 15 U.S.C. § 1091 (1998).

29. *See also In re Canadian Pacific Ltd.*, 754 F.2d 992 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 U.S.P.Q. (BNA) 89 (TTAB 1984); *In re Integrated Resources, Inc.*, 218 U.S.P.Q. (BNA) 829 (TTAB 1983); *In re Landmark Communications, Inc.*, 204 U.S.P.Q. (BNA) 692 (TTAB 1979).

30. Until May 1999 there was only one domain name registry in the United States which

with the registration of trademarks and service marks do not apply to domain names. As a result, domain names may be surnames (i.e. www.smith.com); merely descriptive, generic names for goods or services (i.e. www.flowers.com for electronic retailing of flowers or www.dentist.com for a website that provides nationwide dental referrals or promotes a specific dentist's office); and geographically descriptive or misdescriptive names (i.e. www.arkansaspoultry.org for a trade organization promoting the consumption of Arkansas poultry products). The only prohibition on domain names is that they may not be exactly like any other domain name already registered.³¹ The key is "exactly." Because domain names serve to identify a single location on the Internet, even minor variations in a word or phrase will accomplish this goal. However, minor variations may not be enough to avoid confusion as to the source of the website for the computer user.

A good illustration is *Toys R Us, Inc. v. Abir*.³² In *Abir*, the defendant discovered that neither TOYS R US nor KIDS R US had registered as a domain name an incorrect spelling of their marks, i.e. www.toysareus.com and www.kidsareus.com.³³ Abir thought he would do the company a favor, and make some money for himself, by registering these domain names and then selling or leasing them back to Toys R Us.³⁴ He was shocked when Toys R Us responded to his offer by threatening legal action. Abir then decided that he would sell toys for competitors through the websites.³⁵ Toys R Us brought a trademark infringement and trademark dilution claim against Abir, who admitted in court that he adopted the misspelled marks hoping to pickup visitors who incorrectly entered Toys R Us's domain names.³⁶ The court had no trouble issuing an injunction against Abir and ordered him to give up the websites. Because Abir was found to have willfully and intentionally infringed the Toys R Us marks, he was ordered to pay Toys R Us's attorney's fees in the amount of \$55,000.³⁷

The lesson to be learned from *Abir* is to not forget to check the phonetic equivalents of a company's marks and names. For example, if the mark is

was operated by Network Solutions, Inc. (NSI). Now there are more than two dozen companies registering domain names. However, the procedures used for registering a domain name with any of the registries are similar to those used by NSI.

31. See, e.g., *Help, Reservation, Availability of Web Addresses File* (visited June 4, 1999) <www.networksolutions.com>.

32. 45 U.S.P.Q.2d (BNA) 1944 (S.D.N.Y. 1997), *injunction granted*, No. 97-Civ.-8673 (JGK), 1997 U.S. Dist. LEXIS 22435, at *1 (S.D.N.Y. Dec. 24, 1997).

33. See *Abir*, 45 U.S.P.Q.2d at 1946.

34. See *id.*

35. See *id.*

36. See *id.* at 1947.

37. See *Toys R Us v. Abir*, No. 97-Civ.-8673 (JGK), 1999 U.S. Dist. Lexis 1275, at *1 (S.D.N.Y. Feb. 5, 1999).

ARKSYS, one should check for domain names that use similar spellings such as ARCSYS, ARKSIS, ARCSIS, ARK-SYS, ARC-SIS, ARXSIS, and any other conceivable variations. The use of any of these variations by a competitor could be considered service mark infringement or dilution.

Unscrupulous competitors are not the only ones who infringe or dilute a company's trademarks and service marks over the Internet. Often times a company's mark is registered as a domain name by people who are angry or upset with a company by adding the word "SUCKS" to whatever the mark may happen to be. Some companies who have actually faced this issue include: (1) Netscape, who ran into a problem with NETSCAPESUCKS, a website created specifically to allow people who do not like the Netscape web browser to take pot shots and post derogatory information about the product on the Internet; (2) Chase Manhattan Bank, who ran into a problem with a complaint website called CHASEMANHATTANSUCKS; and (4) Bally Total Fitness Health Clubs, where the website BALLYSUCKS was created as a complaint site for people upset with the health club.³⁸ The user of the BALLYSUCKS name recently won summary judgment against Bally Total Fitness who sued him for trademark infringement and dilution.³⁹ The court held that no prudent consumer would assume that Bally's official website and the defendant's BALLYSUCKS website originated from the same source.⁴⁰ The court found no trademark dilution because the defendant was using the site to make legitimate criticisms of Bally Total Fitness. This court held that trademark owners may not quash unauthorized use of the mark by a person expressing a point of view.⁴¹

V. PTO REGISTRATION OF DOMAIN NAMES

The PTO will, on occasion, register what ordinarily is considered a domain name if it can be shown to also meet the requirements for federal registration as a trademark or service mark.⁴² But a PTO registration does not automatically reserve the name on the Internet. Only a domain name registry can do that. The PTO policy requires the applicant to show that it offers services via the Internet and the applicant must provide specimens which show use of the domain name as a service mark, rather than simply as a URL or

38. See *Netscape Bucks Netscapesucks.com*, INTA BULLETIN (International Trademark Association, New York, N.Y.), Feb. 1, 1999, at 6.

39. See *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1663 (C.D. Cal. 1998).

40. See *id.*

41. See *id.* at 1167.

42. See United States Patent and Trademark Office, *Trademark Examination of Domain Names* (visited June 4, 1999) <www.uspto.gov/web/office/tac/domain/tmdomain>.

Internet address.⁴³ Secondly, the information contained on the website must not merely advertise or promote one's own goods or services.⁴⁴ The PTO examiner will check the website for this purpose. If the website also does something besides promoting a company's own goods and services then registration of the domain name is possible with the PTO. For example, a website owned by a package delivery service may in fact advertise its various services. However, if it also contains an automated tracking feature which allows the user to input a number to find out where their package is, then a service is being provided. In addition, a manufacturer of clothing or shoes may advertise its own clothing and footwear products on its website. However, if it provides a means for consumers to order those goods through the website, such as an on-line or electronic catalog, a service is being provided. Also, a public interest health organization may seek to promote its worthwhile efforts related to curing cancer or some other type of disease. But, if it merely advertises or promotes what it does over the Internet, then it is not providing a service which would allow the PTO to register its domain name as a service mark. If, on the other hand, it provides factual or statistical information about a particular health issue, information like which would be found in a news report or encyclopedia entry, then it is providing a service which is referred to in PTO parlance as providing information about cancer, or providing information about healthy living via a global computer information network.

How an applicant identifies or describes the nature of its services to the PTO is critical in getting a federal registration. The PTO will not let applicants broaden or change the scope of their identification once the application is filed. Applicants, however, may always narrow their identification. For example, applicants may delete things, or clarify an ambiguous identification. The change must fall within the scope of the original identification and not consist of something completely new.⁴⁵ For example, if an applicant states on the federal trademark application "website which advertises automobiles," the website must feature third party classified ads of automobiles. If the applicant is actually advertising its own cars and providing a means for the customer to order custom made automobiles via a global computer network, it may not change its identification to state this after the application is filed. The PTO has also published on its website guidelines on acceptable identifications for services provided over the Internet.⁴⁶

43. *See id.*

44. *See id.*

45. *See In re M.V. Et. Associes*, 21 U.S.P.Q.2d (BNA) 1628 (Comm'r Patents 1991). *See also* 37 C.F.R. § 2.71(b); PATENT AND TRADEMARK OFFICE, *supra* note 19, § 804.01.

46. *See* Patent and Trademark Office, U.S. Dept. of Commerce, *Identification and*

The PTO will not allow applicants to use the word "Internet" in their identification of goods and services on the application. The reason is because "INTERNET" was registered as a federal service mark in 1984 for providing electronic data transmission services in the electronic banking field.⁴⁷ INTERNET was also registered in 1980 as a mark for travel agency services.⁴⁸ The travel agency registration will be up for renewal in 2000. The banking registration is now subject to an on-going cancellation proceeding before the Trademark Trial and Appeal Board based on the ground that it is now a generic term.⁴⁹ Unless and until the INTERNET registrations are canceled, the PTO requires applicants to use "global computer information network" as a substitute.⁵⁰ The reason is that the PTO does not permit the use of registered trademarks or service marks in identifications of goods and services because using registered marks in identifications tends to "genericize" the mark.

There was a time when the PTO would refuse to register any trademark or service mark which included the word INTERNET in the mark because of the above mentioned registrations. The PTO's current position is that the word INTERNET is merely descriptive matter if it involves any type of service provided over the Internet except in the financial services, banking, investment services, and travel industries. Therefore, PTO will refuse to register a mark like REGIONS INTERNET for on-line or electronic banking services based on the likelihood of confusion with the above banking registration. On the other hand, it will not refuse to register HOME DEPOT INTERNET for a service of providing home remodeling information via a website.⁵¹

The PTO also routinely uses Section 2(e)(1) of the Trademark Act,⁵² the prohibition against mere descriptiveness, to refuse registration to many INTERNET marks. Therefore, if the mark in its entirety merely describes the type of service being provided, then it will be refused unless the applicant can show acquired distinctiveness. For example, if a mark is INTERNET AUTOS for a service which runs classified ads for cars over the Internet, or INTERNET DATING SERVICE for an Internet dating service, then the marks

Classification of Certain Computer Related Goods and Services (visited June 4, 1999) <www.uspto.gov/web/offices/tac/domain/domcl.html>.

