

Whose Name is it, Anyway? *Protecting Tribal Names from Cybersquatters*

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ABSTRACT

This article examines the remedies available to tribes to protect their tribal names from cybersquatting—a situation in which a registrant registers a mark or personal name as a domain name on the Internet and then exacts a price to turn the domain name over to the name's owner. It argues that the Anti-cybersquatting Consumer Protection Act (ACPA), the Uniform Domain Name Dispute Resolution Policy (UDRP), and related trademark law can be interpreted to protect tribal names. The article first outlines the technical requirements and protections of the provisions that provide protection against cybersquatting. The article argues that tribes can qualify for protection under the ACPA and the UDRP by establishing that their names are protected as descriptive marks that have acquired secondary meaning. Treating tribal names as descriptive terms that have acquired secondary meaning will enable the protection of tribal names through the interpretation of existing trademark law.

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I. INTRODUCTION

¶1 In 1999, the Native American Menominee tribe discovered that Thomas Weitz, a man from Wisconsin, had registered www.menominee.com and many other Internet domain names that used words closely associated with the tribe.¹ The tribe asked Mr. Weitz to donate the websites to them, arguing that the names were “unique to the tribe of Indians known as the Menominee and [were] inextricably part of the history, culture and ways of [the Menominee] sovereign . . . nation.”² He refused and offered to sell them the domain names, arguing that the tribe did not have trademarks on their names. He remarked: “If you don’t have a trademark, the Internet’s a big place.”³

¶2 Mr. Weitz was correct in one respect: without a trademark in a name, a party cannot successfully dispute the ownership of a domain name incorporating that name. Nevertheless, because the Menominee tribe conducts business as Menominee Casino, Bingo & Hotel,⁴ it was able to argue that the group had developed a trademark interest in the tribal name and therefore could sue under trademark law.⁵ This chain of events is common. Many tribes who have not registered their names as trademarks are faced with the question of how to protect their names from cybersquatting.

1. Gretchen Schuldt, *Menominee Tribe Suing Appleton Man Over Web Domains*, MILWAUKEE J. SENTINEL, Feb. 17, 2000, at 1D.

2. *Id.*

3. *Id.*

4. *Id.*

5. The tribe brought an action against the man. The case was later settled and voluntarily dismissed with stipulations by both parties in 2001. *Menominee Indian Tribe of Wisconsin v. Weitz*, No. 2:00-CV-00245 (E.D. Wis. filed Feb. 14, 2000). Currently, the website is on sale for \$3,688.00. See <http://www.menominee.com> (“Menominee.com is for sale! \$3,688.00”).

¶3 This article examines the remedies available to tribes to protect their tribal names from cybersquatting—a situation in which a registrant registers a mark or personal name as a domain name on the Internet and then extracts a fee to turn the domain name over to the name’s owner.⁶ In other words, cybersquatting is a form of extortion. At first, actions to protect names from cybersquatting were brought under traditional trademark laws. Today, however, the Anticybersquatting Consumer Protection Act (ACPA) and the Uniform Domain Name Dispute Resolution Policy (UDRP) are the two major mechanisms that protect names and marks from cybersquatting.

¶4 Section II of this article outlines the statutory provisions that provide protection against cybersquatting, their technical requirements, and the specific protections these provisions offer against cybersquatting. To obtain protection, claimants must establish a trademark interest in their name.⁷ Once a claimant has established a trademark interest in their name, the statutory provisions authorize a transfer of the domain name back to the rightful owner and, in some situations, monetary damages. The provisions were designed to prevent transfers of wealth from mark owners to cybersquatters when the transfer of wealth does not create a valuable social product.⁸

¶5 Section III argues that tribes⁹ can qualify for protection under the ACPA and the

6. Eric J. Moore, *Review of Selected 2000 California Legislation: Computer/Internet Chapter 218: Stopping Cybersquatters From Harming One of California’s Valuable Resources: Hollywood*, 32 MCGEORGE L. REV. 495, 496 (2001) (defining cybersquatting).

7. It is worth noting here, although this will not be the focus of the paper, that a tribe may arguably obtain protection under the ACPA’s “personal name” provision, which grants a cause of action against “any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party.” 15 U.S.C. § 1129(1)(A) (2000). To establish protection under section 1129, a court would have to interpret the term “living person,” which is left undefined, to include tribes as juristic “persons” in the same way that the term is defined in the Lanham Act, 15 U.S.C. § 1127 (2000). Courts should recognize tribes as juristic living persons given the unique political and legal precedent that treats tribes as sovereign political entities. As Terence Dougherty notes,

given the distinctiveness of historical and contemporary political treatment of Native Americans as a distinct group within the United States, and the fact that the 1934 Act organized Native American tribes as sovereign political entities, it is logical that a conception of group rights be available as a juridical tool when Native Americans (either as individuals or as tribes) litigate Native American concerns in U.S. courts.

Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 368 (1998). The U.S. has traditionally “approached the concerns of Native Americans as group concerns” both politically and juridically. *Id.* at 363. Treating a tribal name as the name of a “living person” is an extension of group right recognition. It is also worth noting that tribes may have a remedy under the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c) (2004), for the dilution of a famous mark. *See Lewittes v. Cohen*, No. 03 Civ. 189, 2004 U.S. Dist. LEXIS 9467, at *18 (S.D.N.Y. 2004) (holding that evidence that a journalist had achieved nationwide recognition and respect was sufficient to survive a motion to dismiss because the evidence demonstrated that his name operated as a famous service mark, protected under anti-dilution laws).

8. WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 180 (2003).

9. When “tribes” are discussed in this article, the term refers to the tribe as a whole, or to the tribal government. When individual members of a tribe are the subject of discussion, it will be clear from the text that the reference is to an individual or individuals.

UDRP by establishing that their names are protected as marks under these provisions. In determining whether tribal names qualify as trademarks under the ACPA and the UDRP, courts should classify tribal names as “descriptive” terms that have acquired “secondary meaning.” For descriptive terms to qualify for trademark protection, they must have obtained secondary meaning.¹⁰ Otherwise, granting property rights in such terms imposes social costs by preventing competitors from using common words to describe their goods and services and allowing mark owners to free ride on preexisting understandings of the words.¹¹ This section analyzes whether tribes can qualify for trademark protection under the ACPA and the UDRP, and argues that the purposes of these two provisions are in line with the protection of tribal names on the Internet.¹² Finally, Section IV offers conclusions and comments on larger issues raised by this article.

