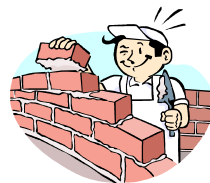


Internet Law

- Module 2
- Commercial Identity Online and Trademarks

The neighborhood versus the net . . .

- Location, Location, Location
- Brand Identity
- Domain names: the new intangible asset



Trademark basics

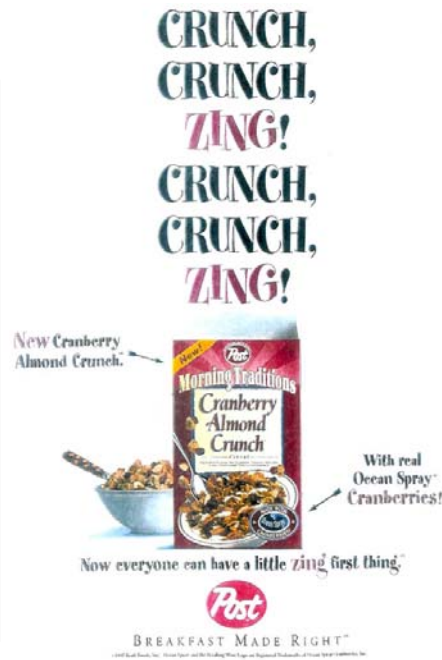
- Signal a common source, or at least affiliation
- Words, phrases, logos . . .
- Federal / state regimes
- Use in commerce
 - Law of marks is based on use of the brand on goods
 - Exclusivity derives from that type of use in commerce
 - Must:
 - “Affix” the mark to goods
 - Move the marked goods in commerce
 - Registration not needed – but Federal registration is highly beneficial
- Service marks
 - Used “in connection with” services to signal common source
- Certification / Collective marks

Trademark

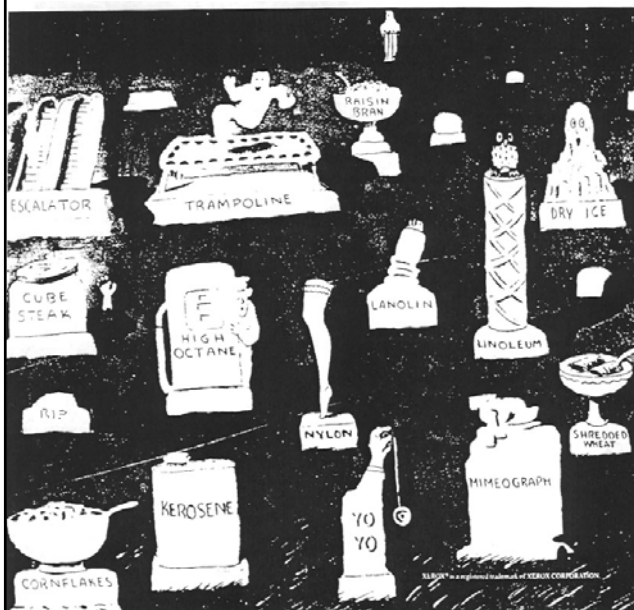
Generic	Descriptive	Suggestive	Arbitrary / Fanciful / Coined
aspirin			  
	“Brilliant” for diamonds	“Brilliant” for shoe polish	“Brilliant” for canned apple sauce

Descriptive?

- character
- function
- feature
- quality
- ingredient
- nature
- purpose
- use
- characteristics
 - dimensions, color, odor. . .



Genericness



Once a trademark, not always a trademark.

They were once proud trademarks, now they're just names. They failed to take precautions that would have helped them have a long and prosperous life.

We need your help to stay out of there. Whenever you use our name, please use it as a proper adjective in conjunction with our products and services: e.g., Xerox copiers or Xerox financial services. And never as a

verb: "to Xerox" in place of "to copy," or as a noun "Xeroxes" in place of "copies."

With your help and a precaution or two on our part, it's "Once the Xerox trademark, always the Xerox trademark."

Team Xerox. We document the world.

Generic -ness

It's *just* not BOTOX® without the ®.

The ® after BOTOX® Cosmetic means it's a
registered trademark of Allergan, Inc.
Not a nickname. Or a generic term for other botulinum toxins.
It's the BOTOX® you and your patients trust.
And the one we trust you'll always use with an ®.