47. See U.S. Registration No. 1560167.

48. See U.S. Registration No. 1137022.

49. See Trademark Trial and Appeal Board Cancellation Proceeding No. 023324.

50. See Patent and Trademark Office, U.S. Dept. of Commerce, *Identification and Classification of Certain Computer Related Goods and Services* (visited June 4, 1999) <www.uspto.gov/web/offices/tac/domain/domcl.html>.

51. However, Home Depot would have to disclaim exclusivity in the word "Internet" apart from the mark because "Internet" is merely descriptive.

52. See 15 U.S.C. § 1052(e)(1) (1998).

will be refused registration on the Principal Register because they are merely descriptive of the services.⁵³

VI. CURRENT ISSUES INVOLVING DOMAIN NAMES

Domain name registries do not search federal trademarks prior to registering any particular domain name. Therefore, registered trademarks and service marks owned by one party can and do get registered as domain names by third parties. Some of these people have no relationship with the trademark owner and their sole motive for registration of the domain name is to sell it back to the true owner. Such persons are often referred to as "cybersquatters."⁵⁴

Many cybersquatters are not proactive. That is, they generally do not register a company's name or mark and then let them know it. There have been exceptions such as in the *Abir* case. In most cases, however, the cybersquatter will likely wait for the trademark owner to approach them. How does one know if they have a problem with a cybersquatter? Confused customers may call or write saying that they tried to access what they thought was the trademark owner's website and got something unexpected, such as pornography, or a competitor's product, by mistake. Cybersquatters are also found by accident such as from employees of the trademark owner surfing the web either at work or at home. Some large companies are now employing "Bounty Hunters" or "Cyber Paralegals" on a full-time, 40-hour-per-week basis, just to surf the web to find misuse of company names, trademarks, copyrights, and other intellectual property rights on the Internet. There are also private companies that specialize in bounty hunting such as NetNames⁵⁵ in New York City, Thomson & Thomson,⁵⁶ a Boston-based trademark searching firm, and Markwatch⁵⁷ which specializes in searching for improper trademark usage on websites.

53. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987). It may be possible to get such marks, if they are already in use in commerce, registered on the Supplemental Register, which is specifically designed for marks which are capable but have not yet acquired distinctiveness. However, if the mark is generic, then it is not capable of acquiring distinctiveness. The PTO has the burden to prove a mark is generic. See *id.*

54. See *Intermatic v. Toepfen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996); Andrew Craig, *Domain Name Group Targets Cybersquatters* (January 19, 1998) <<http://www.techweb.com/news/story/TWB19980119S0004>>; Laura Lorek, *Beware of Cybersquatters*, SOUTH FLORIDA SUN-SENTINEL, May 25, 1997, at 1E.

55. See <<http://www.netnames.com>>.

56. See <<http://www.thomson-thomson.com>>.

57. See <<http://www.markwatch.com>>.

VII. HOW TO GET RID OF CYBERSQUATTERS—THE DISPUTE RESOLUTION PROCESS

A. Steps the Complaining Party Must Take to Initiate the Process

In certain circumstances, a trademark owner can avoid going to court by taking advantage of a domain name registry's dispute resolution policy.⁵⁸ The policy is convoluted. The complainant must first submit an original, certified copy, *not more than six months old*, of a federal trademark registration certificate which is in full force and effect, on the Principal trademark register for any country in the world, and substantially identical to a second level domain name.⁵⁹ Trademarks registered on the Supplement Register of the United States or any similar register in any other country or any state trademark registration will not be acceptable. Trademarks which incorporate design elements, even if registered on a Principal register, will not be accepted. Pending federal trademark applications are not acceptable.⁶⁰ The complaining party must also provide the registry with a copy of the "cease and desist" letter sent to the domain name registrant *dated prior to filing* of the complaint with the registry which indicates the mode of delivery of the letter and the factual basis for believing the domain name registrant received the notice. In addition, the address on the letter must match the address of the domain name registrant in the registry's database of registrants.⁶¹ For example, Network Solutions Inc. (NSI)'s "WHOIS" database is a computerized record of the name, address, and technical information of each domain name registrant and is accessible to the public via NSI's InterNic website. The letter must also state that the complainant believes the domain name registration violates the complainant's trademark rights and it must state the factual and legal bases for this belief.⁶²

Once NSI or a similar registry receives material from the complaining party, the registry will determine the creation date of the registrant's domain name. If the domain name creation date is after the effective date of a valid certified trademark registration, the registry will ask the domain name registrant to supply proof of the registrant's own federally registered trademark or service mark which must also meet the same requirements

58. See *Network Solutions' Domain Name Dispute Policy* (Revision 3, Feb. 25, 1998) <<http://rs.internic.net/domain-info/interNic-domain-6.html>>.

59. See *id.* The second level domain name is the part of the domain name that appears before the .COM, .NET, .ORG, .INT, .MIL, or .EDU portion of the domain name. See *id.*

60. See *id.*

61. See *id.*

62. See *id.*

discussed above. This proof must be supplied within 30 days of the request. The domain name registrant's certified trademark registration's effective date must be prior to the date of any third party's notice of a dispute, i.e. their "cease and desist" letter.⁶³ For example, if the complaining party's cease and desist letter is dated April 1, 1999, the domain name registrant's trademark registration date must be prior to April 1, 1999. If the domain name registrant meets these requirements, the domain name dispute is over as far as the domain name registries are concerned. The domain name registrant will keep the name *and it will not matter which federal trademark registration was issued first*.

If the domain name registrant can't meet these requirements, i.e. the domain name registrant can't supply proof of a federal trademark registration at all or its trademark registration is dated after the complaining party's cease and desist letter, but the domain name registrant wishes to contest the right of the complainant to the domain name, then the domain name will be placed on a "Hold" status and will not be available to anyone to use while this status is in effect.⁶⁴

If either the domain name registrant or the complainant become involved in litigation over the right to use the name, either party may file a file-marked copy of the court complaint with the registry and the registry will maintain the status quo. Specifically, the name will either remain active and in the possession of the domain name registrant during the pendency of the litigation or, if the domain name is on "Hold" status, the name will remain in "Hold" status and the registry will deposit the domain name registration to the registry of the court. When a domain name is on "Hold" status, neither party will be able to use the domain name until the litigation is resolved and the court issues an order awarding the domain name to either the complainant or the original registrant.⁶⁵ All domain name registrants must keep paying annual renewal fees during the period that the domain name is on "Hold" status.⁶⁶

B. Options Available to a Client Who Has a Conflict with Another Domain Name Registration

Ownership of a federal trademark or service mark registration, in typed form, is critical to anybody wanting to use a domain name dispute resolution policy and it does not matter whether one is a complainant or a domain name

63. *See id.*

64. *See Network Solutions' Domain Name Dispute Policy* (Revision 3, February 25, 1998) <<http://rs.internic.net/domain-info/interNic-domain-6.html>>.

65. *See id.*

66. *See id.*

registrant. It will not do a complainant any good to run into a problem with a domain name registration first and then apply for a federal trademark registration. Likewise, if a domain name registrant does not have a federal trademark or service mark registration, the registrant will not be able to keep the domain name active during any dispute over the name. Again, filing or obtaining a trademark registration after the domain name dispute has arisen will not help the domain name registrant.

If a client does not own a federal trademark or service mark registration, and wants to use its mark as an Internet domain name which is already taken by a squatter or someone else, the client has a variety of options: (1) buy the domain name; (2) sue the domain name registrant for trademark infringement; (3) vary the domain name; or (4) enter into an agreement to provide mutual website links.

1. *Buy the Domain Name*

A client may decide to purchase the domain name from the registrant, who is basically free to name his or her price. Many domain names may be purchased for a few thousand dollars. One of the largest payoffs for a domain name to date involved the Alta Vista domain name. Compaq Computers agreed to pay a San Jose, California man \$3.35 million for the domain name www.altavista.com. This amount is believed to be the record amount paid for a domain name. The Alta Vista name was not registered as a trademark when an electrical engineer, Jack Marshall, obtained the www.altavista.com domain name in 1994. Marshall designed software which could be used for creating multi-media postcards for display on the web. In 1995, Digital Corporation, which later merged with Compaq Computers, launched the "Alta Vista" search engine. Digital initially registered www.altavista.digital.com as the domain name. However, many computer users would omit the "digital" portion from the domain name when looking for the search engine's website. As a consequence, they would access Marshall's website which was soon getting hundreds of thousands of hits per day. This enabled him to get premium prices for placing advertisements on his website for others, not to mention the overwhelming exposure to his own products that he would not otherwise have received. Because of the confusion between Compaq's search engine located at www.altavista.digital.com and Marshall's www.altavista.com, Compaq sued Marshall to force him to change his mark and to add a disclaimer to his site. In settling the case, Compaq agreed to pay

\$3.35 million plus it gave Marshall a permanent link from the AltaVista search engine to his new website, www.photoloft.com.⁶⁷

It should be noted that Marshall, in the *AltaVista* case, was not a cybersquatter. Marshall had legitimate and superior rights in the AltaVista mark. In cases where the domain name registrant has a legitimate claim to the name, i.e. he is using it in connection with his own business which happens to be less famous than someone else's business, the courts typically allow the first to register the domain name to keep the domain name.⁶⁸

2. *Sue the Domain Name Registrant for Trademark Infringement or Dilution*

A successful suit may result in a court order for the domain name registrant to transfer the name. However, as many cybersquatters know, it will often cost a company much more to litigate this issue rather than pay a ransom of a few thousand dollars. On the other hand, paying off a cybersquatter can embolden them or others like them to register more of your client's marks knowing that your client will pay the ransom rather than litigate.⁶⁹

In June 1999, Senators Orrin Hatch of Utah and Patrick Leahy of Vermont introduced a bill in the United States Senate⁷⁰ to make cybersquatting a violation of Section 43 of the Trademark Act.⁷¹ The bill would largely codify what many federal courts have already been doing in bad faith cybersquatting cases such as issuing injunctions and awarding attorney fees. However, two new provisions have been added that will make pursuing cybersquatters much more attractive for trademark owners. One is allowing trademark owners to file *in rem* actions against the domain name itself in cases where the domain name registrant can't be found or otherwise made subject to the personal jurisdiction of the federal court. The second is the awarding of statutory damages similar to those found in Section 504 of the

67. See Julia Angwin, *San Jose Man Hits Gold*, SAN FRANCISCO CHRON., July 28, 1998.

68. See *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 983 F. Supp. 1331 (D. Or. 1997) (finding that competing users of the same mark in connection with unrelated goods and services, first to register domain name was allowed to keep it).

