

A Primer on Recent Domain Name Disputes

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I. Introduction

1. "Welcome to cyberspace!"^[1] In 1981 the Internet consisted of a mere 300 computers.^[2] By 1989, that number had increased to fewer than 90,000.^[3] At this stage in its evolution, the Internet (or "net") was primarily the domain of academics and researchers.^[4] Beginning in 1994, however, the Internet entered widespread commercial use. Just two years later, approximately 40 million computers had access to the net.^[5] Analysts predict that, by the year 2000, over 200 million computers will have such capability.^[6] As the number of individuals with Internet access multiplies, the net becomes increasingly attractive for companies wishing to exploit these potential customers. This technological gold rush has led to myriad unfamiliar legal problems. As one observer has noted, "The phenomenal growth of the Internet as a commercial medium has brought about a new set of concerns in the realm of intellectual property."^[7] These new concerns, however, do not necessarily require the adoption of new legal doctrines to resolve them. This paper explores only one of the innumerable novel legal issues that the Internet presents: the domain naming system and its relation to trademark law. "As the Internet grows in prominence as a venue for business, the courts will be called upon to apply traditional legal principles to new avenues of commerce. [Domain name disputes] present such a case."^[8]

II. Domain Names

2. A domain name is the Internet equivalent of a trademark, address, and telephone number. Like addresses and phone numbers, but unlike some trademarks, each domain name is unique. In actuality, any specific domain name, such as "law.virginia.edu,"^[9] is simply an arbitrary surrogate for a specific numerical sequence. This number-chain, for example 123.456.78.91, is known as an Internet Protocol ("IP").^[10] Reading from left to right, the numbers identify increasingly specific entities.^[11] The first set of numbers typically identifies a large computer network.^[12] Subsequent sets of numerals to the right of the first set identify sub-networks and, eventually, an individual computer within any sub-network.^[13] For example, the first chain "123" might identify the University of Virginia's computer system. The numbers "456" might identify the Law School's computers within the larger University network. The numbers "78" might further identify homepages for the Law School's academic journals. Finally, the "91" might indicate the VIRGINIA JOURNAL OF LAW and TECHNOLOGY's specific website. Because it would be practically impossible for individuals to remember a number of different IPs, a Domain Name System ("DNS") was established to correlate these number-chains with more user-friendly alphanumeric equivalents called domain names.^[14] A web browser, such as Netscape Navigator or Microsoft Explorer, translates domain names into their specific numerical IPs and transports a viewer to that site.
3. In all likelihood, technological developments will make current domain naming debates "obsolete and, undoubtedly, historically quaint."^[15] However, at present, these controversies are anything but anachronistic. Battles over the right to use corporate domain names are especially vigorous because of a lack of any comprehensive Internet reference guide. Currently, entering "acompanysname.com" into a web browser may be the most reliable way to contact a company online. "[U]sers interested in communicating with a particular organization or retrieving information about its products must do so without recourse to any centralized, complete directory."^[16] Therefore, the right to use an easily ascertainable domain name may be invaluable. "Because there is no effective alternative method of finding a company's Internet location, having a domain name that corresponds to a well-known trademark may be a prerequisite for a company that wants to establish an Internet presence."^[17] Since many companies choose to use their own identity as their domain name, it has been suggested that a "domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base."^[18] Culling legal principles from analyses of postal addresses, radio station call-letters, and telephone numbers, commentators have attempted to analogize domain name disputes to more familiar areas of law. Practice suggests, however, that courts will employ principles from conventional trademark law in adjudicating domain name disputes, even if domain names do not exactly fit into traditional trademark categories. "Domain names are evolving as a new breed of trademark as commerce and high technology meet on the Internet. Domain names have been described as being like postal addresses, vanity license plates and billboards all rolled into one digital enchilada."^[19]
4. Current technical limitations and existing naming customs help foment domain name disputes. First, the current DNS limits domain names to a maximum of 26 letters. This constraint, plus the fact that easily ascertainable domain names are most desirable, has led many companies to shorten their names or create abbreviations of their corporate identities to serve as domain names. This exercise is more successful for some companies than others. For example, a person searching for

information on International Business Machines would naturally enter "ibm.com" into a web browser. However, a consumer trying to reach Procter & Gamble might not initially try "pg.com." A consumer would probably be even less likely to enter "diarrhea.com," "badbreath.com," "clean.com," "laundry.com," "headache.com," "underarm.com," or "pimples.com," seven other domain names that the company has registered and that will transport a browser to a Procter & Gamble website as well. Second, and potentially more problematic, is the practical impossibility of concurrent domain name use by corporate "twins"[\[20\]](#) on the Internet. For example, federal trademark law allows multiple companies to use the same mark as long as such use is not likely, "to cause confusion, or to cause mistake, or to deceive."[\[21\]](#) By contrast, the DNS does not allow concurrent use of the same domain name. Therefore, while Apple Computer and Apple Records may legally co-exist as separate corporate entities with the same trademark, they may not share the domain name "apple.com."[\[22\]](#) In addition, "[t]he technical constraints of Internet naming conventions make it difficult for trademarks to be kept distinct on the Internet. Such limitations preclude organizations from distinguishing themselves through capitalization, stylized formats, or designs which they would normally use in other media."[\[23\]](#)

