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Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace

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COMMERCE VERSUS COMMENTARY: GRIPE SITES, PARODY, AND THE FIRST AMENDMENT IN CYBERSPACE

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ABSTRACT

The Global Online Freedom Bill of 2006 emphasizes the importance of freedom of speech on the Internet as a fundamental human right. However, the backbone of the World Wide Web, the Internet domain name system, is a poor example of protecting free speech, particularly in terms of the balance between speech and commercial trademark interests. This is apparent from the manner in which the legislature and the judiciary deal with cases involving Internet gripe sites and parody sites. The lack of a clear consensus on the protection of free speech in these contexts is troubling, and can be found in a number of recent cases involving situations such as use

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of the peta.org domain name for a parody site on the activities of People for the Ethical Treatment of Animals; use of bosleymedical.com for a gripe site about the practices of the Bosley Medical Institute; and use of a misspelling of the Reverend Jerry Falwell's last name (fallwell.com) for a website critical of the Reverend's viewpoints on homosexuality. This Article examines how trademark law has come to trump freedom of expression under the domain name system and makes recommendations for regulatory reform to ensure a better balance of rights in the future. In particular, it suggests the development of presumptions against trademark infringement in cases clearly involving criticism or parody of a trademark holder in cyberspace.

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INTRODUCTION

We limit linguistic monopolies because ultimately we value the freedom to communicate above the freedom to own: the language of liberty is seldom heard where liberty of language has been removed from the commons.¹

Suppose that on graduating law school, you and your friends go out to celebrate at Selma's Smokin' Steakhouse. You have plans for a fun-filled evening of beer, baby back ribs, and lampooning your professors. However, when you get there, the service is terrible. The greeter is surly. The servers are extremely rude. The beer is lukewarm, and the fries are cold. When you complain to the manager, you're told that they don't appreciate complaints from "rowdy college kids."

As you have your whole summer ahead of you (BAR/BRI course aside), and you're sitting around your apartment trying to avoid revisiting your Civ Pro notes, you decide to get back at Selma's by setting up an online gripe site to describe your experiences there. You log on to an online domain name registration service and search for domain names you might use for this purpose. You discover that selmas.com is taken by a cookie manufacturer,² but the following names are available: selmassmokinsteakhouse.com, selmassteakhouse.com, selmasstinks.com, selmassucks.com, selmassmokinsteakhousestinks.com, and, selmassmokinsteakhousesucks.com. You could also register some intentional misspellings of relevant words and secure a domain name such as selmasstakehouse.com.

You are not sure whether Selma's Smokin' Steakhouse has its own website or not, but it clearly does not use any of these domain names if it does. You decide to avoid selmasstinks.com and selmassucks.com for fear of upsetting the holder of the Selma's Cookies trademark. However, you register the other domain names listed above for the purposes of your gripe site. Your site recounts your experiences at the steakhouse and invites others to post comments critical of the steakhouse. A couple of your friends post negative comments, and some other people on campus find out about the website and also post negative comments. One of the comments states: "You can get a much better steak at Selina's Steakhouse. Don't go to Selma's. It sucks."

1. Kevin Gray, *Property in Thin Air*, 50 CAMBRIDGE L.J. 252, 286 (1991).

2. This is, in fact, the case as of the date of writing.

Naturally, Selma (of the steakhouse fame) finds out about your website and asks you to remove it and transfer the relevant domain names to her. She even offers you \$500 to do so. You have no intention of taking down the website or transferring the names to her, and, in response to the \$500 offer, you tell her, “It would take a lot more than that.” You intend this as an off-the-cuff comment rather than as an attempt to bargain for transfer of the names at a higher price, although in the back of your mind you wonder how much money she might give you to transfer the names. You do have a *lot* of student loans to pay back, after all.

Finally, Selma sues you for trademark infringement³ of her Selma’s Smokin’ Steakhouse mark, and trademark dilution.⁴ She also brings a claim for infringement of the Anticybersquatting Consumer Protection Act (ACPA).⁵ Do her claims succeed? Does her property interest in the trademark outweigh your First Amendment right to criticize her in the forum you have chosen?⁶ That question is the focus of this article. Surprisingly, there is as yet no clear answer to it. This is partly a result of the variety of trademark-based actions that might apply here, including traditional trademark infringement, trademark dilution, and newer anticybersquatting regulations. Each kind of action embodies a different set of principles and balancing tests, and each implicates the protection of free speech against commercial trademark rights in a different way.

In some ways, the following discussion is a necessary continuation of a dialogue about the appropriate role of trademark law vis-à-vis the First Amendment that began in the latter part of the twentieth century as trademark law began to expand into areas outside the traditional consumer confusion rationale.⁷ A number of commentators have noted that

3. 15 U.S.C. § 1114(1) (2000) (infringement of registered trademark rights); 15 U.S.C. § 1125(a)(1) (2000) (infringement of unregistered trademark rights).

4. 15 U.S.C. §§ 1125(c), 1127 (2000).

5. 15 U.S.C. § 1125(d) (2000).

6. Trademarks are often colloquially referred to as property rights although technically they are not property in more traditional senses of the word. Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 788 (2004) (“[T]rademarks are not property rights in gross, but limited entitlements to protect against uses that diminish the informative value of marks.”); Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1687–88 (1999) (“Commentators and even courts increasingly talk about trademarks as property rights; as things valuable in and of themselves, rather than for the product goodwill they embody.”).

7. Dogan & Lemley, *supra* note 6, at 779–81 (noting that trademark law has expanded in two directions in recent years—the class of people who can be liable for trademark infringement has increased and there has been an expansion away from the traditional consumer confusion rationale for trademark law toward a more general preoccupation with whether a “challenged use diverts attention away from the trademark holder”).

twentieth-century developments such as the dilution doctrine,⁸ the ability to merchandise trademarks per se separate from products to which they might originally have been affixed,⁹ the trend toward permitting assignments of trademarks in gross (without goodwill attached),¹⁰ the idea of “initial interest” confusion,¹¹ and the development of anticybersquatting law and policy¹² have turned trademarks into much stronger property rights than originally contemplated.¹³

As trademark rights have broadened in scope, the tension between trademarks and free speech has intensified. When trademark rights were limited to the prevention of consumer confusion, free speech was less likely to be implicated.¹⁴ However, when trademarks are protected against

8. 15 U.S.C.A. §§ 1125(c), 1127 (West Supp. 2006). Trademark dilution refers to blurring or tarnishing a trademark as distinct from confusing consumers as to the source of a particular product or service. See discussion in Part I.B.2 *infra*.

9. Lemley, *supra* note 6, at 1706–09 (noting, for example, that people buy hats and t-shirts because they have a famous logo emblazoned on them, and trademark law will protect licensing schemes around such uses of marks regardless of whether the trademark in question has any traditional trademark association with the hats or t-shirts).

10. See *id.* at 1709–10. Assigning a trademark in gross refers to the practice of selling a mark without the goodwill—in which its associate value generally lies—attached to the mark.

11. Dogan & Lemley, *supra* note 6, at 780–81 (“‘Initial interest confusion,’ which historically referred to a form of consumer confusion that occurred before the point of sale, has morphed into a standalone doctrine whose criteria bear little relationship to a traditional likelihood of confusion claim. Some courts have used the initial interest confusion doctrine to justify claims against virtually any use that temporarily diverts customers to a website not authorized by the trademark holder, regardless of whether the diversion resulted from confusion or harmed consumer interests in any way.”); Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 559 (2005) (“[T]he doctrine exemplifies the devolution of trademark law. [Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [initial interest confusion] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses [of a relevant mark].”).

12. 15 U.S.C. § 1125(d) (2000). The anticybersquatting provisions of the Lanham Act were introduced in 1999, and they prohibit the practice of registering or using domain names that correspond with trademarks with a bad-faith intent to profit by selling the domain name to the corresponding trademark holder or to a third party.

13. Lemley, *supra* note 6, at 1687–88 (“Courts protect trademark owners against uses that would not have been infringements even a few years ago and protect as trademarks things that would not have received such protection in the past. And they are well on their way to divorcing trademarks entirely from the goods they are supposed to represent. Unfortunately, the changes in trademark doctrine over the last fifty years are not supported by the new economic learning. Rather, these changes have loosed trademark law from its traditional economic moorings and have offered little of substance to replace them.”).

14. Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 166 (1982) (“The first amendment . . . does not operate to restrict the rights afforded trademark owners under traditional doctrine. Trademark law, however, has sometimes ventured beyond the confines of the [consumer] confusion model. Those seeking to extend the scope of trademark protection have championed models more closely allied with property than with tort. When consumer confusion ceases to be the

unauthorized uses that relate to things other than consumer confusion and may, in fact, involve commentary, criticism, artistic expression, and the like, the First Amendment can and should come into play. Trademark law and the First Amendment increasingly collided prior to the rise of the Internet. Obvious examples are: the infamous “Enjoy Cocaine” poster¹⁵ and the “Cocaine is the Real Thing” t-shirts,¹⁶ parodying the well-known Coca Cola trademark; the use of L.L. Bean’s registered trademark in a sexually explicit parody in *High Society* magazine;¹⁷ and the use of the famous Olympic-rings mark in a poster protesting state plans to convert the Olympic Village in Lake Placid into a prison after the winter games.¹⁸

The Internet and the domain name system in particular add a number of new wrinkles to this already confusing balancing act. This is because the Internet is probably the most widespread form of communication invented so far. The extent of the Internet means that many commercial trademark holders can reach a larger potential market than ever before. It also means that people can express themselves generally, whether the content be about trademark holders or otherwise, to a wider audience than ever before. Thus, the scope and scale of potential clashes between trademark interests and the First Amendment is greater than ever before. Additionally, Internet communications generally take place on a global scale, so international harmonization of relevant rules and principles is implicated here in a manner that has not been paralleled in the past. Moreover, the domain name system arguably raises a scarcity problem in terms of both commercial trademark use and free speech that does not arise under real-world paradigms because only one person can register a particular domain name at any given time as the online address for her message, at least as the system is currently constructed.

These factors suggest that it is now time to reconsider how we balance trademark interests with free speech values in the domain space. This article aims to highlight areas that require urgent regulatory attention in the interests of preserving free speech in this context. Part I surveys the ways in which courts have approached the problem of balancing trademark interests with free speech rights in pre-Internet cases. This Part illustrates the legal context in which domain name disputes have subsequently arisen,

touchstone, however, the accommodation between trademark law and the first amendment becomes more problematic.”).

15. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D. N.Y. 1972).

16. *Id.* at 1189 n.5 (referring to a consumer complaint about the t-shirts that was not litigated in the case and did not involve the defendant in this case).

17. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

18. *Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980).

and the fact that the domain name issues are indeed a continuation of preexisting concerns within trademark law and policy about the protection of free speech. Part II examines how courts and legislatures have dealt with the balance between trademark interests and free speech in the context of domain name disputes involving gripe sites and parody sites. Part III identifies and compares different legal and regulatory approaches to balancing trademark and free speech interests in domain names. The issues identified in this Part include: (a) clarifying and streamlining the common-law tests for trademark infringement and ACPA infringement in the online context; (b) creating special new domain name spaces for parody, commentary, and criticism, such as a new .sucks, .parody, .fun, or .crit gTLD;¹⁹ and (c) creating a specific judicial or legislative presumption that utilizing a pejorative word like sucks, parody, or critical at the end of a .com, .net, or .org domain name featuring a trademark will be prima facie evidence of a non-infringing use of the mark.²⁰ These suggestions are not mutually exclusive and could all be developed simultaneously by relevant entities, including courts, legislatures, and private bodies such as the Internet Corporation for Assigned Names and Numbers (ICANN).²¹ Part IV sets out conclusions and suggestions for future legal and regulatory developments in this area.

I. TRADEMARKS AND FREE SPEECH IN THE “REAL WORLD”

A. *Trademark-Related Actions: Basic Principles*

Theoretically, there should be no conflict between trademark law and free speech because the fundamental purpose of trademark law is to prevent consumer confusion with respect to the source of products and services.²² The unauthorized use of trademarks outside the unfair

19. gTLD refers to generic Top Level Domain, such as .com, .org or .net, as opposed to a ccTLD or country code Top Level Domain, such as .uk for the United Kingdom, .ca for Canada, or .au for Australia.

20. It may be possible to argue that such a presumption already exists. *See* discussion in Part III *infra*.

21. ICANN is the body that administers the domain name system. For information on ICANN's role in domain name administration, see <http://www.icann.org/> (last visited July 13, 2006).