69. See, e.g., *Toys R Us v. Abir*, No. 97-Civ-8673, 1999 U.S. Dist. Lexis 1275 (S.D.N.Y. Feb. 5, 1999). This is a tough business decision for a client. Some companies, however, view negotiating with cybersquatters like negotiating with terrorists and would rather spend \$50,000 suing a cybersquatter than the \$5,000 the cybersquatter wants for the domain name. Now that cybersquatting is becoming more disfavored by courts, it is becoming easier to get an award of attorney's fees for willful infringement against cybersquatters.

70. The Anti-Cybersquatting Consumer Protection Act, S. 1255, 106th Cong. (1999). The bill was passed by the Senate on August 16, 1999, and sent to the House.

71. See 15 U.S.C. § 1125 (1998).

Copyright Act, ranging from \$1000 to \$100,000 per domain name infringement.⁷²

However, in order to take advantage of the Bill's provisions, should it become law, the trademark in question would have to be "distinctive" when the domain name was registered. It is interesting to note that the Senate Bill has dropped the "famous and distinctive" requirement as is used in the Federal Trademark Dilution Act and focuses merely on a mark being "distinctive," as the Ninth Circuit recently noted "fame" and "distinctiveness" are not the same and proof that a mark may be distinctive is not proof that it is "famous."⁷³ Secondly, the Bill would provide defenses such as fair use, any legitimate prior use by the domain name owner, and any trademark rights of the domain name owner be considered in determining whether the defendant is a cybersquatter.⁷⁴ In other words, concurrent users of a trademark will still have a "race" to be first to register their trademark as a domain name and those who have legitimate comment or criticism of a company may still be able to use another's mark in their domain name under the doctrine of fair use. The bill would also have no effect on those who squat on descriptive or generic domain names.

The bill would also exempt domain name registries from all liability to a trademark owner for registering a domain name that infringes or dilutes the trademark owner's mark unless the registry had a bad faith intent to profit from the registration of the name.⁷⁵ Domain name registries would also be exempt from liability for terminating or otherwise suspending use of a domain name to registrants accused of cybersquatting even if it is later determined that the domain name registrant is not a cybersquatter.⁷⁶

3. *Vary the Domain Name*

Clients may decide to cleverly vary the domain name so that it is not exactly like the registered domain name as Digital did by initially registering "altavista.digital.com." Digital essentially added its house mark to its product mark. As another example, if the desired domain name is "xyz.com" and it is already taken, try adopting "xyz.arkansas.com," or putting in hyphens or entity designators, i.e. "xyz-inc.com," "x-y-z.com" or a generic word for the goods or services such as "xyzcars.com" if your client sells cars, for example. However, don't get too clever by adopting a name that may be a trademark

72. See S. 1255, 106th Cong. § 4 (1999).

73. See *Avery Dennison v. Sampton*, No. 98-55810, 1999 U.S. App. Lexis 19954 (9th Cir. Aug. 23, 1999).

74. See S. 1255, 106th Cong. § 3 (1999).

75. See S. 1255, 106th Cong. § 5 (1999).

76. See S. 1255, 106th Cong. § 5 (1999).

infringement or dilution of another's mark. Domain name applicants should only pursue these options if they already have a legitimate claim to the mark and it is reasonably certain they will not infringe or dilute someone else's mark.

4. *Enter into an Agreement with the Owner of the Website to Provide Mutual Links*

An example of this strategy is the domain name "DELTA." The appendix includes a list of DELTA trademark registrations. However, only one entity can own the domain name www.delta.com. The owner of this domain name registration is an Internet Service Provider (ISP) called DELTACOMM. Those who access this website and who are looking for the websites of Delta Airlines, Delta Faucets, Delta International Power Tools, or Delta University may click on a hypertext link on DELTACOMM'S homepage and link directly to the websites of these other companies. Needless to say, this method requires the cooperation and reasonableness of the owner of the domain name.

VIII. WHO IS LIABLE FOR REGISTERING INFRINGING DOMAIN NAMES AND WHAT KIND OF RELIEF IS AVAILABLE?

A. NSI Liability

Often the owner of the infringing website is either anonymous, a financial turnip, or is located in a foreign country making it difficult to get real or immediate relief from a domain name infringement. Plaintiffs who have tried to sue Network Solutions, Inc. for registering a domain name which infringes or dilutes their trademarks have thus far not been successful.⁷⁷ While these cases were decided prior to the expansion of the number of domain name registries, they will likely be applicable to the new registries as well.

77. See, e.g., *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949 (C.D. Cal. 1997). The court held that NSI has no duty to screen domain names which incorporate or are confusingly similar to registered trademarks or service marks owned by a Plaintiff. See *id.* at 967. The Academy of Motion Picture Arts and Sciences, the group that issues the "Oscar" awards, also struck out in an attempt to get an injunction against NSI for registering domain names which are confusingly similar to or infringe the Academy's trademarks. See *Academy of Motion Picture Arts & Sciences v. Network Solutions, Inc.*, 989 F. Supp. 1276 (C.D. Cal. 1997). The court said the act of registering domain names did not constitute a commercial use of the marks and there was no evidence of knowledge on the part of NSI to support a claim of contributory trademark infringement. See *id.* at 1280.

B. The Doctrine of Contributory Trademark Infringement

Clients seeking to hold an Internet service provider (ISP), webpage hosting service, or bulletin board service (BBS) liable for assisting someone else in committing a direct trademark infringement may possibly use the doctrine of contributory trademark infringement. The United States Supreme Court has held that the test for contributory trademark infringement is: (1) the defendant intentionally induces another to infringe a trademark; or (2) continues to supply a product to one who it knows or has reason to know is engaging in trademark infringement.⁷⁸ To apply the doctrine of contributory trademark infringement to ISPs, BBSs, or webpage hosters, would require a showing that the service had knowledge or had reason to know that its users or subscribers were committing acts of trademark infringement and that the service did nothing to stop the infringing activity once the service became aware of it. A successful contributory infringement claim is also dependent on a finding that the alleged direct trademark infringer was in fact infringing. In order to hold an ISP, BBS, or webpage hoster liable for contributory trademark infringement clients should put the service on notice by sending copies of any "cease and desist" letters sent to the direct infringer as well as copies of any federal trademark registrations that the client may have for their trademarks.

C. Type of Relief Available

1. *Injunctions*

Perhaps the most important thing is getting the cybersquatter shut down as soon as possible. This is particularly important in situations where the squatter is publishing pornography on the Internet through the use of a domain name similar to the client's trademark,⁷⁹ where a competitor is taking advantage of a client's business goodwill by selling its products and services under marks which are confusingly similar to the client's marks,⁸⁰ or where the squatter is angry at the client's business or organization and is publishing defamatory or derogatory information about its products or services by using

78. See *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844 (1982). A recent Ninth Circuit opinion held that the operator of a flea market who rented booth space to people with knowledge they were selling bootleg copies of musical recordings could be liable for contributory trademark infringement. See *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996).

79. See, e.g., *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, 40 U.S.P.Q.2d (BNA) 1479 (W.D. Wash. 1996).

80. See *Toys R Us v. Abir*, 45 U.S.P.Q.2d (BNA) 1944 (S.D.N.Y. 1997).

the client's marks and logos.⁸¹ One could also get an injunction ordering that the squatter transfer the domain name.⁸²

2. Damages

Generally under both the Lanham Act and the Federal Anti-dilution statute, one must show that the defendant had willful or knowing intent to infringe in order to get money damages for the infringement. Likewise, an award of attorneys fees is not automatic simply because your client wins the case. Willfulness or an intent to infringe or dilute must be shown to get an award of attorneys fees under these Acts.⁸³

IX. WHO SHOULD BE CONCERNED ABOUT CYBERSQUATTERS?

A. Famous People or Companies

People or companies that have any degree of fame or notoriety should be concerned about cybersquatters. Because registration of domain names is relatively cheap (just a few years ago it was free) and because neither NSI nor any other domain name registries investigate the legitimacy of anyone's claim to a name prior to registering the domain name,⁸⁴ thousands of corporate and personal names have already been registered by third parties.

B. Political Candidates

People running for state and federal office should be extremely worried about cybersquatters. Already, domain name speculators are registering names for possible presidential candidates with the intent to auction them off to the highest bidder, whether it be the actual candidate, her competitor, or anyone else who doesn't like the candidate or the party to which she belongs.⁸⁵

81. See, e.g., *Jews For Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J. 1998). See also *Planned Parenthood Fed'n of America, Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. 1997), *aff'd*, 159 F.3d 1351 (3rd Cir. 1998).

82. See *Intermatic, Inc. v. Toepfen*, 947 F. Supp. 1227 (N.D. Ill. 1996); *Panavision Int'l LP v. Toepfen*, 945 F. Supp. 1296 (C.D. Cal. 1996); *Avery Dennison v. Sumpton*, 999 F. Supp. 1337 (C.D. Cal. 1998).

