

# Trademarks and Domain Names

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Internet Law

Fall 2007

Class 18



# Where we are

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- Part I: Public Law
- Part II: Private Law
  - Control over Computers
  - Domain Names
  - Copyright
  - Innovation
  - Case Studies



# In today's class

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- Trademark basics
- DNS basics
- Patterns of domain-name conflicts
- When is a trademark used?
- When does a use cause confusion?



# Trademark law sources

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- Every state has its own trademark laws, which typically provide rights for trademark users without registration
- The federal Lanham Act (15 U.S.C. ch. 22) provides various goodies to those who register their trademarks with the USPTO
- In practice, *always* look both to state and federal causes of action



# Gaining trademark rights

- A trademark is any “word, name, symbol or device” used “to identify and distinguish [one’s] goods . . . from those manufactured or sold by others”
- *The* basic requirement is distinctiveness: the mark can’t just be the generic term for an entire class of goods (why not?)
- Register the mark federally and you get (mostly) exclusive nationwide rights to it



# Trademarkish causes of action

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- Infringement (§ 32 / 1114 + state)
- Dilution (§ 43 / 1125(c) + state)
  - In massive flux; the casebook's treatment of it is thin and now also out-of-date!
- False advertising (§ 43 / 1125(a) + state)
- Right of publicity (state)



# Trademark infringement

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- § 32 / 1114 makes liable “any person who shall, without the consent of the registrant —use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with such use is likely to cause confusion, or to cause mistake, or to deceive”



# Trademark infringement

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- § 32 / 1114 makes liable anyone who:
  - uses in commerce
  - a trademark
  - in connection with the sale of goods
  - without permission
  - in a way likely to cause consumer confusion



# *Sleekcraft* factors

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- Test for likelihood of confusion
  - There are analagous multifactor tests in every circuit; in the Second, they're the *Polaroid* factors, 287 F.2d 492 (1961)

- |                        |                      |
|------------------------|----------------------|
| 1.Strength of P's mark | 5.Marketing channels |
| 2.Similarity           | 6.Degree of care     |
| 3.Proximity            | 7.Defendant's intent |
| 4.Actual confusion     | 8.Expansion          |