22. Denicola, *supra* note 14, at 165 (“Reliance on the confusion rationale as the primary basis of [trademark infringement] liability has effectively insulated trademark doctrine from constitutional attack. The necessity of establishing that the challenged use generates a likelihood of confusion restricts judicial intervention to instances in which the mark is used to misrepresent the source or sponsorship of goods or services. The regulation of such deceptive or misleading commercial speech presents no constitutional difficulties”); Dogan & Lemley, *supra* note 6, at 786 (“Most people think of trademark law in terms of what it forbids: the use of another party’s trademark, or something

competition arena should not technically raise the possibility of a trademark infringement action either because such uses are not in commerce,²³ or because they should not cause consumer confusion.²⁴ However, as trademark law has developed in recent decades, the rights of trademark owners have become more expansive at the potential expense of free expression.²⁵ Thus, pre-Internet trademark law has increasingly struggled to balance rights to free speech against commercial trademark interests.²⁶

To understand the various ways in which free speech has played into traditional trademark analysis, it is necessary to appreciate the two main kinds of trademark-based actions: traditional trademark infringement involving a likelihood of consumer confusion analysis,²⁷ and dilution, involving blurring or tarnishment of a famous mark.²⁸

Traditional trademark infringement law has generally been premised on two interconnected aims: (a) to protect the public when purchasing a product or service to ensure that the purchasers get what they think they are paying for in terms of goods or services from a particular source; and (b) to ensure that those who invest in developing goodwill in a particular mark are protected against unfair misappropriations of that goodwill.²⁹ The Lanham Act contains two different provisions relating to traditional trademark infringement—15 U.S.C. § 1114(1) deals with infringement of registered trademark rights and 15 U.S.C. § 1125(a)(1) deals with

resembling it, in a way that will cause confusion among consumers in the marketplace. Courts commonly describe the goal of trademark law as avoiding consumer confusion, which has the corollary effect of preventing the appropriation of a producer's goodwill.”).

23. 15 U.S.C. §§ 1114(1)(a), 1125(a)(1) (2000).

24. *Id.*; *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1225 (S.D.N.Y. 1977) (“The touchstone of trademark infringement under the Lanham Act . . . is ‘likelihood of confusion’: whether a substantial number of ordinarily prudent purchasers are likely to be misled or confused as to the source of the different products.”); 2 GILSON, TRADEMARK PROTECTION AND PRACTICE § 5.01[1] (2006) (“The issue of whether the use of the same trademark or two similar marks by different parties is likely to cause confusion among the purchasing public is central to most trademark cases.”).

25. Denicola, *supra* note 14, at 166; Lemley, *supra* note 6, at 1710–11 (“As trademarks are transformed from rights against unfair competition to rights to control language, our ability to discuss, portray, comment, criticize, and make fun of companies and their products is diminishing.”).

26. Denicola, *supra* note 14, at 159; Lemley, *supra* note 6, at 1710–13.

27. 15 U.S.C. § 1114(1) (2000) (infringement of registered trademark rights); 15 U.S.C. § 1125(a)(1) (2000) (infringement of unregistered trademark rights).

28. 15 U.S.C. §§ 1125(c), 1127 (2000).

29. GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION 16–17 (2004) (*citing* S. Rep. No. 1333, 79th Cong., 2d Sess. 3 (1946)); Dogan & Lemley, *supra* note 6, at 786 (noting the benefits to both consumers and producers of consumers having access to “truthful information about the source of products and services”).

unregistered rights. Each is premised on the idea of an unauthorized use in commerce of a mark in a manner that is likely to cause confusion.

Over time, different courts have developed varying iterations of a likelihood-of-confusion test as part of the inquiry into whether a trademark has been infringed in a given case. As Professors Dinwoodie and Janis point out, the tests developed in different circuits for likelihood of confusion fit the same general pattern.³⁰ They all include factors such as: (a) the alleged infringer's intent; (b) actual confusion; and (c) a variety of factors that can be referred to as market factors,³¹ such as the relationship between the goods and services in question and the relationship between respective trade channels.³²

The trademark dilution action, on the other hand, does not contain such a test. Dilution is an expansive notion because it recognizes damage to a trademark holder irrespective of consumer confusion.³³ Commentators have noted that such a cause of action potentially erodes the foundations of traditional trademark law, which is premised on protecting consumers from confusion as to the source of particular products or services.³⁴ In fact, the definition of dilution in the Lanham Act specifically provides that a likelihood of consumer confusion is not necessary for a dilution action.³⁵ Dilution is defined as “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”³⁶ A dilution action is restricted in application to a famous mark.³⁷ The original intention was to restrict the dilution action to a “relatively small class of nationally known trademarks whose fame is sufficiently great that the risk of blurring by multiple noncompeting uses is significant.”³⁸ However, as

30. DINWOODIE & JANIS, *supra* note 29, at 469.

31. *Id.*

32. *Id.* at 470–71.

33. *Id.* at 563–66.

34. Lemley, *supra* note 6, at 1698–99 (“The most obvious example of doctrinal creep in trademark law is dilution. Dilution laws are directed against the possibility that the unique nature of a mark will be destroyed by companies who trade on the renown of the mark by selling unrelated goods, such as Kodak pianos or Buick aspirin. But because consumers need not be confused for dilution to occur, dilution laws represent a fundamental shift in the nature of trademark protection.”). *See also* Dogan & Lemley, *supra* note 6, at 777 (making similar observations in the context of applying trademark law to activities on the Internet conducted by search engines and other Internet intermediaries).

35. 15 U.S.C. § 1127 (2000).

36. 15 U.S.C. § 1127.

37. 15 U.S.C. § 1125(c)(1) (2000).

38. Lemley, *supra* note 6, at 1698.

Professor Lemley has noted, the action has taken on a greater life than this in practice, and courts have been prepared to extend protection to local marks even if somewhat obscure,³⁹ and to noncompeting, nonidentical marks.⁴⁰ He also notes that some courts have been prepared to find dilution without engaging in a fame inquiry with respect to the mark.⁴¹

B. Factoring Free Speech into Trademark Infringement

1. Free Speech and Traditional Trademark Infringement

Courts have dealt with First Amendment concerns differently in the traditional trademark infringement context, as opposed to the trademark dilution context. In the context of traditional trademark infringement, there appear to be three different approaches to balancing rights to free expression against the proprietary interests of the trademark holder.⁴² These approaches vary from case to case and, to some extent, from circuit to circuit. They have largely developed in cases involving parodies of a trademark. The approaches are: (a) adding a parody factor to the traditional common-law multifactor likelihood-of-confusion test;⁴³ (b) requiring a stricter showing of all of the likelihood-of-confusion factors when the use of the mark is part of a political, social, or artistic message;⁴⁴ and (c) applying the traditional test for trademark infringement and then conducting a separate balancing of free speech rights with the trademark holder's rights.⁴⁵ It is also possible to argue that there is a distinct parody defense to trademark infringement. However, it is currently unclear whether that is the case.⁴⁶ According to Professors Dinwoodie and Janis, it is more likely that what is often described as a parody defense is really a conclusion about a lack of likelihood of confusion in a given case.⁴⁷

Outside the above traditional approaches, free speech is also arguably accommodated to some extent by the fair use defense to trademark

39. *Id.*

40. *Id.* at 1699.

41. *Id.* at 1698–99.

42. GILSON, *supra* note 24, at § 5.05[10][b].

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.* at § 5.05[10][a] (“Is parody a sufficient excuse, or even an affirmative defense to a charge of trademark infringement? The better view is that parody is not an affirmative defense in a trademark case, but that the humorous intent and any free speech rights of the parodists must be factored into the court’s analysis.”).

47. See DINWOODIE & JANIS, *supra* note 29, at 750.

infringement,⁴⁸ particularly in the form of the nominative use subcategory of the defense recognized by some courts.⁴⁹ The Lanham Act permits unauthorized use of another's mark as a fair use when the mark is used only in a descriptive sense and in good faith.⁵⁰ The nominative use test contains three elements:

First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁵¹

Obviously, fair use and nominative use protect certain informational uses of a trademark, largely in connection with the sale of other goods or services in good faith. It therefore has limited relevance to the focus of this Article—use of trademarks in domain names that identify gripe sites and parody sites on the Internet. These situations generally do not revolve around good-faith sales of goods or services, at least in the traditional trademark sense.⁵² However, there may be some useful parallels here in the sense that, in both contexts, a trademark is being used in an informational or descriptive sense and not in a competing commercial sense.

2. *Free Speech and Trademark Dilution*

In the context of a trademark dilution action, courts have approached the protection of free speech in a different way than the approach taken in traditional trademark infringement actions. Obviously, the approach of linking the protection of free speech to the likelihood-of-confusion factors has no application in the trademark dilution context because a trademark

48. 15 U.S.C. § 1115(b)(4) (2000).

49. 3 GILSON, *supra* note 24, at § 11.08[3][d] (“Some courts recognize a judge-made variation on the statutory fair use doctrine, calling it ‘nominative fair use’ and allowing the use of another’s trademark under certain limited circumstances. In these cases, a defendant uses a trademark that *refers to* another party’s product, such as a television station using the mark BOSTON MARATHON in connection with its broadcast of the marathon.”).

50. 15 U.S.C. § 1115(b)(4) (2000) (“[T]he use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin . . .”).

51. *New Kids On The Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

52. See *infra* Part II for a discussion of relevant case law examples.

dilution action does not require consumer confusion. Even if the defendant's speech is effectively protected against the traditional infringement action in one of the ways described above, it may be enjoined under a dilution action.

The two ways in which free speech interests may be protected under a trademark dilution action are somewhat indirect. The unauthorized use may be preserved if the mark is not sufficiently famous to sustain a dilution action,⁵³ or if the unauthorized use is found to be noncommercial in nature.⁵⁴ There is no specific exception, defense, or balancing test with respect to a dilution action that would protect First Amendment values more directly than this.

Although the dilution statute requires a mark to be famous for a dilution action to succeed, courts have been willing to find this requirement to be satisfied fairly easily.⁵⁵ Additionally, one might argue that for a mark to become the subject of criticism or parody, it presumably must have the requisite degree of fame attached to it.⁵⁶

The dilution statute also has an exception for noncommercial uses that may be of some comfort to those engaging in criticism or commentary.⁵⁷ Certainly, in the Internet context, it would seem to be at least arguable that a pure gripe site or parody site, without more, is not a commercial use for trademark purposes. However, this question may not be as clear-cut as it first appears. Courts have taken varying approaches to the question of whether a gripe site or parody site is commercial for dilution purposes.⁵⁸ Additionally, the dilution analysis in the Internet context may be decreasingly relevant if the ACPA is used more frequently and/or more successfully in these contexts to prevent unauthorized use of a domain name corresponding with a famous trademark.

53. 15 U.S.C. §§ 1125(c), 1127 (2000).

54. 15 U.S.C. § 1125(c)(4)(B) (2000); GILSON, *supra* note 24, at § 5A.01[9][b].

55. Lemley, *supra* note 6, at 1698–99.

56. GILSON, *supra* note 24, at § 5.05[10][a] (“[A]lthough the dilution statute requires that a mark be famous and distinctive, this should not be a barrier to owners of a trademark renowned enough to be parodied.”).

57. *Id.*

58. For example, in *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 920 (E.D. Va. 2000), *aff’d* 263 F.3d 359 (4th Cir. 2001), the District Court for the Eastern District of Virginia held that the defendant's parody site utilizing the plaintiff's PETA mark in its domain name (peta.org) satisfied the commercial use requirement of dilution law because the Website included links to commercial enterprises engaged in conduct that was contrary to the plaintiff's animal protection efforts. In contrast, in *TMI, Inc. v. Maxwell*, 368 F.3d 433, 436 (5th Cir. 2004), the Fifth Circuit Court of Appeals held that a gripe site utilizing the plaintiff's trademark in its domain name was not a commercial use of the mark and did not fall within the ambit of antidilution law.

3. *Book, Movie, and Song Titles: A Special Case?*

There is one particular situation from traditional trademark law that deserves special mention in a discussion about expressive uses of Internet domain names. This is the case of book, movie, and song titles. Courts have developed some nuanced approaches to preserving free speech against trademark infringement claims in situations involving the use of trademarks in such titles; for example, the “Barbie Girl” song⁵⁹ or the *Ginger and Fred* movie.⁶⁰ There has been a trend for courts not to enjoin unauthorized use of trademarks in these contexts, provided that consumers are not misled by the use as to any affiliation or sponsorship by the mark holder⁶¹ and that the title is relevant to the work in question.⁶²

The special treatment of titles may be particularly pertinent in framing a policy for domain names because of the similarities in function between domain names and song, book, or movie titles. Each serves both a *descriptive* and an *identifying* function in relation to an underlying work. In the case of song, book, and movie titles, the title can *describe* the underlying work in the sense that it gives some idea of what the title’s audience may expect the work to be about; for example, the “Barbie Girl” song is most likely some kind of commentary on the Barbie Girl doll and/or ideas she connotes within contemporary society.⁶³ A title can also *identify* a work for future reference; for example, if you have heard the “Barbie Girl” song on the radio and you think that one of your friends might like to listen to it, you will most likely use the song title to identify the song to your friend.

59. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). In this case, Mattel failed to obtain an injunction against the producers of a popular song entitled “Barbie Girl” and relating to the “Barbie Girl” image in society.

60. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). In this case, the movie star Ginger Rogers failed to obtain an injunction against the use of the *Ginger and Fred* movie title in the context of a film about two Italian cabaret performers who made a living imitating Ginger Rogers and Fred Astaire.

61. *Mattel*, 296 F.3d at 902 (“A title is designed to catch the eye and to promote the value of the underlying work. Consumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.”); *Rogers*, 875 F.2d at 1001 (noting that at most some members of the public might draw an incorrect inference that Ginger Rogers was somehow involved with a film entitled *Ginger and Fred*, but that risk is so outweighed by interests in artistic expression as to preclude trademark infringement).

