

## Internet Law

- Module 3
- Domain Names

## Lockheed Martin v. Network Solutions (CD.Cal.1997; aff'd 9th.1999) Trademark Infringement and Domain Names

- No TM use by NSI, no direct infringement
- No inducement
- No knowledge-based contributory infringement
- No "use" for dilution or §43(a) unfair competition

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### § 1114. Remedies; infringement; innocent infringement by printers and publishers

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125 (a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125 (a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

### SKUNK WORKS®

The marks SKUNK WORKS® and the Skunk Logo are registered in the United States Patent and Trademark Office, and in many other countries, in connection with a wide variety of goods and services.

Now owned by Lockheed Martin Corporation, the marks were first used during World War II and are still used today. These marks represent the goodwill associated with the birthplace of many famous aircraft, as well as the research and development capability and cultural mindset that even today make the impossible happen.

Lockheed Martin honors the service of the many dedicated men and women who have contributed to the fame of the SKUNK WORKS® marks through vigilant preservation of these marks and the brand equity they represent. Thus, these marks may not be used by others on their own goods and services without prior written approval by Lockheed Martin. Learn more about our [licensing](#) program.



[Learn more about the Skunk Works®.](#)

## Green Products v. Independence Corn (N.D.Iowa.1997)

- Sr. user mark is GREEN PRODUCTS
- Jr. user use is [www.greenproducts.com](http://www.greenproducts.com)
- Confusion . . . of initial interest?
  - Content or no content posted to the domain . . .
- Under preliminary injunction standard, who gets the domain name . . . impact of “whois”



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## Cardservice Intl. v. McGee (E.D.Va.1997)

- Sr. user mark CARDSERVICE INTERNATIONAL
- Jr. user registered [www.cardservice.com](http://www.cardservice.com)
- McGee is also in the merchant card processing business
- LofC?

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



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## AntiCyberSquatting Consumer Protection Act (ACPA)

- McCarthy: “new category of ‘dilution’”
- Problems of LofC, dilution and unfair competition law with respect to domain names
- ACPA:
  - Bad faith registration liability for registrant, not registrar
  - In rem action
  - Statutory damages
  - New cause for registering non-TM name of others w/out consent w/ intent to profit by resale
- Just domain names, i.e., those registered, whether second level or more



## ACPA

- 15 U.S.C. 1125(d)(1)(A):

A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person -

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that -

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) . . .

## ACPA

- Nine bad faith factors (nonexclusive list)
  - I. Trademark or other IP rights in the domain name
  - II. Extent of domain name use to identify a legal person
  - III. Bona fide offering of goods or services
  - IV. Bona fide noncommercial or fair use of the mark in a site accessible under the domain name
  - V. Intent to divert customers from the mark's owner online location to a goodwill-harming site
  - VI. Offer to sell without having made bona fide use
  - VII. Material and misleading false contact information when applying for the mark
  - VIII. Keeping multiple domain names and knowing that they are identical or confusingly similar to others' marks
  - IX. Extent to which the mark incorporated into the domain name is or is not distinctive or famous

## ACPA

- Safe harbor
  - Believed and had reasonable grounds to believe that use was fair use or otherwise lawful
- Remedies
  - Pre-enactment
  - Post-enactment
- Intent analysis
  - Circumstantial evidence
  - Direct evidence

## Sporty's Farm v. Sportman's Market (2nd.2000)

- Sr. user is Sportman's mark SPORTY for catalogs and products, 60% aviation, 40% other
- Jr. user initiated use of domain [www.sportys.com](http://www.sportys.com)  
Jr. user is a catalog recipient and pilot
  - Selling christmas trees

**sporty's**

SPORTY'S  
**MEN'S COLLECTION**  
STUFF GUYS WANT



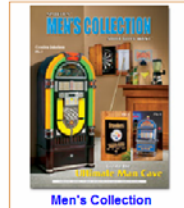
Pilot Shop



Wright Bros. Collection



Preferred Living



Men's Collection



Tool Shop

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## Alitalia-Linee v. Casinoalitalia (E.D.Va.2001)

- ACPA allow both in rem and in personam?
- VA long arm statute apply to foreign defendant? (yes)
- Sr. user airline mark ALITALIA means "Italian Wings"
- Jr. user online casino
  - Does "casino" mean "brothel" in Italian?
- Statutory construction arguments to conclude that the basis are mutually exclusive

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JOIN THE MILLEMIGLIA CLUB  
MileMiglia Program  
Join now

Code/Nickname:  PIN:

Remember me on this computer

**LOGIN**

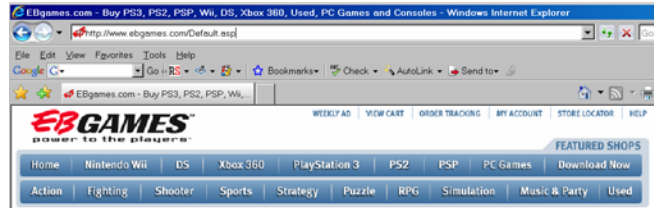
GET YOUR PIN

NEWS: FLIGHTS TO TIMISOARA AND KRAKOW ( 12/12/2007)

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## Electronics Boutique v. Zuccarini (E.D.Pa.2000)



- Sr. user marks EB and ELECTRONICS BOUTIQUE
- Mark application in queue for [www.ebworld.com](http://www.ebworld.com)
- Typosquatting and mousetrapping by Zuccarini (“utterly parasitic”)
- Damages . . .