5. Finally, the domain name registration system itself has helped produce additional disputes. In 1993, the National Science Foundation took financial responsibility for all non-military use of the Internet.[\[24\]](#) It contracted with Network Solutions, Inc. ("NSI"), a Herndon, Virginia company, to provide domain name registration services for commercial websites using the ".com" top level domain.[\[25\]](#) NSI's policy for granting domain names has evolved through four separate versions. Initially, NSI granted domain names on a first-come, first-served basis, without regard to the rights of third parties.[\[26\]](#) NSI did not inquire into whether an applicant had the legal right to use the requested domain name.[\[27\]](#) After two intermediate policies, NSI announced its most recent approach to awarding domain names on September 6, 1996.[\[28\]](#) In registering names, NSI still conducts no independent inquiry into a potential registrant's trademark rights, but merely asks a registrant to attest that she has the right to register the name she seeks.[\[29\]](#) An NSI attorney has stated that, "We want to emphasize that users don't need to have a trademark to get a domain name. The problem is that NSI doesn't have the authority or expertise to adjudicate trademark disputes."[\[30\]](#) Currently, if a domain registration is in dispute, NSI puts the domain "on hold" at the request of a registered trademark holder, irrespective of whether there has been any infringement or dilution.[\[31\]](#) If either a trademark owner or a domain name holder files suit, NSI will deposit control of the site with the registry of the court or arbitrator with jurisdiction over the matter.[\[32\]](#)
6. These difficulties, combined with the global desire to exploit the Internet for financial gain, have already led to a number of legal disputes. The number of conflicts will undoubtedly keep pace with the growth of the Internet as the medium becomes increasingly ubiquitous. As two commentators have noted, "Undoubtedly, more variations of domain name [disputes] will emerge as the Internet evolves and commercial transaction on it increases."[\[33\]](#)

III. Application of Trademark Law to Domain Name Disputes

7. Courts and litigants have generally employed trademark law to settle domain name disputes. Federal law defines a trademark as any "word, name, symbol, or device, or any combination thereof... to identify and distinguish... goods... from those manufactured or sold by others and to indicate the source of the goods."[\[34\]](#) The majority of claims for trademark infringement and unfair competition emphasize that the defendant's registration of a specific domain name is likely to confuse or deceive the public to the detriment of the plaintiff. These claims generally coincide with the dual purposes underlying statutory trademark protection.

One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trademark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.[\[35\]](#)

8. Enacted in 1946, the Lanham Act protects trademarks at the federal level.[\[36\]](#) At the state level, trademark statutes, unfair competition statutes, and common law safeguard trademarks as well. However, these tools do not generally provide much protection not already found in the Lanham Act.[\[37\]](#) Generally, plaintiffs bring two basic types of infringement claims in the context of domain name disputes: trademark use that is likely to cause consumer confusion, and trademark use that is likely to dilute the value of a trademark.[\[38\]](#)

9. Pursuant to the Lanham Act, a plaintiff may bring a trademark infringement claim due to a likelihood of confusion relating to the origin, source, or other misrepresentations concerning the nature or quality of goods or services.[\[39\]](#) In order to succeed in a likelihood of confusion case, a plaintiff must establish that the defendant's mark is so similar that commercial use of the defendant's mark is likely to result in consumer confusion as to the source of goods.[\[40\]](#) The level of protection that courts afford any given mark hinges on the mark's intrinsic strength. Courts measure a trademark's strength based on an analysis of five loosely defined categories into which trademarks generally fall: arbitrary, fanciful, suggestive, descriptive, and generic.[\[41\]](#) Courts grant marks that fall into any of the first three categories a high level of protection.[\[42\]](#) If a court finds that a mark is merely descriptive, however, it may provide less protection absent a finding that the mark has acquired a "secondary meaning."[\[43\]](#) Finally, generic marks receive no protection.[\[44\]](#)

10. Although determining the strength of any given trademark is an important analytical step, the heart of any trademark infringement claim hinges on the potential likelihood of "consumer confusion."[\[45\]](#) Each federal circuit has its own set of criteria it investigates in determining whether a likelihood of consumer confusion exists. These criteria generally include: the aforementioned strength or weakness of a mark; the goods at issue; the similarity between the marks; the defendant's intent, including evidence of bad faith; the similarity of distribution channels for the goods; the sophistication of consumers; and actual evidence of consumer confusion.[\[46\]](#) However, these criteria are neither all-inclusive nor dispositive of the issue.[\[47\]](#) Each likelihood of confusion determination is an extremely fact-based inquiry and is largely a question of fact. "While the Lanham Act enumerates objective criteria for determining infringement, the thrust of the established tests is subjective: Whether misrepresentation exists

depends on whether the viewer of an infringing mark is confused as to the origin or source of the marked goods."[\[48\]](#)