62. *Mattel*, 296 F.3d at 901 (“We expect a title to describe the underlying work, not to identify the producer, and Barbie Girl [the song] does just that.”); *Rogers*, 875 F.2d at 1001 (noting that the film title *Ginger and Fred* is “entirely truthful as to its content in referring to the film’s fictional protagonists who are known to their Italian audience as ‘Ginger and Fred’”).

63. As noted by Judge Kozinski in the *Mattel* case, “The song pokes fun at Barbie and the values that Aqua [the pop band] contends she represents.” *Mattel*, 296 F.3d at 901.

Domain names can also serve both of these functions, particularly in the context of a gripe site, parody site, or other kind of commentary site (for example, a fan site). A domain name can *describe* an underlying website in the sense of giving some idea of what the user might expect to find on the site; for example, a user might expect nikesucks.com to resolve to a Website critical of the Nike corporation.⁶⁴ Even a domain name without a pejorative term attached to it like “sucks” or “stinks” could possibly be expected to resolve to any Website *about* a relevant trademark holder, as opposed to a website actually *owned and operated by* the trademark holder.

A domain name can also *identify* a relevant website in the same sense that a book, song, or movie title can identify an underlying work. This aspect of domain name practice is unlikely to change even as search engines become more sophisticated. If I have found a particularly interesting Website relating either to commerce or to commentary and I want to discuss it with someone else, I am likely to mention the domain name of the site in the course of the discussion. This will particularly be the case if I want to refer someone else to the site. If I can identify the site as nikesucks.com, this is a much better way of directing someone else to the site than simply describing the site contents and hoping that the other person can retrace my search steps and find the same site.

Courts have often protected book, song, and movie titles against trademark infringement actions because of consumers’ expectations about the function of a title in identifying and describing a relevant underlying work. It may be possible to draw some lessons from this practice in developing a framework for balancing free speech interests against commercial trademark interests in domain names. The deference that courts have given to book, song, and movie titles should not, of course, be overstated. There is no clear test for the protection of these titles that could create certainty as to whether a particular title does or does not infringe a protected trademark. As with other kinds of trademark cases, courts have developed a series of guidelines to help address the issue of trademark infringements in song, book, and movie titles. One example is that courts arguably have been less likely to find trademark infringement in the case of a mark utilized in a title where the use parodies the owner of the mark, rather than a different topic.⁶⁵ Thus, the “Barbie Girl” song title is

64. In fact, as the date of writing, this domain name appears to be unregistered.

65. GILSON, *supra* note 24, at § 5.05[10][b].

protected because the underlying song makes fun of ideas related to the “Barbie” image in society.⁶⁶

On the other hand, the use of marks relating to Dr. Seuss books, including the title *The Cat in the Hat*, was found to be infringing in a case where the use of the marks had no bearing on the trademark holder and were, in fact, a commentary on the O.J. Simpson trial.⁶⁷ In *Dr. Seuss Enterprises v. Penguin Books*, the distinction between making fun of an intellectual property holder with an unauthorized use and making fun of something else trading on the plaintiff’s property was drawn with respect to both copyrights and trademarks held by the plaintiffs.⁶⁸ In the context of trademark infringement, the court tied its reasoning back to the idea of the likelihood of consumer confusion. “[T]he cry of ‘parody!’ does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark. A non-infringing parody is merely amusing, not confusing.”⁶⁹

Perhaps what this tells us for a discussion of developing a framework for protecting free speech in certain domain name uses is that the title cases are predominantly really about consumer confusion. Thus, like the question as to whether there is a parody defense to trademark infringement, the question of infringing song, movie, and book titles really boils down to the fundamental trademark inquiry as to whether consumers would likely be confused by the particular use. There may be a developing judicial presumption against consumer confusion in title cases, and this may usefully be translated to the domain name context in similar cases. These cases may include those where the use of a particular domain name is unlikely to cause confusion because it serves mainly an *identifying* and *descriptive* function in relation to the underlying Web page and does not confuse consumers as to the source of particular goods or services.

This would still leave the question as to a trademark dilution action where consumer confusion is not the touchstone of the cause of action.⁷⁰

66. *Mattel*, 296 F.3d at 901.

67. *Dr. Seuss Enter. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997) (involving both copyright and trademark infringements of copyrights and marks held by the plaintiff).

68. *Id.* at 1400–01 (with respect to copyright infringement), 1405–06 (with respect to trademark infringement).

69. *Id.* at 1405.

70. *Mattel*, 296 F.3d at 905 (“Dilution . . . does not require a showing of consumer confusion . . . and dilution injunctions therefore lack the built-in First Amendment compass of trademark injunctions.”).

In *Mattel, Inc. v. MCA Records*,⁷¹ a claim for trademark dilution against the distributors of the “Barbie Girl” song failed on the basis that the reference to the Barbie doll in the song and its title fell within the noncommercial use exception to a dilution action.⁷² The court considered the legislative history of the dilution statute in identifying a congressional intention that the noncommercial use exception was included in the statute to ensure the preservation of First Amendment interests with respect to noncommercial expression.⁷³ Although the speech in the “Barbie Girl” song and song title was clearly commercial to some extent in that it was part of a commercially released sound recording, the court held that it was not purely commercial and so could fall within the noncommercial use exemption to trademark dilution.⁷⁴

In so holding, Judge Kozinski noted

[a]lthough the boundary between commercial and noncommercial speech has yet to be clearly delineated, the “core notion of commercial speech” is that it “does no more than propose a commercial transaction” If speech is not “purely commercial”—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.⁷⁵

He proceeded to hold that the “Barbie Girl” song is not purely commercial speech because it also “lampoons the Barbie image and comments humorously on the cultural values Aqua [the pop band] claims she represents.”⁷⁶

Whether or not this is precisely what Congress intended in its definition of noncommercial speech, it seems intuitively to be a good line to draw for the purposes of this discussion. If we can recognize a judicial presumption, or at least a judicial leaning, against trademark dilution in cases where the unauthorized use of a mark is for purposes of identifying and describing an underlying work that does not compete commercially with the mark holder’s products or services, this may be very useful in the domain name context. Where a domain name is used to identify the

71. *Id.* at 894.

72. 15 U.S.C. § 1125(c)(4)(B) (2000).

73. *Mattel*, 296 F.3d at 905–07. *See also* GILSON, *supra* note 24, at § 5A.01[9][b] (“The most important exception to Dilution Act liability is for the ‘[n]oncommercial use of a mark.’ This exception makes clear that the Act is intended to prevent the courts from enjoining speech that has been recognized to be constitutionally protected.”).

74. *Mattel*, 296 F.3d at 906.

75. *Id.* (quoting *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983))).

76. *Id.* at 907.

contents of a site that is a parody or criticism of a mark holder, the same reasoning should ring true. This is because domain names, like movie and song titles, clearly can, and often do, serve an identifying and descriptive function with respect to the associated Website.

The question is whether it is necessary to perform a detailed likelihood-of-confusion and dilution analysis in such cases, or whether we can begin to acknowledge an *ex ante* presumption that such uses are noncommercial (for dilution purposes) and will not confuse consumers (for trademark infringement purposes). This may create a better balance between trademark law and free speech interests, and the presumption may cut against a discernable judicial trend to extend trademark rights in a way that might chill expression on the Internet. However, before proposing such an approach as a solution to a perceived problem, it is necessary to identify ways in which courts have been approaching this problem in the domain name context to date, along with the impact of more recent trademark legislation such as the ACPA on these disputes.

II. TRADEMARKS AND FREE SPEECH IN THE DOMAIN SPACE

A. *Free Speech Under the ACPA*

Trademark holders who are concerned about unauthorized uses of domain names corresponding with their marks have a number of options available. They can obviously utilize traditional trademark law and may, in some cases, be able to use trademark dilution law.⁷⁷ Additionally, the late 1990s brought new avenues for trademark holders in the form of the ACPA and the Uniform Domain Name Dispute Resolution Policy (“UDRP”).⁷⁸ Both were directed at the practice known as cybersquatting—that is, registering domain names that match well-known trademarks with the intent of profiting from transfers of the names to the rightful owners.⁷⁹ This practice had become prevalent in the early days of the World Wide Web when many corporations with well-known marks did not recognize the full potential of registering domain names corresponding with their marks. One of the most famous cybersquatters was Dennis Toepfen, who registered over one hundred domain names corresponding with well-known marks with the intention of selling the names to the

77. See *supra* Parts I.B.1 & 2.

78. A full text of the policy is available at <http://www.icann.org/dndr/udrp/policy.htm> (last visited July 13, 2006).

79. DINWOODIE & JANIS, *supra* note 29, at 623.

rightful owners for profit.⁸⁰ Traditional cybersquatters were generally regarded as acting in bad faith in a moral, and ultimately also a legal, sense as there was arguably no useful social outcome for their activities.⁸¹

Initially, aggrieved mark holders either negotiated with cybersquatters for transfer of the relevant domain names, and/or resorted to litigation under existing trademark principles—actions for basic trademark infringement and dilution. Courts were sympathetic for the most part, finding trademark infringements and dilutions to be made out even in cases where there was no obvious consumer confusion (for infringement purposes) and no obvious commercial use.⁸² In *Panavision International v. Toeppen*,⁸³ for example, the Ninth Circuit Court of Appeals was prepared to find the in-commerce requirement satisfied for dilution purposes on the basis that the defendant cybersquatter's business was registering domain names corresponding with well-known trademarks and selling them to rightful trademark owners.⁸⁴ In *Planned Parenthood v. Bucci*,⁸⁵ the court identified two ways in which the in-commerce requirement for trademark infringement and dilution was satisfied: (a) defendant cybersquatter's actions affected the plaintiff's ability to offer its services over the Internet;⁸⁶ and (b) Internet users constitute a national, if not international, audience who must use interstate telephone lines to access the Internet, and the nature of the Internet itself satisfies the in-commerce requirement.⁸⁷ The court in *Planned Parenthood* further held that there was a likelihood of consumer confusion on the facts because the defendant was offering informational services about abortion and birth control.⁸⁸ Finally, the court held that a disclaimer on the defendant's Website

80. See Jacqueline D. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 WAKE FOREST L. REV. 1361, 1369–71 (2005).

81. See *id.* at 1387–92 (describing the development of the idea that cybersquatting was an immoral commercial practice and extending traditional trademark actions to combat this practice based on notions of bad faith).

82. See, e.g., *Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998) (finding trademark dilution where the defendant had registered domain names corresponding with famous marks owned by the plaintiff and had put material unrelated to the plaintiff's marks or business on the relevant website); *Planned Parenthood Fed'n of Am. v. Bucci*, 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997) (finding trademark infringement and dilution to be made out where defendant registered domain name corresponding with plaintiff's trademark for purposes of a Website critical of plaintiff's point of view).

83. 141 F.3d 1316 (9th Cir. 1998).

84. *Panavision*, 141 F.3d 1316, 1325 (“Toeppen’s ‘business’ is to register trademarks as domain names and then sell them to the rightful trademark owners This is a commercial use.”).

85. 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997).

86. *Id.* at 1434.

87. *Id.*

88. *Id.* at 1437–38.

distinguishing itself from the plaintiff's services would not cure the confusion.⁸⁹

Planned Parenthood was not actually a classic cybersquatting case because the defendant in question wanted to utilize the plaintiff's trademark for a website that promulgated a point of view opposed to the plaintiff's.⁹⁰ In many ways, that case is more akin to the situations under consideration in this article—gripe sites and parodies. The defendant in *Planned Parenthood* was not seeking to extort money from the plaintiff for transfer of the name.⁹¹ He wanted to retain the name and use it himself to promulgate his own views.⁹² However, the case is a good example of how pre-ACPA courts handled these situations and how easy it seems to satisfy a court that trademark infringement or dilution is made out even in circumstances that do not involve what one might consider traditional infringing elements.

Because of concerns about cybersquatting, Congress enacted the ACPA, which was largely constructed around Dennis Toepfen's conduct.⁹³ It creates a civil action against a person who traffics in or uses a domain name corresponding with a trademark with a bad-faith intent to profit from the mark.⁹⁴ The Act sets out a nonexclusive list of factors that courts may consider when ascertaining whether relevant conduct is in bad faith.⁹⁵ The factors include:

- (a) the trademark or other intellectual property rights of the registrant in the domain name;⁹⁶

89. *Id.* at 1441 ("Due to the nature of Internet use, defendant's appropriation of plaintiff's mark as a domain name and home page address cannot adequately be remedied by a disclaimer. Defendant's domain name and home page address are external labels that, on their face, cause confusion among Internet users and may cause Internet users who seek plaintiff's web site to expend time and energy accessing defendant's web site [A] disclaimer on the defendant's home page would not be sufficient to dispel the confusion induced by his home page address and domain name.").

90. *See* Lipton, *supra* note 80, at 1393.

91. *Id.*

92. His conduct was perhaps more morally, and maybe legally, questionable than the situations under discussion here because he did additional things that might facilitate consumer confusion. For example, he displayed a banner that read, "Welcome to the PLANNED PARENTHOOD HOME PAGE!" prominently on his website. *Bucci*, 42 U.S.P.Q. 2d at 1432.

93. This is evident from the drafting. *See* discussion in Part II.A *infra*.

94. 15 U.S.C. § 1125(d)(1)(A) (2000) (creating civil liability for violators).

