

# A JUDICIAL SAFE HARBOR UNDER THE ANTI-CYBERSQUATTING CONSUMER PROTECTION ACT

By J. Ryan Gilfoil

The Anti-Cybersquatting Consumer Protection Act (ACPA)<sup>1</sup> of 1999 provides trademark owners with a means of combating cybersquatters. While the ACPA was aimed at the classic domain-name speculator,<sup>2</sup> the Act has also been asserted against a different class of would-be malefactors: “cybergrippers.” A cybergriper, often a former customer of the mark owner, registers an Internet domain name similar to the mark. The cybergriper then establishes a website at the domain criticizing the mark owner and airing his dissatisfaction with the mark owner’s business practices. In contrast to the squatter, the cybergriper’s aim is to disparage the mark owner’s business, rather than to profit from the domain name or website. Some early cases under the ACPA confronted cybergrippers with less-than-clean hands; the grippers’ statements, sites, or registration activity incriminated them.<sup>3</sup> Although the outcomes of these cases were arguably correct, the courts’ reasoning in some ways represented an overzealous application of the ACPA, which was not intended to prohibit criticism or parody.<sup>4</sup>

In 2004, courts decided several cases (“the 2004 cases”) involving pure cybergripping, with little or no evidence of an attempt to profit from the domain names.<sup>5</sup> In each instance, the court refused to find liability.

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1. 15 U.S.C. § 1125(d) (2000).

2. Legislative history behind the ACPA enumerates examples of cybersquatting: “register[ing] well-known brand names . . . in order to extract payment from the rightful owners;” “register[ing] . . . marks with the hope of selling them to the highest bidder;” “divert[ing] customers . . . to the cybersquatter’s own site, many of which are pornography sites;” and “defraud[ing] consumers.” S. REP. NO. 106-140, at 5-6 (1999) [hereinafter SENATE REPORT].

3. In two cases, the grippers’ statements indicated intent to resell and profit from the domain names, while the sites’ content or links to commercial content vitiated claims of legitimate noncommercial use. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 369 (4th Cir. 2001); *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1131-33 (D. Colo. 2000). In another case, the griper’s “typo-squatting”—registration of misspelled variations of the plaintiff’s trademark—indicated bad faith. *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 114 (D. Mass. 2002).

4. See SENATE REPORT, *supra* note 2, at 9 (“[N]oncommercial uses of a mark, such as for comment, criticism, parody, news reporting, etc., are beyond the scope of the bill’s prohibitions . . .”).

5. *TMI Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004); *Bosley Med. Inst., Inc. v. Kremer*, No.

These cases present an opportunity to examine how the ACPA functions against a class of domain name registrants who were not squarely in Congress's sights when the ACPA was passed.<sup>6</sup>

Part I of this Note provides a primer on the domain name system and the elements of the ACPA. Part II briefly describes the 2004 cases. Part III examines the application of the ACPA to two types of domain names frequently used for cybergripping. This Note contends that the 2004 cases establish a judicial safe harbor for pure criticism of a mark owner regardless of the domain name used, and that this judicial safe harbor reflects a correct interpretation of the ACPA in light of congressional intent. This Note also examines the activities a cybergriper can take or fail to take that may jeopardize the judicial safe harbor.

## I. BACKGROUND

### A. The Domain Name System

Every computer on the Internet is identified by a unique Internet Protocol or "IP" address, a binary number consisting of 32 ones and zeros.<sup>7</sup> Other computers use this IP address to route data, such as webpages, to and from the computer, just as a street address is used to route paper mail. Obviously, calling up CNN's news servers by entering 32 ones and zeros into a web browser would be quite cumbersome, so a computer on the Internet may be assigned a domain name. A domain name is a unique alphanumeric "string,"<sup>8</sup> such as <cnm.com> or <dartmouth.edu>, that corresponds to a unique IP address.<sup>9</sup> The domain name can be used instead of the IP address to locate the computer.

Since people prefer to deal with readable domain names, while computers prefer purely numeric IP addresses, computers called "domain name servers" or "DNS servers" are available to translate domain names into IP addresses, and vice versa.<sup>10</sup> When a user enters the domain name

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01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336 (S.D. Cal. Apr. 30, 2004); *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362 (D.N.J. 2004).

6. The cases run counter to early predictions that the ACPA would "favor Internet commerce over other legitimate uses of the Internet, particularly those primarily employed by individuals." Allon Lifshitz, Recent Development, *Cybersquatting*, 38 HARV. J. ON LEGIS. 529, 545 (2001).

7. Marshall Brain, *How Domain Name Servers Work*, HOWSTUFFWORKS, at <http://computer.howstuffworks.com/dns2.htm> (last visited Feb. 26, 2005).

8. A sequence of letters, numbers, and other characters.

9. *Id.*, at <http://computer.howstuffworks.com/dns3.htm>.

10. *Id.*, at <http://computer.howstuffworks.com/dns1.htm>.

<cnn.com> into his browser, he indicates that he wants the default webpage of the <cnn.com> domain. The user's computer contacts a domain name server to find out the IP address that corresponds to <cnn.com>. The user's computer can then properly address its request for news and send it to CNN's servers.

Because IP addresses are unique, domain names must be unique: there can be only one <cnn.com>.<sup>11</sup> Domain names are "registered," or activated and assigned to owners, on a first-come, first-served basis.<sup>12</sup> No one verifies whether a registrant has a legitimate claim to a domain name.<sup>13</sup>

## B. The ACPA

As the Internet became increasingly commercialized, prescient individuals saw an opportunity to profit by registering domain names similar to famous trademarks. Because domain names are unique, a squatter who registers <cocacola.com> prevents the manufacturer of Coke from using that domain name.<sup>14</sup> Further, since registration is a first-come, first-served, largely unregulated process, all that a squatter has to do to register <cocacola.com> is be the first applicant. Prior to the passage of the ACPA, trademark owners typically sued squatters under the Federal Trademark Dilution Act (FTDA).<sup>15</sup> But dilution lawsuits were "expensive and uncertain,"<sup>16</sup> in part because of the stringent requirement that the underlying mark be famous.<sup>17</sup> Congress therefore enacted the ACPA to specifically prohibit cybersquatting.

The ACPA imposes liability on a person who, with "a bad faith intent to profit from" a distinctive or famous mark, "registers, traffics in, or uses a domain name" that is "identical or confusingly similar to" the mark.<sup>18</sup> In addition, in the case of a famous mark, the "identical or confusingly simi-

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11. *Id.*, at <http://computer.howstuffworks.com/dns3.htm>. However, multiple unique domain names may be assigned to one IP address.

12. *Domain Name Disputes*, BITLAW, at <http://www.bitlaw.com/internet/domain.html> (last visited Feb. 26, 2005).

13. *Id.*

14. Use of a trademark on a physical product is, in contrast, non-rivalrous and thus less powerful. Accordingly, the legal standard for liability for such use is more demanding and is predicated on the mark owner's actual use of the mark in commerce. See David J. Franklyn, *Owning Words in Cyberspace: The Accidental Trademark Regime*, 2001 WIS. L. REV. 1251, 1253.