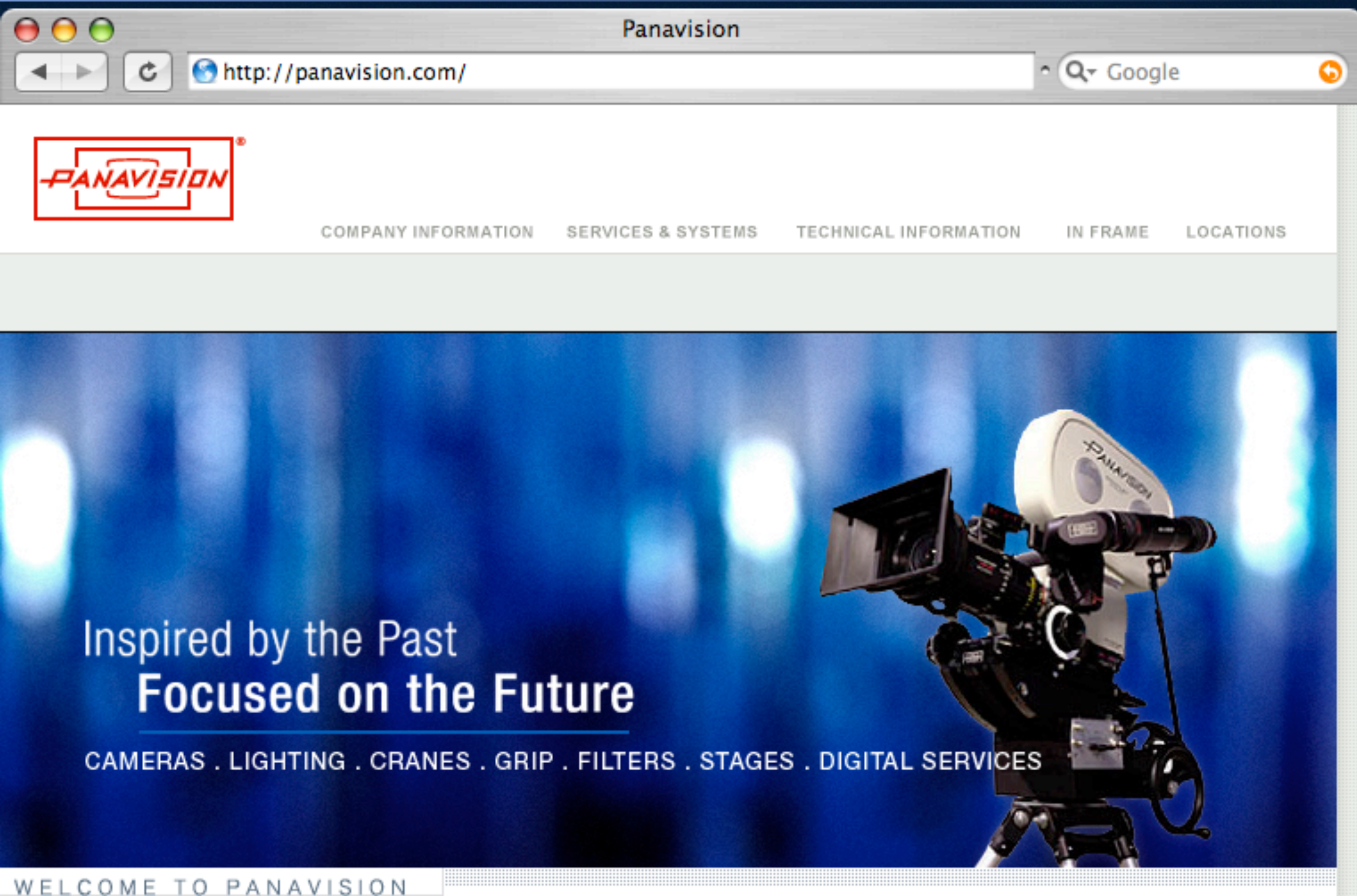
# Domain-name basics

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- You know the technical details already
  - We'll discuss the business structure of the system on Tuesday
- Until the late 1980s, Jon Postel handed out domain names to anyone who asked
- NSI, who took it over, only started charging fees in 1995!
- Trademark law came late to the party



# Panavision.com today





# Pana, Illinois





# *Panavision Int'l v. Toeppen*

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- Toeppen registers panavision.com first; he offers to sell it to Panavision for \$13,000
- Is what he's doing good or bad?
  - What if he registered it out of spite and refused to sell at any price?
  - Does it matter how people found web sites in 1995? In 2007?
  - What would Frank Easterbrook say?



# Patterns of domain disputes

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- Panavision-style domain squatting
- Ad-funded placeholder sites
- Gripe sites
- Competitors
- Independent claims to the same name
- How would you characterize MikeRoweSoft.com? Amazom.com?



# PlannedParenthood.com today



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or

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### Take Action

Read the story of [Emily X](#), a Planned Parenthood worker and activist, who is blogging her daily life and work.

Join Our Action Network

### Highlights



#### Ask Dr. Cullins

My girlfriend used to be bulimic, and hasn't had her period in about six months. Can she still become pregnant?

[Learn more](#) or [browse archive](#)



# *Planned Parenthood v. Bucci*

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- Bucci registers plannedparenthood.com first, and uses it to advertise an anti-abortion book
- Is what he's doing good or bad?
  - Is there a free speech angle?
  - What if he adds a disclaimer?
  - Should his motives matter?



# Use in commerce vs. commercial use

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“any person who shall . . . **use in commerce** . . . a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services [in a way] likely to cause confusion”



# Use in commerce

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- *Bucci* treats this one as jurisdictional
  - If a “use” of a trademark isn’t “in commerce,” does that mean the defendant is automatically off the hook?
- The *Bucci* position is contested
  - Mark Lemley thinks that “use” means “use [as a trademark]”