95. 15 U.S.C. § 1125(d)(1)(B)(i) (2000).

96. 15 U.S.C. § 1125(d)(1)(B)(i)(I).

- (b) the extent to which the domain name consists of the legal name of the registrant or a name that is otherwise commonly used to identify that person;⁹⁷
- (c) the registrant's prior use of the domain name in connection with a bona fide offering of goods or services;⁹⁸
- (d) the registrant's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;⁹⁹
- (e) the registrant's intent to divert customers from the mark owner's online location in a manner likely to cause consumer confusion or trademark dilution;¹⁰⁰
- (f) the registrant's offer to transfer the domain name to the mark owner or a third party for financial gain without having used or intending to use the domain name for a bona fide offering of goods or services;¹⁰¹
- (g) the registrant's provision of misleading false contact information when registering the domain name, the person's failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;¹⁰²
- (h) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others, or dilutive of famous marks of others;¹⁰³ and,
- (i) the extent to which the mark incorporated in the registrant's domain name is distinctive for the purposes of the dilution provisions of the trademark legislation.¹⁰⁴

The Act provides that a bad-faith intent may not be found in a situation where the court determines that the registrant believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.¹⁰⁵

97. 15 U.S.C. § 1125(d)(1)(B)(i)(II).

98. 15 U.S.C. § 1125(d)(1)(B)(i)(III).

99. 15 U.S.C. § 1125(d)(1)(B)(i)(IV).

100. 15 U.S.C. § 1125(d)(1)(B)(i)(V).

101. 15 U.S.C. § 1125(d)(1)(B)(i)(VI).

102. 15 U.S.C. § 1125(d)(1)(B)(i)(VII).

103. 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

104. 15 U.S.C. § 1125(d)(1)(B)(i)(IX).

105. 15 U.S.C. § 1125(d)(1)(B)(ii).

Although this legislation provides some clear rules against traditional Toeppen-style cybersquatting,¹⁰⁶ it raises concerns as well. The most obvious is whether it was necessary at all given that courts apparently were not having too much trouble finding trademark infringement and dilution in such situations prior to the enactment of the ACPA.¹⁰⁷ The second concern that is only emerging in more recent cases is that the ACPA is a tool that is, in fact, extremely narrowly tailored to Toeppen-style cases, and its application in other kinds of domain name disputes, including complaints about gripe sites and parody sites, can be problematic.

The notion of a bad-faith intent to profit, which is central to an ACPA claim, has caused some confusion in cases involving gripe sites and parody sites.¹⁰⁸ Further, the bad faith factors have not been all that useful in cases that do not fit the Toeppen paradigm. For example, as with the opening hypothetical to this Article, a person may register multiple iterations of a domain name containing a business's trademark for the purposes of criticizing or lampooning the business.¹⁰⁹ Is this the kind of multiple registration that the ACPA contemplates as one of the bad-faith factors?¹¹⁰ It would seem that the ACPA's notion of multiple registrations should relate to registering multiple domain names corresponding to

106. *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005) (stating that the paradigmatic harm that the ACPA was intended to combat is the practice of cybersquatters registering several hundred domain names in an effort to sell them to legitimate owners of the marks); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 810 (6th Cir. 2004) (same); *TMI, Inc. v. Maxwell*, 368 F.3d 433, 439 (5th Cir. 2004) (same); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1123 (D. Minn. 2000) ("Congress passed the [ACPA] to protect 'consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks—a practice commonly referred to as 'cybersquatting.'") (quoting *Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 495 (2d Cir. 2000)).

107. *See Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998) (finding trademark dilution where the defendant had registered domain names corresponding with famous marks owned by the plaintiff and had put material unrelated to the plaintiff's marks or business on the relevant website); *Planned Parenthood Fed'n of Am. v. Bucci*, 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997) (finding trademark infringement and dilution where defendant registered domain name corresponding with plaintiff's trademark for purposes of a Website critical of plaintiff's point of view).

108. *See* discussion in Part II.A, *infra*.

109. *See, e.g., Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672 (9th Cir. 2005) (defendant registered two domain names corresponding to plaintiff's mark for the purposes of a gripe site); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004) (defendant registered several domain names corresponding to plaintiff's mark for the purposes of a gripe site); *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110 (D. Mass. 2002) (defendant registered sixteen domain names corresponding to the plaintiff's mark for the purposes of a gripe site).

110. 15 U.S.C. § 1125(d)(1)(B)(i)(VIII) (2000).

multiple marks, rather than *one* mark if the legislation is aimed at conduct such as that engaged in by Toeppen.

One might also query whether this factor should have been included in the legislation at all. Clearly, it was included to combat conduct such as Dennis Toeppen's in the early days of the domain name system—registering multiple domain names corresponding with trademarks with the intent to extort money from legitimate mark holders for transfer of the names to them.¹¹¹ However, this factor may be unnecessarily confusing in subsequent practice. Is it really relevant to a cybersquatting claim that the defendant has registered multiple domain names, even if they correspond to multiple well-known trademarks? What does this factor really tell the court in any given case?

A traditional Toeppen-style cybersquatter who registers names with the sole intent to profit from their transfer to the rightful owner may well register: (a) multiple domain names corresponding with multiple marks; (b) multiple domain names corresponding with one mark; or, (c) one domain name corresponding with a mark. In the case of registering multiple domain names corresponding with multiple marks, the registrant may make legitimate use of some of the domain names, while holding the others hostage for profit from the rightful owners. She may, for example, run gripe sites or parody sites (assuming these are legitimate uses) from some of the domain names, while using others to extort money from relevant mark holders. She may, in fact, run gripe sites or parody sites from *all* of the domain names and let it be known that they are available for sale if a mark holder wants them. Alternatively, she may run gripe sites or parody sites from all of the domain names and say nothing about sale, hoping that people will simply make her an offer in due course.

This latter practice is akin to people registering domain names corresponding with the personal names of famous people and setting up fan sites, which so far appears to be a legitimate use of the domain names for the most part.¹¹² Some of these registrants may be prepared to transfer

111. *See Toeppen*, 141 F.3d 1316.

112. UDRP arbitration panels have not generally ordered transfers of domain names to celebrities in such cases on the basis that these are a legitimate use of the names, provided that they do not cause confusion as to sponsorship or affiliation. *See, e.g., Bruce Springsteen v. Jeff Bugar and Bruce Springsteen Club*, WIPO Arbitration and Mediation Center Case No. D2000-1532 (Jan. 2001) (holding by a majority of WIPO arbitration panel to decline to transfer domain name of an authorized fan site, *bruce.springsteen.com*, to singer Bruce Springsteen because the site was found to be a legitimate use of the domain name and did not preclude the singer from utilizing *bruce.springsteen.net*). There is also some question as to whether all celebrities have requisite trademark rights in their personal names to seek the protection of the UDRP. *See Lipton, supra* note 80, at 1416–19. Even the personal name

the names to relevant celebrities for a fee and are using the fan sites as placemarks to satisfy the legitimate use requirements of the UDRP,¹¹³ while others may legitimately want to maintain fan sites and not transfer them to relevant celebrities or their management.¹¹⁴ There is not necessarily any easy way to discern a bad-faith registrant from a legitimate registrant in these kinds of situations.

Looking at other relevant-bad faith factors in the ACPA, what would constitute an offer to transfer the domain name to the mark owner or a third party for financial gain?¹¹⁵ Clearly the legislature had in mind schemes designed with the *central aim* of transferring names to rightful owners for profit.¹¹⁶ What about situations where a registrant is prepared to transfer the names, or might be prepared to transfer the names, to the rightful owner, but that was not the *initial aim* of the registration? Could the comment in the opening hypothetical that it would take a lot more than \$500 to buy the domain name satisfy the bad-faith factor relating to an offer to transfer the domain name to the mark owner?

Although judicial decisions have not focused so much on this issue, there has been some confusion about the application of the related bad-faith intent to profit aspect of the ACPA.¹¹⁷ As Mr. Snow has pointed out, the statute attaches liability for a bad-faith intent even after the registrant has registered the relevant domain name.¹¹⁸ In other words, there is a temporal problem with the statute in that it does not require the bad faith intent to exist at the time of domain name registration.¹¹⁹ This, in turn, means that any subsequent attempt to sell the name for profit that could in some way be described as bad faith could run afoul of the ACPA. This might include an offer to sell the name to a complainant after a dispute has arisen, thus bolstering the complainant's grounds for an ACPA claim.¹²⁰

provisions of the ACPA may not assist here if the bad-faith intent to profit from transfer of the name factor cannot be satisfied. See 15 U.S.C. § 1129(1)(A) (2000); Lipton, *supra* note 80, at 1424.

113. See Uniform Domain Name Dispute Resolution Policy, cl. 4(c), available at <http://www.icann.org/dndr/udrp/policy.htm> [hereinafter UDRP].

114. See, e.g., *Springsteen*, WIPO Arbitration and Mediation Center Case No. D2000-1532.

115. 15 U.S.C. § 1125(d)(1)(B)(i)(VI) (2000).

116. 15 U.S.C. § 1125(d)(1)(A).

117. See discussion in Part II.A, *infra*.

118. Ned Snow, *The Constitutional Failing of the Anticybersquatting Act*, 41 WILLAMETTE L. REV. 1, 41 (2005).

119. *Id.*

120. See, e.g., *People for the Ethical Treatment of Animals, Inc. v. Doughney*, 113 F. Supp. 2d 915, 920–21 (E.D. Va. 2000), *aff'd* 263 F.3d 359 (4th Cir. 2001) (finding defendant had requisite bad-faith intent to profit from transfer of a domain name corresponding with plaintiff's mark even though his comment that the plaintiff could "make him an offer" for the name occurred after the litigation commenced).

Most attempts to sell a domain name corresponding with a trademark to a rightful trademark owner could, in some way, be regarded as bad faith, at least from the mark holder's point of view. Certainly, mark holders would argue that those operating gripe sites about them who then agree to transfer the names back to them for a fee, as is a possibility in the above hypothetical, satisfy the requisite bad-faith intent to profit criterion from the ACPA. This does not mean that the argument will always be successful, but it does mean that the narrow tailoring of the ACPA to combat Toepfen-style cybersquatting has significant potential for confusion in application to nontraditional cybersquatting cases.¹²¹

Another problem with the bad-faith intent to profit requirement can arise when the defendant has set up a gripe site or parody site in such a way that the defendant, or someone connected to the defendant, receives a financial benefit from referring to or advertising products or services that may or may not be relevant to the plaintiff's activities. If the products or services are relevant to the plaintiff's activities, they may bolster the likelihood that the plaintiff will succeed on a traditional trademark infringement claim.¹²² If not, the possibility of an ACPA success still looms large.

There is also currently some judicial confusion as to whether an ACPA claim requires a showing of a commercial use of the mark by the defendant. Some courts have interpreted the ACPA's fourth bad faith factor¹²³ as imposing a burden on the defendant to satisfy the court that she has not used the relevant mark in a commercial manner. At least one court has suggested that the commercial use requirement might be satisfied by the fact that the Website in question potentially deters customers from the plaintiff's online location.¹²⁴ However, not all courts have subscribed to

121. See, e.g., *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1124 (D. Minn. 2000) (involving plaintiff who argued that an inference could be made that defendant's intent in registering a domain name corresponding with its trademark for a gripe site complaining about plaintiff's service was to use the domain name as leverage to extract money from plaintiff to help compensate defendant for his perceived losses from his dealings with plaintiff; the court noted that the argument has some merit, but the court could not conclude in preliminary proceedings that the plaintiff was likely to prevail on the argument because the record did not sufficiently reflect a bad-faith intent to profit).

122. See, e.g., *Planned Parenthood Fed'n of Am. v. Bucci*, 42 U.S.P.Q. 2d 1430, 1433 (S.D.N.Y. 1997) (suggesting that plaintiff and defendant were effectively competing in offering informational services on abortion and birth control).

123. The fourth factor relates to "the registrant's bona fide non-commercial or fair use of the mark in a site accessible under the domain name." 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (2000).

124. See *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 920 (E.D. Va. 2000), *aff'd* 263 F.3d 359 (4th Cir. 2001) (finding that the commercial use requirement appears to have been satisfied by the fact that the defendant's Website linked to the Websites of organizations selling fur and animal products and potentially deterred the plaintiff's customers from

this approach. In *Bosley Medical Institute v. Kremer*,¹²⁵ the Ninth Circuit Court of Appeals held that the ACPA does not contain a commercial use requirement. The court was concerned that an approach that requires a commercial use and all too readily finds it in cases of commentary and parody sites could lead to a situation where most otherwise constitutionally protected consumer commentary would be placed under the restrictions of the Lanham Act.¹²⁶

Even courts that have recognized a commercial use requirement in the ACPA have split on the question whether the defendant's use of the website to link to other websites where goods and services are available would satisfy the requirement. In *People for the Ethical Treatment of Animals v. Doughney*,¹²⁷ the court accepted as relevant to the commercial use requirement the fact that the defendant's Website linked to other sites where customers could purchase fur and animal products antithetical to the plaintiff's views and messages.¹²⁸ However, in similar circumstances, the Fourth Circuit Court of Appeals in *Lamparello v. Falwell*¹²⁹ held that the defendant's linking of his commentary website to an Amazon.com Webpage selling a particular book would not support an ACPA claim because the link on his webpage "does not diminish the communicative function of his website."¹³⁰ The court also suggested that the commercial use requirement was not satisfied here because the defendant "did not even stand to gain financially from sales of the book at Amazon.com."¹³¹ This sounds reasonable, but it also appears to directly contradict *Doughney*.¹³²

Further, is it different from the facts in the introductory hypothetical where someone posts a message on the Website suggesting that customers might prefer Selina's Steakhouse to Selma's Steakhouse? Selina's Steakhouse may detract custom from Selma's and arguably confuse consumers along the lines addressed in *Doughney*. Would this be a trademark infringement and/or an ACPA infringement even though the purpose of the Website is commentary and criticism? What about a

finding the plaintiff's website—these factors also satisfied the plaintiff's traditional trademark infringement claim).