15. 15 U.S.C. § 1125(c) (2000); see, e.g., *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998); see also Lifshitz, *supra* note 6, at 529-36 (describing limits of pre-ACPA legal weapons against cybersquatters).

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

17. 15 U.S.C. § 1125(c)(1).

18. *Id.* § 1125(d)(1)(A).

lar” requirement may be met by a domain name that is instead “dilutive of” the mark.<sup>19</sup> To succeed in an ACPA claim, the plaintiff must prove three elements: 1) plaintiff’s mark is distinctive or famous; 2) defendant’s domain name is identical or confusingly similar to plaintiff’s mark; and 3) defendant registered, trafficked in, or used the domain name with a bad-faith intent to profit.<sup>20</sup> The ACPA provides nine factors for the court to evaluate when determining whether the defendant had a bad-faith intent to profit.<sup>21</sup> The first three factors take into account a defendant’s prior rights

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19. *Id.* § 1125(d)(1)(A)(ii)(II).

20. *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 367 (D.N.J. 2004).

21. The factors are:

- (I) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
- (III) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
- (IV) the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
- (V) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;
- (VI) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct;
- (VII) the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct;
- (VIII) the person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and
- (IX) the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of [15 U.S.C. § 1125].

15 U.S.C. § 1125(d)(1)(B)(i). In contrast with trademark dilution, there is no commercial use requirement, but commercial use is relevant to the bad-faith inquiry under the fourth

to the domain name due to trademark ownership, the defendant's own legal name, or the defendant's sale of goods. The next two factors examine the nature of the defendant's site, accounting for noncommercial or fair use of the domain name, and for the defendant's intent to lure the mark owner's customers to his site by confusing them. The next three factors examine the defendant's behavior, taking into account offers to sell the domain, defendant's use of a false name when registering the domain, or defendant's history of domain-name squatting. And the last factor accounts for the strength of the trademark.

The first two elements of ACPA liability—whether the mark is distinctive and whether the domain name is similar to the mark—are fairly straightforward. Accordingly, the court's inquiry usually centers around determining whether a defendant showed a bad-faith intent to profit. Although the nine bad-faith factors enumerated by the ACPA guide this inquiry, the ACPA factors are not exclusive, and the court is free to assign to the factors any relative weight it chooses.<sup>22</sup> In other words, the court has wide latitude to discern bad-faith intent from the facts of each case. Furthermore, the ACPA provides a legislative safe harbor for those defendants who "believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful."<sup>23</sup> Thus, either an absence of bad-faith intent to profit, or a genuine and reasonable belief that one's use of a domain name is legitimate, will preclude liability under the ACPA. However, in practice, defendants rarely invoke the legislative safe harbor, perhaps because of the more nebulous nature of the fair use defense.<sup>24</sup>

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and fifth factors. See P. Wayne Hale, Note, *The Anticybersquatting Consumer Protection Act & Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 16 BERKELEY TECH. L.J. 205, 218-25 (2001) (contrasting the ACPA and the FTDA); Jian Xiao, Note, *The First Wave of Cases Under the ACPA*, 17 BERKELEY TECH. L.J. 159, 162 (2002) (same).

22. See 15 U.S.C. § 1125(d)(1)(B)(i) ("In determining whether a person has a bad faith intent . . . a court may consider factors such as, but not limited to" the nine enumerated factors.); see also Adam Silberlight, *Domain Name Disputes Under the ACPA in the New Millennium: When Is Bad Faith Intent to Profit Really Bad Faith and Has Anything Changed with the ACPA's Inception?*, 13 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 269, 283-84 (2002) (discussing a court going beyond the enumerated factors to impose ACPA liability).

23. 15 U.S.C. § 1125(d)(1)(B)(ii); see also Xiao, *supra* note 21, at 174-75 (discussing recent cases in which the defendant invoked the legislative safe harbor).

24. *But see* Rohr-Gurnee Motors, Inc. v. Patterson, No. 03 C 2493, 2004 U.S. Dist. LEXIS 2068, at \*14 (N.D. Ill. Feb. 9, 2004) (accepting the § 1125(d)(1)(B)(ii) fair use defense in approving defendant's motion for attorney's fees). Further, even partial bad faith may preclude the protection of the explicit safe harbor provision. *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 270 (4th Cir. 2001) ("We do not think

Legislative history indicates that the primary motivations for the ACPA were promoting e-commerce, combating fraud and public confusion, and protecting the consumer goodwill to which mark owners are entitled.<sup>25</sup> Congress's examples of prohibited behavior included the classic domain-name speculator and the squatter who diverts traffic to a commercial or pornographic site.<sup>26</sup> In contrast, the Senate Report to the ACPA states that noncommercial uses such as "comment, criticism, [or] parody" are "beyond the scope" of the ACPA.<sup>27</sup>

## II. THE CYBERGRIPER CASES

### A. Liability for Grippers

Several earlier cases decided under the ACPA found liability for cybergrippers.<sup>28</sup> In 2000, a district court in Colorado decided *Morrison & Foerster LLP v. Wick*.<sup>29</sup> In that case, the defendant registered variations on the name of law firm Morrison & Foerster (MoFo) in order to "get even" with corporate America.<sup>30</sup> He used the domains to post disparaging comments aimed at MoFo and links to sites having racist or otherwise unsettling content.<sup>31</sup> The court held that the defendant's expressed desire to "mess with" corporate America and "see these people squirming" strongly suggested bad faith.<sup>32</sup>

The *Morrison & Foerster* court also found support for liability under the fifth factor of the ACPA because the defendant, by using a domain similar to MoFo's trademark, intended to divert MoFo's customers by creating a likelihood of confusion.<sup>33</sup> In addition, under the sixth factor, the court found an offer to sell based on information the defendant provided

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Congress intended the safe harbor to protect defendants operating, at least in part, with unlawful intent."); see also Lifshitz, *supra* note 6, at 541 (noting that the defendant must prove "both a subjective and objective belief that his use of the domain name was fair or lawful").

25. SENATE REPORT, *supra* note 2, at 4-5.

26. *Id.* at 5-6.

27. *Id.* at 9. However, Congress noted that parodic or critical use of a domain name would not *alone* preclude liability. Otherwise, a bad-faith registrant might post a pretextual parody in order to inoculate himself against ACPA liability. *Id.*

28. *But see, e.g.,* Northland Ins. Cos. v. Blaylock, 115 F. Supp. 2d 1108 (D. Minn. 2000).

29. 94 F. Supp. 2d 1125 (D. Colo. 2000).

30. *Id.* at 1127, 1133.

31. *Id.* at 1128.

32. *Id.* at 1133.