83. See 15 U.S.C §§ 1117(a), 1125(c) (1998). See also *Toys R Us v. Abir*, No. 97-Civ.-8673, 1999 U.S. Dist. Lexis 1275 (S.D.N.Y. Feb. 5, 1999).

84. See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949 (C.D. Cal. 1997).

85. See, e.g., Lawrence Arnold, *Forbes Learns Lesson About Speed of Business on the Web*, THE ASSOCIATED PRESS, Mar. 18, 1999, available in LEXIS, News Group. All File; Donna Ladd, *King Of The URLS*, THE VILLAGE VOICE, May 4, 1999 at 37. See also

While the names of presidential candidates are likely the most lucrative domain names to cybersquatters, there is absolutely no reason why this activity could not be applied to candidates for statewide or local offices. Since many people now get news and information, even local news, via the Internet, a candidate for a local city council or school board seat in a relatively small town could run into a problem like this if the race is hotly contested. Since it only costs someone \$70 to register a domain name with most domain name registries, an opponent to a political candidate in year 2000 elections could register his likely opponent's or the incumbent's name and then start blasting him or her on the Internet. Since someone's status as a political candidate is not a service as defined in either the state or federal trademark or dilution acts, they would not be able to use trademark or unfair competition laws to get rid of the derogatory website.⁸⁶ Therefore, those who are considering running for political office in 2000 should lock up their domain names now.

X. SHIFTS IN SQUATTING

Because those who thought they would get rich from squatting on famous marks are finding that they are in fact getting sued and almost always losing, many cybersquatters are shifting toward squatting on highly descriptive and generic terms, such as www.lawyer.com. From a trademark use and registration standpoint, the word "LAWYER" for use in connection with legal services is unregistrable and not capable of functioning as a service mark for legal services. However, the value of such a website to a law firm may be enormous. Therefore, cybersquatters who snatch up these kinds of domain names will likely earn big money by selling or leasing generic and highly descriptive domain names and they will be virtually immune from trademark infringement and dilution lawsuits because of the high degree of descriptiveness inherent in the domain names.⁸⁷

<<http://www.presidentialelection.com>>. This cybersquatter is holding an on-line public auction of this domain name to the highest bidder.

86. While it is possible that a state or local political candidate could possibly use the law of defamation against the owner of the derogatory website, defamation law may not be wholly effective because the court is likely to determine that the candidate-plaintiff is a public figure under *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964). See also *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657 (1989).

87. Incidentally, www.lawyer.com has already been registered to Mail.com, who leases the designation as a personalized or vanity e-mail address for lawyers, for example, jefflook@lawyer.com.

XI. DOMAIN NAMES AND TRADEMARK OR SERVICE MARK DILUTION

Just because a trademark or service mark is not being infringed by the use or registration of a domain name does not mean that the domain name registrant is not diluting the trademark or service mark under either the Federal Anti-Dilution Act,⁸⁸ or a state anti-dilution act.⁸⁹ Dilution statutes are designed to protect the distinctive quality of famous and distinctive trademarks and service marks. Unlike infringement, there is no requirement that the respective users of a mark or name are directly competitive in their respective businesses or that consumer confusion exists. All that is required is that the junior user's commercial use of the mark dilute the distinctive quality of another mark.⁹⁰ The key language in this and in many state acts are the words "FAMOUS AND DISTINCTIVE." If a mark is weak or descriptive, and has not acquired a wide degree of fame at least regionally or nationally for the federal act,⁹¹ or within the state under a state act, then the mark cannot be diluted. Likewise, some marks which are relatively famous are, nevertheless, not distinctive because of a wide degree of use of the same or similar marks by other parties.⁹² Domain names which incorporate famous and distinctive marks have been found to be dilutions of famous and distinctive marks. The state and federal anti-dilution statutes use the wording famous *and* distinctive, not famous *or* distinctive, meaning that fame *and* distinctiveness are required in order to take advantage of federal and state anti-dilution acts. The appendix of this article includes lists showing various owners for the marks APPLE, MERCURY, and DELTA on differing types of goods and services. Some of these marks are more famous than others and none of the marks are merely descriptive or even suggestive of the nature of their goods and services. Therefore, they would probably be considered "fanciful" or "inherently distinctive" marks. However, none of these trademark owners would likely be able to use the dilution statute to prevent any and all other use of these marks by third parties. They might be able to

88. See 15 U.S.C. § 1125(c) (1998).

89. See, e.g., ARK. CODE ANN. § 4-71-213 (Michie 1996), which is highly similar in wording to the federal act.

90. See the definition of dilution in 15 U.S.C. § 1127. See also ARK. CODE ANN. § 4-71-201(3).

91. See *Star Markets, Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030, 1035 (D. Haw. 1996) (finding that fame in one state is not sufficient under federal anti-dilution statute). See also *Wawa Dairy Farms v. Haaf*, 40 U.S.P.Q.2d (BNA) 1629 (E.D. Pa. 1996) (finding that fame in five states was sufficient under the federal anti-dilution statute), *aff'd*, 116 F.3d 471 (3rd Cir. 1997).

92. See, e.g., *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449 (4th Cir. 1999); *Avery Dennison v. Sumpton*, No. 98-55810, 1999 U.S. App. LEXIS 19954 (9th Cir. Aug. 23, 1999).

use a dilution claim, however, to stop others from using similar marks in the particular field that they do business in and are famous to the consuming public for. For example, Delta Airlines might be able to use the dilution statute in an action involving airline services or other types of transportation and travel services. This would also likely meet the tests for a trademark infringement. However, the airline would not likely be able to use the federal or a state dilution statute such as Arkansas' statute to stop someone from selling a brand of cheese under the trademark DELTA.

*Intermatic, Inc. v. Toeppen*⁹³ is a case involving well-known "Cybersquatter," Dennis Toeppen. Toeppen had registered numerous famous trademarks and service marks as domain names with the intent to "sell" them off to the trademark owners for a substantial profit.⁹⁴ One of the marks Toeppen registered was www.intermatic.com.⁹⁵ Intermatic owned five incontestable federal trademark registrations for the mark INTERMATIC for various electrical products.⁹⁶ Intermatic did not find out about Toeppen until it tried to register the www.intermatic.com domain name with InterNic.⁹⁷ Because of Toeppen's prior registration, Internic refused to register Intermatic's domain name application.⁹⁸ Intermatic sued Toeppen for trademark infringement and dilution. The court found that Intermatic had spent about \$16 million in advertising its products in the eight years prior to the court's decision.⁹⁹ It had been using the INTERMATIC mark on its products for about 50 years.¹⁰⁰ The judge granted summary judgement in favor of Intermatic under the federal anti-dilution statute. Important factors in granting the summary judgement included Intermatic's long use of the mark, the fact that the mark was "fanciful," that is, it did not merely describe or was not highly suggestive of the nature of the goods, that Intermatic had federal trademark registrations for the mark, and that Intermatic had exclusive use of the mark prior to Toeppen's registration of the domain name. Further, Toeppen had never used the INTERMATIC mark in connection with any goods or services of his own.¹⁰¹ The judge held that Intermatic's name and reputation would be at Toeppen's "mercy" and could be associated with a

93. 947 F. Supp. 1227 (N.D. Ill. 1996).

94. *See id.* at 1230.

95. *See id.* at 1232.

96. *See id.* at 1230.

97. *See id.* at 1232.

98. *See id.*

99. *See Intermatic*, 947 F. Supp. at 1230.

100. *See id.* at 1239.

101. *See id.* at 1233.

wide variety of messages on Toeppen's web page if the domain name were allowed to remain with Toeppen.¹⁰²

In *Panavision International, L.P. v. Toeppen*,¹⁰³ Panavision sued Dennis Toeppen for registering the domain names "panavision.com" and "panaflex.com." These were two federally registered trademarks owned by Panavision for use in connection with theatrical motion picture and television cameras and equipment.¹⁰⁴ Toeppen received a "cease and desist" letter from Panavision, but Toeppen responded by saying that it would cost Panavision \$13,000 to have the domain names transferred.¹⁰⁵ Panavision refused to pay and instead sued Toeppen under state and federal anti-dilution statutes.¹⁰⁶ Like the Illinois court in the *Intermatic*¹⁰⁷ case, the California court found that Panvision had widespread use of the marks, heavy advertising and promotion of the marks, and that the marks had acquired secondary meaning through many years of use by Panavision.¹⁰⁸ The judge further said that Toeppen "prevented Panavision from using its marks in a new and important business medium,"¹⁰⁹ and that "merely . . . registering a famous mark as a domain name for the purpose of trading on the value of the mark by selling the domain name to the trademark owner violates the federal and state dilution statutes."¹¹⁰

Persons using a famous mark as a domain name to publish derogatory information about the owner may also dilute a mark. In *Planned Parenthood Federation of America, Inc. v. Bucci*,¹¹¹ the Defendant, Richard Bucci, was the host of a daily radio talk show called "Catholic Radio."¹¹² Planned Parenthood, a well known organization which promotes and advocates pro-choice abortion issues,¹¹³ also owned a federal trademark registration for the mark PLANNED PARENTHOOD.¹¹⁴ Bucci registered the domain name "plannedparenthood.com," and published anti-abortion information on the website, a position in direct conflict with Planned Parenthood's well known mission.¹¹⁵ Much of the information Bucci's web page promoted a book

102. *See id.* at 1239.

103. 945 F. Supp. 1296 (C.D. Cal. 1996).

104. *See id.* at 1298-99.

105. *See id.* at 1300.

106. *See id.*

107. *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227 (N.D. Ill. 1996).

108. *See Panavision*, 945 F. Supp. at 1302-03.