125. 403 F.3d 672, 680 (9th Cir. 2005).

126. *Id.*

127. 113 F. Supp. 2d 915.

128. *Id.* at 919–20. It is not clear to what extent this factor swayed the ACPA analysis as distinct from the trademark infringement analysis; however, it was clearly in the court's mind as relevant to the plaintiff's claims.

129. 420 F.3d 309, 320 (4th Cir. 2005).

130. *Id.*

131. *Id.*

132. See *infra* for a more detailed comparison of the two cases on this point.

situation where you later decide to fund your Website design through advertising and thus gain revenues from the Website? Is this a commercial use for ACPA purposes, assuming such a requirement to exist?

The drafting and interpretation of the above-mentioned provisions of the ACPA have implications for the protection of free speech in cyberspace and may necessitate some judicial or legislative clarification on the kinds of situations that will not run afoul of the legislation where free speech is implicated. Several courts have already recognized the potential for free speech to be chilled on the Internet in an overzealous application of the ACPA. In *Northland Insurance v. Blaylock*,¹³³ for example, Judge Doty in the District Court of Minnesota noted:

While the public interest clearly demands that the Internet be used responsibly and in conformance with intellectual property laws, the right of defendant to openly express his viewpoint should likewise not be curtailed absent clearer demonstration that the claims against him have merit. . . . Public policy requires that preliminary injunctions, especially those that stand to potentially chill a person's right to free speech, no matter how disagreeable that speech may be, should only be granted in the most extraordinary of circumstances¹³⁴

However, courts have not given complete deference to the operators of gripe sites and parody sites whose Internet domain names correspond with well-known marks. Moreover, the cases in which courts have been prepared to enjoin uses of particular domain names in the parody or commentary context are often difficult to distinguish from the cases in which courts have not been prepared to grant relief.¹³⁵ The distinctions that courts make often rely heavily on justifications relating to multiple domain name registrations by a defendant and post-registration intentions to sell domain names to rightful owners, both of which are problematic bad-faith criteria as noted above.

In *Falwell*,¹³⁶ for example, the Fourth Circuit Court of Appeals was not prepared to enjoin the defendant's use of a domain name comprising a misspelling of the plaintiff's name (www.fallwell.com) for a website critical of the plaintiff's views on homosexuality.¹³⁷ The court

133. 115 F. Supp. 2d 1108 (D. Minn. 2000).

134. *Id.* at 1125.

135. See discussion in Part II.A, *supra*.

136. 420 F.3d 309 (4th Cir. 2005).

137. *Id.*

distinguished two similar cases¹³⁸ on the basis that the defendants in those cases had registered multiple domain names corresponding to marks held by various other people, and that, in one case, the defendant had made a comment in the course of the litigation that the plaintiff could “make him an offer” for transfer of the name.¹³⁹ As noted above, it is difficult to see how the multiple registrations of other domain names have any bearing on the use of the domain name corresponding to the plaintiff’s mark where, in fact, the defendant is actually utilizing the name for some speech purpose—unlike the classic Toeppen-style situation where the defendant is not using the domain name to communicate anything in particular.¹⁴⁰ Clearly the registration of multiple domain names is contemplated as only one of the bad-faith factors in the ACPA, and courts can be swayed by the other factors despite multiple registrations of domain names.¹⁴¹ However, it seems that utilizing the bad-faith factors from the ACPA can lead to results that are counterintuitive when they are applied to situations that are not on all fours with classic Toeppen-style cybersquatting.

B. Free Speech Under the UDRP

The UDRP is the basis of a private dispute resolution system that is implemented under the domain name registration contract for generic top level domains (“gTLDs”) such as .com, .org, and .net. When a person registers such a domain name, she becomes contractually bound as part of the registration agreement to submit to a private arbitration if someone complains about registration of the relevant name.¹⁴² Like the ACPA, the UDRP’s main purpose is to protect trademark interests in domain names and to prevent bad-faith registrations and uses for non-legitimate purposes.¹⁴³ It is a fast, inexpensive, online procedure that can result in a transfer of a domain name to a rightful owner.¹⁴⁴

138. *Coca-Cola Co. v. Purdy*, 382 F.3d 774 (8th Cir. 2004); *People for the Ethical Treatment of Animals, Inc. v. Doughney*, 113 F. Supp. 2d 915 (E.D. Va. 2000), *aff’d* 263 F.3d 359 (4th Cir. 2001).

139. *Fabwell*, 420 F.3d at 321.

140. In *Toeppen*, for example, Toeppen had registered two of Panavision’s marks and used one for a Website containing photographs of the town of Pana in Illinois. The other Website merely contained the word “hello.” Lipton, *supra* note 80, at 1388–89.

141. See list of bad faith factors in Part II.A, *supra*.

142. UDRP, *supra* note 113, at cl. 4.

143. See, e.g., *id.*, at cl. 2 (“By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your

To succeed in a UDRP arbitration, the complainant must prove that: (a) the domain name in question is confusingly similar to a trademark in which the complainant has rights;¹⁴⁵ (b) the registrant has no legitimate interests in the domain name;¹⁴⁶ and (c) the domain name has been registered and is being used in bad faith.¹⁴⁷ The UDRP includes a list of factors that will suggest that a domain name has been registered and is being used in bad faith for these purposes. The UDRP's bad-faith factors include circumstances indicating that: (a) the registrant intended to transfer the domain name to the complainant or to a third party for a profit;¹⁴⁸ (b) the registrant transferred the name to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;¹⁴⁹ (c) the registrant registered the name primarily for the purpose of disrupting the business of a competitor;¹⁵⁰ and (d) the registrant has used the name to attempt to attract Internet users to its own online location by creating confusion as to the sponsorship or affiliation of the registrant with the complainant's mark.¹⁵¹

As with the ACPA, the registrant has an opportunity to defend herself by establishing that she has a legitimate interest in the domain name in question. The UDRP sets out some factors that arbitrators may consider in deciding whether a use of a domain name by a registrant is legitimate for UDRP purposes. These factors include: (a) before any notification of the dispute, the registrant used, or made demonstrable preparations to use, the relevant domain name in connection with a bona fide offering of goods or services;¹⁵² (b) the registrant has been commonly known by the relevant name;¹⁵³ and (c) the registrant is making a legitimate noncommercial or fair use of the name without intent for commercial gain to mislead consumers or tarnish a trademark.¹⁵⁴

responsibility to determine whether your domain name registration infringes or violates someone else's rights.”).

144. *Id.* at clause 4(i) (“The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.”).

145. *Id.* at cl. 4(a)(i).

146. *Id.* at cl. 4(a)(ii).

147. *Id.* at cl. 4(a)(iii).

148. *Id.* at cl. 4(b)(i).

149. *Id.* at cl. 4(b)(ii).

150. *Id.* at cl. 4(b)(iii).

151. *Id.* at cl. 4(b)(iv).

152. *Id.* at cl. 4(c)(i).

153. *Id.* at cl. 4(c)(ii).

154. *Id.* at cl. 4(c)(iii).

The UDRP thus reflects the same policy aims as the ACPA, even though it achieves them slightly differently. Arguably, the First Amendment is not technically implicated by the UDRP in the same way as it might be by provisions of the Lanham Act, such as the ACPA, because it is not congressional action subject to First Amendment guarantees.¹⁵⁵ In particular, a UDRP arbitration is not decisive of the parties' respective rights in the sense that the dispute can still be litigated before a domestic court under national trademark law.¹⁵⁶ However, just because the UDRP is not technically subject to the First Amendment does not mean that free speech is not implicated by the policy. In fact, because of the global reach of the policy, and the fact that domestic litigation may be too costly for some disputants, the UDRP could have a greater impact on free expression than domestic trademark law.

A brief consideration of the key provisions of the UDRP evidences that it suffers from some of the same flaws as the ACPA in the sense that, on its face, it seems focused on the protection of trademark interests to the detriment of other important interests in domain names, such as free speech.¹⁵⁷ However, the drafting of the UDRP is subtly different from the ACPA and may, as a result, strike a better balance than the ACPA. For example, whereas the ACPA does not create a temporal link between the development of a registrant's bad faith motives and the actual *time of registration* of a domain name, the UDRP does contemplate such a link. In other words, the UDRP contemplates that a domain name should be transferred to the complainant where the domain name in question "*has been registered* and is being used in bad faith."¹⁵⁸ The UDRP's list of bad-faith factors is also generally drafted in terms of bad-faith *registration* of a name as opposed to an intent that developed at a later time—for example, after the commencement of litigation, as was the case in the *Doughney* litigation.

155. See *Estée Lauder, Inc. v. Hanna*, WIPO Arbitration and Mediation Center, Case No D2000-0869 (Sept. 25, 2000).

It may well be that Respondent is making a "fair use" of Complainant's marks in their "consumer complaint" websites and that the contents of those sites are constitutionally protected in the United States. It is, however, neither necessary nor appropriate to make such an evaluation here. The issue to be determined under paragraph 4(a)(ii) of the [UDRP] is more restricted and specific.

Id. ¶ 6B.

156. UDRP, *supra* note 113, at cl. 4(k); see also *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110 (D. Mass. 2002) (domain name registrant was unsuccessful in a UDRP arbitration and brought civil claims against the arbitrator and the trademark holder in a domestic court).

157. See Lipton, *supra* note 80, at 1374–77.

158. UDRP, *supra* note 113, at cl. 4(a)(iii) (emphasis added).

The requirement that bad faith be shown at the time of registration avoids some of the problems that arise under the ACPA in situations such as the introductory hypothetical—where there was not necessarily a bad-faith profit motive at the time of registration, but, later on (after a dispute arises), the registrant considers making a profit from sale of the name to the rightful owner. In these situations under the ACPA, the registrant is in a no-win situation because, even if she registered the domain name without an intent to profit in bad faith, any subsequent attempt to sell the name to the rightful owner, say, to avoid protracted litigation, may appear to create the requisite bad-faith motive and bolster the complainant's case. Under the UDRP, at least, the complainant has to establish that the domain name in question was actually *registered* in bad faith and *has been used* in bad faith.¹⁵⁹

This still leaves the question open as to whether the registration and use of a domain name for purposes of a gripe site or parody would satisfy the UDRP criteria. However, it is at least arguable that clause 4(c)(iii) of the UDRP¹⁶⁰ would exempt some of these situations in its suggestion that legitimate noncommercial or fair uses will not satisfy the bad faith test.¹⁶¹ This clause certainly gives room to UDRP arbitrators to protect free speech in the form of criticism, commentary, or parody, provided that there is no concurrent consumer confusion or tarnishment of a relevant mark.¹⁶²

The problem is, as with judicial interpretations of the ACPA, there is no clear test as to when a commentary site is a fair or legitimate use. A comparison of two early UDRP decisions involving consumer commentary and gripe sites demonstrates the confusion that can arise under the UDRP in this respect. These decisions also show that, regardless of how the UDRP is drafted, UDRP arbitrators are likely to be influenced, at least to some extent, by domestic trademark laws.¹⁶³ Thus, judicial

159. *Id.*

160. Clause 4(c)(iii) cites the following circumstance as potentially demonstrating a legitimate interest in a domain name: “[The registrant is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.” UDRP, *supra* note 113, at 4(c)(iii).

161. This should also be the case under the ACPA, but this has not always been apparent in practice as evidenced by the above discussion of relevant ACPA cases.

162. UDRP, *supra* note 113, at cl. 4(c)(iii).

163. *See, e.g.,* Bridgestone Firestone, Inc. v. Myers, WIPO Arbitration and Mediation Center, Case No. D2000-0190 ¶ 6 (July 6, 2000) (“The discussion and decision herein will . . . be governed by the terms of the [UDRP], although reference by analogy may be made to principles of U.S. law, as two of the Complainants are U.S. corporations, Respondent is a U.S. resident, and both parties have cited U.S. law in their submissions.”).

interpretations of the ACPA may well be decisive in applying provisions of the UDRP even though the UDRP does not have as many, or as intricate, bad-faith factors as the ACPA.¹⁶⁴

In *Estée Lauder, Inc. v. Hanna*,¹⁶⁵ a UDRP arbitration panel ordered a domain name registrant who had registered deliberate misspellings of the complainant's mark as domain names (estelauder.com and estelauder.net) to transfer the names to the complainant.¹⁶⁶ The respondent's motive appeared to have been profit as he represented a firm of personal injury lawyers who represented litigants against large corporations.¹⁶⁷ The Websites in question contained comment forms for visitors to complain about Estée Lauder to the Better Business Bureau and/or to the site operator, although the site operator was not identified.¹⁶⁸ The registrant had apparently engaged in similar conduct with respect to other well-known trademarks.¹⁶⁹ The complainant alleged that the registrant was a cybersquatter and was creating confusion as to the affiliation or sponsorship of the relevant sites.¹⁷⁰ The registrant responded that its use was noncommercial and that it included clear disclaimers on its websites for the purpose of avoiding any such confusion.¹⁷¹

In deciding that the registrant was not making a legitimate use of the relevant domain names, the panelist drew a distinction between the domain names themselves and the Website contents.