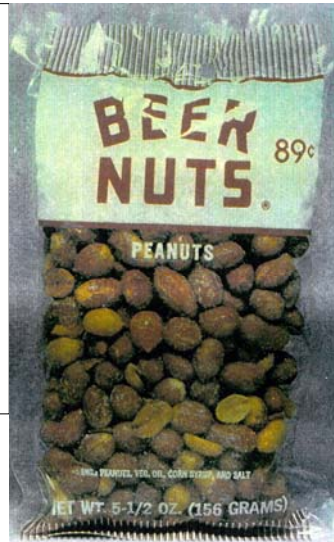
BOTOX®
—Cosmetic
Botulinum Toxin Type A

ALLERGAN ©2003 Allergan, Inc., Irvine, CA 92612 BOTOX is a registered trademark of Allergan, Inc. www.botox.com 0304625

Likelihood of Confusion HYPO



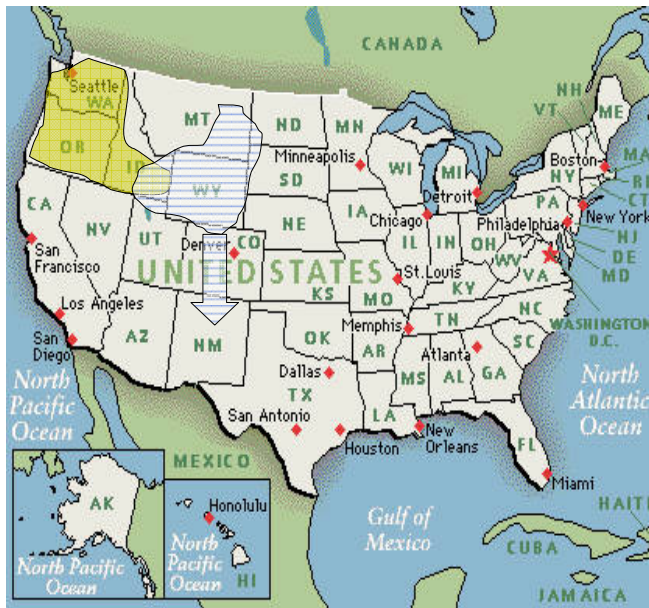
1. strength of the mark
2. proximity of the goods
3. similarity of the marks
4. evidence of actual confusion
5. marketing channels used
6. type of goods and the degree of care likely to be exercised by the purchaser
7. defendant's intent in selecting the mark
8. likelihood of expansion of the product lines



Geographic Scope

- Two c/l users of the same TM
- c/l rule – only protected where products sold or advertised
- Exceptions:
 - Where reputation established
 - Normal expansion of business
 - Anywhere someone intentionally trades on the TM owner's goodwill
- Earlier user has superior rights in area of overlap

- User One 
- User Two 



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Playboy v. Universal Tel-A-Talk (E.D.Pa.1998)

- Senior user's marks
 - PLAYBOY work mark
 - Rabbit Head Design symbol mark
 - Referred to as Playboy BUNNY
 - Trademark www.playboy.com
- Junior (alleged infringing) user's use
 - Descriptive text on web page
 - "Playboy's Private Collection"
 - URL use: "adult-sex.com/playboy/..."
 - Email name use; linking
- LofC analysis



- strength of the mark
- proximity of the goods
- similarity of the marks
- evidence of actual confusion
- marketing channels used
- type of goods and the degree of care likely to be exercised by the purchaser
- defendant's intent in selecting the mark
- likelihood of expansion of the product lines

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Albert v. Spencer (SDNY.1998)

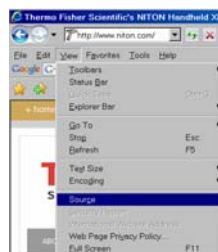
- Senior user
 - AISLE SAY for magazine published theatre reviews
- Junior user in good faith
 - www.aislesay.com
 - Similar content
- LofC analysis

1. strength of the mark
2. proximity of the goods
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Niton v. Radiation Monitoring Devices (D.Mass.1998)