33. *Id.* at 1132.

when he registered the domains.<sup>34</sup> The court rejected the defendant's claim that his sites were bona fide, noncommercial parodies under the fourth factor because the domain names themselves did not simultaneously call to mind and criticize MoFo.<sup>35</sup>

Later, in 2001, the Fourth Circuit decided *People for the Ethical Treatment of Animals v. Doughney (PETA)*.<sup>36</sup> Here, the defendant posted a parody site entitled "People Eating Tasty Animals" at <peta.org>, a domain name identical to the animal rights organization's service mark.<sup>37</sup> Importantly, the site included links to organizations promoting eating meat, wearing fur and leather, hunting, and other similar pursuits.<sup>38</sup> The court first evaluated PETA's trademark infringement claim. Under this claim, the court found the parody site's links, along with the likelihood of diverting consumers seeking PETA's official site, sufficient to render the parody site "in connection with" the sale of goods.<sup>39</sup> The court appeared to apply this finding to its ACPA analysis, reasoning that a use in connection with the sale of goods could not be a noncommercial use under the fourth factor.<sup>40</sup> Further, under the sixth factor, the court found that the defendant's statements on his site and in the press suggesting a settlement indicated intent to profit.<sup>41</sup>

Finally, in 2002, a district court in Massachusetts decided *Toronto-Dominion Bank v. Karpachev*.<sup>42</sup> In that case, the griper posted criticism of the plaintiff banking and investment firm at sixteen domain names, each a misspelled variation on the plaintiff's name.<sup>43</sup> The site likened the plaintiff to Nazis and Soviet communists and described the real-life murder of some of the firm's employees by a disgruntled customer.<sup>44</sup> The court focused on the defendant's intent to divert consumers and his registration of multiple domain names under the fifth and eighth factors.<sup>45</sup> The court con-

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34. *Id.*

35. *Id.* at 1131, 1134-35.

36. 263 F.3d 359 (4th Cir. 2001).

37. *Id.* at 362-63.

38. *Id.* at 363.

39. *Id.* at 364-66.

40. *See id.* at 369.

41. *Id.* at 368. The defendant made the statements prior to the filing of the lawsuit. *Id.* at 363.

42. 188 F. Supp. 2d 110 (D. Mass. 2002).

43. *Id.* at 111.

44. *Id.* at 112 & n.3.

45. *Id.* at 114.

clusorily rejected the defendant's claim of fair use under the fourth factor.<sup>46</sup>

## B. The 2004 Cases Reject Liability for Grippers

The 2004 cases<sup>47</sup> share a common fact pattern. A customer had a bad experience with a seller of goods or services. The customer registered a domain name consisting of a variant of the seller's trademark or service mark and posted a website at that domain name. On the website, the customer described the seller's alleged malfeasance and urged readers to take their business elsewhere. In response, the seller sued under the ACPA. The courts in all four cases found no liability under the ACPA due to a lack of bad-faith intent to profit.

In *Mayflower Transit, LLC v. Prince*, for example, the fourth bad-faith factor was determinative: the court held that cybergripping was a "bona fide noncommercial or fair use of the mark," consistent with the previously-recognized right to use a trademark for parody or other commentary.<sup>48</sup> According to the court, the ACPA was not intended to prevent cybergripping.<sup>49</sup> The court also held that the absence of an attempt to sell the domain name to the mark owner indicated a lack of bad faith.<sup>50</sup> The Fifth Circuit employed a similar analysis in *TMI Inc. v. Maxwell*.<sup>51</sup>

In *Lucas Nursery & Landscaping, Inc. v. Grosse*, the Sixth Circuit reached a similar conclusion, focusing primarily on the absence of an offer to sell the domain name. According to the court, without "intent to trade on the goodwill of another's mark," there was no bad faith.<sup>52</sup> Finally, in *Bosley Medical Institute, Inc. v. Kremer*,<sup>53</sup> while the southern California district court apparently applied the ACPA incorrectly,<sup>54</sup> it found that the

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46. *See id.*

47. *TMI Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004); *Bosley Med. Inst., Inc. v. Kremer*, No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336 (S.D. Cal. Apr. 30, 2004); *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362 (D.N.J. 2004).

48. *Mayflower*, 314 F. Supp. 2d at 369-70.

49. *Id.* at 369.

50. Bad faith is relevant under the sixth factor. *See id.* at 371.

51. 368 F.3d at 436-39.

52. 359 F.3d at 810 (quoting SENATE REPORT, *supra* note 2, at 9).

53. No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336 (S.D. Cal. Apr. 30, 2004).

54. The court stated that the plaintiff's cybersquatting claims were based upon 15 U.S.C. § 1125(d), the ACPA. *Id.* at \*18. But the court analyzed the claims as though they were infringement claims, requiring commercial use and likelihood of confusion. *Id.* at \*20-\*30. These are not requirements of the ACPA, though commercial use and likelihood

noncommercial nature of the sites and the absence of an attempt to sell justified the defendant's exoneration.<sup>55</sup>

### III. DISCUSSION

This Part examines the application of the ACPA to two situations that arose in the 2004 cases: griping at domains having a name similar to the mark, or "same-name griping;" and griping at "-sucks" domains, or "pejorative-suffix griping." The Part describes whether, and how, the ACPA applies to each type of gripe site and concludes that the 2004 cases establish a judicial safe harbor for pure-criticism sites. This Part contends that a griper may jeopardize the judicial safe harbor by taking such steps as: linking to sites offering goods for sale or even simply promoting economic activity; making statements that can be construed as offers to sell the domain names, including offers to settle; posting offensive content or even simply overheated criticism; registering numerous gripe sites; or providing incomplete or misleading registration information.

#### A. Same-Name Griping

Same-name griping consists of setting up a complaint site at a domain name identical or confusingly similar to the mark, such as <mayflower-vanline.com> where the service mark is MAYFLOWER and the mark owner is a moving company.<sup>56</sup>

##### 1. Applying the ACPA

By definition, a same-name case meets the "identical or confusingly similar" prong of the ACPA. Assuming the plaintiff meets the fame or distinctiveness prong, liability hinges on the third prong: the bad-faith intent to profit inquiry, guided by the nine enumerated factors. The 2004 cases illustrate the discretionary nature of the court's inquiry into bad-faith intent to profit by either ignoring most of the enumerated factors and focusing instead on the fourth and sixth factors, or analyzing all the factors but weighing the fourth and sixth very heavily.<sup>57</sup> Either way, the 2004 cases

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of confusion may be relevant under, for instance, the fifth bad-faith factor. *See* discussion of the ACPA *supra* Part I.B.

55. *See Bosley*, 2004 U.S. Dist. LEXIS 8336, at \*24-\*27.

56. *See Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 365-66 (D.N.J. 2004).