11. In addition to a likelihood of confusion claim, domain name plaintiffs often allege that a defendant's registration and use of a domain name dilutes the strength of a registered mark. Dilution claims are especially attractive to trademark owners because plaintiffs need not actually prove a likelihood of consumer confusion. Rather, dilution plaintiffs merely assert that a defendant's conduct will reduce the distinctiveness or goodwill associated with a trademark.[\[49\]](#) Generally, there are two ways in which trademark dilution might reduce distinctiveness or goodwill: blurring and tarnishment. Blurring is "the whittling away of an established trademark's selling power through its unauthorized use by another upon dissimilar goods."[\[50\]](#) For example, if a company sold "Pepsi" footballs or "Microsoft" lipstick, it might be liable for dilution by blurring. Tarnishment is the association of a plaintiff's mark with lesser quality goods or with unwholesome or unsavory content.[\[51\]](#) For example, Toys "R" Us recently obtained a preliminary injunction against a company maintaining a sexually explicit pornographic Internet site at "adultsrus.com."[\[52\]](#)
12. Effective January 1996, Congress passed the Federal Trademark Dilution Act of 1995 ("FTDA" or "Act").[\[53\]](#) The FTDA, which was incorporated as § 43(c) of the Lanham Act revised the previous unfair competition sections of the Act and created a federal cause of action for dilution. The legislation affords plaintiffs injunctive relief and also creates the possibility of monetary damages and the destruction of goods upon a showing of bad faith.[\[54\]](#) The Act has been a virtual windfall for many aggrieved trademark owners. It has especially benefited plaintiffs in domain name disputes since Congress intended its passage to protect trademark owners' rights on the Internet.

The legislative history of Section 43(c) of the Lanham Act indicates that it was intended, in part, to address [domain name disputes]. Senator Leahy, in discussing this provision, stated: "it is my hope that this anti-dilution statute can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others."[\[55\]](#)

Armed with this explication of Congressional intent, courts have employed the FTDA to substantially benefit trademark holders alleging on-line infringement. As noted, proving dilution under the Act requires a lower burden of proof than under previous trademark infringement law, yet provides the same temporary injunctive relief as an infringement action.[\[56\]](#) Not surprisingly, "dilution claims based on domain name disputes have emerged as the most prevalent and successful trademark claim."[\[57\]](#)

13. Despite the initial attractiveness of applying traditional trademark law to domain names, the fit may not be as seamless as some courts have suggested. Indeed, "The challenge is to determine whether the square peg of existing trademark law can fit into the Internet's round holes."[\[58\]](#)
14. As noted, one major distinction between the DNS and trademark law is the Lanham Act's allowance of concurrent users. For example, trademark law permits the United Way to peacefully coexist with United Airlines and the United Mineworkers of America since each entity operates in

- a decidedly different field of business. However, the DNS only allows one "united.com." In addition, federal trademark law affords limited protection to similar businesses using similar names if those businesses operate in different geographical areas.[\[59\]](#) The global nature of the Internet, however, virtually prohibits the DNS from drawing any geographical boundaries.[\[60\]](#)
15. Yet another problem with applying trademark law to the Internet involves the fact that the Patent and Trademark Office ("PTO") refuses to register certain works as trademarks, while NSI registers the same words as domain names. The PTO generally requires that trademarks be sufficiently distinctive to keep common words and phrases available for use in the marketplace. For example, the PTO has registered the distinctive name "Procter & Gamble," whereas the DNS simply protects "pg.com," a designation that may or may not receive trademark protection. In addition, the DNS has allowed such non-distinct terms such as "television.com" to be registered. This oversight has led to exactly the type of conduct that the PTO intended to avoid with its trademark registration requirements. A visit to the "television.com" website supports this assertion.[\[61\]](#) This webpage, under the heading "Domain for Sale," identifies the author's wishes to arbitrage the domain name "television.com."[\[62\]](#)

With the emerging possibilities of entertainment delivery through the Internet, *the value of easily-remembered domain names has increased*. I acquired this domain name with a different purpose in mind. Now I find myself in possession of an asset which would be considerably more useful to other organizations than to me. *This represents the first, and probably only, time that the television.com domain will be for sale....* This is a very flexible domain name. It could be used to *segment a very broad market*: classic.television.com, kids.television.com, sports.television.com, news.television.com. This is an asset that will last pretty much forever. Unlike most entertainment products (books, videos, films, etc.) which have a lifecycle in the market, *television.com will remain an ever more valuable destination on the rapidly expanding internet.*[\[63\]](#)

The site then explains that the author has already rejected a \$50,000 cash offer from CNet, which later purchased "radio.com" and "tv.com" for the comparatively bargain price of \$30,000.[\[64\]](#) While trademark law does not prevent a company from using the generic word "television" in its name, it simultaneously does not provide a remedy for the user against a direct competitor that chooses to use the same word. However, NSI's registration system has granted the current owner of "television.com" a virtual monopoly on its use.