- Niton
 - Internet searches for Niton lead to RMD web site
 - Why?
- RMD
 - Internet searches for Niton lead to RMD web site
 - Why?



```
<meta name="Description" content="Handheld
NITON XRF analyzers provide rapid, non-destructive
testing of metal alloys, electronic components,
environmental samples, art and artifacts, mining and
forensic samples. Customers have the choice of
miniature x-ray tube or radioisotope technology."
/><meta name="Keywords" content="NITON, XRF,
PMI, metal analysis, x-ray fluorescence, weee/RoHS,
Lead Paint Testing, Portable x-ray equipment,
portable XRF, XRF analysis, RoHS testing, RoHS
screening, xray fluorescence, XRF analyzer, portable
XRF analyzer, x-ray fluorescence analyzer, alloy
analysis, alloy testing, alloy identification, positive
material identification, metals analysis, scrap metal
recycling, ed XRF, scrap sorting, NITON Analyzer,
lead paint analysis, x-ray fluorescence instrument,
soil analysis, lead paint analyzer, RoHS directive" />
```



NITON XLp 300



```
<meta name="description" content="RMD - Radiation
Monitoring Devices, Inc - in Watertown, MA.
University quality research; commercial grade
products">
<meta name="keywords" content="RMD rmd
radiation monitoring devices watertown MA
massachusetts research technology thinktanks">
```

Types of confusion

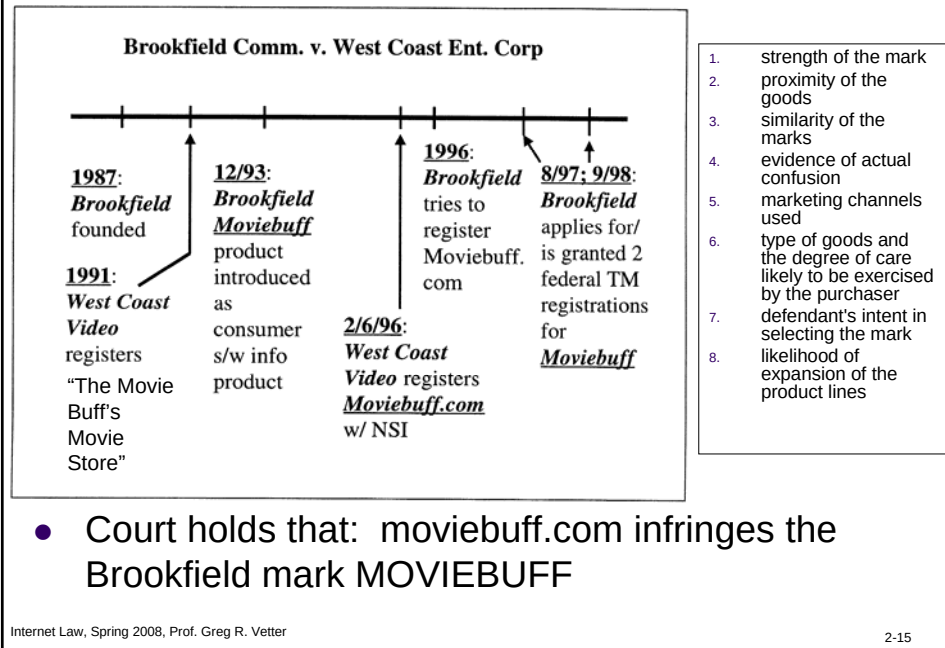
- Confusion as to the products
 - Confusion leading to purchase of infringer's product (Sleekcraft) when trademark ("TM") owner sells the same product
- Confusion as to source
 - Infringer uses TM owner's mark on products the TM owner does not sell at all
 - Two possible types of harm: (i) potentially inferior quality of infringer's products; (ii) if TM owner expands into product area where infringer sells, very high chance of likelihood of confusion
- Confusion as to sponsorship
 - For example, United States Olympic Committee label on soup
- Initial interest confusion
 - Confusion that is dispelled before purchase occurs
- Post-sale confusion
 - Confusion after the sale of a product
- Reverse Confusion
 - A large company adopts the mark of a smaller TM owner
 - Risk is not junior user trading on goodwill of senior, but that the public comes to associate the mark not with its true owner, but with the infringing junior user who may have spent a lot of money to advertise it



Brookfield v. West Coast (9th.1998) Initial Interest Confusion



Brookfield v. West Coast (9th.1998)



Brookfield v. West Coast (9th.1998)