[R]espondent may well, and likely does, have extensive rights of free speech to provide a platform to criticize Complainant and a right to the fair use of the Complainant's marks in so doing. The contents of Respondent's websites may also be a perfectly legitimate use of those rights. But Respondent could well have chosen to use a domain name that was not confusingly similar to

164. For example, the arbitration panel in *Estée Lauder, Inc. v. Hanna*, WIPO Arbitration and Mediation Center, Case No. D2000-0869 ¶ 6B (Sept. 25, 2000), noted that the respondent was alleged to be a cybersquatter because he had registered multiple domain names (even though this is not a UDRP bad faith factor). This may be contrasted with cases where a UDRP arbitration panel considers legitimate interest factors that are *not* expressly set out in the UDRP or in the ACPA and are likely to be of more benefit to the domain name registrant. *See, e.g.,* *Bridgestone Firestone Inc. v. Myers*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 ¶ 6 (July 6, 2000) (acknowledging that free speech may be a legitimate interest factor even though not expressly listed in the terms of the UDRP).

165. WIPO Arbitration and Mediation Center, Case No. D2000-0869 (Sept. 25, 2000).

166. *Id.*

167. *Id.*

168. *Id.* ¶ 4C.

169. *Id.*

170. *Id.* ¶ 5.

171. *Id.* ¶ 6B.

Complainants and/or in which Complainant has no rights; it intentionally chose not to do so Respondent's free expression rights do not here give it a right or legitimate interest in the domain names at issue.¹⁷²

This statement may be contrasted with the decision of a UDRP arbitration panel in *Bridgestone Firestone v. Myers*.¹⁷³ As with the *Estée Lauder* decision, the panel in *Bridgestone* accepted a right to free expression as a legitimate interest contemplated under the UDRP.¹⁷⁴ However, unlike the *Estée Lauder* decision, the arbitrator in *Bridgestone* felt that the use of a domain name corresponding with a well-known mark for the purposes of a gripe site with no obvious commercial motive would not justify a decision to transfer the name to the mark holder.¹⁷⁵ The registrant, an ex-employee of the complainant, had registered www.bridgestone-firestone.net which corresponded with the complainant's marks.¹⁷⁶ In terms of the argument that the registrant sought commercial profit because the Website in question contained an offer to transfer the domain name to the complainants, the arbitrator felt that commercial sale was not the registrant's primary purpose in registering or using the name.¹⁷⁷ Thus, there was no bad-faith registration or use.¹⁷⁸

The arbitrator was clearly mindful of the delicate balance necessary to promote free speech on the Internet while at the same time protecting legitimate trademark interests in online commerce. In recognizing the importance of preserving freedom of expression in the global Internet context, the arbitrator noted:

Although free speech is not listed as one of the [UDRP's] examples of a right or legitimate interest in a domain name, the list is not exclusive, and the Panel concludes that the exercise of free speech for criticism and commentary . . . demonstrates a right or legitimate

172. *Id.* This reasoning is somewhat similar to pre-ACPA reasoning of the Ninth Circuit in *Toeppen*, where it held that a domain name is more than just a Web address and that a mark holder's customers may be discouraged if they cannot find its Web presence by typing its name into the URL at the top of a Web browser, rather than into a search engine. *Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998). Admittedly that case involved the use of a domain name actually corresponding with the plaintiff's mark whereas the *Estée Lauder* arbitration is a case of typo-piracy where the registrant used a deliberate misspelling of the complainant's name as its domain name. However, the underlying reasoning between *Estée Lauder* and *Toeppen* seems comparable.

173. WIPO Arbitration and Mediation Center, Case No. D2000-0190 (July 6, 2000).

174. *Id.* ¶ 6.

175. *Id.*

176. *Id.*

177. *Id.*

178. *Id.*

interest in the domain name under Paragraph 4(c)(iii). The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.¹⁷⁹

In this light, the arbitrator did not feel that registrants wanting to establish gripe sites should be restricted to particular iterations of trademarks in their domain names, such as www.trademarksucks.com, to designate a site for criticism or commentary.¹⁸⁰ However, the decision is somewhat murky in that it is not clear that the arbitrator would have been favorably disposed to a gripe site operator using a .com gTLD, as opposed to .net or .org.

In the cybersquatting cases, the domain names in question generally were trademark.com domain names, which prevented the trademark holder from utilizing the customary commercial domain name for its “official” site Here, however, the domain name registrant has not usurped the <.com> domain, but has utilized only the <.net> domain, has posted disclaimers on the website homepage, and has included criticism and commentary on the site so that a reasonably prudent Internet user can tell that the site is not the trademark holder’s “official” site.¹⁸¹

Here, the arbitrator seems to be suggesting a presumption that the use of a .com gTLD corresponding to a trademark will be in bad faith while the use of any other gTLD will not necessarily support such a presumption.

Since there are now seven generic top level domains, with more in the process of being approved, as well as some 240 country top level domains, there are hundreds of domain name permutations available to Complainants. Respondent’s use of one of those permutations other than the principle <.com> domain name for purposes of critical commentary is a legitimate noncommercial and fair use.¹⁸²

179. *Id.*

180. *Id.*

181. *Id.* The arbitrator further cited the Ninth Circuit Court of Appeals case of *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 880–81 (9th Cir. 1999), which held that .net generally applies to networks and .com generally applies to commercial entities, so a factfinder might infer that trademark dilution does not occur with a .net registration. This is another good example of a UDRP arbitrator looking to domestic trademark law for guidance on principles of good-faith versus bad-faith registration and use.

182. *Bridgestone*, WIPO Arbitration and Mediation Center, Case No, D2000-0190 at ¶ 6.

This may, in fact, be a sensible suggestion and is considered in more detail in the following sections. One downside is that it does relegate those wanting to comment on a particular mark holder to a lesser domain space than the mark holder. Assuming that Internet users will find sites by guessing at domain names rather than using search engines, gripe site and parody site operators can potentially reach a larger audience if they can use .com versions of names than if they are relegated to other gTLDs.

How, then, to reconcile *Estée Lauder* and *Bridgestone*? The *Estée Lauder* panel based the distinction on the fact that the registrant in *Bridgestone* had only registered a .net version of the relevant name whereas the registrant in *Estée Lauder* had entered the .com arena.¹⁸³ However, the *Bridgestone* decision in and of itself does not in practice create an effective protection for free speech because, as noted above, UDRP arbitrations are not the end of the story if the aggrieved party at the end of the dispute wants to continue in a domestic court. In particular, the *Bridgestone* panel expressly acknowledged that the UDRP does not allow for a formal hearing of a trademark dilution claim that was also alleged against the registrant by the complainant.¹⁸⁴ Thus, the victory at arbitration may have been a minor hurdle for the registrant facing a potential trademark dilution claim. Even a threatening post-arbitration letter from the complainant referring to its potential for a successful dilution suit could have chilled the registrant's speech.

An attempt to balance free speech with commercial trademark interests in the domain space must involve a policy that encompasses the application of all relevant parts of trademark law. It would be pointless to clarify the confusions underlying the ACPA and the UDRP in the hope of promoting a better balance between trademarks and free speech while allowing the balance to be destroyed by an overzealous application of traditional trademark infringement and/or dilution laws. This must be kept in mind while considering the various options for future development described below. The following discussion is not necessarily intended to be comprehensive or decisive. Rather, its aim is to draw together the various threads of ideas that have been suggested in prior cases and

183. *Estée Lauder, Inc. v. Hanna*, WIPO Arbitration and Mediation Center, Case No. D2000-0869 ¶ 6C (Sept. 25, 2000) ("One salient difference with the case at hand is that in *Bridgestone* the Respondent had registered the "net" domain name only, and this was an important factor in the Panel conclusion that . . . Respondent was not misleadingly diverting internet users to his site. Here, Respondent had registered and linked both the "net" and "com" versions of a name confusingly similar to that of Complainant's marks in order to enhance the possibilities of diversion.").

184. *Bridgestone*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 at ¶ 6.

arbitrations involving domain names and to try and identify some potential avenues for future legal and regulatory development on this basis.

III. DOMAIN NAMES AND FREE SPEECH: STRIKING THE RIGHT BALANCE

A. “Zoning” Speech in Cyberspace

One possibility for better balancing free speech interests against trademark interests in the domain space would be a kind of “zoning” of the domain space along the lines suggested by the UDRP arbitrator in *Bridgestone*. This might involve recognizing a rule that trademark holders are entitled to the most obvious .com versions of their trademarks in the domain space,¹⁸⁵ and those wishing to comment on trademark holders should be relegated to a different gTLD, such as .net or .org. Some courts and arbitrators have already arguably begun to accept such a rule.¹⁸⁶ There might be other permutations of such an approach, such as creating special new gTLDs specifically for gripe sites and parodies, such as .sucks, .stinks, .bites, .fun, or .humor. If this were done, a rule could be instituted that trademark holders could claim all of the standard gTLDs, including .net and .org, while commentators could be relegated to the new gTLDs.

Yet another variation of this approach is that rejected by the UDRP arbitrator in *Bridgestone*: to require those wanting to establish gripe sites or parody sites to use domain names such as www.trademarksucks.com.¹⁸⁷ Unlike the first variation described above, this would require no change to the domain name registration system in that there would be no need to create any new gTLDs. There would also be no need to keep commentators out of the .com domain space provided that they included pejorative terms like sucks, stinks, or perhaps parody, fun, or humor as part of the domain name.¹⁸⁸

185. In particular, they would be entitled to trademark.com versions of their marks.

186. See *Bridgestone*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 at ¶ 6 (citing the Ninth Circuit Court of Appeals case *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868 (9th Cir. 1999), which held that .net generally applies to networks and .com generally applies to commercial entities, so a factfinder might infer that trademark dilution does not occur with a .net registration).

187. *Id.* ¶ 6 (“The Panel sees no reason to require domain name registrants to utilize circumlocutions like www.trademarksucks.com to designate a website for criticism or consumer commentary.”).

188. Indeed, such an approach would find support, at least in the parody context, from the Fourth Circuit Court of Appeals decision in *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366–67 (4th Cir. 2001). There, the court suggests that for a parody to succeed, the parody message must be conveyed simultaneously with representation of the mark in question; thus, a Website parody that appears under a direct representation of a trademark, such as peta.org, will not satisfy this

This kind of zoning approach to balancing trademark rights and speech interests in the domain space has a number of advantages. For one thing, adopting any of the above variations on this approach would create clear rules for trademark infringement. These rules could cleanly cut across all possible trademark-based actions, including infringement, dilution, and claims under the ACPA and the UDRP. Thus, if the domain name registrant had utilized an appropriate domain zone for her activities, there would be a presumption against any kind of trademark-based infringement, whereas if the registrant had utilized an unauthorized zone for criticism or commentary, there could be a presumption of infringement.

Of course, the latter assertion does not necessarily follow from the former. Creating free speech zones in cyberspace does not mean that utilizing a non-designated zone would automatically result in a trademark infringement. Presumably, a registrant with the choice between a safe speech zone and a protected trademark zone who chose the latter could still argue noninfringement on the basis that she was not causing confusion or dilution, and had not registered the domain name in bad faith for a profit motive. For example, a registrant who chose *nike.com* or *nike.net* for a gripe site, as opposed to *nike.sucks*, or perhaps *nikesucks.com*, might still defend a trademark infringement action if she could establish that she was not confusing consumers or diluting Nike's mark and had not registered the domain name in bad faith for a profit. However, in a system with protected speech zones, it might become more difficult for a defendant to establish such things. The presumption may well arise that the decision not to use a protected speech zone is *prima facie* evidence of a bad-faith intent on the part of the registrant.

Under such a system, judicial and arbitral decisions would presumably be much easier, to the extent that claims were litigated at all. If a person registered a domain name in a protected speech zone, it would not be necessary for courts and arbitrators to make such complex determinations about bad-faith profit motives or consumer confusion. The presumption would be that the use of the protected zone would negate these claims because consumers would not likely be confused by the use of a trademark in a known commentary zone. Trademarks would not be diluted by their use in such a zone, and it would presumably be a showing of good faith, rather than bad faith, on the part of the registrant to utilize such a zone. Even if a registrant utilized the Website in question for some level of

notion of parody, whereas a simultaneous communication of the two messages, such as *petaparody.org*, presumably would satisfy this test.

profit, such as referring to a preference for competitors of the targeted mark holder, this should not be sufficient to show consumer confusion or dilution in a known free speech zone.