57. Perhaps because of the wide latitude to inquire into bad faith granted by the ACPA, courts rarely invoke the Act's explicit "safe harbor" provision, 15 U.S.C. § 1125(d)(1)(B)(ii). In the 2004 cases, only *Mayflower* applies the statutory safe harbor, and even then only cursorily. *See id.* at 369.

illustrate that the fourth and sixth factors are the most important in the context of a mark owner seeking to prevent online criticism. These factors favor, respectively, a defendant who makes a “bona fide noncommercial” use of the mark in his website and a defendant who does not offer to sell the domain name.<sup>58</sup>

For instance, *Mayflower* addresses the other factors but indicates that the fourth factor ultimately guides its decision. Under the fourth factor, the defendant made a bona fide noncommercial use of the MAYFLOWER mark that precluded bad faith.<sup>59</sup> That bona fide noncommercial use was criticism. *Lucas* emphasized the sixth factor instead. Without an offer to sell the domain name, there is no intent to profit.<sup>60</sup> *TMI* focused on both the fourth and sixth factors, emphasizing the use of the site as a vessel for criticism and the absence of an attempt to sell.<sup>61</sup> And while *Bosley*, as mentioned above, misapplied the ACPA, its conclusion amounts to an exoneration of the defendant on the fourth factor. According to the *Bosley* court, criticism is a legitimate noncommercial purpose.<sup>62</sup>

The 2004 holdings on the fourth factor represent a departure from some early cases under the ACPA and other areas of trademark law. Several earlier decisions held that simply by registering a domain name similar to a trademark, one prevents consumers from reaching the mark owner’s site and thereby engages in a commercial use;<sup>63</sup> the commercial nature of the use precludes the protection of the fourth factor. The 2004 case law is more in accordance with congressional intent behind the ACPA. If Congress provided for the possibility of noncommercial use even when the domain name is “identical or confusingly similar to” the

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58. 15 U.S.C. § 1125(d)(1)(B)(i)(IV), (VI) (2000). As is suggested by the fact that the ACPA contemplates the possibility of noncommercial use, the “mere use of another’s name on the Internet . . . is not per se commercial use.” See *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1166 (C.D. Cal. 1998); see also 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:97.2 (2004).

59. *Mayflower*, 314 F. Supp. 2d at 369.

60. See *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 810 (6th Cir. 2004).

61. See *TMI Inc. v. Maxwell*, 368 F.3d 433, 439-40 (5th Cir. 2004).

62. See *Bosley Med. Inst., Inc. v. Kremer*, No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336, at \*27 (S.D. Cal. Apr. 30, 2004).

63. See, e.g., *E.&J. Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 275 (5th Cir. 2002). For a similar holding under non-ACPA causes of action, see *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 365-66 (4th Cir. 2001), and *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 U.S. Dist. LEXIS 3338, at \*15 (S.D.N.Y. Mar. 24, 1997).

mark, then clearly a per se rule that considers such a domain name to be a commercial use is inappropriate.<sup>64</sup>

Instead, the 2004 cases establish that criticism constitutes a bona fide *noncommercial* use within the meaning of the fourth factor of the ACPA. Further, the courts' emphasis on the fourth and sixth factors of the ACPA appears to create a judicial safe harbor for a same-name griper who does not attempt to sell the domain name and does not include commercial content in his site.<sup>65</sup> The gripers did not offer products or services, display banner advertising, link to other sites offering products for sale,<sup>66</sup> or make any statements that could be reasonably construed as attempts to sell the domain name to the mark owners. Further, their criticism was a response to a dispute, not a cover-up for classic domain-name speculating. Since courts are free to weigh these factors more heavily than the other factors, the absence of these activities, in accordance with congressional intent, justifies a holding that the griper lacks the bad-faith intent to profit required by the ACPA.

## 2. *Stepping Outside the Judicial Safe Harbor*

The judicial safe harbor does not automatically protect a gripe site simply because it criticizes the mark owner. A griper can take, or fail to take, actions that may jeopardize the judicial safe harbor. The first three ACPA factors almost always weigh against the same-name griper.<sup>67</sup> The

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64. See 15 U.S.C. § 1125(d)(1)(A)(ii)(I), (d)(1)(B)(i)(IV) (2000).

65. Other cases holding similarly under the ACPA include *Northland Insurance Companies v. Blaylock*, 115 F. Supp. 2d 1108 (D. Minn. 2000). *But see, e.g., Toronto Dominion Bank v. Karpachev*, 188 F. Supp. 2d 100, 114 (D. Mass. 2002) (holding a gripe site to not be a "fair use").

66. With the possible exception of *Bosley*, where the gripe site may have contained links to industry websites. *Bosley*, 2004 U.S. Dist. LEXIS 8336, at \*24.

67. The first ACPA factor inquires into the defendant's own trademark rights in the domain name. 15 U.S.C. § 1125(d)(1)(B)(i)(I). For instance, many companies could claim trademark rights in the domain name <delta.com>: an airline, a faucet manufacturer, and a dental insurance provider, among others. The typical same-name griper will himself have no trademark rights in the domain name. The second factor looks for something similar, a situation where the defendant's legal name *is* the domain name. *Id.* § 1125(d)(1)(B)(i)(II). Unless the griper happens to be named John Deere or Betty Crocker, he or she will be out of luck. (In early 2004, 17-year-old Mike Rowe agreed to relocate his website at <mikerowesoft.com> after reaching an agreement with Microsoft. The terms of the settlement included a free Xbox game console. *Microsoft to Take Over MikeRoweSoft.com*, CNN.COM, Jan. 26, 2004, at <http://www.cnn.com/2004/TECH/internet/01/26/mikerowesoft.settle.ap>). The third factor asks whether the defendant has previously made a "bona fide" use of the domain name to offer goods or services. 15 U.S.C. § 1125(d)(1)(B)(i)(III). By "bona fide," the statute likely is referring to a situation

ninth factor could go either way: it weighs against the griper if the mark is particularly well-known or distinctive and in his favor if not.<sup>68</sup> However, as noted above, the 2004 cases' focus on the fourth and sixth factors means that these factors are not likely to be determinative. The courts are likely to focus instead on behavior relevant under the other bad-faith factors.

a) Commercial Use

Selling or intending to sell competing goods clearly takes the registrant outside the safe harbor.<sup>69</sup> But a griper might take smaller steps toward commercial activity. For instance, a griper might place banner advertisements or links to commercial sites on his site.<sup>70</sup> The ads and links would be most relevant to the fourth factor, which requires noncommercial use. In the 2004 cases, the courts considered the absence of commercial ads or links to weigh in the defendants' favor.<sup>71</sup> Further, courts have held the presence of such ads or links sufficient to weigh the fourth factor against the defendant. In *PETA*, links to organizations promoting meat, fur, and leather, along with the likelihood of diverting consumers, were sufficient to vitiate a claim of noncommercial use.<sup>72</sup> In contrast, the court in *Bosley* was unwilling to find commercial use from tangential commercial content. The *Bosley* website criticized a hair clinic and contained links to other hair industry websites.<sup>73</sup> These sites in turn featured links to commercial sites.<sup>74</sup> Thus, banner ads or links to clearly commercial sites probably pre-

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similar to the first factor: a defendant who has been using the mark for unrelated goods. A same-name griper will lose on this factor as well.

68. See *Gallo*, 286 F.3d at 276; *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 499 (2d Cir. 2000).

69. See *Sporty's Farm*, 202 F.3d at 499. See generally *Hale*, *supra* note 21 (analyzing the case).

70. See *Lifshitz*, *supra* note 6, at 532 (describing a dispute in which advertising revenue supported a conclusion under a trademark infringement claim that the cybersquatter's use was "in commerce").

71. See *TMI Inc. v. Maxwell*, 368 F.3d 433, 438 (5th Cir. 2004); *Bosley*, 2004 U.S. Dist. LEXIS 8336, at \*24; *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 371-72 (D.N.J. 2004).

72. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 364-65, 369 (4th Cir. 2001). In another infringement case, not involving the ACPA, the defendant's links to his own web design company, and to his girlfriend's blouse company, constituted use of the plaintiff's mark in connection with the advertising of goods. *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003). A use in connection with the advertising of goods would likely not be a noncommercial use under the ACPA.