## GlobalSantaFe Corp. v. GlobalSantaFe.com (E.D.Va.2003)

- Merger of users to senior user
  - GLOBAL MARINE } GLOBAL-SANTAFE
  - SANTA FE }

- Registrars:

Hangang



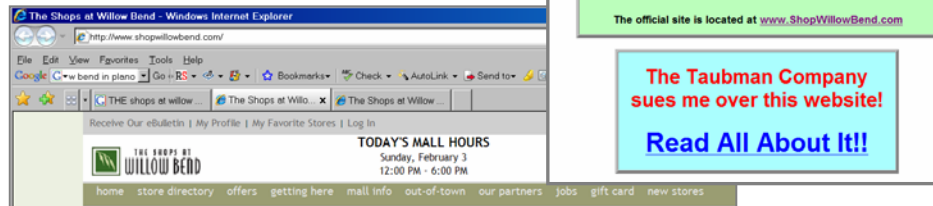
Verisign

- Registry Database held by a gTLD exclusive registrar versus a second-level domain registrar
- Question 2: “Internet ball in American cyberspace”

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

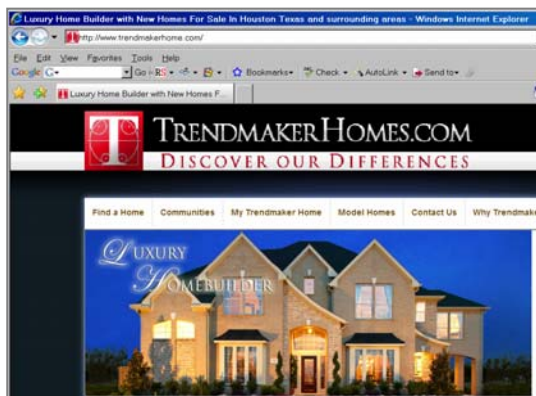
### Gripe Sites

- Sr. user: THE SHOPS AT WILLOW BEND
- Jr. user – no TM use if links to two other businesses come down
- No commercial use via “offer” to sell domain name
- No LofC
  - Helps the lost find their way



## TMI v. Maxwell (5th.2004)

- Sr. user mark TRENDMAKER HOMES
- Registrant – 1 year site telling story of dispute
- ACPA v. Dilution – commercial use requirement?
- Under ACPA, no bad faith intent to profit



## ICANN UDRP - Helfer & Dinwoodie

- Checking mechanisms on those implementing UDRP decisions over domain names
  - Built into the system's document ("creational")
  - External - national courts
  - Internal – compare to traditional arbitration panelists
- Standardization of procedures for challenging panelist partiality?
- External review by national courts
  - 10 days
  - Cause of action under local law?
  - Review jurisdiction by national court?
  - Unlikely to develop expert courts as registry companies disperse
  - Automatic enforcement w/out national courts
- Internal review
  - Selection of panelists
  - Published opinions



## Madonna v. Parisi & "Madonna.com" (WIPO.2000)

- Parisi involved w/ famous site  
[www.whitehouse.com](http://www.whitehouse.com)
- Parisi, as Respondent, does not have a persuasive set of legitimate interests in the domain name
  - No good reason to choose MADONNA
  - Not using Tunisia mark in that jurisdiction
  - Gift to hospital
  - Web site disclaimer is insufficient
- Bad faith acquisition = bad faith registration



### Weber-Stephen Prods. v. Armitage Hardware (N.D.III.2000)

- Weber: UDRP, then Fed. Dist. Ct., on successive days
- Armitage: motions for stays & other matters
- Court is not bound by ICANN Administrative Proceedings under the UDRP
- Degree of deference to give UDRP determination is a decision for another day



### Barcelona.com v. City of Barcelona (4th.2003)

- Spanish citizen w/ Del. corp. to own barcelona.com
- City Council awarded the domain via UDRP proceeding
- UDRP relevant for ACPA in two contexts
  - May limit liability of registrar
  - Authorizes suit in court
- Not jurisdictional
- Extension 5 after the case notes that that appellate court reverses the UDRP award to the City
  - No TM meaning in this geographic term, so City can't win under Lanhan act, which applies over Spanish law



## Registering Domain Names

- Brookfield case: fact of mere domain name registration of moviebuff.com isn't "use" for TM priority
- ICANN Registrar Accreditation Agreement (May 17, 2001)
- VeriSign Service Agreement terms excerpt
  
- Country code top level domains
  - .tv

## Registering Domain Names as Marks

- Use of characters comprising domain name as a mark in the eyes of the ordinary consumer
- Advertising one's own product or services on the internet isn't a service
- TLDs merely for DNS registry services
- Intent to use applications
- Surnames
- Descriptiveness
- Generic refusals
- Geographical marks
  - But, sometimes it is just a descriptiveness issue
- LofC

### **In re Dial-A-Mattress (Fed.Cir.2001)**

- Examiner and TTAB rejected mark application for 1-888-M-A-T-R-E-S-S
- Generic test: what is genus; does the term primarily refer to that genus
- Can dissect a compound word mark to prove genericness
- But, this is a phrase, not a compound word; generally judge marks as a whole
- Descriptive, but acquired distinctiveness