- Second issue: can West Coast use, in other domain names (not moviebuff.com), the term Moviebuff in metatags?
- No direct confusion
 - Search engines show both sites
 - Domain names are different
- Initial interest confusion
 - Preliminary injunctive relief is appropriate in order to eliminate West Coast's use of metatags confusingly similar to Moviebuff

Playboy v. Netscape (9th.2004)

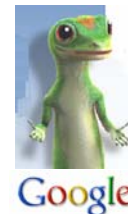
- Excite/Netscape
 - Require adult oriented companies using keyword search banner ads to use a 400+ term list containing
 - playboy
 - playmate
- LofC factors favor a showing that there is initial interest confusion (IIC) when banner ads not labeled
- Concurrence concern w/ Brookfield
 - If banner ads are labeled, no IIC
 - Mere distraction with another choice in the list



1. strength of the mark
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8. likelihood of expansion of the product lines

Gov't Employee Ins. Corp. v. Google (E.D.Va.2004)

- GEICO as mark holder seeks to stop Google's "practice of selling advertising linked to [GEICO's] trademarks"
- Sufficient allegations that it is "trademark use" when searching for GEICO on Google brings up sponsored links with the GEICO mark in the text or heading of the ad



Portion of the Google AdWords FAQ, Trademark section, from 1/20/2008

Trademark Complaints
As a provider of space for advertisements, Google is not in a position to arbitrate trademark disputes between advertisers and trademark owners. As stated in our Terms and Conditions, advertisers are responsible for the keywords and ad text that they choose to use. Accordingly, Google encourages trademark owners to resolve their disputes directly with the advertiser, particularly because the advertiser may also be using your trademark on similar ads in other programs.

However, Google takes allegations of trademark infringement very seriously and, as a courtesy, we're happy to investigate matters raised by trademark owners. You are not required to be a Google AdWords advertiser in order to send a complaint.

If you have concerns about the **use of your trademark in AdWords ads**:

- [File a trademark complaint in the U.S. or Canada.](#)
- [File a trademark complaint outside the U.S. and Canada.](#)

If you have concerns about the **use of your trademark in a parked domain name**:

- [File an AdSense for Domains trademark complaint.](#)

Once Google receives all of the required information from the trademark owner, the claim will be investigated, and appropriate action will be taken.

Please note: Such trademark investigations will only affect ads served on or by Google. In the case of an AdSense for Domains trademark complaint, an investigation will affect only the domain names of sites in our AdSense for Domains program. Additionally, Google's trademark policy does not apply to search results, only to sponsored links. For trademark concerns about websites that appear in Google search results, the trademark owner should contact the site owner directly.

Bihari v. Gross (SDNY.2000)

- Disgruntled interior design client, Gross, registers www.bihari.com and www.bihariinteriors.com
- Later, into the dispute, after taking down these 2 sites, Gross registers 2 others; both using Bihari Interiors in metatags
- As a “TM.Use” – LofC analysis

1. strength of the mark
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1-800 Contacts v. WhenU.Com (2nd.2005)

- Dist. Ct. – preliminary injunction against WhenU
- WhenU’s software, downloaded to a user PC, has a directory of web addresses, search terms and keywords
- Pop up/under or panoramic ads upon user access to 1-800 site
 - Five complaints by 1-800 / two relied on by the district court
- Use in the “SaveNow” directory
- Use by displaying the pop up/under and panoramic windows
- Three distinct elements: use / in commerce / LofC



Dilution – possible types or theories of harm

Type	“Tiffany” example (famous mark for a jewelry store) [example described in a recent 7 th circuit case]	Other Example(s)
Blurring	“Tiffany” for an upscale restaurant	Goldfish  Dupont shoes, Buick aspirin tablets, Schlitz varnish, Kodak pianos, Bulova gowns
Tarnishment	“Tiffany” for a “restaurant” that is actually a “striptease joint”	John Deere  Snuggles  Victoria’s Secret

Dilution – § 43(c) – remedies for dilution of famous marks (Act of 2006)

(1) INJUNCTIVE RELIEF.—Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) DEFINITIONS.--(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered . . . on the principal register.