73. *Bosley*, 2004 U.S. Dist. LEXIS 8336, at \*24.

74. *Id.*

clude the fourth-factor safe harbor, while links to general industry sites are more likely safe.

A cybergriper might offer and charge for services on his site such as a dating service for jilted consumers. Such behavior would likely weigh against the safe harbor. In *Bosley*, for instance, it was relevant that the defendant was “not engaged in his own business enterprise.”<sup>75</sup> In *TMI*, the Fifth Circuit noted the absence of evidence that the defendant had any intent to charge for the use of his site.<sup>76</sup> Additionally, a website that solicits contributions—or even that is simply part of a broad political movement that solicits contributions—has been held to be “commercial” under other areas of the Lanham Act.<sup>77</sup>

#### b) Offers to Sell

As described above, the presence or absence of an offer to sell the domain name can weigh heavily into the bad-faith inquiry under the sixth factor. *Mayflower* suggests that a court will take into account the griper’s frustration with his unpleasant commercial experience and interpret his statements in a more charitable light.<sup>78</sup> In that case, the court read the griper’s demand that the moving company “‘do something’ about the dispute” as a demand for change in the company’s business practices rather than a demand for a payout.<sup>79</sup> In *Bosley*, the griper sent a letter threatening to harm the company’s business by disseminating criticism over the Internet, but offering to “discuss” the matter first.<sup>80</sup> According to the court, the letter did not constitute an offer to sell the domain name, though the possibility of a quid pro quo was perhaps implicit.<sup>81</sup> Similarly, in *Interstellar Starship Services, Ltd. v. Epix Inc.*, an offer to sell made by the defendant’s attorney during settlement negotiations, without the defendant present, did not constitute bad faith.<sup>82</sup>

On the other hand, the court found an implicit offer to sell in *Morrison & Foerster* based on the information the defendant provided when he registered the disputed domain names. In that case, the griper registered the domain under the name “NameIsForSale.com.”<sup>83</sup> The website at <nameis-

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75. *Id.*

76. *TMI*, 368 F.3d at 438.

77. *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 U.S. Dist. LEXIS 3338, at \*19 (S.D.N.Y. Mar. 24, 1997).

78. *See Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 369 (D.N.J. 2004).

79. *Id.*

80. *Bosley*, 2004 U.S. Dist. LEXIS 8336, at \*26.

81. *See id.*

82. 304 F.3d 936, 947 (9th Cir. 2002).

83. *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1127 (D. Colo. 2000).

forsale.com> encouraged visitors to “[n]ame the property” (that is, the domain name) they wanted to sell or buy.<sup>84</sup> In *PETA*, the defendant’s explicit statements swayed the sixth factor against him. The griper had made comments on his website and in the press suggesting that PETA “settle” with him or “make him an offer.”<sup>85</sup> For a defendant engaged in the business of selling domain names, a simple offer to “assist” the mark owner may constitute an offer to sell.<sup>86</sup> Further, the mere fact that the defendant has offered to sell *other* domain names may weigh against him.<sup>87</sup>

However, a griper likely may sell the domain without fear if the mark owner initiates the transaction. According to *Taubman Co. v. Webfeats*, decided under another section of the Lanham Act, acceptance of an offer “under threat of litigation” does not indicate the griper’s initial intent was to sell the domain name.<sup>88</sup>

### c) Offensive Content

The manner in which the griper conveys his criticism may also jeopardize his safe harbor. Courts have drawn a distinction between criticism that is “bona fide” under the fourth factor and that which is simply a pretext for inconveniencing the mark owner or for claiming fair use.<sup>89</sup> For instance, it appears that racist or pornographic content, or slurs against the plaintiff, may not be a bona fide noncommercial use. The websites in the 2004 cases, where the defendants were exonerated, consisted primarily of warnings to other consumers and descriptions of the gripers’ mistreatment at the hands of the plaintiffs.<sup>90</sup> In contrast, the griper’s site in *Morrison & Foerster* contained disparaging comments such as “Greed is good!” and “Parasites No Soul . . . No Conscience . . . NO PROBLEM.”<sup>91</sup> The defen-

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84. *Id.* at 1132.

85. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 368 (4th Cir. 2001).

86. *E.&J. Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 275-76 (5th Cir. 2002) (citing the defendant’s offer to “assist” the plaintiff as evidence the defendant intended to sell the domain to the plaintiff).

87. *Id.*

88. *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003).

89. *See, e.g., Shields v. Zuccarini*, 254 F.3d 476, 485-86 (3d Cir. 2001).

90. *TMI Inc. v. Maxwell*, 368 F.3d 433, 435 (5th Cir. 2004) (a narrative of the dispute); *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 808 (6th Cir. 2004) (complaints about the hasty nature of plaintiff’s work); *Bosley Med. Inst., Inc. v. Kremer*, No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336, at \*4 (S.D. Cal. Apr. 20, 2004) (“numerous derogatory and critical statements” about plaintiff); *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 366 (D.N.J. 2004) (warnings such as “do not do business with [plaintiffs] . . . Don’t be their next victim!”).

91. *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1128 (D. Colo. 2000).

dant also posted links to sites with offensive names such as <www.jewkike.com>.<sup>92</sup> The court concluded that the site simply was “not bona fide parody.”<sup>93</sup> While the court did not cite the offensive content of the defendant’s site as a basis for its rejection of the parody defense, one can reasonably infer that the scurrilous nature of the slurs played some role in the court’s decision.<sup>94</sup> Such a view would be in accordance with congressional intent that a pretextual parody not serve as an inoculant against the ACPA.<sup>95</sup>

It is worth noting that while the 2004 cases did not address the parody defense specifically, by allowing same-name griping on other grounds they avoid an uncomfortable holding of *Morrison & Foerster*. In that case, the griper claimed that the First Amendment protected his use of the domain name as a parody.<sup>96</sup> The court rejected this defense because the griper’s *domain names*<sup>97</sup> were not themselves parodies: they did not simultaneously refer to and ridicule the law firm of Morrison & Foerster.<sup>98</sup> The court considered irrelevant whether the *website* at the domain was a parody. But it is difficult to see how any meaningful parodic message could be conveyed within the limited length and character set of a domain name. Legislative history suggests that Congress intended to provide a parody

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92. *Id.*

93. *Id.* at 1131; see also *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535-36 (E.D. Va. 2000) (noting in dicta that an “effective parody . . . would seriously undermine” a claim of bad faith) (emphasis added).

94. See Silberlight, *supra* note 22, at 297 (observing that the *Morrison & Foerster* court disapproved of the defendant’s “personal, vengeful tactics”).

95. SENATE REPORT, *supra* note 2, at 9 (“To recognize such an exemption would eviscerate the protections of the bill by suggesting a blueprint for cybersquatters who would simply create criticism sites in order to immunize themselves from liability despite their bad-faith intentions.”). Congress was also concerned about pornographic sites posted by squatters, so presumably such sites would not be bona fide noncommercial uses. See *id.* at 6. An additional case that is difficult to reconcile with the 2004 decisions can perhaps best be understood as falling under a “pretextual” exception to the judicial safe harbor. In *Toronto-Dominion Bank*, where the griper compared the plaintiff to Nazis and described a murder that could have been interpreted as a threat, the court conclusorily rejected a claim to fair use. *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 111, 114 (D. Mass. 2002). Because the court did not explain its reason for rejecting the defense, one can only speculate that the court was swayed by the wild nature of the griper’s accusations. See *id.* at 114.