II. TRADEMARK PROTECTIONS AGAINST CYBERSQUATTING

¶6 The trademark provisions of the ACPA and UDRP are the primary mechanisms available for preventing cybersquatting.¹³ Congress enacted the ACPA in 1999.¹⁴ The

10. In order for descriptive terms to qualify for trademark protection, they must have obtained secondary meaning. As a general rule, descriptive terms must meet stringent requirements before obtaining trademark protection. *Canal Co. v. Clark*, 80 U.S. 311, 324 (1872). The reason why descriptive marks must meet more stringent requirements is because there are only a limited number of descriptive terms that can be used to describe goods and services. To grant a trademark property interest in such words prevents such words from being freely used. Moreover, because the word is descriptive, it comes with some pre-attached meaning, which would enable the potential trademark owner to take advantage of the meaning without putting in any additional work to increase the value of the mark. *See generally id.* at 324-25.

11. LANDES & POSNER, *supra* note 8, at 187.

12. There are several issues that should be flagged that are outside the scope of this article. One is the effect of the first-in-time–first-in-right nature of domain name registration. The first-in-time–first-in-right issue introduces another problem of allocation: the scarcity of domain names and the difficulty of determining which of several potentially valid mark owners has a right to a domain name. *See generally Anticybersquatting Consumer Protection Act Report*, S. REP. NO. 106-140 (1999) [hereinafter S. REP. NO. 106-140]; *Internet Domain Name Trademark Protection: Hearing before the Subcommittee on Courts and Intellectual Property of the House Judiciary Committee*, 105th Cong. (1997) (statement of Hon. Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, Patent and Trademark Office, U.S. Dept of Commerce), available at http://commdocs.house.gov/committees/judiciary/hju51543.000/hju51543_0.HTM. One of the major issues concerning allocation of domain names is that entitlements to domain names “are handled without any apparent concern for questions of distributive justice,” focusing instead on the “values of free speech, privacy, intellectual creation, and autonomy” to the detriment of Native American tribes. Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715, 796 (2003). Indeed, “Indigenous Peoples have been saying that the existing intellectual property right’s [sic] (IPR) system is completely inadequate to recognize and protect” their cultures. David J. Stephenson, Jr., *The Nexus Between Intellectual Property Piracy, International Law, the Internet, and Cultural Values*, 14 ST. THOMAS L. REV. 315, 319 (2001). These concerns, while pressing, are beyond the scope of this article. This article will also not address whether a tribe can meet other elements of the provisions of the ACPA and UDRP, whose requirements have been detailed thoroughly elsewhere. *See, e.g.*, Barbara A. Solomon, *Two New Tools To Combat Cyberpiracy—A Comparison*, 90 TRADEMARK REP. 679, 680-711 (2000).

13. Before the ACPA, trademark law, such as the Lanham Act and the Federal Trademark Dilution Act, provided only limited protection against cybersquatting. Congress feared that the Lanham regime, whose origin predates the rise of the Internet, left too many loopholes open for abuse by cybersquatters. *See* S. REP. NO. 106-140, *supra* note 12, at 5-6.

UDRP was established by the Internet Corporation For Assigned Names and Numbers (ICANN), an organization established to regulate and manage all domain names, and is the mandatory arbitration policy for settling domain name disputes for ICANN-accredited registrars.¹⁵

A. The Anticybersquatting Consumer Protection Act: Litigation in the United States

¶7 The ACPA enables a trademark owner to bring a civil action against any person who, with “a bad faith intent to profit from that mark,” “registers, traffics in, or uses a domain name” that is “identical or confusingly similar” to a distinctive or famous mark, including personal names which are protected as marks.¹⁶ In a departure from other, more stringent trademark protections that require a showing of specific harms, the ACPA enables a court to find a civil party liable for bad faith registration of a trademark as a domain name.¹⁷

¶8 Far from relaxing the requirements that give rise to civil liability, however, the ACPA adopts a metered approach to cybersquatting violations by requiring a showing of bad faith on the part of the domain name registrant.¹⁸ The ACPA’s requirement of bad faith exists to narrowly tailor protection to the prevention of cybersquatting.¹⁹ In adopting a metered approach, the ACPA avoids chilling innocent registration of trademarks as domain names by noncommercial parties.²⁰ Rather than being designed to grant ownership of domain names to trademark owners without regard to the validity of their interests, the ACPA prevents wealth transfers to free riding cybersquatters.²¹ The statute includes a non-exhaustive list of nine factors to guide courts’ evaluations of bad faith,²² but courts often forgo formal analysis of the statute’s factors in favor of an ad hoc determination based on the facts of each case.²³ If a party is successful under the ACPA and the domain name registrant falls within the jurisdiction of the United States, the party can obtain monetary relief in addition to transfer or cancellation of the domain name.²⁴

14. Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, Div. B, § 1000(a)(9) [Title III (§§ 3001 to 3010)], 113 Stat. 1536, 1501A-545 (1999) (codified at 15 U.S.C. §§ 1114, 1117, 1125, 1129 (2000)).

15. ICANN, *FAQs: What is ICANN?*, at <http://www.icann.org/faq/#WhatisICANN> (last modified June 9, 2004).

16. 15 U.S.C. § 1125(d)(1).

17. Compare 15 U.S.C. §§ 1114(1), 1125(a), (c) with 15 U.S.C. § 1125(d). See also Neil Martin, *The Anticybersquatting Consumer Protection Act: Empowering Trademark Owners, But Not the Last Word on Domain Name Disputes*, 25 J. CORP. L. 591, 603 (2000).

18. 15 U.S.C. § 1125(d)(1).

19. See S. REP. NO. 106-140, *supra* note 12, at 7; Melinda Giftos, *Reinventing a Sensible View of Trademark Law in the Information Age*, 2 CHI.-KENT J. INTELL. PROP. 2 (2000), at <http://jip.kentlaw.edu/art/volume2/2-1-2.htm>.

20. See S. REP. NO. 106-140, *supra* note 12, at 7; Giftos, *supra* note 19, at 2.

21. LANDES & POSNER, *supra* note 8, at 180.

22. See 15 U.S.C. § 1125(d)(1)(B).

23. See, e.g., *Sporty’s Farm LLC v. Sportsman’s Mkt.*, 202 F.3d 489, 499 (2d Cir. 2000); *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 269 (4th Cir. 2001); *N. Light Tech., Inc. v. N. Lights Club*, 236 F.3d 57, 64-65 (1st Cir. 2001).

24. 15 U.S.C. § 1125(d).

