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

<table>
<thead>
<tr>
<th>Generic</th>
<th>Descriptive</th>
<th>Suggestive</th>
<th>Arbitrary / Fanciful / Coined</th>
</tr>
</thead>
<tbody>
<tr>
<td>aspirin</td>
<td>Dog Chow</td>
<td>Q Tips</td>
<td>EXON</td>
</tr>
</tbody>
</table>

“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...
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 ®.

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


- 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

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
### 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**


- **Niton**
  - 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.

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

- Court holds that: moviebuff.com infringes the Brookfield mark MOVIEBUFF

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
  - LoF 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


- 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
Bihari v. Gross (SDNY.2000)

- 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
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

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

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

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.

Brookfield v. West Coast (9th.1998)

Fair Use

● Truthful use to identity 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?”
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 commentary

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

- 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