However, the disadvantages of such a scheme might outweigh the advantages of clarity and certainty. For one thing, it seems distasteful as a matter of policy to zone speech. There is no obvious analogue to this in the physical world. We do not generally create zones in the physical world where people are and are not allowed to express opinions on particular issues, other than in cases where speech interests clash with private property interests.¹⁸⁹ In the real world, private property interests do not always trump speech interests,¹⁹⁰ and, even to the extent that they do, do we want the Internet to become too much like a private property model? Over the years, there have been many objections to making online locations too much like real property.¹⁹¹ Do we want ownership of a trademark to mean that the mark holder also owns one or more domain spaces and all content attached to them? Or would we rather conceptualize the Internet as a global communications medium where free speech plays a foundational role?¹⁹²

The other obvious problem with the system described above is that it relegates speech to lesser zones than trademark interests. Assuming that domain names will continue to have some use as search tools,¹⁹³ it is more

189. See, e.g., *PruneYard Shopping Ctr. v. Robins*, 447 U.S. 74 (1980); *Marsh v. Alabama*, 326 U.S. 501 (1946); *State v. Shack*, 277 A.2d 369 (N.J. 1971). These cases involve courts balancing rights to free speech in various contexts with private property rights in the physical world, with courts occasionally carving out exceptions to what otherwise might be thought of as almost absolute real property rights for purposes of expressing messages or accessing a particular audience for specific information.

190. *Id.*

191. For a detailed discussion on arguments for and against this point of view, see Michael A. Carrier, *Cabining Intellectual Property Through a Property Paradigm*, 54 DUKE L.J. 1 (2004); Dan Hunter, *Cyberspace as Place and the Tragedy of the Digital Anticommons*, 91 CAL. L. REV. 439, 503 (2003); Mark A. Lemley, *Place and Cyberspace*, 91 CAL. L. REV. 521 (2003); Jacqueline Lipton, *Information Property: Rights and Responsibilities*, 56 FLA. L. REV. 135 (2004); Jacqueline Lipton, *Mixed Metaphors in Cyberspace: Property in Information and Information Systems*, 35 LOY. U. CHI. L.J. 235 (2003); Alfred C. Yen, *Western Frontier or Feudal Society?: Metaphors and Perceptions of Cyberspace*, 17 BERKELEY TECH. L.J. 1207, 1209 (2002).

192. See, e.g., *Bridgestone-Firestone, Inc. v. Myers*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 ¶ 6 (July 6, 2000) (“The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.”). The United States Government recently endorsed the importance of free speech in cyberspace in the Global Online Freedom Bill introduced into the 109th Congress on February 14, 2006. This legislation does not specifically relate to domain name disputes but refers to broader government interests in free speech in an online context.

193. See Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 543–50 (describing the use of domain names as search tools and suggesting that they will be used less often as search engines become more sophisticated).

likely that a user looking for information about a business will type its trademark followed by .com into a web browser, rather than some pejorative variation on the mark. Thus, a commentator on a particular business is likely to receive a lesser audience if forced to use a speech zone indicator than if she were allowed to use a standard gTLD version of the relevant mark, perhaps including the .com version.

One might also question whether this kind of system really adds much to the current state of affairs. It is arguably the case now that people wishing to parody or criticize trademark holders can use pejorative variations of marks in domain names, at least in existing domain spaces¹⁹⁴—that is, putting to one side the possibility of creating new gTLDs such as .sucks for commentary sites. However, there has been some confusion in recent years as to whether registrants utilizing pejorative suffixes in domain names are free from trademark infringement liability. In a recent UDRP arbitration involving the Air France trademark, a UDRP arbitration panel split on this question.¹⁹⁵ The majority panelists held that the domain name *airfrancesucks.com* for a complaint and commentary website was sufficiently confusing to consumers to justify an order for the name to be transferred to Air France.¹⁹⁶ The dissenting panelist disagreed on the consumer confusion point.¹⁹⁷ Thus, a clear rule to zone speech into domain name zones utilizing particular suffixes would lessen such confusion, even though it is subject to the criticisms identified above.

B. Revising the Tests for Trademark Infringement

1. Traditional Trademark Infringement

In addition to the approaches based on zoning the domain space described above, another possible approach to achieving a better balance of speech and trademark interests in the gripe site and parody context would be to clarify some of the current tests for infringement of trademark laws in these kinds of cases. This could be achieved concurrently with the

194. *See, e.g.*, *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998). In this case, the court found that a gripe site utilizing “ballysucks” as part of its domain name did not infringe the plaintiff’s mark. However, the domain name in question was not a direct transcription of the Bally mark with ‘sucks’ attached—rather, it was *www.compupix.com/ballysucks*, a subpage of a website with a domain name that did not correspond to Bally’s mark.

195. *Société Air France v. Virtual Dates, Inc.*, WIPO Arbitration and Mediation Center, Case No. D2005-0168 (May 24, 2005).

196. *Id.* ¶¶ 6–7.

197. *Id.* at dissent.

zoning model described above, or as a stand-alone approach. As noted in the earlier parts of this discussion, there are three types of actions available under the Lanham Act that may implicate free speech in the gripe site and parody context: traditional trademark infringement, dilution, and ACPA infringement. There is also the possibility of a complaint being brought by a mark holder under the UDRP.

All of these avenues have created different problems for the balance of speech interests against trademark interests, so it is necessary to consider them separately to work out how they might be revised to better take account of speech interests. It may be that some general guidelines can be developed that cut across all these actions—such as creating a policy as to whether trademark holders should be entitled to .com versions of domain names corresponding letter for letter with their mark (trademark.com names). However, some more specific guidelines ultimately may need to be developed for the individual peculiarities of the different actions, for example, by streamlining the notion of bad faith under the ACPA.

For traditional trademark infringement, the domain name registrant must have created, or at least be creating a potential for, consumer confusion.¹⁹⁸ The problem in cyberspace is that it is often unclear, with respect to parody sites and gripe sites, how to determine whether consumer confusion is likely to exist as a result of a domain name registrant's activities. In *People for the Ethical Treatment of Animals v. Doughney*,¹⁹⁹ for example, it would seem that consumers interested in the ideas and services of PETA likely would not be confused by Doughney's peta.org Website. Yet, the District Court for the Eastern District of Virginia and the Fourth Circuit Court of Appeals were prepared to find a likelihood of consumer confusion.²⁰⁰ This judicial practice has not been uncommon in such cases where courts are relying increasingly on a notion of initial interest confusion,²⁰¹ even where consumers are not actually confused as to source by the Website in question.

198. 15 U.S.C. §§ 1114(1), 1125(a)(1) (2000).

199. 113 F. Supp. 2d 915 (E.D. Va. 2000); *aff'd* 263 F.3d 359 (4th Cir. 2001).

200. *Id.*

201. Goldman, *supra* note 193, at 559 (“[Initial interest confusion] lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, [it] has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses.”). See also *Brookfield Commc'ns v. Coast Entm't*, 174 F.3d 1036, 1054–64 (9th Cir. 1999); *Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998) (finding that consumers would not actually have been confused as to source by defendant's Website, but may have been distracted from finding the plaintiff's actual Web presence).

However, as noted above, in similar circumstances to *Doughney*, the Fourth Circuit Court of Appeals in *Falwell*²⁰² found no trademark infringement when the defendant registered a domain name taking advantage of a deliberate misspelling of the plaintiff's surname to criticize the plaintiff's views on homosexuality. The Fourth Circuit distinguished its earlier decision in various ways. With respect to the ACPA claim, it made a distinction on two grounds: (a) that the defendant in *Doughney* had suggested a willingness to sell the domain name to the plaintiff after the litigation commenced; and (b) that the defendant had registered some fifty to sixty other domain names corresponding with well-known trademarks.²⁰³ These factors were said by the court to play into the bad-faith intent to profit test for ACPA infringement.²⁰⁴ Whether or not this analysis bears close scrutiny, the Fourth Circuit's attempt to distinguish its earlier reasoning on consumer confusion for trademark infringement purposes seems even more spurious. In *Falwell*, the Fourth Circuit suggests that *Doughney* is distinguishable in the trademark infringement context in that it dealt with a constitutional *parody* defense to trademark infringement, while *Falwell* is a simple question of consumer confusion.²⁰⁵

Since parody might be regarded as a subclass of critical speech, it seems strange as a matter of policy to subject the two cases to different legal tests. Why should a consumer criticism site that is not a parody effectively be subject to a lower standard of constitutional scrutiny than a criticism site that takes the form of a parody, particularly when both are equally unlikely to confuse consumers, and both involved links to other Websites where goods or services could be purchased?²⁰⁶ It seems that, reading between the lines, maybe the answer lies in the subject matter of the relevant speech. Maybe the court felt that a somewhat clumsy parody of PETA's activities did not merit the same constitutional protection as a critical stance on the Reverend Jerry Falwell's views on homosexuality.

In any event, it may be necessary for the purposes of online trademark law to create some clearer judicial or legislative presumptions about the use of particular gTLDs containing trademarks. In some ways, it may not matter what the presumptions are, as long as they can provide greater guidance to those registering and using Internet domain names. A

202. 420 F.3d 309 (4th Cir. 2005).

203. *Id.* at 320–21.

204. *Id.* at 320.

205. *Id.* at 316–17.

206. In *Doughney*, the defendant's website contained links to organizations that sold fur and animal products, while in *Falwell*, the defendant's website contained a link to a particular book for sale on the amazon.com Website.

presumption that .com names that correspond letter by letter to a trademark (trademark.com names) are reserved to trademark holders and may not be used for gripe sites or parody sites would lessen some of the current confusion.²⁰⁷ Of course, such a presumption would raise the criticisms identified above in relation to relegating commentary to particular gTLD speech zones.²⁰⁸

By the same token, a presumption that a critic who registers any domain name corresponding in any way with a trademark, whatever the particular gTLD suffix, would not be liable for trademark infringement provided that the website included a clear disclaimer on the relevant Webpage would also lessen confusion. This would obviously run counter to some of the current judicial precedent,²⁰⁹ and it therefore may have to be achieved by way of legislation. This approach could be criticized because it potentially cuts off rightful trademark holders from an obvious domain space.²¹⁰ However, as the UDRP panel noted in *Bridgestone*, there are many permutations and combinations of relevant domain names that a rightful trademark holder can utilize.²¹¹ Additionally, a rightful trademark holder could always bargain with the registrant for transfer of the name, provided that the current law was amended to ensure that such a bargain would not create a bad-faith intent to profit from a mark under the ACPA.²¹²

207. Of course, disputes could still arise between legitimate trademark holders with similar marks over who has the better right to a corresponding domain name. However, resolving such disputes raises different issues than balancing commercial interests with free speech interests and is therefore beyond the scope of this article. The issue of competitions for domain names between multiple legitimate trademark holders is taken up in *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, Lipton, *supra* note 80, at 1405–13. See also Goldman, *supra* note 193, at 546 (suggesting domain name sharing in these kinds of circumstances).

208. It also would not, in and of itself, deal with cases of deliberate misspellings of trademarks in domain names, such as fallwell.com.

209. *Planned Parenthood Fed'n of Am. v. Bucci*, 42 U.S.P.Q. 2d 1430, 1441 (S.D.N.Y. 1997).

210. *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000), *aff'd* 263 F.3d 359, 366 (4th Cir. 2001).

211. *Bridgestone-Firestone, Inc. v. Myers*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 (July 6, 2000) (“Since there are now seven generic top level domains, with more in the process of being approved, as well as some 240 country top level domains, there are hundreds of domain name permutations available to Complainants. Respondent’s use of one of those permutations other than the principal <.com> domain name for purposes of critical commentary is a legitimate noncommercial and fair use.”). Obviously, the suggestion being made in this paper is that it is possible to create a workable presumption that even a .com name might be registered and used legitimately by a nontrademark holder. This is taking the idea one step further than the arbitrator in *Bridgestone*, but the underlying notion of a variety of options available to the trademark holder is still valid.

212. This would also better deal with deliberate misspelling cases because there would be less emphasis on the exact spelling of the domain name for the purposes of the presumption, and more emphasis on the use of disclaimers on a relevant website, which is arguably an easier question to deal with in litigation or arbitration.

Either presumption might be justified on policy grounds, and either could create greater certainty for users of the domain name system than currently exists today. In fact, a mixture of the two could be created by following the suggestion of the panel in *Bridgestone* and reserving .com names for commercial trademarks while presuming that other gTLDs are open to anyone provided that disclaimers are utilized to avoid consumer confusion. However, not all trademark holders will want to avail themselves of a .com presence, as they may feel that they are better described by a .org or a .net suffix. Some public interest groups may prefer a less commercial-looking online presence. Of course, such entities could defensively register the .com version of their name and redirect it to another website with a .org or .net suffix.

2. Trademark Dilution

As is evident from the above discussion, the trademark dilution in cyberspace question may really boil down to a consideration of whether a particular domain name/Website combination falls within the noncommercial use exception to dilution.²¹³ As with a song or movie title, it might be presumed that any domain name that corresponds with someone else's mark would appear on its face to be potentially dilutive.²¹⁴ If a domain name corresponding to a particular mark resolves to a Website that is critical of or humorously parodies the mark holder, this would seem obviously to blur or tarnish the reputation of the mark. As noted by Judge Kozinski in *Mattel*, "dilution injunctions . . . lack the built-in First Amendment compass of trademark injunctions"²¹⁵ because dilution does not require a showing of consumer confusion. Thus, it would seem relatively easy to satisfy the basic element of a dilution claim in establishing blurring or tarnishment in a gripe site or parody site context.