96. *Morrison & Foerster*, 94 F. Supp. 2d at 1134.

97. The domain names included <morrisonfoerster.com>, <morrisonandfoerster.com>, <morrisonforester.com>, and <morrisonandforester.com>. *Id.* at 1127.

98. See *id.* at 1134-35.

defense against squatting.<sup>99</sup> Yet the *Morrison & Foerster* holding would amount to a per se rule against parody for a same-name griper.<sup>100</sup>

d) False Identification

Under the seventh factor, a griper who uses false contact information when he registers the domain increases his chance of liability.<sup>101</sup> In *Morrison & Foerster*, the griper failed to supply his full name and address, instead giving a P.O. box and e-mail address.<sup>102</sup> The court viewed this as evidence of bad faith.<sup>103</sup> In contrast, in *Northland Insurance Companies v. Blaylock*, the court refused to weigh this factor against the defendant even though he had provided a false company name in his registration.<sup>104</sup> The fact that the defendant provided his correct address and subsequently corrected the false company name weighed in his favor.<sup>105</sup>

e) Multiple Registrations

A griper who registers multiple domain names similar to the mark increases his chance of liability under the eighth factor.<sup>106</sup> The factor targets the classic “warehouse” of domain names who registers domains by the dozen in order to extort payment from mark owners. The exact number of domain names necessary to suggest bad faith is unclear. In *Mayflower*, the griper registered three domains, each similar to the name of a party involved in the dispute.<sup>107</sup> The court held that the factor cut both ways: on

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99. See SENATE REPORT, *supra* note 2, at 9.

100. *But see* Xiao, *supra* note 21, at 176 (arguing that the *Morrison & Foerster* court’s holding on parody is consistent with the ACPA’s purpose of curtailing cyber-squatting).

101. See 15 U.S.C. § 1125(d)(1)(B)(i)(VII) (2000).

102. *Morrison & Foerster*, 94 F. Supp. 2d at 1132.

103. *Id.*

104. The defendant registered the domain under the name “North Land Insurance Company,” a name nearly identical to the plaintiff’s. 115 F. Supp. 2d 1108, 1124 (D. Minn. 2000).

105. *Id.* at 1124-25.

106. 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

107. The domain names were <mayflowervanline.com> for the national moving company, Mayflower Transit; <lincolnstoragewarehouse.com> for Lincoln Storage Warehouses, an affiliated agent of Mayflower; and <cumberlandinsurancegrp.com> for an insurer involved in the claim. *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 365-66 (D.N.J. 2004); *see also* *TMI Inc. v. Maxwell*, 368 F.3d 433, 434-35, 440 (5th Cir. 2004) (considering a defendant who registered two variations on the plaintiff’s TREND-MAKER HOMES mark: <trendmakerhome.com> and <trendmakerhome.info> and holding that because the defendant registered the two domains “for the same purposes,” and only registered the “.info” domain after the “.com” registration expired, this factor did not harm the defendant).

one hand, the defendant indeed registered multiple domains; on the other hand, all the registrations related to involved parties and “could reasonably be considered part of [defendant’s] wider criticism of the . . . incident” that prompted his dissatisfaction.<sup>108</sup> In contrast, in *Toronto-Dominion Bank*, the griper registered sixteen misspelled variations of the plaintiff’s TD WATERHOUSE mark.<sup>109</sup> The eighth factor therefore weighed against the defendant.<sup>110</sup>

#### f) Implicit Disclaimers

Diverting the mark owner’s customers to the gripe site may weigh against the griper under the fifth bad-faith factor. The factor weighs against a defendant if the following elements are met: 1) intent to divert consumers from the mark owner’s official site, 2) for commercial gain or with intent to disparage, 3) by creating a likelihood of confusion.<sup>111</sup> It is difficult for a same-name griper to argue successfully that he did not intend to divert consumers given that he chose a domain name identical to the mark.<sup>112</sup> Thus, the griper seems to meet the first element. A pure-criticism site would not seem to meet the “commercial gain” requirement, but would meet the alternate “intent to disparage” criterion of the second element.<sup>113</sup> However, arguably, a griper should be exonerated on this factor by the third element. Pejorative content on the gripe site should alert the consumer that this is not the mark owner’s official site, thus eliminating any likelihood of confusion. In other words, pejorative content serves as an implicit disclaimer.

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108. *Mayflower*, 314 F. Supp. 2d at 369; see also *TMI*, 368 F.3d at 440 (weighing the eighth factor in favor of a same-name griper where he registered a second domain name only after registration of his first gripe site expired).

109. *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 111 (D. Mass. 2002).

110. *Id.* at 114.

111. See 15 U.S.C. § 1125(d)(1)(B)(i)(V). While the “likelihood of confusion” language suggests a trademark infringement-style inquiry, the courts typically conduct a superficial analysis rather than a multi-factor inquiry in the manner of *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

112. *But see TMI*, 368 F.3d at 440 (holding the fact that the domain name was nearly identical to the mark insufficient to show intent to divert). If the mark owner does not have a website, the fifth factor automatically weighs in favor of the griper. *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 810 (6th Cir. 2004).

113. *But see Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1114, 1124 (D. Minn. 2000) (weighing the fifth factor in favor of a cybergriper because of a lack of intent to “tarnish,” even though the site “house[d] complaints and criticism of plaintiff’s business”).

Gripe cases under the ACPA have not consistently adhered to this view. In *Mayflower*, for instance, the court found the fact that consumers attempting to reach the company's official site might inadvertently reach the gripe site sufficient to turn the fifth factor against the defendant, despite the site's pejorative content.<sup>114</sup> Similarly, in *Morrison & Foerster*, the court held that "a user may wonder about [law firm] Morrison & Foerster's affiliation with the sites or endorsement of the sites," even though the gripe sites contained paranoid, anti-Semitic, and anticorporate rantings.<sup>115</sup> On the other hand, the *Bosley* court, although not explicitly analyzing the fifth factor, noted that pejorative content would "immediately alert a visitor . . . that he had not accessed" the mark owner's official site.<sup>116</sup>

Arguably, even if pejorative content dispels any likelihood of confusion once the consumer has looked at the gripe site, the court should weigh the fifth factor against the defendant based on the trademark infringement doctrine of initial interest confusion.<sup>117</sup> Initial interest confusion is one way a likelihood of confusion may arise under a trademark infringement claim. It occurs when an unscrupulous seller uses someone else's mark to get a customer's initial attention, even if the seller immediately thereafter makes clear that his goods are not the same as the mark owner's. A classic example involves a fast-food restaurant, brand X, that erects a highway billboard telling motorists there is a brand Y restaurant at this exit. Only after motorists get off the highway do they discover that there is no brand Y here, only brand X. Consumers are no longer confused, but having gone to the trouble of getting off the highway, many consumers will simply throw up their hands and take X rather than hold out for Y.