Dilution (Trademark Dilution Revision Act of 2006)

(B) For purposes of paragraph (1), 'dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), 'dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) EXCLUSIONS.--The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with--

- (i) advertising or promotion that permits consumers to compare goods or services; or
- (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

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Brookfield v. West Coast (9th.1998)

Fair Use

- Truthful use to identify a competitor's goods
 - Rightful copying
 - Comparative advertising
- MovieBuff isn't used as a descriptive term in West Coast's metatags
 - movie buff, or Movie Buff is different, due to the space
- Hypothetical allowed use: "Why pay for MovieBuff when you can get the same thing here for free?"

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Bihari v. Gross (SDNY.2000)

Fair Use

- Fair use applies to the online context
- Note necessary for plaintiff's mark to be characterized as "descriptive"
- Gross used the terms not as a mark, but to identify Bihari
- A different rule forecloses (chills) discourse and commentg

Playboy v. Welles (9th.2002)



- Reverses S/J of LofC and Dilution
- Traditional fair use is for describing
- Nominative fair use is for naming when there is no good alternative
- 3-factor test instead of LofC analysis
 - No descriptive substitute
 - Use no more of mark than necessary
 - No suggestion of sponsorship or endorsement, even if commercial use
- Welles' uses of PEI marks
 - Headlines and banner ads (nominative)
 - Metatags (nominative, sufficiently sparse use)
 - Wallpaper/Watermarks ("PMOY '81" pattern not nominative)
- No Dilution for headlines and metatags, remand for PMOY

Planned Parenthood v. Bucci (SDNY.1997)

- Planned Parenthood mark: strong, “incontestable”
- PP web site is www.ppfa.org
- Bucci established www.plannedparenthood.com
- Initial greeting text declares it as PP’s home page
- First amendment protects use of a mark when used in a communicative message (or a title), not when used to identify the source a product
- No artistic implications of plannedparenthood.com as a title

Bally v. Faber (C.D.Cal.1998)

- Complaint site: www.compupix.com/ballysucks
- Different from
 - Enjoy Cocaine
 - Mutant of Omaha
- Faber’s speech is protected by First Amendment
- Thus protecting his use of the mark

Unauthorized

Bally Total Fitness

Complaints!

Bally Total Fitness customer complaints, issues, problems, beefs, grievances, solutions, and advice.

☐ **Editorial:** Bally says its 4 million members are "proof positive that Bally Total Fitness is providing the latest and best in fitness programs and facilities at a reasonable price." Could millions of people possibly be wrong?

☐ **How to Cancel Your Membership:** First, read your contract carefully...

☐ **How to Deal with BTF:** Don't give Bally's access to your financial accounts.

☐ **How to Stop Automatic Payments:** "Your Automatic Payment Plan election will remain in effect unless and until you give written notice..."

☐ **Many people fail to meet health test:** According to the Milwaukee Journal Sentinel: "The biggest offender by far is Bally Total Fitness..."

☐ **Names, Addresses, Phone Numbers:** The Bally Total Fitness Company Directory.

☐ **Scam Alerts:** Scams frequently reported in the Complaint Guestbook.

☐ **Attention Bally Employees:** Is Bally violating the Fair Labor Standards Act with respect to overtime? Do you have other information that should be posted on this website?

☐ **More:** The complete index to the Unauthorized Bally Total Fitness Complaint Website.

BTF [sues](#) creator of this Website!

Bally Total Fitness is NOT Responsible

You will not file any claim because of Bally Total Fitness' negligence, including injuries that may result from improperly maintained equipment and negligent instruction.

Simplified from their legalese. For the full text see compupix.com/ballysucks.

This site is not affiliated with Bally Total Fitness Health Clubs.

Name.Space v. Network Solutions (2nd.2000)

- Alternative gTLD system
 - Some sufficiently lengthy to perhaps be expressive
 - .forpresident
 - .microsoft.free.zone
- Name.Space alleges NSI's refusal to include new gTLDs into the zone file of the root servers is a 1st Amendment problem
- Appellate court rejects analogy below of domain names to telephone numbers and alpha addresses
- Also, their functional nature also doesn't automatically exclude them from 1st Amendment protection

Taubman Co. v. Webfeats (6th.2003)

- Taubman mark: The Shops at Willow Bend
- Misleading commercial speech isn't protected by the 1st Amendment
- Use in www.taubmansucks.com is purely an exhibition of Free Speech
 - Lanham act is not invoked