The real question will be whether the use might be excused as a noncommercial use even if the domain name registrant conducts some kind of commercial activity on the site. Such activity might include advertising on the Website or linking to other Websites where products or services are sold. If the *Mattel* reasoning controls here, there is a strong

213. 15 U.S.C. § 1125(c)(4)(B) (2000).

214. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904 (9th Cir. 2002) ("To be dilutive, use of the mark need not bring to mind the junior user alone. The distinctiveness of the mark is diminished if the mark no longer brings to mind the senior user alone."). Presumably, this reasoning could apply by analogy to a use of a domain name for a gripe site or parody site where the goods or services of the relevant trademark holder are themselves being parodied on the site.

215. *Id.* at 905.

argument that these kinds of situations could be excused as noncommercial under the dilution statute. In *Mattel*, Judge Kozinski noted that the congressional purpose was clearly not to prohibit or threaten noncommercial speech, including “parody, satire, editorial and other forms of expression that are not a part of a commercial transaction.”²¹⁶ Using evidence of this Congressional intent, the judge drew a distinction between speech that does no more than propose a commercial transaction—purely commercial speech—and other speech.²¹⁷ He favored full First Amendment protection for speech that does more than propose a commercial transaction.²¹⁸ This seems a fitting analogy for most gripe sites and parody sites, given that the domain names in question will generally function much like a song or movie title and that the sites are being utilized for speech purposes. This reasoning could potentially encompass all domain names, including .com names unless a presumption is to be created that would reserve .com names for trademark holders, as suggested above.

As matters currently stand, the extension of trademark dilution into the domain space leads to peculiar judicial reasoning that does not further the policy aims underlying the dilution statute. In *Doughney*,²¹⁹ for example, the trial court regarded the following factors as decisively supporting the plaintiff’s dilution claim: (a) the defendant used PETA’s trademark in its domain name;²²⁰ (b) this use caused actual economic harm to the mark by lessening its selling power;²²¹ and (c) the defendant also linked his site to commercial enterprises engaged in conduct antithetical to the plaintiff’s animal rights message.²²² It is difficult to see how these factors relate to the aims of the dilution statute, which are to protect the famous mark against “companies who trade on the renown of the mark by selling unrelated goods, such as Kodak pianos or Buick aspirin.”²²³

The fact that a defendant uses a plaintiff’s mark in its domain name is the very definition of a gripe site or parody site. Utilizing this factor to establish dilution, as in *Doughney*, would be tantamount to a presumption that gripe sites and parody sites must be relegated to lesser domains such

216. *Id.*

217. *Id.* at 906.

218. *Id.*

219. *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915 (E.D. Va. 2000), *aff’d* 263 F.3d 359 (4th Cir. 2001).

220. *Id.* at 920.

221. *Id.*

222. *Id.*

223. Lemley, *supra* note 6, at 1698.

as petasucks.org or petaparody.org. Further, the fact that the defendant promoted an anti-animal-rights message and linked to other sites selling fur and animal products is not the same as the defendant trading off the plaintiff's marks in an unrelated product market. The facts here simply do not support the purposes of a dilution claim. The Fourth Circuit Court of Appeals in *Doughney* subsequently chose not to rule on the dilution claim, having found trademark infringement and ACPA infringement made out on the facts.²²⁴

The courts or Congress, with or without the help of ICANN, should start putting the brakes on the extension of dilution actions to domain name cases. The policy rationale for dilution does not fit the gripe site or parody site context, and there are other actions available to protect trademark holders against unfair competition on the Internet. In an emerging area of both speech and commercial practice, too many regulations favoring commerce over commentary should be avoided, particularly where the policy basis for the rules is unclear and there are other options available to an aggrieved trademark holder.

3. *The ACPA and the UDRP*

The main technical difficulty with applying the ACPA and the UDRP in cases involving gripe sites and parody sites is that there is significant confusion as to what constitutes bad faith for the purposes of each of these regulatory measures outside the traditional cybersquatting context.²²⁵ This problem is exacerbated under the ACPA by the fact that the legislation is drafted in a way that disconnects the bad-faith purpose from the actual registration.²²⁶ Thus, a subsequent offer to sell the name to a rightful trademark holder can technically constitute the requisite bad-faith intent even if such a sale was not the registrant's intent at the time of registration.²²⁷ Additionally, some of the bad faith factors in the ACPA, although not mandatory in a given case, can be confusing when applied to gripe sites and parody sites. As noted above, the registration of multiple domain names is an obvious example of this.²²⁸ A traditional cybersquatter would generally register multiple names and not use them for anything in particular,²²⁹ whereas a gripe site or parody site developer may register

224. *Doughney*, 263 F.3d at 371 n.3.

225. See discussion in Part II.A, B, *supra*.

226. *Id.*

227. See discussion in Part II.A, *supra*.

228. See *supra* Part II.A.

229. One example is Dennis Toeppen's conduct in registering over one hundred domain names

multiple domain names, but will use some or all of the names for speech purposes.

The ACPA and the UDRP were never intended to curtail free expression in cyberspace. They were intended to curb the practice of bad-faith cybersquatting. Their drafting, particularly that of the ACPA, may in retrospect prove to be much broader in scope than required to achieve their aims. It may now be that some drafting revisions should be adopted to clarify that these regulations were not intended to curb legitimate gripe sites and parody sites. Failing this, courts and arbitrators may have to take a more vigilant stance to protect speech in the domain space than has been the case in the past.

In terms of drafting changes, the ACPA should reflect the fact that it is bad-faith *registration* or *acquisition* of a domain name that is proscribed under the legislation. Simply offering to sell a name to a rightful owner subsequent to the onset of a dispute should not be evidence of a bad-faith intent to profit under an ACPA claim. Additionally, it is arguable whether the list of bad faith factors in the ACPA really adds anything significant to the notion of bad-faith intent to profit from registration or use of the name. In the early days of the ACPA, these factors arguably gave useful guidance to courts and litigants in outlining the kind of conduct that traditionally went along with bad-faith cybersquatting.

However, as noted in the above discussion, today the bad faith factors potentially cause some confusion when they are applied outside the cybersquatting context. It may be worth removing some or all of the bad faith factors from the ACPA, particularly items like the registration of multiple domain names, that arguably do not add much to a claim except unnecessary complexity. It might be assumed that courts now generally have a good idea of what is and what is not traditional cybersquatting and that the existence of the list of factors describing this practice, even though they are not mandatory in any given claim, are skewing judicial interpretations of the ACPA in noncybersquatting cases. As with all trademark related claims, it would be extremely useful for the application of both the ACPA and the UDRP if a general policy could be developed for domain names to clarify whether .com names should be reserved to trademark holders. If such a presumption were created, as suggested in the *Bridgestone* arbitration,²³⁰ then the registration of a .com name relating to

corresponding with well-known marks and not utilizing them for any particular speech purpose.

230. *Bridgestone Firestone, Inc. v. Myers*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 ¶ 6 (July 6, 2000).

a particular mark by someone other than a relevant mark holder could be added as a bad faith factor.

IV. CONCLUSIONS

There are a number of difficulties currently inherent in trademark law and policy in terms of finding an appropriate balance between protecting commercial trademark interests and facilitating free speech interests in domain names. These difficulties are a result of a number of factors, including the general broadening of trademark law in the real world to encompass situations outside the traditional consumer confusion context, as well as the regulatory reaction to cybersquatting in the 1990s, resulting in overbroad regulations that have the potential to chill speech. A number of things have to happen on the domestic and international levels to create a more balanced framework between trademarks and free speech on the Internet.

One obvious possibility would be to develop laws and policies that would scale back trademark infringement actions so they only cover situations where there is true consumer confusion and not just initial interest confusion.²³¹ In this context, disclaimers placed prominently on gripe sites and parody sites should generally suffice to combat a likelihood of consumer confusion for trademark infringement purposes. Additionally, trademark dilution actions should rarely, if ever, be available for domain names utilized for gripe sites and parody sites. There should be a presumption that such uses are per se noncommercial for the purposes of dilution law.²³² Further, the ACPA and the UDRP should be limited to cases of clear bad-faith cybersquatting and should not be extended to situations involving critical commentary on gripe sites or parody sites.

It may also be appropriate to start developing some clear presumptions about the use of domain names in the gripe site and parody site context. There are enough cases and arbitral decisions on record for the major policy issues to be identified. It is time to start putting together the competing thoughts in this area to develop a clearer policy about permissible and impermissible uses of domain names in this context, particularly in the .com space and, more particularly, with respect to .com names that correspond to a trademark character for character (trademark.com names). It would be a good idea to adopt a presumption that domain names other than trademark.com names are not per se

231. See *supra* Part III.B.1.

232. See 15 U.S.C. § 1125(c)(4)(B) (2000).

reserved to a relevant trademark holder and can be utilized for gripe sites or parody sites provided there is no consumer confusion or trading off the trademark holder's goodwill. This rule could apply to trademarksucks.com names as well as to trademark.org and trademark.net names.²³³ It may be augmented by a legislative requirement that a disclaimer be employed on such sites to remove any possibility of consumer confusion as to affiliation or sponsorship of the site.

This would leave open the question of trademark.com names, as well as potentially .com names involving a deliberate misspelling of a trademark, such as fallwell.com. If there is indeed an established practice on the Internet of users expecting trademark.com names to belong to registered trademark holders, as opposed to, say, trademark.org or trademark.net names, then this might justify a presumption of trademark infringement where another person registered such a name or a deliberate misspelling of such a name. On the other hand, such a presumption does raise the concerns identified above.

When moving forward in any of the directions suggested here, recent developments in search engine technology should also be kept in mind. Some people would argue that any attempts to streamline trademark law as it applies to domain name disputes are a waste of time because of the increasing sophistication of search engine technologies and the increasing reliance by Internet users on search engines to find targeted sites. Professor Goldman has suggested that the ways in which search engines are utilized in modern practice "may portend the eventual death of domain names"²³⁴ and that "top search engine placements have eclipsed domain names as the premier Internet locations."²³⁵ However, even if the suggestions made in this Article work temporarily and then become largely unnecessary in practice, they will still serve two important functions. They will help to resolve problems facing society and the courts today.²³⁶ They will also facilitate discussions about the creation of some

233. This rule follows the line of reasoning suggested by the UDRP panel in *Bridgestone*, WIPO Arbitration and Mediation Center, Case No. D2000-0190 at ¶ 6.

234. Goldman, *supra* note 193, at 548.

235. *Id.*

236. Some recent examples include: *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672 (9th Cir. 2005) (gripe site utilizing plaintiff's trademark as domain name); *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005) (gripe site/commentary utilizing misspelling of plaintiff's trademarked name as the domain name); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004) (claim under the anticybersquatting provisions of the Lanham Act concerning an Internet gripe site utilizing a common law trademark); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004) (gripe site case utilizing plaintiff's trademark in domain name); *Stenzel v. Pifer*, No. C06-492 2006 U.S. Dist. LEXIS 32397 (W.D. Wash. May 22, 2006) (including a plaintiff seeking declaratory judgment that his registered

broader principles relating to balancing free speech with trademark rights in the Internet context more generally by bringing free speech concerns to the forefront of the debate. The creation of new and more balanced regulatory principles may help in developing other aspects of Internet regulation in the future, including the development of regulations relating to the use of trademarks within search engine technologies.²³⁷

Law and policymakers should start thinking about clarifying all of these issues. Developing mechanisms that facilitate free speech in the domain space is an important next step in the emerging framework for Internet regulation. The mechanisms suggested here would avoid chilling critical commentary about trademark holders on the Internet. They would also potentially save money in Internet commerce by creating greater certainty as to competing interests in domain names and thus avoiding protracted and often costly litigation.²³⁸ Additionally, and most importantly, they would underscore the importance of free speech on the Internet as a guiding principle for future Internet regulation.

domain name did not infringe the defendant's trademark rights); *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110 (D. Mass. 2002) (including the registration of multiple domain names corresponding to plaintiff's trademarks by a disgruntled customer of the plaintiff); *Ford Motor Co. v. 2600 Enter.*, 177 F. Supp. 2d 661 (E.D. Mich. 2001) (finding that trademark law does not prohibit unauthorized linking of a noninfringing domain name to the plaintiff's website utilizing the plaintiff's trademark in its own domain name); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108 (D. Minn. 2000) (gripe site case utilizing plaintiff's trademark in the domain name); *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915 (E.D. Va. 2000), *aff'd* 263 F.3d 359 (4th Cir. 2001) (alleged parody site utilizing plaintiff's registered trademark as the domain name).

237. For a discussion of increasing problems in applying trademark law to activities of Internet search engines, see Dogan & Lemley, *supra* note 6; Goldman, *supra* note 193.

238. Although the UDRP is intended to save money in this context by keeping domain name disputes out of court, the above discussion has demonstrated that the UDRP is aimed more at traditional cybersquatting practices than at gripe site and parody site cases. The issues raised in disputes involving gripe sites and parody sites are more complex than those raised in traditional cybersquatting disputes, so these disputes now tend to end up being litigated more than cybersquatting actions.