109. *See id.* at 1304.

110. *See id.*

111. No. 97-Civ.-0629 (KMW), 1997 WL 133313, at *1 (S.D.N.Y. Mar. 24, 1997).

112. *See id.* at *1.

113. *See id.*

114. *See id.*

115. *See id.*

which advocated restrictions or bans on abortion.¹¹⁶ The court granted an injunction against Bucci preventing him from using PLANNED PARENTHOOD as a trademark or as a domain name.¹¹⁷ The court held that Bucci's promotion of the book was commercial in nature and that Bucci was a non-profit political activist who solicits funds for his activities.¹¹⁸ The court also noted that Bucci's actions were specifically intended to cause harm to Planned Parenthood.¹¹⁹

*Jews For Jesus v. Brodsky*¹²⁰ involved a non-profit, international outreach ministry founded in 1973 that consisted of Jewish people who advocated and followed the teachings of Jesus Christ. The group sued Brodsky,¹²¹ a Jewish Internet website developer, who had very strong and critical things to say about their organization.¹²² Brodsky had been quoted in the public media that he believed that the organization was a "cult" that preyed upon Jewish people through deceit and trickery.¹²³ Jews For Jesus had distributed religious pamphlets and materials for over 20 years and in 1995 registered the www.jews-for-jesus.org domain name.¹²⁴ The website contained many of the organization's religious tracts available in electronic form.¹²⁵ In 1997, Brodsky registered www.jewsforjesus.org and posted highly critical statements about Jews For Jesus on the website. He also had links to other Jewish organizations which had strong and highly critical statements about the Jews For Jesus organization.¹²⁶ Brodsky admitted in court documents that his "intent behind the bogus Jews For Jesus site is to intercept potential converts before they have a chance to see the obscene garbage on the real site."¹²⁷ The court found that although the JEWS FOR JESUS mark may have been descriptive when it was adopted, it had become distinctive and famous through widespread advertising and promotion by the organization.¹²⁸ It also said that Brodsky's *mere use of the domain name to criticize and disparage* the Jews For Jesus organization *was a commercial use* in that he prevented Jews For Jesus from fully exploiting their mark.¹²⁹ The court rejected

116. *See id.* at *2.

117. *See Bucci*, 1997 WL 133313, at *12.

118. *See id.* at *5.

119. *See id.*

120. 993 F. Supp. 282 (D.N.J. 1998).

121. *See id.* at 288.

122. *See id.* at 290.

123. *See id.*

124. *See id.* at 288-89.

125. *See id.* at 290.

126. *See Brodsky*, 993 F. Supp. at 290-91.

127. *See id.* at 291.

128. *See id.*

129. *See id.* at 308.

Brodsky's claim that his First Amendment rights would be violated by having to give up the domain name. The court noted that Brodsky did not have a right to use false and deceptive marks to confuse the public. Further, his message was not barred because he could use another, non-confusing domain name to post his message.¹³⁰

Do the *Bucci* and *Brodsky* decisions mean that all politically motivated uses of someone else's mark are dilutions of famous marks? Probably not. The federal anti-dilution act¹³¹ specifically has provisions which allow for fair, non-commercial, use of another's mark. It also has a "news" commentary and reporting exception.¹³² In *Bucci*, the Defendant was doing far more than what is normally considered a fair use, or non-commercial use. Also, the *Brodsky* court held that intentional deception of the public and disparagement of a trademark owner's services was a commercial use in and of itself. Finally, both cases indicate that no one has a constitutional right to falsely identify themselves to consumers, even if the message they seek to bring is political or a matter of public interest.

It is no secret that pornography is rampant on the Internet and that the vast majority of businesses, whether they have websites of their own or not, would not want to have their valuable names, trademarks, and service marks associated with pornography. This is the ultimate dilution of a mark. In *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*,¹³³ Hasbro, a maker of toys and children's games ran into this problem. Hasbro owned a federal registration for CANDYLAND, a children's game.¹³⁴ The defendants had registered www.candyland.com as a domain name for a sexually explicit website.¹³⁵ The judge in *Hasbro* did not hesitate to issue an injunction against the pornographic website based on dilution grounds.¹³⁶

The defendant cybersquatter in *Avery-Dennison v. Sumpton*¹³⁷ registered over 12,000 surnames as Internet domain names with the .NET designation.¹³⁸ Sumpton would then lease the domain names to people who had these surnames to use as e-mail addresses, i.e. bill@smith.net.¹³⁹ Two of the 12,000 surnames registered were "Avery" and "Dennison."¹⁴⁰ Avery Dennison, an

130. See *id.* at 312-13.

131. See 15 U.S.C. § 1125(c) (1998).

132. See 15 U.S.C. § 1125(c)(4) (1998).

133. No. C96-130WD, 1996 WL 84853, at *1 (W.D. Wash. Feb. 9, 1996).

134. See *id.* at *1.

135. See *id.*

136. See *id.*

137. 999 F. Supp. 1337 (C.D. Cal. 1998).

138. See *id.* at 1338.

139. See *id.*

140. See *id.*

office products manufacturer, owned federal trademark registrations for "Avery" and "Dennison."¹⁴¹ It also had domain name registrations for www.avery.com and www.averydennison.com.¹⁴² The court found that the Plaintiff's marks were famous and that defendant's domain name registrations diluted the marks. In some strongly worded language, the court said: "It is the registration of the trademark name as a domain name, which denies the holder of the famous trademark from using its trademark name as an Internet domain name, that dilutes the ability to identify goods and services."¹⁴³

On August 23, 1999, the Ninth Circuit reversed the district court in the *Avery-Dennison* case. The key factor in reversing the lower court was the Ninth Circuit's finding that while "Avery" and "Dennison," two relatively common surnames, may have "acquired distinctiveness" through long use and heavy advertising, the marks were not also "famous."¹⁴⁴ The court held that the Federal Trademark Dilution Act and its California counterpart dilution act "requires a showing greater than distinctiveness to meet the threshold element of fame; as a matter of law, Avery-Dennison has failed to fulfill this burden."¹⁴⁵ Not only did the Ninth Circuit reverse the lower court's awarding of summary judgment in favor of Avery-Dennison for \$300 each, the Ninth Circuit instructed the district court to award summary judgment to Sumpton and to take evidence on whether Avery-Dennison should be required to pay Sumpton's attorneys fees.¹⁴⁶

The lesson to be learned from the highlighted cases is that each of the plaintiffs owned federal trademark registrations for their respective marks. If clients have not federally registered their marks with the Patent and Trademark Office, this is a good reason why they should. This is one of the specific factors listed in the federal anti-dilution act¹⁴⁷ which a court is to consider in the dilution analysis and one which many federal courts are weighing very heavily in favor of the trademark owner in dilution cases. It is also highly relevant in using a domain name registry's domain name dispute policy.¹⁴⁸ Furthermore, if you are on the defendant's side of a dilution claim, the fact

141. *See id.*

142. *See id.* at 1341.

143. *See Avery-Dennison*, 999 F. Supp. at 1341. However, since Sumpton had no specific intent to sell the domain names back to Avery Dennison or even the highest bidder, it ordered that principles of equity required Avery Dennison to pay Sumpton the sum of \$300 per domain name. The court observed that if Sumpton sold all 12,000 of his domain names for \$300, he would make a profit of \$2.4 million. *See id.* at 1342.

144. *See Avery-Dennison v. Sumpton*, No. 98-55810, 1999 U.S. App. LEXIS 19954, at *1 (9th Cir. Aug. 23, 1999).

145. *Id.*

146. *See id.*

147. *See* 15 U.S.C. § 1125(c)(1)(H) (1998).

148. *See* discussion under Section VII, *infra*.

that your client also has a federally registered trademark for one similar to the plaintiff's could be useful in showing that the plaintiff's mark is not distinctive.

XII. COPYRIGHT PROBLEMS IN CYBERSPACE

Copyrights are also infringed by Internet websites. For example, an infringer could post someone else's copyrighted materials on the infringer's own website. The owner of a website could also link to another's website without permission. Briefly, copyrights are a "bundle" of rights defined by federal statute,¹⁴⁹ which give the copyright owner the exclusive right to do or authorize others to do any of the following: (1) Reproduce the copyrighted work; (2) Prepare a derivative work based upon the copyrighted work; (3) Distribute copies or phono records of the copyrighted work to the public by sale or other transfer of ownership or by rental, lease or lending; (4) In the case of literary, musical, dramatic and choreographic works pantomimes and motion pictures and other audiovisual works, the exclusive right to perform the copyrighted works publicly; (5) In the case of literary, musical, dramatic and choreographic works, pantomimes, and pictorial, graphic or sculptural works, including individual images from motion picture or other audio-visual works, the exclusive right to display the copyrighted work publicly; (6) In the case of sound recordings, to perform the copyrighted works publicly by means of digital audio transmission.¹⁵⁰

The above rights exist in what the Copyright Act defines as "original works of authorship," which are fixed in any tangible medium of expression, now known or later developed, from which the works can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.¹⁵¹ The Copyright Act defines works of authorship as "literary works, musical works, including the accompanying words, dramatic works, including any accompanying music, pantomimes and choreographic works, pictorial, graphic and sculptural works, motion pictures and other audio-visual works, sound recordings and architectural works."¹⁵²

Copyrights do not exist in ideas, procedures, processes, systems, methods of operation, concepts, principles, or discoveries regardless of the form in which they are described, explained, illustrated, or embodied.¹⁵³ Because most computers nowadays can reproduce and display, text, graphics, photos,

149. See 17 U.S.C. § 106 (1998).

150. See 17 U.S.C. § 106.

151. See 17 U.S.C. § 102(a) (1994).

152. See 17 U.S.C. § 102(a).

153. See 17 U.S.C. § 102 (b) (1994).

motion pictures, video and audio, in near perfect quality, copyrightable works are easily infringed through the Internet.