IV. Selected Domain Name Disputes

16. The example of the "television.com" domain name holder is instructive. Although not actionable, since the Lanham Act does not permit anyone to hold a trademark on the word "television," the conduct is analogous to that of some domain name defendants. Such cases, however, make up only one of a number of categories of domain name disputes. Given the relatively limited number of domain name decisions and each dispute's inherent distinctiveness, the cases belie simple categorization. Commentators attempting to analyze domain name disputes have created arbitrary

classes of disputes that offer little analytical help.^[65] In general, however, chronology may be the most effective tool with which to analyze domain name case law. To an extent, the earlier domain name cases reflect the initial idealistic, non-competitive nature of the Internet. Later cases, however, mirror the increasingly commercial, profit-driven nature of the medium.

17. In one of the earliest domain name cases to attract popular attention, MTV brought action against one of its former employees, videojockey Adam Curry.^[66] Curry obtained a domain name registration for "mtv.com" while still employed at MTV and with the network's consent.^[67] After Curry left the network, MTV belatedly realized the Internet's potential and brought suit, alleging various trademark violations.^[68] Curry originally threatened to fight the litigation, "all the way to the Supreme Court....This will be the 'Roe vs. Wade' of the...information superhighway."^[69] However, despite his protestations, Curry eventually settled out of court and MTV obtained the use of "mtv.com."^[70] Importantly, before the case settled, the court intimated that an improper domain name registration could infringe on a lawfully registered trademark.^[71]
18. In keeping with the initial tenor of the Internet, many of the earliest domain name disputes amounted to mere pranks. Two of the more famous examples involve what has become known as "domain name grabbing." "Grabbing," or "squatting," occurs where an individual notices the failure of a company to register a domain name and then registers the name for herself.^[72] In 1994, Joshua Quittner, a writer for Wired magazine, was investigating an article on domain name registration. In researching the article, he noticed that McDonald's had failed to acquire a website, so he registered a domain name at "mcdonalds.com."^[73] After several months, McDonald's noticed the misappropriation of its name and demanded that Quittner surrender the website.^[74] Perhaps sensing a public relations disaster, McDonald's eventually agreed to Quittner's request that the company donate \$3,600 to a New York City high school for computer equipment and an Internet connection.^[75] As consideration for the donation, Quittner agreed to transfer the rights to "mcdonalds.com."^[76]
19. In a somewhat less innocent prank, the Princeton Review, Inc., a test preparation company, registered a domain at "kaplan.com."^[77] The Stanley H. Kaplan Educational Centers, Ltd. is the world's largest test preparation firm and the Princeton Review's arch rival.^[78] When viewers logged onto the "kaplan.com" site, the page informed them that they had reached the Princeton Review and invited them to submit complaints about Kaplan.^[79] Princeton's antics only lasted four days, however.^[80] Upon learning of Princeton's registration, Kaplan immediately threatened suit to stop Princeton's use of "kaplan.com."^[81] Princeton responded by claiming its actions were no more than a prank and offered to trade the site for a case of beer.^[82] Kaplan, however, was not amused with Princeton's actions and took the case to arbitration. There, Kaplan eventually retrieved the rights to "kaplan.com" and Princeton, apparently, did not receive its case of beer in return.^[83] Neither party received damages nor attorneys fees.^[84]
20. These early pranks gave way to more serious disputes, some of which involved "squatters" who registered a domain name using a registered trademark with the intent to arbitrage the domain name to the trademark owner. Depending upon an observer's point of view, these individuals are either forward-thinking entrepreneurs, or unscrupulous "cybersquatters."

While many may find patently offensive the practice of reserving the name or mark of a federally registered trademark and then attempting to sell the name back to the holder of the trademark, others may view it as a service....Speculation and arbitrage have a long history in this country.[\[85\]](#)