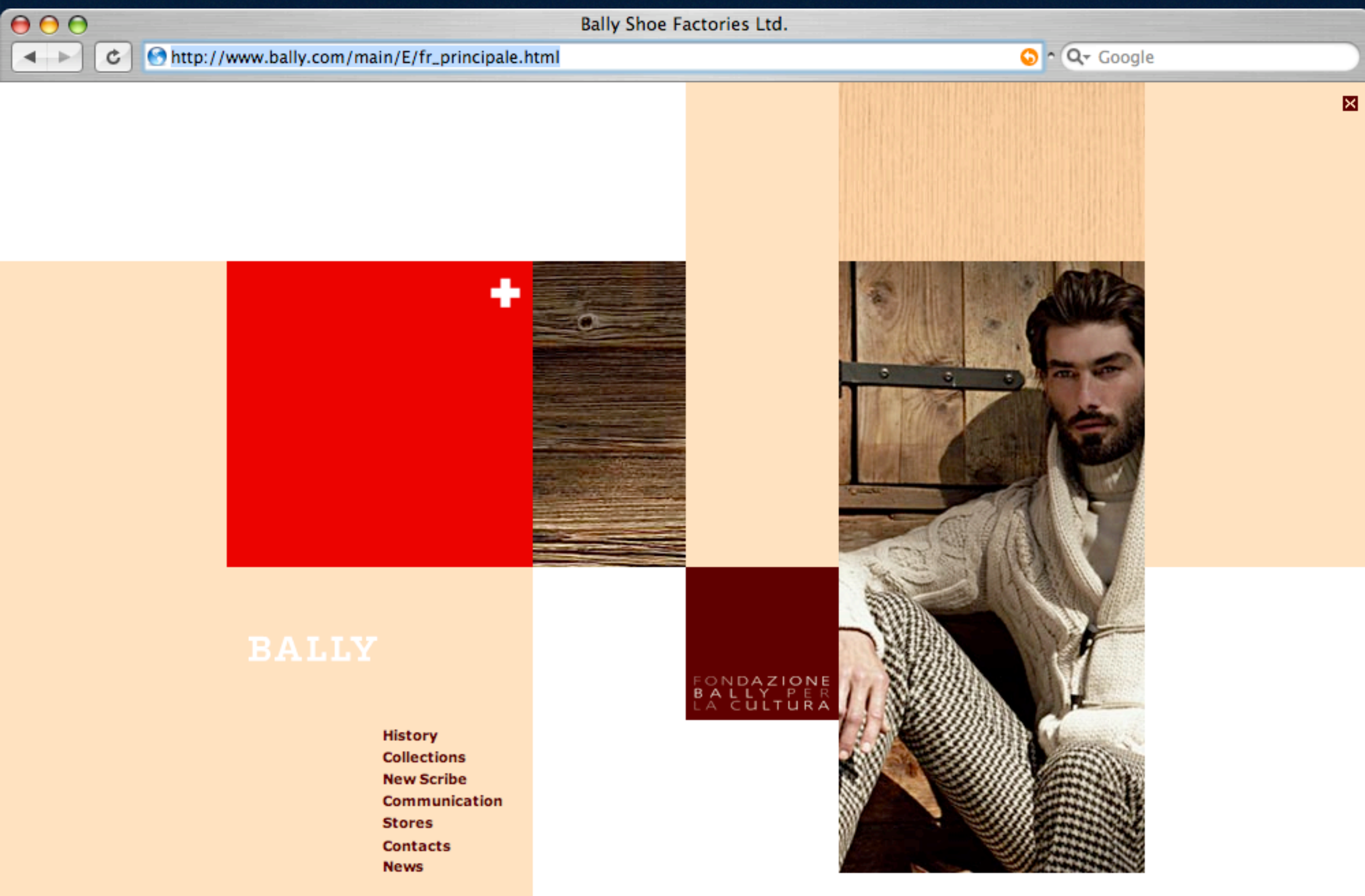
# Commercial use

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- “In connection” with sale / distribution / advertising of goods / services?
- *Bucci* gives three reasons:
  - Advertising for Roberge’s book
  - Promoting an anti-abortion agenda
  - Diverting users from reaching the actual Planned Parenthood site
- Which of these do you buy?



# bally.com today





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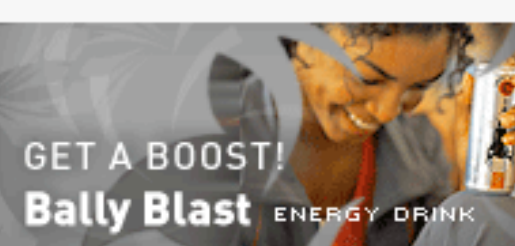
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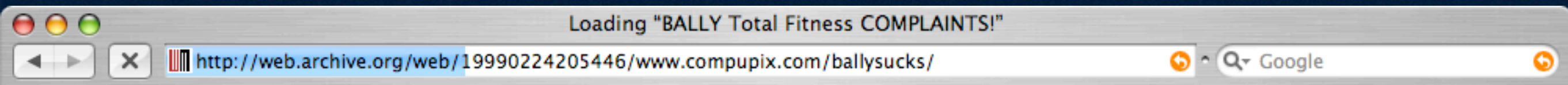
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# compupix.com/ballysucks



Bally Total Fitness SUCKS

Unauthorized

## Bally Total Fitness Complaints!



### Scam Alerts!

#### Scams to Look Out For

After joining Bally Total Fitness, I went home and read the contract. I realized that I didn't want to be a member. The next day I went back to the club to cancel my membership. I was told that only my salesman could cancel my membership... and he wasn't in. I was told to come back the next day. When I finally met with my salesman he told me that I had 3 days to cancel and those 3 days had passed.

I went to Bally Total Fitness to look around and check the place out. The saleswoman told me that they were having a special. She said they had a 30-day free trial. I took it. Within a week, I realized that I didn't want to have anything to do with Bally's. I informed the saleswoman that that I wanted to cancel. She told me that I had to mail-in my request within 3 days, and those 3 days had passed. I was stuck with a 3-year "contract," which was actually a loan, with Bally Total Fitness.



# *Bally*: use of the trademark?

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- The BALLY mark shows up in two places:
  - In the filename
  - In the page itself
  - But *not* in the domain name(!)
- Should these three possible kinds of uses be treated differently?



# *Bally: the Sleekcraft factors*

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- Do they seem a little . . . repetitive?
- Do they seem a little . . . repetitive?
- Do some of these factors seem more important than others?
- Does the list as applied to a gripe site seem somehow beside the point?
- (Which may be why the judge cuts off the analysis based on lack of relatedness)



# Coda: the secret to *Sleekcraft*

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- Barton Beebe, 95 CAL. L. REV. 1581 (2006):
  - If the marks aren't similar, D wins
  - Then if D acted in bad faith, P wins
  - Then if actual confusion, P wins
  - Then if the goods are dissimilar, D wins
  - Then if P's mark is strong, P wins
  - Then otherwise, D wins



# Next time

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More ways to skin a domain-squatting cat