There are three types of copyright infringement: direct, contributory, and vicarious. Direct copyright infringement occurs when the defendant actually violates one of the copyright holder's exclusive rights under Section 106 of the Copyright Act.¹⁵⁴ However, in many cases the direct infringer either cannot be located or is financially insolvent. In such cases some copyright owners have used contributory and vicarious copyright infringement theories can hold more financially solvent third parties such as Internet Service Providers (ISPs), Bulletin Board Service (BBSs) operators and webpage hosting services liable for assisting others in committing copyright infringements through Internet websites. Contributory copyright infringement occurs when the defendant has knowledge of the infringing activity and induces, causes or materially contributes to the infringing conduct of another.¹⁵⁵ Vicarious copyright infringement occurs when the defendant has the right and ability to control the infringer's acts and the defendant receives a direct financial benefit from the infringement.¹⁵⁶

One egregious case of contributory copyright infringement is discussed in *Sega Enterprises, Ltd. v. Maphia*.¹⁵⁷ In this case, Maphia was a BBS operator who allowed subscribers to the service to upload or download bootleg copies of Sega video games. Maphia sold devices which facilitated the copying of the games. Specifically, the devices would allow someone to dump the software from a Sega video game cartridge onto an ordinary computer floppy disk.¹⁵⁸ It also sold adapters to allow Sega games downloaded on ordinary floppy disks to be used in Sega game machines.¹⁵⁹ He also actively encouraged subscribers to upload and download games to the BBS.¹⁶⁰ The court held that Maphia did not commit direct infringement, that is, the user of the service was the person who actually copied the programs.¹⁶¹ However, Maphia was found liable for contributory copyright infringement because it knew of the infringing activity, actively solicited people to commit

154. See 17 U.S.C. § 106 (1994).

155. See *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996). See also *Sega Enter. v. Maphia*, 948 F. Supp. 923 (N.D. Cal. 1996); *Religious Tech. Ctr v. Netcom On-line Communication Servs.*, 907 F. Supp. 1361 (N.D. Cal. 1995).

156. See *Religious Tech. Ctr. v. Netcom On-line Communication Servs.*, 907 F. Supp. 1361 (N.D. Cal. 1995).

157. 948 F. Supp. 923 (N.D. Cal. 1996).

158. See *id.* at 928-29.

159. See *id.*

160. See *id.*

161. See *id.* at 932.

direct infringements and it profited financially from the sale of devices to facilitate the copying as well as through subscription fees.¹⁶²

Due to widespread concern by ISPs and BBSs over virtually unlimited liability for acts of subscribers who commit copyright infringements through the use of their services, Congress placed a limitation on liability for such services in the Digital Millennium Copyright Act,¹⁶³ enacted last year. It amended the Copyright Act to provide limitations on liability for ISPs or BBSs for alleged direct or contributory infringement related to the infringing activities of users or subscribers. It also imposes certain duties on ISPs and BBSs in order to take advantage of the new law's limitations on liability.

The new law specifically exempts ISPs and BBSs from liability for direct copyright infringement committed if the claim is based solely on the fact that the provider transmitted, routed, or provided connections to a user or subscriber who posts infringing material and the transmission, routing or temporary storage of the infringing material is carried out through an automatic, technical process without selection of the material by the service provider.¹⁶⁴ The provider also cannot select the recipients except through an automatic response to the request of another.¹⁶⁵ It limits contributory infringement liability based solely on providing access to infringing materials if the ISP or BBS has no prior knowledge of the infringing material, it expeditiously removes or disables access to the material once it receives notice of the infringement, and it receives no financial benefit directly attributable to the infringing activity.¹⁶⁶ The law also limits liability for merely providing links to infringing material on another website provided the ISP or BBS does not have actual knowledge or, in the absence of such knowledge, is not aware of facts or circumstances from which an infringement should be readily apparent.¹⁶⁷ The ISP or BBS also cannot receive a financial benefit directly related to the link to the infringing material and it must respond expeditiously to remove or disable the link upon notice of a claimed infringement.¹⁶⁸

ISPs or BBSs who wish to take advantage of the limitations must designate an agent to receive notifications of claimed copyright infringement to both the United States Copyright Office and to the general public through access to the ISP's or BBS's own website.¹⁶⁹ ISPs and BBSs are exempt from

162. See *id.* at 933.

163. 17 U.S.C. § 512 (1994).

164. See 17 U.S.C. § 512(a)(1)-(2).

165. See 17 U.S.C. § 512(a)(3).

166. See 17 U.S.C. § 512(c).

167. See 17 U.S.C. § 512(c).

168. See 17 U.S.C. § 512(c).

169. See 17 U.S.C. § 512(c)(2) (1994).

liability if they disconnect or disable access to a website accused of copyright infringements, even if it is later determined that the website owner did not commit copyright infringement.¹⁷⁰ To guard against frivolous, false, and unmeritorious claims of copyright infringement, the new act imposes liability if the plaintiff knowingly or materially misrepresents that the on-line activity complained of is infringing.¹⁷¹ If so, the plaintiff is liable to the defendant for damages, including court costs and attorney fees.¹⁷²

XIII. LINKING, FRAMING, AND METATAGGING

Some legal issues that are far from settled with respect to copyright or trademark infringement involve "linking,"¹⁷³ "framing,"¹⁷⁴ and "metatagging."¹⁷⁵ Some view out-links as nothing more than the equivalent of a footnote or legal citation. However, an equally strong argument is that these links, if made without the permission of the linked website's owner, violate that owner's right to reproduce, display, or create derivative works from copyrighted material.¹⁷⁶ There is also the issue of whether one should obtain permission to link. By and large, most website owners never bother to get permission to link from their websites to those of others. In many cases, however, linked website owners do not object because such practices further their goal of disseminating their website's information to as many people as

170. See 17 U.S.C. § 512(g) (1994).

171. See 17 U.S.C. § 512(f) (1994).

172. See 17 U.S.C. § 512(f).

173. See generally *PC Webopaedia* (last modified Nov. 25, 1997) <<http://webopedia.internet.com/TERM/l/link.html>>. Linking is the process that allows the transfer of information stored on one computer to another computer without having to type the web address of each site. A link is nothing more than storing the Internet web address of the linked site on the linking site. Linking allows Internet sites to connect, simply by having the user "click" on a designated area on the site. Linking may lead to another file in the same website, or to a file on a different computer located elsewhere on the Internet. See *id.*

174. See generally *PC Webopaedia* (last modified June 16, 1997) <<http://webopedia.internet.com/TERM/f/frames.html>>. Framing is another type of link; however, instead of sending the computer user away or out from the linking website, the linking website brings information from another website to the user of its website. Often times this information is surrounded by a "frame" so that the website user is still looking at the original website, but the information within the frame is being imported from some other site.

175. See Alan Richmond, *META Tagging for Search Engines* (visited June 24, 1999) <<http://www.stars.com/Search/Meta/Tag.html>>. Metatags are key words used primarily by search engines to index, identify, and document contents of a web page. Metatags are invisible to computer users. An example of what a computer metatag looks like is attached to the appendix. The key-word portion of the metatag reviewed by web-browsing programs is highlighted in boldface.

176. See 17 U.S.C. § 106 (1994 & Supp. II 1996).

possible. However, one should not assume that because one website owner didn't object to a link to their site, doesn't mean that someone else will not.

Framing is probably a more serious threat to copyright and trademark properties than linking. Two of the first cases on framing are *Washington Post Co. v. Total News, Inc.*¹⁷⁷ and *Futuredontics, Inc. v. Applied Anagramics, Inc.*¹⁷⁸ Total News operated a website that made news sources from all over the world available on a single website.¹⁷⁹ The company placed a frame around the entire border of the computer screen. At the top was the Total News logo. The side of the frame featured links to various newspapers, magazines, and news services, such as the *Washington Post*.¹⁸⁰ The lower part of the frame featured advertising sold by Total News to third parties.¹⁸¹ When one accessed one of the links, such as the *Washington Post*, the Total News website would pull in the information from the *Post* website so that it appeared within the Total News frame.¹⁸² The *Post* and several other publications included on the Total News links sued Total News, alleging copyright, trademark, and unfair competition claims.¹⁸³ On June 5, 1997 the parties settled, with Total News agreeing to eliminate its frame.¹⁸⁴ However, Total News was allowed to maintain out-links to the other news sources, provided that the links were in plain text and did not feature the stylization, logos, or graphics of any of the other news sources.¹⁸⁵ In addition, the links could not imply any sort of sponsorship, affiliation, or endorsement of Total News's service by any of the plaintiff organizations.¹⁸⁶

Futuredontics owned a website that provided dental referral services.¹⁸⁷ It sued Applied Anagramics for framing material from Futuredontics's website in Applied Anagramics site.¹⁸⁸ Futuredontics claimed that Applied Anagramics's act of framing violated its right to create derivative works of its copyrighted materials.¹⁸⁹ The court denied Applied Anagramics Motion to

177. No. 97-Civ.-1190 (S.D.N.Y. June 5, 1997).

178. No. CV 97-6991 ABC (MANX), 1998 WL 132922, at *1 (C.D. Cal. Jan. 30, 1998), *aff'd* 152 F.3d 925 (9th Cir. 1998).

179. See *Publishers Settle Dispute Over Framing with Web Site Owners*, ANDREWS COMPUTER & ONLINE INDUS. LITIG. REP., June 17, 1997, available in WESTLAW, ANCOILR database.