In the Internet context, the use of the mark as the domain name could cause initial interest confusion because, as noted in *Morrison & Foerster*, perhaps the most common method of finding a website is to type in the company name with the suffix ".com."<sup>118</sup> The consumer seeking MoFo, like the motorist seeking brand Y, naturally expects to find the law firm at

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114. *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 368 (D.N.J. 2004).

115. *See Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1132 (D. Colo. 2000). Other cases weighing the fifth factor against a registrant include *E.&J. Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 276 (5th Cir. 2002); *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 369 (4th Cir. 2001); and *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 114 (D. Mass. 2002).

116. *Bosley Med. Inst., Inc. v. Kremer*, No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336, at \*30 (S.D. Cal. Apr. 30, 2004).

117. *See, e.g., Interstellar Starship Servs., Ltd. v. Epix Inc.*, 304 F.3d 936, 942 (9th Cir. 2002).

118. *See Morrison & Foerster*, 94 F. Supp. 2d at 1132.

<morrisonandfoerster.com>,<sup>119</sup> but instead finds a gripe site.<sup>120</sup> However, under many circuits' approach to initial-interest confusion, a griper is likely in the clear because of the wide disparity between the "goods" he offers—criticism—and the goods offered by the mark owner.<sup>121</sup>

### g) Explicit Disclaimers

An explicit notice on the gripe site, indicating that it is not the mark owner's site, is also relevant under the fifth factor of the ACPA. The *Bosley*, *Lucas*, and *Taubman* courts all held that a disclaimer dispelled any potential confusion.<sup>122</sup> In addition, a link to the mark owner's official site helps ward off a claim of bad faith.<sup>123</sup> On the other hand, because it only takes effect once the consumer has reached the gripe site, a disclaimer would likely have no effect under the fifth factor if the court were to accept a plaintiff's claim of initial-interest confusion.<sup>124</sup>

## B. Pejorative-Suffix Gripping

Pejorative-suffix gripping consists of setting up a complaint site at a domain name that includes the mark, or a close variation on it, and an additional pejorative suffix, such as "sucks" or "beware" or "warning." For example, a pejorative-suffix griper might register <mayflowervanlinebeware.com>.<sup>125</sup>

### 1. Applying the ACPA

In contrast to a same-name griper, when the ACPA is applied to a pejorative-suffix griper, it is not even clear that we reach the bad-faith factors. The ACPA requires that the domain name be "identical or confus-

119. Internet domain names cannot use ampersands.

120. One area where the analogy with the motorist example fails is that in the motorist example, the brand X restaurant created the confusion by erecting the billboard. On the Internet, the griper does not do anything to create consumers' expectation that MoFo will be at <morrisonandfoerster.com>.

121. See, e.g., *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1018-19 (9th Cir. 2004); *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 297 (3d Cir. 2001); *Deere & Co. v. MTD Holdings, Inc.*, No. 00 Civ. 5963 (LMM), 2004 U.S. Dist. LEXIS 2550, at \*45-\*47 (S.D.N.Y. Feb. 19, 2004).

122. *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 810 (6th Cir. 2004); *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003) (considering another section of the Lanham Act); *Bosley Med. Inst., Inc. v. Kremer*, No. 01-1752 WQH (JMA), 2004 U.S. Dist. LEXIS 8336, at \*29-\*30 (S.D. Cal. Apr. 30, 2004).

123. *Rohr-Gurnee Motors, Inc. v. Patterson*, No. 03 C 2493, 2004 U.S. Dist. LEXIS 2068, at \*14-15 (N.D. Ill. Feb. 9, 2004) (holding that the defendant's link from her gripe site to the plaintiff's site weighed in favor of her reasonable belief of fair use).

124. See the discussion of implicit disclaimers *supra* Part III.A.2.f.

125. See *Mayflower Transit, LLC v. Prince*, 314 F. Supp. 2d 362, 365 (D.N.J. 2004).

ingly similar to” a non-famous mark.<sup>126</sup> But in a pejorative-suffix case, the domain name is not identical to the mark. Nor is it confusingly similar to the mark, because the pejorative suffix should dispel any confusion. No consumer would reasonably believe, for instance, that <chevysucks.com> was in any way affiliated with Chevrolet. Recent pejorative-suffix cases confirm this view.<sup>127</sup>

The language of the ACPA suggests another route against a pejorative-suffix griper, at least for an owner of a famous mark. For a famous mark, the domain name need not be “identical or confusingly similar to” the mark to engender liability; it may also be “dilutive of” the mark.<sup>128</sup> The ACPA is not clear, however, as to what it means by “dilutive of” in this context, and how the “dilutive of” test should be applied.<sup>129</sup>

#### a) Defining the “Dilutive of” Requirement

It seems reasonable to assume that the ACPA refers to the FTDA, which created the federal dilution cause of action in 1995.<sup>130</sup> Dilution under the FTDA refers to the “lessening of the capacity of a famous mark to identify and distinguish goods or services,” regardless of whether the mark owner and other parties compete in the marketplace and regardless of the likelihood of consumer confusion.<sup>131</sup> There are two types of dilution identified by scholars.<sup>132</sup> The classic type of dilution is “blurring,” which occurs when another party uses a famous mark to identify other, unrelated goods.<sup>133</sup> Although there is no likelihood of confusion, and thus no trademark infringement, the “capacity of [the] famous mark to identify” the original goods is weakened because the famous mark may no longer call to mind the original goods and those goods alone.<sup>134</sup> For instance, the BUICK trademark is strongly linked to cars, and only cars, in most con-

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126. 15 U.S.C. § 1125(d)(1)(A)(ii) (2000).

127. See *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000); see also *Taubman*, 319 F.3d at 778 (holding that a pejorative suffix removes any possibility of confusion under an infringement cause of action).

128. 15 U.S.C. § 1125(d)(1)(A)(ii)(II).

129. This Note does not consider dilution as applied to same-name griping. The “dilutive of” language in the ACPA is superfluous for a same-name griper because a same-name griper’s domain name is, by definition, “identical or confusingly similar to” the mark. See 15 U.S.C. § 1125(d)(1)(A)(ii)(II).

130. See *id.* § 1125(c); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 420-21 (2003).

131. See 15 U.S.C. § 1127.

132. 4 MCCARTHY, *supra* note 58, § 24:67.

133. See *id.* § 24:68.

134. See 15 U.S.C. § 1127.

sumers' minds; an aspirin sold under the same name would dilute the BUICK mark by weakening that link.<sup>135</sup>

The second type of dilution is "tarnishment," which occurs when another party's unauthorized use degrades the mark.<sup>136</sup> Use of the trademark on shoddy goods or in an unwholesome or derogatory context may cause dilution through tarnishment.<sup>137</sup> Despite the recognition of tarnishment as a form of dilution by scholars, it is not clear that the FTDA authorizes a federal remedy against tarnishment. Some legislative history and application of the FTDA suggests that it does.<sup>138</sup> On the other hand, as the Supreme Court has noted, the language of the statute suggests otherwise.<sup>139</sup>

A literal interpretation of the "dilutive of" prong of the ACPA suggests that the plaintiff must prove all the elements of dilution merely to fulfill that prong.<sup>140</sup> But asking the plaintiff to meet the substantial hurdle of proving dilution simply as a "gateway" into the ACPA would render the ACPA essentially superfluous in these situations. After all, remedies for dilution already include surrendering the domain name,<sup>141</sup> the primary remedy authorized by the ACPA.<sup>142</sup> Further, prior to the passage of the ACPA, dilution was the primary cause of action against squatters.<sup>143</sup> As noted by Congress, the ACPA was enacted to catch squatters who fall

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135. See H.R. REP. NO. 104-374, at 3 (1995).