¶9 If the domain name registrant falls outside the jurisdiction of the United States or cannot be located, the ACPA allows mark owners to bring *in rem* actions against the domain name itself.²⁵ This expansion of *in rem* actions beyond disputes concerning real property is a novel development in the law,²⁶ and offers remedies to complainants who would otherwise be held hostage by cybersquatters beyond the reach of personal jurisdiction. Nevertheless, the *in rem* provision of the ACPA limits relief to recovery of the disputed domain name.²⁷ Any monetary damages must be recovered in a civil suit against the registrant.²⁸

B. The Uniform Domain Name Dispute Resolution Policy: Alternative Dispute Resolution in a Global Venue

¶10 The Internet Corporation For Assigned Names and Numbers (ICANN) is a non-profit private organization that provides “technical coordination” for the Internet.²⁹ ICANN was established “in October 1998 by ‘a coalition of the Internet’s business, technical, academic, and user communities’”³⁰ and takes responsibility for coordinating the assignment of Internet domain names, IP addresses, and other technical aspects of the Internet that must be standardized for the Internet to function properly.³¹ To coordinate the assignment of Internet domain names, ICANN has established the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP is “an alternative form of dispute resolution [designed] to combat cybersquatting”³² and avoid the high costs of litigating under the *in rem* provision of the ACPA. As such, dispute resolution under the UDRP provides a quick and less expensive solution to cybersquatting.

¶11 To bring a successful claim under the UDRP, a complainant must establish that the domain name is “identical or confusingly similar to a trademark or service mark in which the complainant has rights,” the registrar has “no rights or legitimate interests” in the domain name, and the “domain name has been registered and is being used in bad faith.”³³ Mark owners can bring UDRP administrative proceeding claims against registrants of domain names, as long as the registrants have registered the domain names through an ICANN accredited registrar.³⁴ Furthermore, participation in administrative proceedings under the UDRP is mandatory, and in order for a domain name registrar to be accredited by ICANN, a party must agree that any disputes regarding any domain

25. *Id.* § 1125(d)(2)-(4).

26. Martin, *supra* note 17, at 606-07.

27. 15 U.S.C. § 1125(d)(2)(D)-(3).

28. *Id.*

29. See ICANN, *ICANN Information*, at <http://www.icann.org/general/> (last modified Jan. 13, 2004).

30. Donna L. Howard, Comment, *Trademarks and Service Marks and Internet Domain Names: Giving ICANN Deference*, 33 ARIZ. ST. L.J. 637, 655 (2001) (explaining the role of ICANN) (quoting from ICANN’s Web site).

31. *ICANN Information*, *supra* note 29.

32. Dara B. Gilwit, Note, *The Latest Cybersquatting Trend: Typosquatters, Their Changing Tactics, and How to Prevent Public Deception and Trademark Infringement*, 11 WASH. U. J.L. & POL’Y 267, 282 (2003).

33. ICANN, *Uniform Domain Name Dispute Resolution Policy*, ¶ 4(a)(i)-(iii), at <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (Oct. 24, 1999) [hereinafter ICANN UDRP].

34. ICANN, *FAQs*, *supra* note 15.

name it registers are subject to resolution under the UDRP.³⁵ This provision expands on the *in rem* protections offered by the ACPA³⁶ and, in effect, creates global *in rem* jurisdiction over domain names that are registered by ICANN accredited registrars. The relief afforded by the UDRP is similar to the *in rem* provision of the ACPA, in that claimants can establish jurisdiction over the website itself, regardless of whether they can obtain jurisdiction over the registrant of the domain name. A successful claimant can cancel or acquire ownership of the domain name.³⁷ Unlike the ACPA, however, the UDRP does not provide any form of monetary relief.³⁸

C. Trademark Requirements

¶ 12 In order for tribes to claim the protection of the ACPA and the UDRP, they must first establish a trademark interest in their names.³⁹ Mark registration under the Lanham Act is not necessary.⁴⁰ Claimants must merely establish that they are “using some designation as a mark and the mark is distinctive.”⁴¹ Trade and service marks are any word or name used in commerce by a person to distinguish goods or services of the person from the goods and services of others and to indicate the source of the goods or services.⁴² To establish a group interest in a mark, groups can register collective marks—

35. ICANN recognizes various companies as official registrars authorized to register domain names on the Internet. See ICANN, *Registrar Accreditation: Overview*, at <http://www.icann.org/registrars/accreditation-overview.htm> (last modified Dec. 5, 2003). Because anyone seeking to register a domain name typically must go through one of ICANN’s official registrars, ICANN is able to require mandatory submission to the UDRP when a dispute over a domain name arises. See ICANN, *Domain Name Dispute Resolution Policies*, at <http://www.icann.org/udrp/> (last modified Mar. 23, 2005); ICANN, *Registrar Accreditation: Process*, at <http://www.icann.org/registrars/accreditation-process.htm> (last modified Dec. 5, 2003).

36. See *ICANN Information*, *supra* note 29.

37. ICANN UDRP, *supra* note 33, ¶ 4(i).

38. *Id.* ¶ 4(a)(i)-(iii) (“The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.”).

39. To qualify for trademark protection under the ACPA and the UDRP, a claimant will typically have to meet roughly the same standards. Differences in the standards applied are addressed in the next Section, although it suffices here to say that a UDRP claimant will likely have an easier time establishing ownership of a mark. See Solomon, *Two New Tools*, *supra* note 12, at 685-86 (noting that “panelists will generally look for guidance to the law of the country where the complainant is domiciled,” but “not all of the panels follow United States law to a tee”).

40. Neither the ACPA nor the UDRP requires registration of a mark for it to be protected as a trademark. *Id.* at 685. This lack of a registration requirement likely stems from the trademark theory that dictates that trademark registration does not necessarily establish trademark rights, but merely recognizes rights that were previously acquired by use. See Beverly W. Pattishall, *The Use Rationale and the Trademark Registration Treaty*, 2 A.P.L.A.Q.J. 97, 98-99 (1974). Despite the fact that neither the ACPA nor the UDRP requires trademark registration, registration does have benefits, such as a granting the trademark a presumption of validity and establishing a date of nationwide first use that will allow a mark owner to establish a priority interest in the trademark over others attempting to use the name. Thus, although tribes do not need to register their names under the Lanham Act, doing so would tend to strengthen any cybersquatting claims they might bring. See 15 U.S.C. § 1115(a) (2004); MarkLaw.com, *Benefits of Trademark Registration*, at <http://www.marklaw.com/trademark-FAQ/benefits.htm> (last visited June 26, 2005).

41. See Solomon, *Two New Tools*, *supra* note 12, at 685.

42. 15 U.S.C. § 1127.

trade or service marks that are “used by the members of a cooperative, an association, or other collective group or organization.”⁴³

¶ 13 Mark owners establish property rights in a mark by using the mark in commerce to designate the source of goods or services.⁴⁴ There are several elements to this inquiry. A court will first examine whether there are any *goods or services* being offered.⁴⁵ Next the court must determine whether the mark is “*used in commerce*” to designate the source of the goods or services. The first part of this inquiry looks to whether the mark is *used* in a trademark way to *designate the source of a product*.⁴⁶ In order for a name to be protected, the use of a mark must be actual,⁴⁷ “*bona fide*,”⁴⁸ and “*in commerce*”⁴⁹ to identify the source of a service or product⁵⁰ or “*in the sale or advertising of*” the service or product.⁵¹ Ownership is not acquired through use “made merely to reserve a right in a

43. *Id.*

44. *Id.*; See Pattishall, *supra* note 40, at 98-99.