180. See *id.*

181. See *id.*

182. See *id.*

183. See *id.*

184. See *id.*

185. See *Publishers Settle Dispute*, *supra* note 179, at 24, 327.

186. See *Publishers Settle Dispute*, *supra* note 179, at 24, 327.

187. See *Futuredontics, Inc. v. Applied Anagramics, Inc.*, No. CV 97-6991 ABC (MANX), 1998 WL 132922, at *2008 (C.D. Cal. Jan. 30, 1998), *aff'd*, 152 F.3d 925 (9th Cir. 1998).

188. See *id.* at *2009.

189. See *id.*

Dismiss for Failure to State a Claim, because Futuredontics adequately stated a copyright infringement claim based on its allegations of framing the copyrighted materials.¹⁹⁰

Metatags are key words used primarily by computer search engines and web browsers to locate and identify relevant websites in response to a search request. A metatag is essentially an electronic version of a library's card catalog that includes much of the information found on a card catalog entry, i.e. author or personal names, the subject matter of the website and any other information the website owner deems relevant or desirable. Many search engines rely heavily on key word metatags to specify a list of terms that the engine will associate with the particular webpage. When the user enters a key word into a search engine, the search engine returns the address of the sites containing matching key word metatags. Before long, "metataggers" discovered that by incorporating competitors' names or trademarks into the metatags for their websites, computer users conducting an Internet search with a competitor's name or mark would find the metatag's website listed among the search results. The following cases illustrate some of the issues involved in metatagging.

*Insituform Technologies, Inc. v. National Envirotech Group, L.L.C.*¹⁹¹ involved two competing companies in the construction supply business. National Envirotech, a competitor of Insituform's, implanted the words "INSITUPIPE"¹⁹² and "INSITUFORM"¹⁹³ into metatags for its website. Both words are federal trademarks registered to Insituform. National Envirotech did not simply metatag the Insituform marks in its website. It also displayed portions of Insituform's marketing materials on National Envirotech's website, causing consumers to assume a connection existed between the two companies.¹⁹⁴ The case settled, with National Envirotech agreeing not to use Insituform's trademarks in its metatags or on its website.¹⁹⁵

In *Playboy Enterprises, Inc. v. Calvin Designer Label*,¹⁹⁶ the defendant registered Internet domain names that incorporated Playboy's trademarks with Network Solutions, Inc.¹⁹⁷ Calvin Designer also used "Playboy" in the metatag for its website and repeated the words "Playboy" and "Playmate"

190. See *id.* at *2010.

191. No. 97-2064 (E.D. La. Aug. 27, 1997).

192. See U.S. Registration No. 1643612.

193. See U.S. Registration No. 1216690.

194. See *New Legal Issues: Use of Meta Tags*, COMPUTER L. STRATEGIST, September, 1997, available in WESTLAW, CLST database.

195. See *id.*

196. 985 F. Supp. 1220 (N.D. Cal. 1997).

197. See *id.* at 1221. The domain names registered were www.playboyxxx.com and www.playmatelive.com.

hundreds of times in black lettering against a black background, making the words invisible to the computer user, but detectable by a search engine.¹⁹⁸ This enabled Calvin Designer's website to rank at or near the top of the return list by some search engines whenever a computer user searched the terms "PLAYBOY" or "PLAYMATE."¹⁹⁹ The court ordered the defendant to immediately stop using the PLAYBOY and PLAYMATE trademarks in connection with its website, and required the defendant to delete the marks from its website's metatags.²⁰⁰

Perhaps the first case to deal solely with the issue of misleading metatags was *Oppedahl & Larson v. Advanced Concepts*.²⁰¹ Oppedahl & Larson is a law firm specializing in intellectual property law, and, in particular, intellectual property issues on the Internet.²⁰² Advanced Concepts is a webpage-design service that used the Oppedahl & Larson service marks in its metatags.²⁰³ Advanced Concepts and Oppedahl & Larson were not direct competitors in any aspect of their respective businesses, but Advanced Concepts wanted to gain hits from a well-known law firm in this particular area of law. Advanced Concepts did not use the Oppedahl & Larson marks in any other manner in connection with their website except in the invisible metatags.²⁰⁴ Oppedahl & Larson brought the action against Advance Concepts for federal unfair competition, federal dilution, common-law unfair competition, and common-law trademark infringement.²⁰⁵ The case settled, with Advance Concepts agreeing to remove Oppedahl & Larson marks from its metatags.²⁰⁶ The question as to whether a trademark infringement or dilution occurs from merely using another's trademark in a metatag is not settled. However, there are lower federal court decisions which suggest such a practice may be permissible in some cases.

In *Playboy Enterprises v. Welles*,²⁰⁷ Playboy sued former Playmate Terri Welles for using the wording "Playmate" and "Playboy" in metatags for her personal website and for using the wording "Playmate of the Year" in the title of her homepage.²⁰⁸ Ms. Welles was in fact Playmate of the Year in 1981 and

198. *See id.*

199. *See id.*

200. *See id.* at 1221-22.

201. No. 97-Z-1592, 1998 U.S. Dist. LEXIS 18359, at *1 (C.D. Colo. Feb. 6, 1998).

202. *See Law Firm Alleges "Meta Tagging" Violates Trademark Laws*, ANDREWS COMPUTER & ONLINE INDUS. LITIG. REP., Sept. 16, 1997, available in WESTLAW, ANCOILR database.

203. *See id.*

204. *See id.*

205. *See id.*

206. *See Oppedahl & Larson*, 1998 U.S. Dist. LEXIS 18359.

207. 7 F. Supp. 2d 1098 (S.D. Cal. 1998), *aff'd*, 162 F.3d 1169 (9th Cir. 1998).

208. *See id.* at 1100-01.

had appeared in many of Playboy's magazines.²⁰⁹ The court held that her use of the term constituted a fair use and did not infringe Playboy's marks because the title "Playmate of the Year" was bestowed upon her by Playboy.²¹⁰ It is important to note that Ms. Welles minimized all references to Playboy on her website and included disclaimers that her website was not affiliated with or sponsored by Playboy. In addition, her website acknowledged Playboy's trademark ownership of the terms "Playboy" and "Playmate."²¹¹

The *Welles* case clearly suggests that the use of another's trademark in a metatag is not *per se* trademark infringement or dilution. *Bally Total Fitness Holding Corp. v. Faber*²¹² is another case holding that the use of another's mark in a metatag is permissible under certain circumstances. The *Bally* court stated:

[T]he average Internet user may want to receive all the information available on Bally. The user may want to access the official Internet site to see how Bally sells itself. Likewise, the user may also want to be apprised of the opinions of others about Bally. This individual will be unable to locate sites containing outside commentary unless those sites include Bally's marks in the machine readable code upon which search engines rely. Prohibiting Faber from using Bally's name in the machine readable code would effectively isolate him from all but the most savvy of Internet users.²¹³

XIV. THE FUTURE OF DOMAIN NAME REGISTRATION

An affirmative answer to the question of whether to add new top-level domains is viewed by many as opening new territories to a cyber-land rush. There are proposals to add other top-level domains, such as .BUS, .STORE, .FILM, .BANK, .ENT, .ARTS, and several others for specific types of businesses.²¹⁴ Those arguing in favor of adding such designations say that the additional designations will help reduce confusion by making it more clear to the computer user the type of business offered by the domain-name registrant. It will also allow trademark owners prevented from using their trademark as a domain name because of a prior domain name registration, to use their trademark as a domain name. However, while it is possible that consumers

209. *See id.* at 1100.

210. *See id.* at 1102.

211. *See id.* at 1104.

212. 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998).

213. *See id.* at 1165 (footnote omitted).

214. *See* U.S. Department of Commerce, *Management of Internet Names and Addresses* (White Paper, June 5, 1998) <<http://www.ntia.doc.gov/ntiahome/domainname/domainhome.htm#3>>.

will be able to distinguish "xyz.film" from "xyz.bank," will they be able to distinguish the source of "xyz.com" from "xyz.bus" or "xyz.store," particularly if the business in question is a retailer with stores, catalogs and on-line or electronic retailing services? Trademark owners are concerned that additional top-level domains will force them to register more domain names to prevent others from registering first. They are also concerned that the additions will make it more difficult and expensive to police the Internet for confusingly similar websites and domain names.

XV. INTERNATIONAL DOMAIN NAME ISSUES

A domain-name registration secured in the United States is not necessarily secured world-wide, for each country has its own domain-name registry. Therefore, if a client or business has extensive business operations overseas, then it should also look into registering its name in those countries as well.

Some countries have profited greatly from registering domain names. For example, each country that hooks into the worldwide web is given a two-letter country code that appears immediately after the second-level domain name, i.e. www.xyz.us.com. Two countries that experienced booms in domain-name registrations were Turkmenistan, whose country code is "tm," and American Samoa, whose code is "as." Many common-law countries, such as the United States, use the letters "tm" to serve as notice of a common-law or unregistered trademark. Some companies and domain name profiteers have registered famous trademarks in Turkmenistan because its "tm" country code is the same as the "Trademark" abbreviation.²¹⁵ Scandinavians took a particular interest in American Samoa because the two-letter "as" code is the same as a common entity designator in Scandinavian countries.²¹⁶

Occasionally, new countries are granted new top-level domain name designations by the Internet Assigned Number Authority (IANA), a United States-based authority that assigns Internet addresses.²¹⁷ Whenever this happens, the usual result is a rush to register domain names for people who have previously been denied registration elsewhere. Another result is the

215. An example of this involves a well known Arkansas company, Wal-Mart, registered as www.wal-mart.com in the United States. However, if someone types in www.wal-mart.tm, for example, they will not get Wal-Mart in Bentonville, Arkansas, but whoever owns the Wal-Mart domain name registration in Turkmenistan. In this case, a French-based Internet Service Provider (ISP) owns the Turkmenistan domain name registration.