21. Interestingly, the vast majority of these cases involve the same defendant, Dennis Toeppen. Toeppen, an Illinois resident, has registered approximately 240 Internet domain names involving corporate trademarks including, "panavision.com," "panaflex.com," "intermatic.com," "americanstandard.com," "aircanada.com," "anaheimstadium.com," "camdenyards.com," "deltaairlines.com," "eddiebauer.com," "crateandbarrel.com," and numerous others.[\[86\]](#) "Toeppen has registered [these] Internet domain names without seeking the permission from any entity that has previously used the names he registered, because he contends that permission was unnecessary."[\[87\]](#) These corporations may take some solace, if any, from the fact that they are not alone in cyberspace. "As of October 1994, fourteen percent of the Fortune 500 companies had found the most desirable form of their domain name registered by someone else."[\[88\]](#) Not even the biggest bully in the Internet schoolyard is immune from such actions. An Austin, Texas computer company named Zero Micro Software registered a domain name at "microsoft.com."[\[89\]](#)
22. Not surprisingly, Intermatic,[\[90\]](#) Panavision,[\[91\]](#) and American Standard[\[92\]](#) all brought suit against Toeppen alleging a variety of federal and state trademark dilution and infringement, unfair business practice, and business tort claims. Since the question of domain name use is a relatively novel legal issue, these cases would appear to be instructive for future domain name litigants. However, as one commentator has noted, the value of these early cases might not be as great as expected. "[M]any courts have demonstrated great ignorance of the nature of the Internet, which brings both the basis and guiding value of some of the cases into question."[\[93\]](#) Another author has noted that, "trademark law itself has become a confusing subject for the courts even without the complication of technological dimensions...Adding computers to the mix has naturally led to further confusion among judges and litigants."[\[94\]](#) Even without the element of the Internet, trademark law by itself has often proved difficult for courts. "Regretfully, the body of law relating to the Lanham Act has developed into a tangled morass....Courts struggling to move mountains often find they have only affected minuscule changes in trademark jurisprudence and occasionally have created their own likelihood of confusion."[\[95\]](#)
23. In *Intermatic*, the court granted the plaintiff summary judgment on the issue of trademark dilution, but denied to do so on the issues of unfair competition and trademark infringement.[\[96\]](#) Here, Toeppen had initially intended to use "intermatic.com" to sell computer software, but, after receiving the plaintiff's demand to relinquish the site, he displayed a map of Champaign-Urbana, his home town.[\[97\]](#) In its decision, the magistrate characterized Toeppen as a "cybersquatter" which it defined as a individual who "attempt[s] to profit from the Internet by reserving and later reselling or licensing domain names back to the companies that spent millions of dollars developing the goodwill of the trademark."[\[98\]](#) Indeed, "One of Toeppen's business objectives is to profit by the resale of licensing these domain names, presumably to the entities who conduct business under those names."[\[99\]](#) The magistrate found that Toeppen's intent to arbitrage the name amounted to "commercial use" for purposes of the Lanham Act.[\[100\]](#) Further, the magistrate held

that Toeppen's mere use of the Internet satisfied the "in commerce" requirement.[\[101\]](#) The decision stated that the case met the Lanham Act's dilution requirement for four reasons: 1) Intermatic is a famous mark, 2) Toeppen was engaged in a commercial use of the Intermatic trademark, 3) Toeppen's use of the Internet constituted commerce, and 4) Toeppen caused dilution of the distinctive quality of the mark.[\[102\]](#) In addition, Toeppen's use of the trademark might frustrate the expectations of consumers who "expect to locate Intermatic on the Internet through the 'intermatic.com' domain name."[\[103\]](#) The magistrate did, however, acknowledge that Intermatic was technically able to establish a web page at another site, using "intermatic-inc.com" as an example.[\[104\]](#) Nevertheless, Toeppen's use of Intermatic's trademark reduced "the capacity of Intermatic to identify and distinguish its goods and services by means of the Internet."[\[105\]](#) Finally, the magistrate distinguished this case from other potential disputes and noted that important policy matters compelled its decision stating:

This is not a situation where there were competing users of the same name by competing parties and a race to the Internet between them. This case involves one party, Intermatic, with a long history of trademark use, and a second, Toeppen, who has effectively enjoined Intermatic from using its trademark...to register the "intermatic.com" domain name. This activity clearly violates the Congressional intent of encouraging the registration and development of trademarks to assist the public in differentiating products. It would seriously undermine the trademark policy to prevent a company from exercising its mark by reason of Toeppen's conduct.[\[106\]](#)

24. In Panavision, Toeppen registered "panavision.com" and used the site to display an aerial view of Pana, Illinois.[\[107\]](#) Toeppen informed Panavision that he would agree to discontinue his use of the domain name in exchange for \$13,000.[\[108\]](#) Rather than pay Toeppen's ransom, Panavision filed suit. The court held that Toeppen had violated federal and California anti-dilution laws, granted Panavision a preliminary injunction, and ordered Toeppen to transfer the name to the plaintiff.[\[109\]](#) The court observed that the Panavision mark was sufficiently famous and that Toeppen's use of the "panavision.com" lessened the capacity of the mark to "identify and distinguish goods and services" under the FDTA.[\[110\]](#) Further, Toeppen had also diluted the mark by preventing Panavision from using its exact trademark as a domain name.[\[111\]](#) The court had some difficulty in finding that Toeppen satisfied the Lanham Act's "commercial use in commerce" requirement. Using reasoning similar to Intermatic, the Panavision court found that Toeppen's very intent to arbitrage the name amounted to commercial use despite the fact that Toeppen never used "panavision.com" to sell any goods or services.[\[112\]](#) Finally, the court prohibited Toeppen from using "Panavision," "Panaflex," or any other similar mark likely to cause confusion in a domain name.[\[113\]](#) In its decision, the court attempted to balance the rights of domain name holders with those of trademark registrants.[\[114\]](#) It asserted that its ruling neither inhibited competition nor granted trademark holders presumptive rights in domain names making use of their trademark.[\[115\]](#) It noted that the cases did not present the issue of whether an innocent registrant of "panavision.com" would be liable for trademark dilution.[\[116\]](#) It would appear from

this dicta that the FTDA would protect innocent registrants of domain names involving trademarks, so long as they employ their websites for non-commercial use.