45. Pattishall, *supra* note 40 at 98-99. The statute does not define what constitutes a “good” or “service,” although courts have attempted to fill in the definitions. When referring to “goods,” courts seem to use a broad definition that includes products or items. For examples of a range of items qualifying as “goods,” see *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 408, 410-12 (2d Cir. 1917) (syrup and flour); *Scarves by Vera, Inc. v. Todo Imps., Ltd*, 544 F.2d 1167, 1169-70 (2d Cir. 1976) (perfume and cosmetics); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1328 (7th Cir. 1977) (deodorant and baking soda); *In re Mars, Inc*, 741 F.2d 395, 396 (Fed. Cir. 1984) (candy bars and fresh citrus fruits). For a discussion of “services,” see *Am. Int’l Reinsurance Co. v. Airco, Inc*, 570 F.2d 941, 943 (C.C.P.A. 1978), *cert. denied*, 439 U.S. 866 (1978) (suggesting that the term “services” be “liberally construed”).

46. 15 U.S.C. § 1127. A non-trademark use of a word is use in a “way that does not identify the source of a product” or service. *Id.* Whether a mark is “used” is a complicated question. The analysis changes depending on the type of suit that is brought. For example, although a plaintiff bringing a trademark infringement claim must establish that the defendant “used” the mark in commerce, some infringement cases are not the “usual trademark cases” where the defendant is “using a mark to identify its goods that is similar to the plaintiff’s trademark.” *Interactive Prods. Corp. v. A2Z Mobile Office Solutions, Inc.*, 326 F.3d 687, 695 (6th Cir. 2003) (holding that the defendant’s use of the plaintiff’s mark in the post-domain path name of the defendant’s website did not constitute use in commerce). Moreover, “[u]se is not established merely because trademarks are simultaneously visible to a consumer.” *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 728 (E.D. Va. 2003) (holding that a display of Internet pop-up advertisements that appeared when a user went to U-Haul’s website did not constitute use). If a mark is not used to advertise or promote a good or service or used in a manner that hinders or impedes consumers’ access to websites, there is no “use” for infringement purposes. *Id.* at 727-29. See also *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467, 489 (S.D.N.Y. 2003) (holding that infringement use is not an issue of whether the “Plaintiff adequately used its mark to establish a valid service mark, [but rather] the question is whether the *Defendant* is ‘using’ Plaintiff’s trademark,” implying that there is a different standard for these two questions) (emphasis in original). Suffice it to say that courts seem to agree that in order for a plaintiff to prove the mark is “used in commerce,” the plaintiff must use it to “identify or distinguish the services being offered.” *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 106 F.3d 355, 361 (11th Cir. 1997) (holding that mere display of a mark on a sign on an interior wall of the plaintiff’s restaurant did not constitute a valid service mark use).

47. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916) (“[T]he right grows out of use, not mere adoption.”).

48. 15 U.S.C. § 1127.

49. *Id.*

50. *Interactive Prods. Corp.*, 326 F.3d at 695; *Lone Star Steakhouse*, 106 F.3d at 361.

51. 15 U.S.C. § 1127.

mark.”⁵² A mark must also be used in *commerce*.⁵³

¶ 14 The court will also look to how the mark is used in relation to the goods or services offered in order to determine the standard under which a potential owner’s interest will be judged.⁵⁴ There are five kinds of marks: (1) generic;⁵⁵ (2) descriptive;⁵⁶ (3) suggestive;⁵⁷ (4) arbitrary;⁵⁸ and (5) fanciful.⁵⁹ In determining the “amount of use necessary to create protected rights” in a word or words, courts will classify the words as “strong” or “weak” marks that are respectively entitled to more or less protection.⁶⁰

¶ 15 Descriptive marks are subject to a higher level of scrutiny than suggestive, arbitrary, and fanciful marks because they are not protectable or registrable unless the mark holder can establish that such marks carry “secondary meaning,”⁶¹ which is a “distinctiveness that serves to identify the product with its manufacturer or source.”⁶² Secondary meaning is required to prevent the mark from being “incapable of identifying the good,” and thus undermining the policy rationales behind granting trademark protection (i.e. lowering the cost of searching for suitable products).⁶³ If secondary meaning were not required, a seller would be able to capitalize on the prior meaning of the word without having attached any additional value to the mark.⁶⁴ Additionally, granting legal protection to a purely descriptive mark would “be likely to prevent [competitors] from using identifiers that they require in order to be able to compete efficiently” by being able to describe their product.⁶⁵ In other words, descriptive terms must acquire secondary meaning to justify granting trademark protection in order to ensure that the term’s “primary significance in the minds of the consuming public is not

52. *Id.*

53. *Id.*

54. Courts classify words in order to determine how easily they can attain mark protection. *Duluth News-Tribune, a Div. of Northwest Publ’ns, Inc. v. Mesabi Publ’g Co.*, 84 F.3d 1093, 1096 (8th Cir. 1996) (“As a preliminary matter, we must determine whether plaintiff’s mark is strong enough to merit trademark protection.”).

55. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (defining “generic” as referring to “the genus of which the particular product is a species”).

56. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (defining “descriptive” as referring to “a characteristic or quality of an article or service” (quoting *Vision Center v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1980))).

57. *Id.* at 791 (defining suggestive marks as requiring the exercise of “the imagination in order to draw a conclusion as to the nature of the goods and services”).

58. *Id.* (referring to arbitrary marks as common words “applied in an unfamiliar way”).

59. *Abercrombie & Fitch*, 537 F.2d at 11 n.12 (defining fanciful marks as “words invented solely for their use as trademarks”).

60. *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219, 1243 (D. Colo. 1976), *aff’d*, 561 F.2d 1365 (10th Cir. 1977).

61. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (descriptive marks may acquire distinctiveness which will allow them to be protected, and this acquired distinctiveness is generally called “secondary meaning”); *see also Zatarains*, 698 F.2d at 791 (stating that “a descriptive term may be elevated to trademark status with proof of secondary meaning”).

62. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001)

63. LANDES & POSNER, *supra* note 8, at 187.

64. *Id.*

65. *Id.*

the product itself, but the identification of it with a single source.”⁶⁶

¶16 Suggestive, arbitrary, and fanciful marks, on the other hand, are usually protected without any additional showing of secondary meaning because granting property interests in such words neither prevents competitors from describing their products nor encourages free riding on available words.⁶⁷

III. TRIBAL NAME PROTECTION UNDER THE ACPA AND UDRP

A. Tribal Names and Statutory Requirements

1. Anticybersquatting Consumer Protection Act

¶17 Courts will engage in two inquiries to determine whether a tribal name qualifies for mark protection under the anticybersquatting provisions: (1) whether the name is in fact being used in commerce as a mark to identify a product or service; and (2) the amount of use required for the name to be protected as a mark. A court will first determine whether a tribal name is being *used in commerce* as a mark to distinguish *goods* or *services* “from those manufactured or sold by others and to indicate the source of goods [or services], even if that source is unknown.”⁶⁸ Under the Lanham Act, a mark is “used in commerce” on goods when

(A) it is placed . . . on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods, and (B) the goods are sold or transported in commerce.⁶⁹

A service mark is “used in commerce” when it is used

in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.⁷⁰

In order to determine whether a tribal name is being used in commerce as a mark to distinguish the source of goods or services, a court will first analyze whether the tribe is in fact providing goods or services that are sold, transported, or rendered in commerce. Given that courts have adopted a broad definition of “goods,”⁷¹ a court will likely find

66. *Big O Tire Dealers*, 408 F. Supp. at 1243 (stating that in order to acquire secondary meaning, a “merely descriptive term used as a trademark must have been so used that its primary significance in the minds of the consuming public is not the product itself, but the identification of it with a single source”).

67. *Zatarains*, 698 F.2d at 790-91; 15 U.S.C. § 1052(e)(1)-(5), LANDES & POSNER, *supra* note 8, at 188.

68. 15 U.S.C. § 1127.

69. *Id.*

70. *Id.*

71. *Id.* See also *Aunt Jemima Mills*, 247 F. at 409-10.

that a tribe produces or sells goods if it produces or sells any tangible product, food, or artwork, as a tribe. If a tribe does not produce or sell goods, it may still be able to qualify for protection under these statutes if it can establish that it provides a “service.”⁷² The ACPA makes “no attempt” to “define ‘services’ simply because of the plethora of services that the human mind is capable of conceiving.”⁷³ As a result, courts have also adopted a broad definition of “services,” stating that an act can qualify as a “service” if it is “performed to the order of or for the benefit of others than” the mark owner.⁷⁴ Thus, a court will likely find that a tribe that runs a museum or casino, gives tours of historical locations, or even provides historical information about itself, provides a service because it performs functions for the benefit of others—the public.

¶ 18 In addition to establishing that a good or service is provided, a tribe must establish that it *uses* its tribal name as a mark to *designate the source* of the goods or services *in commerce*. A court will first look at whether a term is actually⁷⁵ used as a trademark.⁷⁶ The primary purpose of a trademark “is to provide a means for the consumer to separate or distinguish one manufacturer’s goods from those of another.”⁷⁷ Thus, the term must be used in a “way sufficiently public to identify or distinguish the marked” goods or services as those originating from the mark owner.⁷⁸ In other words, the tribe must use its tribal name to identify itself as the source of its goods or services. The Cherokee tribe, for example, could use its mark to designate itself (the tribe) as the source of a piece of art.

¶ 19 Next, a court will look at whether the mark is used *in commerce*. Although “commerce” is typically understood to refer to sales, the Lanham Act recognizes that different legal entities engage in commerce in different ways.⁷⁹ For-profit companies

72. 15 U.S.C. § 1127.

73. *Am. Int’l Reinsurance Co.*, 570 F.2d at 943.

74. *In re Canadian Pac. Ltd.*, 754 F.2d 992 (Fed. Cir. 1985).

75. See *Hanover Star Milling Co.*, 240 U.S. at 405-10 (focusing on the requirement that a mark must be actually used).

76. 15 U.S.C. § 1127. A non-trademark use of a word “does not identify the source of a product” or service. *Interactive Prods. Corp.*, 326 F.3d at 695.

77. *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1264 (5th Cir. 1975).

78. *New Eng. Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951). See also *Coca-Cola Co. v. Busch*, 44 F. Supp. 405 (E.D. Pa. 1942).

79. An instructive example of the distinction between the commercial and non-commercial use of a mark is provided in *HQM, Ltd. v. Hatfield*, 71 F. Supp. 2d 500 (D. Md. 1999). The Plaintiff, HQM, used the HATFIELD mark in connection with its sale of meat products under a HATFIELD logo, clearly a “commercial use.” By contrast, the defendant, Mr. Hatfield, used “Hatfield,” his own last name, in registering the “hatfield.com” domain name and using it for personal email. *Id.* at 501, 503. Mr. Hatfield’s use of the mark was found not to constitute “commercial use,” as there was no allegation that he was conducting any business using the domain name or was interested in selling the domain name itself. For examples of companies engaging in commerce sufficient to qualify for trademark protection, see sources cited *supra* note 45; *Jones v. U.S.*, 529 U.S. 848, 848-49 (2000) (describing the “use-in-commerce” requirement of a federal arson statute which punished the burning of any building used in commerce and stated that the “use-in-commerce requirement is most sensibly read to mean active employment for commercial purposes, and not merely a passive, passing, or past connection to commerce”); *Am. Int’l Reinsurance Co.*, 570 F.2d at 943 (stating that a company’s program that administered annuity plans for its employees was a service within the meaning of the Lanham Act sufficient to qualify for trademark protection, regardless of the fact “that the services in question are not applicant’s principal trade or business”).

might sell shares, goods, or services, while non-profit organizations might solicit donations. Most charities also have some sales—for example, transactions in museum gift shops. Under these circumstances, both actors can be described as engaging “in commerce.” The only difference is the way they are raising capital. Similar to non-profit organizations, tribes also pursue ways of raising capital. When a tribe places its tribal name on goods or documents it sells,⁸⁰ the tribal name is being used in commerce. For example, a tribe running a gift shop on the tribal reservation might affix the tribal name to the items sold in the gift shop.

¶20 The standard for services is more amorphous. A mark will be protected as a service mark when the mark for that service is “used or displayed in the sale or advertising of that service”⁸¹ and the services are either “rendered in commerce” or the services are rendered in (1) “more than one State” or (2) “in the United States and a foreign country” and (3) “the person rendering the services is engaged in commerce in connection with the services.”⁸² If a tribe provides free services, engages in some “commerce in connection with the services,” and renders the services “in more than one State or in the United States and a foreign country,” then that tribe is engaging *in commerce* under the statute.⁸³ Thus, if a tribe seeks to provide information pamphlets on the tribe’s activity that benefits a party other than itself (a service), advertises the pamphlets under the name of the tribe (uses its name as a mark to advertise and designate the source of the service), attempts to solicit donations from visitors, and buys supplies to produce more pamphlets (engaging in commerce in connection with the provision of the services), a court should find that the tribe used its tribal name as a service mark because such activities should fall under the statutory language of the Lanham Act.