216. For example, the domain name www.volvo.as, which actually belongs to the Swedish car manufacturer, is not on the Swedish domain-name registry but is on the American Samoa registry located half a world away from the car maker's home country.

217. See Christian Anderson, *Approaches to Trademark Challenges Presented by Domain Names*, CLIENT TIMES, Winter 1999, at 1.

opening of new territory for cybersquatters. Currently the rush is on to register in the Keeling Islands (Cocos), a group of small islands in the Indian ocean that are an off-shore territory of Australia.²¹⁸ The islands were given "cc" as their two-letter country designation.²¹⁹ As more top-level country domains that are added to the Internet, it becomes increasingly likely that confusingly similar domain names will be registered elsewhere in the world. As for the people of the Cocos, they may never have to pay taxes again due to the money earned from registering top level domain names.

XVI. PATENT LAW PROTECTION FOR WEBPAGE AND ICON DESIGNS

In addition to obtaining trademark and copyright law registrations for computer websites, it may also be possible to get a design patent for website features. A design patent confers the right to exclude others from making, using or selling "any new, original and ornamental design for an article of manufacture."²²⁰ However, design patents must meet the requirements of Sections 102 and 103 of the Patent Act.²²¹ Section 102, called the "prior art" restriction, imposes a requirement that the design was not used by others or described in printed publications prior to the invention by the applicant.²²² Section 103 basically says that even if the design is not exactly like that described in the prior art, if the differences are such that the subject matter as a whole was obvious to someone skilled in the trade at the time of the invention, a design patent is not issued.²²³ This is the so-called "non-obviousness" requirement. Assuming one meets the requirements to receive a design patent for their website, there are pros and cons of having a design patent in lieu of a copyright.

A. Design Patent Limitations

1. *The Design Patent's Short Duration*

A design patent term lasts for fourteen years. This is a short span of time when compared to a copyright, which lasts ninety-five years for most

218. *See id.* Cocos has a population of slightly more than 600 people and all the islands together are only about 24 times the size of the mall in Washington, D.C. *See id.*

219. *See id.*

220. 35 U.S.C. § 171 (1994).

221. *See* 35 U.S.C. §§ 102(a)-103 (1994).

222. *See* 35 U.S.C. § 102(a) (1994). For example, the invention was described in a printed publication anywhere in the world or was in use or for sale in this country more than one year prior to the filing of the patent application.

223. *See* 35 U.S.C. § 103(a) (Supp. III. 1997).

institutional owners and works created for hire,²²⁴ and for the life of the individual or the last survivor, if more than one, plus 70 years, if the copyright is owned by an individual or individuals.²²⁵ Assume that an individual sole proprietor who designs a webpage is currently twenty-two years of age, and the work is not "for hire," i.e. not designed for an employer or third party. If the individual lives to age 100, the copyright would last nearly midway through the 22nd century.²²⁶ However, if the designer obtains a design patent for the webpage, it would expire when the designer turns 36.

2. *The Design Patent's Lengthy and Expensive Application Process*

A design patent will take months, perhaps as long as a couple of years, to get through the Patent and Trademark Office (PTO) and will cost several hundred dollars in filing fees and perhaps a few thousand dollars in attorney's fees. The benefits of having a design patent are not effective until the patent is actually granted by the government. Copyright benefits, on the other hand, arise the moment the design is reduced into a form that can be reproduced or viewed.²²⁷ Furthermore, an application for copyright registration with the Copyright Office costs thirty dollars and can be filed by the applicant without much difficulty.

3. *Limited Protection of Design Patents*

The protection afforded by a design patent is only for whatever is listed in the patent claim, that is, how the patent owner describes what the patent is. Therefore, if the webpage design is changed, the patent would not necessarily protect the new design. It would only allow the patent holder to keep someone from using the old, patented, design. Also, a design patent would not protect the content, or substantive information, contained on the webpage, nor would it prevent anyone from calling or identifying their website by a name substantially similar to patent holder's.

224. See 17 U.S.C.A. § 302(c) (West Supp. 1999). As measured from the date of first publication of the website. See *id.*

225. See 17 U.S.C.A. § 302(a)-(b) (West Supp. 1999).

226. To be exact, the copyright would last until the year 2147.

227. See 17 U.S.C. § 102 (1994).

4. *Design Patents and Trademark Registrations Compared and Contrasted*

While a little more difficult to obtain than a copyright registration, it is possible that the overall design of a webpage could also function as a source identifying service mark. If the design is inherently distinctive, it could be registered on the Principal Trademark Register without having to show secondary meaning or "acquired distinctiveness."²²⁸ If the design is not inherently distinctive but not purely functional, i.e. the design is merely ornamental or decorative, then it could be registered after showing that consumers have come to recognize the design as a source identifier for a service through long, continuous, and exclusive use by the applicant and/or extensive promotion of the particular design as a source identifying mark.²²⁹ If the webpage is actually being used in connection with a service, rights would begin once it was used to identify and distinguish a service from those of others. If the webpage is not actually used in connection with the performance of a service,²³⁰ i.e. it is a personal webpage, an inactive webpage, under construction, reserved for future use, or merely advertises a company's own goods and services, then the overall design could not be claimed as a service mark no matter how distinctive it might be. If it is a service mark, however the duration of the mark, unlike a design patent or copyright, can last for as long as it is used to identify the service, i.e. forever.²³¹

B. The Advantage of Obtaining a Design Patent

What is the upside of having a design patent? Recall that with copyrights, one cannot get copyright protection for procedures, processes, systems or methods of operation. Therefore, the portion of a webpage that falls under one of these categories, such as a stylized icon or the way the icons are arranged or laid out on the page, would not be copyrightable if it is found to be a process, system or method of operation.²³² Similarly, purely functional

228. Cf. 15 U.S.C. § 1052(e)(1) (1994) (addressing merely descriptive and deceptively misdescriptive marks); *supra* text accompanying note 17 (discussing merely descriptive and deceptively misdescriptive marks).

229. See, e.g., *Qualitex Co. v. Jacobsen Products Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

230. See generally 15 U.S.C. § 1091(a) (1994).

231. Of course, if federally registered, one would have to renew the registration every 10 years. See 15 U.S.C. § 1059(a) (1994). But even one failed to renew, the right to continue using it would not expire. See *id.*

232. See 17 U.S.C. § 102(b) (1994). See also U.S. COPYRIGHT OFFICE, LIBRARY OF CONGRESS, COPYRIGHT REGISTRATION FOR ON-LINE WORKS, CIRCULAR 66 (1998).

matter, like an icon that performs a specific operational function, cannot serve as a trademark or service mark, nor can webpage designs that do not identify services performed for third parties. However, such things could be the subject of a design patent if they otherwise meet the requirements for design patent registration under the Patent Act.²³³ The PTO has issued design patents for computer icons that are features used in computer software.²³⁴ Therefore, it could be possible to get a design patent to protect similar features of a webpage that would not otherwise be protected under copyright or trademark law.

XVI. CONCLUSION

What will the future hold for intellectual property in the virtual wild west? Hopefully, many of the novel issues being raised today involving linking, framing, and metatagging will become settled principals of law in the early years of the next century so that the public and intellectual property owners will know what constitutes an infringement or a dilution and what does not. Courts will hopefully fashion a system governing the use of trademarks in metatags that fairly balances the rights of trademark owners with the public's First Amendment freedom of speech rights. Ideally, the system would allow use of a trademark in a website's metatag for non-commercial purposes but would prohibit other website owners from capitalizing on the fame or reputation of another's intellectual property for personal or economic gain.

It is not likely that the current top-level domain name abbreviations, .COM, .NET, .ORG, .EDU, .INT, .GOV, and .MIL will last indefinitely. As more people begin using the Internet to purchase goods and services, and as more companies develop electronic marketing and retailing plans, the pressure on the federal government to increase the number of commercial, top-level domains will probably become too great to resist. More top-level domains will likely proliferate the problems that trademark owners encounter with cybersquatters and may not effectively alleviate consumer confusion as to the source of highly similar domain names. This will make the need to obtain federal registration for trademarks and service marks even more important in order for a trademark owner to adequately deal with cybersquatters and Internet infringers. It will also likely increase the value of having an older ".COM" domain as many users of the Internet automatically or instinctively default to this domain when searching for a business.

233. See 35 U.S.C. § 171 (1994).

234. See, e.g., design patent numbers 385,549; 385,864; and 386,476.

In terms of copyrighted works, the more advanced computers become in making virtually perfect reproductions and copies of sound, video, still photos, graphics, and text, the more likely it will be that such works will be infringed on a massive scale. The creators of copyrightable works, as well as trademark owners, will need to exercise vigilance in patrolling the Internet for infringers and will need to act quickly to stop the activity. If not, they risk losing their right to control the manner by which their intellectual works are distributed, used and displayed. This is not unlike the real property concept of adverse possession.²³⁵ If a land owner fails to take appropriate action against an adverse possessor in a timely fashion, then the land owner can lose his or her ownership rights in the land. The main difference, however, is that in the virtual world adverse possession of intellectual property will happen on a much larger, and much faster, scale.

235. Adverse possession is described as follows:

[a] method of acquisition of title to real property by possession for a statutory period under certain conditions; it consists of actual possession with intent to hold solely for possessor to exclusion of others and is denoted by exercise of acts of dominion over land including making of ordinary use and taking of ordinary profits of which land is susceptible

BLACKS LAW DICTIONARY 49 (5th ed. 1979) (internal citations omitted).