25. In American Standard,[\[117\]](#) Toeppen gave up the fight much more easily than in either Panavision or Intermatic. Here, Toeppen did not contest entry of a preliminary injunction against him prohibiting the use of "americanstandard.com."[\[118\]](#)
26. These "cybersquatter" cases compose one of a number of categories of domain name disputes. Another significant category may be characterized as involving unwholesome, or deceptive, practices. Generally, courts deciding these types of cases have found trademark dilution when domain name holders have used, or suggested the use of, a famous mark in registering their domain name.
27. In Hasbro, Inc. v. Internet Entertainment Group, Ltd.,[\[119\]](#) the plaintiff toy manufacturer intended to launch a new interactive division based on the strength of one of its popular children's board games.[\[120\]](#) However, when Hasbro inquired about the availability of its desired site, it discovered that the defendant had already registered a domain name at "candyland.com."[\[121\]](#) Even more disturbing to Hasbro was the fact that the defendant was using the site to sell sexually explicit products and services.[\[122\]](#) The defendant countered that it was the rightful owner of the domain, having previously paid more than \$20,000 to acquire the use of the domain name for itself.[\[123\]](#) In addition, the Internet Entertainment Group had already spent \$700,000 in developing the site, including an estimated \$150,000 for advertising in adult magazines.[\[124\]](#) Hasbro subsequently filed suit for trademark infringement and dilution.[\[125\]](#) It asserted that the defendant's "use of the CANDYLAND name in connection with a sexually explicit pornographic Internet site by its very nature tarnishes the pure, sweet, wholesome and fun imagery associated with Hasbro's CANDYLAND mark, and is certainly likely to undermine or damage the positive association evoked by the mark."[\[126\]](#) The defendant answered that there are a significant number of third-party non-competitor uses of the word "candyland" and asserted that it does not compete with Hasbro in any market.[\[127\]](#) "IEG never intended to compete with Hasbro 'by making and selling similar goods.' IEG markets its services for a fee to adults, and has restricted its advertising to adult publications. IEG does not market its services to 'children aged 3 and older' as is Hasbro's Candy Land board game."[\[128\]](#)
28. Upon receipt of a cease and desist letter from Hasbro, the defendant took a number of affirmative precautions to "avoid any possible confusion surrounding the internet address and the Candy Land name."[\[129\]](#) The defendant removed objectionable pictures and graphics from its free guest site (while maintaining the pictures at its members-only site). It also posted a disclaimer and reference to the lawsuit at its site in order to help ameliorate the possibility of confusion. Finally, it displayed its own trade name more prominently at the site.[\[130\]](#)
29. The defendant's actions, however, did not persuade the court. Although neglecting to enumerate its rationale, the court found that the defendant had diluted Hasbro's mark.[\[131\]](#) It also observed a likelihood of success on Hasbro's federal and state dilution claims.[\[132\]](#) It added that the defendant's use of the "candyland.com" domain name caused Hasbro injury, and that the probable harm to Hasbro outweighed any inconvenience the defendant would experience if required to stop using the "candyland.com" domain name.[\[133\]](#)

30. While the Hasbro court found dilution by direct appropriation of a trademarked name, other courts adjudicating domain name disputes have found dilution even in the absence of an exact use of a trademark. In Toys "R" Us, Inc. v. Akkaoui,^[134] the plaintiff held "an array of trademarks ending with the phrase 'R Us.'"^[135] In August 1996, the plaintiffs discovered that the "Defendants were operating an Internet site and shopping service featuring a variety of sexual devices and clothing under the name 'adultsrus.'"^[136] After sending a cease and desist demand letter, Toys "R" Us filed suit alleging trademark dilution, trademark infringement, false designation of origin, and unfair competition.^[137] Plaintiffs also sought a preliminary injunction to enjoin defendants, ensure removal of the domain name, and prevent any future trademark infringement or dilution.^[138] The court found that, "Because of Plaintiff's promotional activity and because of the mark's inherent peculiarity, the "R Us" family of marks have [sic] acquired a strong degree of distinctiveness."^[139] The court agreed with Toys "R" Us on the dilution issue and issued the preliminary injunction. Citing Hasbro, the court stated that, "'Adults R Us' tarnishes the 'R Us' family of marks by associating them with a line of sexual products that are inconsistent with the image Toys 'R' Us has striven to maintain for itself."^[140] The court then dismissed the plaintiff's infringement claim, because it found Toys "R" Us likely to succeed on the merits of the dilution claim.^[141]
31. Yet another case involved a surreptitious attempt to "trade off" a famous name to a trademark registrant's detriment. In Planned Parenthood Fed'n of America, Inc. v. Bucci,^[142] the defendant, doing business as Catholic Radio, registered a website at "plannedparenthood.com."^[143] Unlike in Hasbro or Toys "R" Us, however, the defendant's actions strongly suggested an intent to deceive consumers. The website greeted browsers with the message, "Welcome to the PLANNED PARENTHOOD HOME PAGE!"^[144] The page included a scanned image of a book entitled, The Cost of Abortion along with several links that allowed viewers to read portions of the work.^[145] The text provided eventually revealed that The Cost of Abortion was an pro-life publication.^[146] At trial, the parties disputed the defendant's intent in authoring such a page. The court, however, made "the factual finding that defendant's motive in choosing plaintiff's mark as his domain name was, at least in part, to attract to his home page Internet users who sought plaintiff's home page."^[147]
32. The defendant argued that his use of plaintiff's mark was protectible under the Lanham Act because it was non-commercial speech.^[148] The court, however, found the defendant's argument unavailing for two reasons. First, Bucci's use of "plannedparenthood.com," though arguably non-commercial in of itself, affected the plaintiff's ability to offer services over the Internet.^[149] Second, the very use of the Internet would satisfy the Lanham Act's "in commerce" requirement.^[150] The court cited Intermatic for the proposition that a typical Internet message qualifies for Lanham Act protection by itself.^[151]
33. After finding the Lanham Act applicable to the action, the court turned to the question of whether Bucci's use of plaintiff's mark resulted in a likelihood of confusion.^[152] After parsing the Second Circuit's criteria for determining the likelihood for consumer confusion^[153] the court found that "the bulk of the...factors demonstrate [sic] that there is a significant likelihood of confusion that warrants the granting of a preliminary injunction."^[154] The court dismissed defendant's