¶21 Once a court decides that a tribal name is being used as a mark it will next evaluate the amount of use required for protection under the ACPA based on the mark’s relationship to the goods or services provided. To do so, a court must determine whether the mark is generic, descriptive, suggestive, arbitrary, or fanciful in relation to the goods or services with which it is associated. If the tribal name is considered suggestive, arbitrary, or fanciful at the time the name was registered as a domain name, it automatically may qualify for protection against cybersquatting under the ACPA, provided other statutory requirements are also met.⁸⁴ In most instances, however, tribal names will not be characterized as suggestive, arbitrary, or fanciful.⁸⁵ Furthermore, if a

80. 15 U.S.C. § 1127.

81. *Int’l Bancorp v. Societe Des Bain De Mer Et Du Cercle Des Etrangers a Monaco*, 329 F.3d 359, 372 (4th Cir. 2003).

82. 15 U.S.C. § 1127.

83. *Id.*

84. *Id.* § 1125(d).

85. Arguments can be made that tribal names should be classified as suggestive, arbitrary, or fanciful, but none of these designations accurately depicts tribal names. Suggestive marks are those that give some indication of the goods or services being offered but are not descriptive in the sense that “an effort of the imagination on the part of the observer” is required to know their nature. *Gen. Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir. 1940). A tribal name like “Cherokee” does not necessarily require an imaginative leap to connect it to the goods being offered because it merely describes the source or quality of the goods or services. Similarly, an “‘arbitrary’ word is one which is in common linguistic use but when used with the goods in issue it neither suggests nor describes any ingredient, quality, or characteristic of

tribe's name is considered generic, it will automatically be denied protection.⁸⁶ However, a tribal name is not generic when used to designate the source of goods or services that the tribe provides.⁸⁷ Therefore, in most cases, a tribal name will be characterized as descriptive. If a court deems a tribal name descriptive, the tribe must then establish that the name has acquired secondary meaning in order for it to be given protection as a mark. The secondary meaning requirement for descriptive terms adds an additional step for gaining protection from cybersquatting under the ACPA.⁸⁸

¶ 22 Tribal names qualify for trademark protection as descriptive terms with secondary meaning. A descriptive term is one that “draws attention to the ingredients, quality, or nature of the product. For example, “Tender Vittles” as applied to cat food is descriptive.”⁸⁹ Surnames and geographic terms are also examples of descriptive terms.⁹⁰ Tribal names used in connection with goods or services denote a certain quality or describe the nature of the good or service. In the same way that the term “German Beer” denotes a certain quality of beer, “Cherokee beads” denotes a certain quality of artwork. In addition to referring to a quality or nature of a particular good or service, tribal names are unique in that they identify the source of the good or service—i.e., it comes from the particular tribe. The term “Cherokee beads,” for example, in addition to denoting the quality of the good, also denotes that the beads originate from the Cherokee tribe.

¶ 23 Descriptive terms receive less protection under trademark law because descriptive language is limited and should be universally available to others who would like to use it

those goods. OLD CROW for whiskey is an example of an arbitrary word.” *Big O Tire Dealers*, 408 F. Supp. at 1243. Tribal names, however, suggest qualities and characteristics of goods in the same ways that any ethnic terms describe goods—in a descriptive fashion, which makes it inherently not an arbitrary term. It also seems unlikely that a court would consider a tribal name a fanciful term. Fanciful terms are those coined “for the sole purpose of functioning as a trademark.” *Id.* It is unlikely, however, that a court would extend this definition to include a name “coined” not for trademark purposes, but for the sole purpose of designating a group of people such as a tribe, especially if the court were to construe this standard strictly.

8615 U.S.C. § 1052(e)(1)-(5). A generic term “is one which is the language name for the product. BUTTER is the language word for butter.” *Big O Tire Dealers*, 408 F. Supp. at 1243.

87. Tribal names, when used to designate a source of goods or services, cannot be generic, because they are the language words for tribes—not for the goods or services. The only use of a tribal name that should be considered generic is use of the tribal name to reference the tribe itself. When used to refer to something other than the tribe, the word should no longer be considered “generic.”

88. 15 U.S.C. § 1125(d).

89. *Big O Tire Dealers*, 408 F. Supp. at 1243; see also 6 WILLIAM MEADE FLETCHER ET AL., FLETCHER CYCLOPEDIA OF PRIVATE CORPORATIONS § 2427 (2005); *Elgin Nat'l Watch Co. v. Ill. Watch Case Co.*, 179 U.S. 665, 676 (1901).

90. See, e.g., *Ford Motor Co. v. Ford d/b/a Ford Records*, 462 F.2d 1405, 1407 (C.C.P.A. 1972), cert. denied, 409 U.S. 1109 (1973) (holding that there is no right to use a surname when it will be confused with a name that has already acquired source indicating significance); *Barcelona.com v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 629 (4th Cir. 2003) (stating that because the City of Barcelona did not own and did not use any trademarks in the United States to identify any goods or services, and thus had not acquired secondary meaning, the name “Barcelona” should be treated as a “purely descriptive geographical term entitled to no trademark protection”); *Cmty. of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494 (2d Cir. 1962) (holding that if a geographical name acquires secondary meaning it can be registered as a trademark.).

in the same competitive market.⁹¹ The use of such terms for trade identity purposes is so common that courts are hesitant to grant exclusive rights to any one owner. Like descriptive terms, tribal names could be thought of as terms that should be universally available to all to describe goods or services, and thus subject to more stringent requirements for obtaining trademark protection.⁹²

¶ 24 If a court classifies a tribal name as descriptive, the tribe must then prove that the term has acquired secondary meaning to gain protection against cybersquatting. A descriptive term acquires secondary meaning when the name has become “distinctive of the applicant’s goods [or services] in commerce.”⁹³ Secondary meaning, or distinctiveness, establishes the link between the mark and the product.⁹⁴ Without it, the mark in question would fail to designate the specific source of the good or service, and would allow the mark owner to prevent other producers from describing their own goods and services.⁹⁵ Moreover, allowing ownership of descriptive terms without requiring them to have added value (source identifying power) would allow owners to free ride on the meaning attached to the descriptive term.⁹⁶ To determine whether a term has acquired secondary meaning, relevant factors include the length and manner of use, the manner and extent of advertising and promotion, sales volume, and evidence that potential purchasers view the mark as indicating the product’s source.⁹⁷

¶ 25 When used in connection with goods or services, most, if not all, tribal names will have acquired secondary meaning. Tribal names inherently identify a source—the tribe. For all federally recognized tribes, a source-identifying quality of a tribal name has been acquired through years of the name being used to identify the tribe. Thus, when tribes use their tribal names in association with goods or services they provide, such as the Menominee Casino, Bingo & Hotel, many consumers automatically think that the source of those goods or services is the tribe.⁹⁸

¶ 26 Moreover, with respect to arts and crafts, the secondary meaning of tribal names

91. See FLETCHER, *supra* note 89 § 2427; *Am. Waltham Watch Co. v. U.S. Watch Co.*, 173 Mass. 85, 86-87 (1899); *City of Coral Gables v. Rosenthal*, 141 So. 2d 632 (Fla. App. 1962) (“[T]he general rule is that geographical names are regarded as common property, and a trade name of this type usually cannot be exclusively appropriated, especially when the article to which it is applied is the product of the place designated.” (citations omitted)).