136. 4 MCCARTHY, *supra* note 58, § 24:69.

137. *Id.* § 24:104.

138. The FTDA was intended "to protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it . . ." 141 CONG. REC. H1295 (daily ed. Dec. 12, 1995) (statement of Rep. Moorhead); see also *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996); *Dr. Seuss Enters., L.P. v. Penguin Book USA, Inc.*, 924 F. Supp. 1559, 1573 (S.D. Cal. 1996).

139. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003). State laws such as Massachusetts's, noted in *Moseley*, provide relief for "injury to business reputation." *Id.* at 430 (quoting 1947 Mass. Acts, p. 300, ch. 307). This would be tarnishment.

140. Proving dilution was made more difficult by the Supreme Court's holding that the FTDA requires proof of actual dilution, not merely the likelihood of dilution. *Moseley*, 537 U.S. at 432-33; see also Brian Paul Gearing, Note, *Moseley v. V Secret Catalogue, Inc.*, 19 BERKELEY TECH. L.J. 221, 233-40 (2004) (discussing the effect of the decision on the difficulty of proving dilution).

141. See *Panavision Int'l, L.P. v. Toeppen*, 945 F. Supp. 1296, 1306 (C.D. Cal. 1996), *aff'd*, 141 F.3d 1316 (9th Cir. 1998).

142. See 15 U.S.C. § 1125(d)(1)(C) (2000).

143. See, e.g., *Panavision*, 141 F.3d at 1324-27; *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108 (D. Minn. 2000); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 U.S. Dist. LEXIS 3338 (S.D.N.Y. Mar. 24, 1997). *Northland* included a dilution claim as well as an ACPA claim.

through the cracks of a dilution claim.<sup>144</sup> The “gateway” interpretation is at odds with this goal.

b) Applying the “Dilutive of” Requirement

Assuming the ACPA requires dilution as a threshold inquiry for a domain name not “identical or confusingly similar to” the mark,<sup>145</sup> the court in *Bally Total Fitness Holding Corp. v. Faber* arguably held that a pejorative-suffix griper does not blur.<sup>146</sup> In *Bally*, the defendant established a gripe site at the URL <www.compupix.com/ballysucks>.<sup>147</sup> The court concluded that the griper’s use was not a commercial use in commerce—an essential element of a dilution claim<sup>148</sup>—despite the fact that the defendant referred to the gripe site when promoting his web design skills elsewhere on his website.<sup>149</sup> That the BALLY mark appeared in a directory name on the web server, rather than in the domain name, is probably irrelevant because a holding of commercial use for a clean-hands pejorative-suffix griper would probably depend on a likelihood of diverting consumers.<sup>150</sup> <ballysucks.com> is no more likely to divert consumers seeking the official Bally site than <www.compupix.com/ballysucks>.

Similarly, a tarnishment claim against a pejorative-suffix gripe site would likely fail because of the commercial use in commerce element.<sup>151</sup> Even if the commercial use requirement were met, however, use of the plaintiff’s mark “in the context of a consumer commentary” is a protected use “necessary to maintain broad opportunities for expression.”<sup>152</sup>

144. SENATE REPORT, *supra* note 2, at 16 (“Warehous[ers] . . . have been largely successful in evading the case law developed under the Federal Trademark Dilution Act.”).

145. 15 U.S.C. § 1125(d)(1)(A)(ii)(II).

146. 29 F. Supp. 2d 1161 (C.D. Cal. 1998).

147. *Id.* at 1162.

148. The primary elements relevant to our inquiry that a plaintiff must establish to prove blurring are: 1) defendant’s use must cause dilution of the distinctive quality of plaintiff’s mark; and 2) defendant’s use of the mark must be a commercial use in commerce. *Northland*, 115 F. Supp. 2d at 1122. The other elements are: “plaintiff’s mark must be famous;” “plaintiff’s mark must be distinctive;” and “the use must have occurred after the plaintiff’s mark . . . [became] famous.” *Id.*

149. *Bally*, 29 F. Supp. 2d at 1167.

150. See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 364-66 (4th Cir. 2001) (holding that the likelihood of diverting consumers contributed to rendering the defendant’s use “in connection with” the sale of goods under a trademark infringement claim).

151. See *Bally*, 29 F. Supp. 2d at 1167.

152. See *id.*

### c) An Alternate View of the “Dilutive of” Requirement

More likely, by placing “dilutive” domain names within reach of the ACPA, Congress merely meant to enable litigation against domain names that *might* blur or tarnish famous marks but for the commercial use requirement of the FTDA. In other words, <buickaspirin.com> and <buick-sucks.com> would pass the identical, confusingly similar, or dilutive prong of the ACPA based on a prima facie inquiry. <buickaspirin.com> and <buicksucks.com> lessen the mental link between the BUICK mark and cars, or cast aspersions on the BUICK mark. Accordingly, the court could proceed to the bad-faith inquiry.

The court’s inquiry into bad faith would be nearly identical to that for a same-name griper, with the exception of the fifth factor. This is because the only difference between a same-name griper and a pejorative-suffix griper is the domain name used. Yet the domain name used is only important under the first, second, and fifth factors. The other factors focus instead on extrinsic elements such as the registrant’s behavior and the site’s content.

Of the factors related to the domain name, as noted in Part III.A.1, only the fifth factor is likely to matter in a griper case. This factor, focusing on intent to divert consumers from the mark owner’s official site, would automatically weigh in favor of the griper because <buick-sucks.com> does not divert consumers seeking out <buick.com>. Moreover, because the fifth factor is rarely a determining element in an ACPA case, even if a court found that the fifth factor weighed against a pejorative-suffix griper, the fourth and sixth factors could still warrant a finding of no liability. Because the activities that may jeopardize the judicial safe harbor are also unrelated to the actual domain name used, the analysis of these activities, in Part III.A.2, applies here as well.

## IV. CONCLUSION

Congress did not intend the ACPA to prohibit the use of a domain name for non-pretextual criticism or parody.<sup>153</sup> By creating a judicial safe harbor for cybergrippers posting bona fide criticism or parody without commercial content, links to commercial sites, or offers to sell, the 2004 cybergriper decisions reflect the correct interpretation of the ACPA as to both same-name and pejorative-suffix grippers in light of congressional intent. This interpretation is probably not the best outcome from the perspective of mark owners and satisfied consumers who merely seek conven-

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153. SENATE REPORT, *supra* note 2, at 9.

ience in using the Internet. Yet, in the absence of a change in the tide of judicial opinion, mark owners likely are stuck. They will have to rely on prompt registration of their trademarks or payoffs to irate consumers to keep savvy grippers shunted into obscure corners of the web.