arguments that his use of the plaintiff's trademark was protected as a parody or under a First Amendment exception. First, the court rejected the parody defense because it was "not persuaded by the defendant's argument that the message of the home page provides an ironic and contrasting allusion to plaintiff, nor...that the banner heading of the homepage is sarcastic."[\[155\]](#) Second, the court found the First Amendment defense inappropriate because it found the defendant intended to identify the source of a product, rather than as part of a communicative message.[\[156\]](#) Finally, in awarding the preliminary injunction, the court found that the defendant's proffered use of a disclaimer on his website, "would not be sufficient to dispel the confusion induced by his home page address and domain name."[\[157\]](#)

34. Despite their numerous dissimilarities, many of the cases discussed share one common element that aided the judicial decision-making process: the defendant, whether intentionally or unintentionally, appropriated a mark to which he held no rights. In these instances, courts have not found it difficult to find for a trademark owner over an individual with no trademark rights of her own. Notwithstanding the presence of the Internet, these cases present what commentators have described as "garden variety infringement and dilution" claims.[\[158\]](#) These cases are somewhat distinguishable from the category of cases described in Intermatic -- those in which competing users of the same name race for domain name registration.
35. On April 25, 1996, the District Court for the Central District of California issued the first federal ruling prohibiting the use of a domain name based on trademark infringement. In Comp Examiner Agency v. Juris,[\[159\]](#) Comp Examiner used the domain "juris.com" to provide legal publishing and forensic-related goods.[\[160\]](#) Juris, a legal software company, owned a federally registered trademark on the word "JURIS" and brought suit alleging trademark infringement.[\[161\]](#) Finding Juris' success on the merits likely, the court preliminarily enjoined Comp Examiner from using the name "JURIS," the domain name "juris.com," or any confusingly similar variation.[\[162\]](#)
36. Not surprisingly, this precedent gave rise to numerous progeny. In Actmedia, Inc. v. ActiveMedia International Inc.,[\[163\]](#) the plaintiff had done business under the name "Actmedia" since 1972 and had owned a valid federal trademark since 1986.[\[164\]](#) The defendant, however, had abbreviated its name and was the first to register a website at "actmedia.com."[\[165\]](#) Without any discussion of its rationale, the court held that the defendant's use of the trademark violated the Lanham Act and Illinois common law.[\[166\]](#) The court stated that ActiveMedia's actions: 1) constituted unauthorized use and misappropriation of the mark, 2) amounted to false designation of origin, 3) were likely to cause confusion in the marketplace, and 4) were likely to cause confusion that plaintiff sponsored or approved of defendant's commercial activities.[\[167\]](#)
37. In a case involving somewhat similar issues, TeleTech Customer Care Management (California) Inc. brought action against Tele-Tech Co., Inc. alleging trademark infringement and dilution.[\[168\]](#) Here, the plaintiff owned a federally registered service mark for the name "Teletech."[\[169\]](#) Defendant, however, registered its own website at "teletech.com."[\[170\]](#) It asserted that, at the time of registration, it was unaware of the fact that it could have registered "tele-tech.com" as its domain name.[\[171\]](#) The court observed that the plaintiff had spent millions of dollars promoting and advertising its services and that, "[a]s a result of these efforts, it appears that TeleTech has built up and now owns valuable goodwill symbolized" by its mark.[\[172\]](#) The court noted that

defendant's use of the "teletech.com" domain name prevented the plaintiff from using its registered service mark as its domain name.[\[173\]](#) The defendant's actions therefore, "caus[ed] hardship to Plaintiff Customers and potential customers of Plaintiff are unable to locate Plaintiff's website..."[\[174\]](#) Further, the court stated that defendant could easily use the "tele-tech.com" domain name with its distinctive hyphenation.[\[175\]](#) Considering these elements together, the court eventually found that the "balance of hardships tip[ped] sharply in plaintiff's favor."[\[176\]](#) Finally, it concluded that the plaintiff will likely succeed on the merits of its service mark infringement, Lanham Act § 43(a), unfair competition, federal dilution, and state dilution claims.[\[177\]](#) Therefore, it granted plaintiff's motion for a preliminary injunction.[\[178\]](#)