92. If a court grants mark protection to a tribal name, it should consider the tribal name a collective mark, which is a trade or service mark that can be used for trade purposes by any member of an association. 15 U.S.C. § 1127. A collective mark would enable individual tribal members to use the tribal name in accordance with the standards set forth by the tribe. In addition, the court should grant the collective mark to the tribal government, rather than to any individual tribal member because so many individual members of the tribe will likely want to use the mark. Furthermore, the tribal government is the best user of a domain name that contains the tribe’s name because it represents the interests of the individual members.

93. 15 U.S.C. § 1052(f).

94. *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 747 F.2d 81, 90 n.10 (2d Cir. 1984).

95. See *Canal Co. v. Clark*, 80 U.S. 311, 327 (1872).

96. LANDES & POSNER, *supra* note 8, at 187.

97. *Platinum Mortgage Corp. v. Platinum Fin. Group*, 149 F.3d 722, 728 (7th Cir. 1998).

98. *Cf. Native Am. Arts, Inc. v. Waldron Corp.*, 399 F.3d 871, 874 (7th Cir. 2005) (stating that consumers may be confused when sellers use a tribal name in connection with non-Native American goods and services without qualifying that the good or service did not come from a Native American group).

has been statutorily prescribed. The Indian Arts and Crafts Act⁹⁹ prohibits selling a good “in a manner that falsely suggests it is . . . an Indian product.”¹⁰⁰ Under the Act, “the unqualified use of the term ‘Indian’ or . . . of the name of an Indian tribe . . . in connection with an art or craft product is interpreted to mean . . . that the art or craft product is an Indian product.”¹⁰¹ Essentially, the Act “makes ‘Indian’ the trademark denoting products made by Indians.”¹⁰² Thus, a “non-Indian maker of jewelry designed to look like jewelry made by Indians is free to advertise the similarity but if he uses the word ‘Indian’ [or any other tribal name] he must qualify the usage so that consumers aren’t confused and think they’re buying not only the kind of jewelry that Indians make, but jewelry that Indians in fact made.”¹⁰³

¶ 27 Once a tribe establishes that it has a trademark in its name, it must then meet the ACPA requirements to protect its domain name against cybersquatters. To do so, a tribe must establish that the registrant had a bad faith intent to profit from that mark and registered, trafficked in, or used a domain name that was “identical or confusingly similar,” “without regard to the goods or services of the parties,” to the mark at issue.¹⁰⁴ These requirements have been examined in detail elsewhere.¹⁰⁵

2. Uniform Domain Name Dispute Resolution Policy

¶ 28 The UDRP generally applies looser interpretations of trademark law than the ACPA.¹⁰⁶ The UDRP requires a mark owner to establish that the domain name is “identical or confusingly similar to a trademark or service mark in which the complainant has rights,” that the registrar has “no rights of legitimate interests in respect of the domain name,” and that the “domain name has been registered and is being used in bad faith.”¹⁰⁷

¶ 29 UDRP administrative panels, though they often refer to United States trademark law for guidance, do not rigidly follow that law.¹⁰⁸ For example, the complainant need

99. 25 U.S.C. §§ 305 et seq.

100. *Id.* § 305e(a).

101. 25 C.F.R. § 309.24(a)(2) (2004).

102. *Native Am. Arts*, 399 F.3d at 873.

103. *Id.* at 874.

104. 15 U.S.C. § 1125(d)(1).

105. See, e.g., Solomon, *Two New Tools*, *supra* note 12, at 686; Oliver R. Gutierrez, Comment, *Get Off My URL! Congress Outlaws Cybersquatting in the Wild West of the Internet*, 17 SANTA CLARA COMPUTER & HIGH TECH. L.J. 139, 161-66 (2000); Marc Lorelli, Note, *How Trademark Litigation Over Internet Domain Names Will Change After Section 43(d) of the Lanham Act*, 78 U. DET. MERCY L. REV. 97, 114-26 (2000).

106. See Solomon, *Two New Tools*, *supra* note 12, at 686 (discussing examples in which UDRP administrative panels have loosely interpreted trademark law); see also Barbara A. Solomon, *Domain Name Disputes: New Developments and Open Issues*, 91 TRADEMARK REP. 833, 843-45 (2001) (discussing examples in which UDRP administrative panels have expanded the protections offered by the UDRP beyond the text of the UDRP).

107. ICANN UDRP, *supra* note 33, ¶ 4(a)(i)-(iii).

108. See Solomon, *Two New Tools*, *supra* note 12, at 685-86 (“[P]anelists will generally look for guidance to the law of the country where the complainant is domiciled . . . , [but] not all of the panels follow United States law to a tee.” (citations omitted)).

not have a registered mark in order to qualify for protection under the UDRP.¹⁰⁹ Indeed, a complainant can establish rights “in a mark merely by filing an intent to use application—an option that is not supported by the Lanham Act.”¹¹⁰ Additionally, a “complainant does not have to show that he or she has obtained rights in the mark worldwide or even in the country where the domain name registrant is located.”¹¹¹

¶ 30 Moreover, UDRP administrative panels are not bound by rigid applications of the text of the UDRP.¹¹² UDRP administrative panels have interpreted the UDRP to include protection of famous personal names, famous geographic names, and rights of publicity, regardless of whether those words were registered as trademarks.¹¹³ Thus, UDRP panels might view the claims of tribes, legal entities similar to corporations, with favor.¹¹⁴

¶ 31 Given that the UDRP does not require entities to have a valid trademark in their name in order to offer them protection against cybersquatting, tribes seeking protection against cybersquatting may have an easier time prosecuting their claims against cybersquatting under this regime.

¶ 32 Once a tribe establishes a trademark in its name, it must establish the additional

109. *Id.* at 685.

110. *Id.* at 686 (citations omitted).

111. *Id.*

112. See Solomon, *Domain Name Disputes*, *supra* note 106, at 843 (noting that although the UDRP was originally drafted to address domain names that infringe trade or service marks, it “is being regularly employed to deal with the abusive registration of famous personal names and also has been employed to address the registration of place names”).

113. *Id.* at 843, 851-54. In an August 2000 UDRP decision regarding the domain name *barcelona.com*, for example, the panel wrote that the registrant was “definitely taking advantage of the normal confusion of the public which by using a Barcelona route in Internet would normally expect to reach some official body or representative of the city of Barcelona itself.” *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc.*, WIPO Case No. D2000-0505 (2000), available at <http://www.arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html>. The panel found it important that, “for the public at large, when thinking of ‘Barcelona,’ the first and only city that is reasonably thought of, is the city of Barcelona in Spain.” The decision ultimately transferred the domain name to the city government, relying on the fact that the city had registered many domain names with the word “Barcelona” in it under Spanish trademark law, and relying on the provisions of the UDRP. *Id.* This decision indicates that UDRP panels may be more inclined to act favorably towards claimants with nontraditional trademark claims than courts applying the ACPA. This decision, however, was effectively overturned by a federal court opinion when the registrant filed a declaratory action under the ACPA seeking an order that the City of Barcelona had no trademark in the domain name. *Barcelona.com v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617 (4th Cir. 2003). The Fourth Circuit found that, because the City did not own and did not use any trademarks in the United States to identify any goods or services, it had not acquired secondary meaning, and the name “Barcelona” thus should be treated as a “purely descriptive geographical term entitled to no trademark protection.” *Id.* at 629. This judicial decision indicates that courts may police UDRP panel decisions when they run afoul of United States trademark laws. The basis for the Fourth Circuit’s opinion, however, is not dispositive on the issue of whether tribal names should be protected as trademarks—as previously argued, tribal names are not geographic terms.

114. The WIPO panel has not yet amended the UDRP to explicitly provide protections for government entities, although governments may be able to obtain protection under existing laws if they can establish that their names are marks. *Virtual Countries, Inc. v. Republic of South Africa*, 300 F.3d 230, 233 (2d Cir. 2002). If WIPO does amend the UDRP, this may be another option for tribes seeking to protect their names.

elements of a UDRP claim. A complainant must establish that the domain name is “identical or confusingly similar to a trademark or service mark in which the complainant has rights,” that the registrar has “no rights or legitimate interests” in the domain name, and that the “domain name has been registered and is being used in bad faith.”¹¹⁵ These requirements are discussed in detail in other scholarship.¹¹⁶

B. The Purposes of ACPA and UDRP Align with the Reasons for Protecting Tribal Names

¶ 33 The ACPA and UDRP were enacted to enable mark owners to protect their reputations and economic interests by protecting their marks from cybersquatters. The reasons why the ACPA and the UDRP were enacted also justify the protection of tribal names from cybersquatting. Tribes have economic and reputational interests in the protection of their tribal names, just as any other individual or company has such interests in the protection of their personal name or trademark.

¶ 34 Tribes have economic interests in their names that justify preventing cybersquatting on their names. The impetus for the ACPA is rooted in preventing cybersquatting on domain names bearing names that, if held hostage, will yield a profitable return and prevent the name’s owner from being able to use the website to their own benefit.¹¹⁷ Tribes are in just as much danger of cybersquatting as are companies, non-profit organizations and even individuals, to whom express protection against cybersquatting has been clearly extended.¹¹⁸ Tribes are economic, social, and political entities. If part of the goal of the legislation is to prevent others from capitalizing on the familiarity and value of names by registering domain names identical to a trademark,¹¹⁹ then there is good reason to prevent cybersquatters from capitalizing on the familiarity and value of tribal names.

¶ 35 Not only do tribes have an economic interest in their names, but tribes also have an interest in protecting their reputations from harmful cybersquatters. The ACPA was designed to “combat a new form of high-tech fraud” that destroys reputations by enabling cybersquatters to “engage in a variety of nefarious activities—from the relatively-benign parody of a business or individual, to the obscene prank of redirecting an unsuspecting consumer to pornographic content, to the destructive worldwide slander of centuries-old

115. ICANN UDRP, *supra* note 33, at ¶ 4(a)(i)-(iii)

116. *See* Solomon, *Two New Tools*, *supra* note 12, at 680-700.

117. *See* 145 Cong Rec. S14986, S15019 (daily ed. Nov 19, 1999) (quoting Sen. Hatch reacting to an ESPN story regarding people who were buying domain names based on the personal names of promising high school athletes in the hope of profiting if those athletes became famous).

118. Congress also enacted a personal name provision in the ACPA, which protects the names of “living persons” from cybersquatting. 15 U.S.C. § 1129.

119. *See* source cited *supra* note 117; *Cybersquatting and Consumer Protection: Ensuring Domain Name Integrity*, Hearing before the S. Comm. on the Judiciary, 106th Cong. (1999) (statement from Anne H. Chasser, President of the International Trademark Association) available at <http://judiciary.senate.gov/oldsite/72299ac.htm> (last visited July 3, 2005).

brand name.”¹²⁰ In the same way that companies have an interest in preventing damage done by misleading cybersquatters, tribes also have a strong interest in preventing the denigration of their names, identities, and personhood.¹²¹ Treating tribes as juristic entities with a right to protect their names from cybersquatters is a logical extension of trademark laws and is analogous to using trademark laws to protect non-profit corporations’ identities.

IV. CONCLUSION

¶ 36 Tribes can seek protection against cybersquatting under the ACPA and UDRP. To protect their names, however, tribes will first have to establish that their tribal names are protectable as marks. To satisfy this requirement, tribes should argue that their names are descriptive terms that have obtained secondary meaning and are used in commerce to designate the source of the tribe’s goods or services. Because UDRP arbitration panels appear willing to extend protection against cybersquatting to non-traditional types of plaintiffs, tribes should first seek to protect their names under the UDRP. Enabling tribes to obtain protection of their names from cybersquatting on the Internet will help them protect their economic interests and their reputations. Conceiving of tribes as groups with economic interests will not only help tribes protect their names from cybersquatting, but will also help combat the myth that Native Americans exist solely in museums as “noble savages”¹²² by recognizing and treating tribes as groups that exist in today’s world with modern concerns and modern interests.

120. See [145 Cong Rec. S7325, S7334](#) (daily ed. June 21, 1999) (statement of Sen. Abraham).

121. For a discussion of how intellectual property issues affect tribal integrity, see Dougherty, *supra* note 7, at 376 (1998); Jessica Herrera, *Not Even His Name: Is the Denigration of Crazy Horse Custer’s Final Revenge?*, 29 HARV. C.R.-C.L. L. REV. 175, 177 (1994) (addressing litigation to prevent the use of the likeness of a Native American chief by a liquor distributor); MICHAEL F. BROWN, WHO OWNS NATIVE CULTURE 236 (Harvard 2003).

122. For a discussion of myths surrounding Indians, see Kristal Markowitz, Comment, *Cultural Tourism: Exploration or Exploitation of American Indians?*, 26 AM. INDIAN L. REV. 233, 240-43 (2001-2002); Glen Stohr, Comment, *The Repercussions of Orality in Federal Indian Law*, 31 ARIZ. ST. L.J. 679, 684-87 (Summer 1999).