38. In a somewhat similar case, Judge Clarke of the Norfolk Division of the Eastern District of Virginia, recently presided over a domain name dispute involving credit card processing competitors.[\[179\]](#) In Cardservice International, Inc. v. McGee, the plaintiff owned a registered trademark for the word "Cardservice International," but the defendant registered a domain name at "cardservice.com."[\[180\]](#) McGee offered merchant card services from his website through a company held out as "EMS--Card Service on the Caprock."[\[181\]](#) When contacted by plaintiff's lawyer, McGee claimed that the DNS limitations forced him to use "cardservice.com" because its technical limitations did not allow him to register a domain name with a space between the words "card" and "service."[\[182\]](#) The plaintiff registered its own website at "cardsvc.com" and filed suit in September 1996 alleging trademark infringement, unfair competition, misappropriation, and unjust enrichment.[\[183\]](#) The court initially granted plaintiff's request for a preliminary injunction, prohibiting McGee from using any variation of "cardservice" on the Internet and ordering him to remove all content from the "cardservice.com" website.[\[184\]](#) Subsequently, the court found McGee in contempt for violation of the injunction.[\[185\]](#) Apparently, plaintiff "introduced evidence indicating that McGee intended to use a new site identified by the domain name 'csimall.com' -- a name apparently derived [from] the letters 'CSI' which has been used to refer to Cardservice International -- to engage in 'guerrilla warfare' on the internet against Cardservice International."[\[186\]](#)
39. In supporting its order of a permanent injunction, the court reasoned that "there is a likelihood of confusion between Cardservice International's registered mark and McGee's use of 'cardservice.com' and 'Card Service' on the internet."[\[187\]](#) The court added that the minor differences between plaintiff's registered mark and defendant's use "do not preclude liability under the Lanham Act when the unauthorized use is likely to cause confusion."[\[188\]](#) Judge Clarke added that McGee's use prevented Cardservice International from obtaining a domain name containing its registered mark.[\[189\]](#) Therefore, the defendant's use would confuse the plaintiff's consumers who would know of no other avenue by which to reach Cardservice on the Internet.[\[190\]](#) "Such a result is exactly what the trademark laws were designed to protect against [sic]."[\[191\]](#) Cardservice's registration of a trademark means that it should not "be forced to compete with others who would also use the words 'cardservice.'"[\[192\]](#) In addition, the court noted that the "terms of the Lanham Act do not limit themselves in any way which would preclude application of federal trademark law to the internet."[\[193\]](#) Finally, the court found that defendant's conduct after the initiation of litigation was in bad faith and with malicious intent.[\[194\]](#) The court held that

defendant's actions rose to the level of "exceptional circumstances" under the Lanham Act and awarded the plaintiff \$63,246.25 in attorneys' fees.[\[195\]](#)

V. Conclusion

40. Conclusions in such a nascent area of law are difficult to draw. It does appear, however, that some trends may be culled from the inchoate decisions involving domain name disputes. First, it appears that domain name plaintiffs achieve the most success by alleging that defendants have diluted their federally registered trademarks. These claims have been effective in preventing the exploitation of corporate trademarks and good will. For the most part, trademark holders alleging dilution have been able to obtain their trademarked name for use as a domain name for Internet commerce. However, future decisions might undermine these assertions. As two trademark attorneys recently noted, "[T]he intersection between domain names and trademark law will remain murky for the foreseeable future. The Internet has only recently left its womb and courts and lawyers are attempting to grapple with the myriad of legal issues that its creation has spawned."[\[196\]](#)
41. Commentators have even contested this final point, disagreeing about whether trademark law is properly applied to domain name disputes. Numerous authors have expressed concern that trademark holding plaintiffs may end up with a property right on the Internet that exceeds the bounds of what the Lanham Act actually protects. These commentators have suggested that courts should be very wary about granting trademark holders virtual monopolies over trademarked names, especially in light of the Lanham Act's allowance of concurrent use. They worry that the application of dilution law to anything less than truly famous marks will produce anti-competitive results. To help combat these effects, two attorneys have suggested a "use it or lose it approach" by which domain name owners would be required to show use of their domain names or risk forfeiture. This approach would prevent "warehousing" of domain names by certain holders.
42. To help ameliorate some of these problems, some observers have suggested applying analytical frameworks used in radio station call-letter and telephone mnemonic disputes to domain name law. Despite the potential benefits of these approaches, courts have so far been unwilling to extend their purview of domain name disputes beyond traditional trademark law. "Although [the Internet] is a new medium, courts must still apply traditional trademark law, while also considering the policy implications....By applying the law of trademarks to the Internet [a court] strikes an appropriate balance between trademark law and the attendant policy concerns..."[\[197\]](#)
43. Two assertions, however, are more certain and receive universal agreement. The first is that these disputes will only increase in number in years to come. The second is that domain name disputes present an exciting confluence between the traditional legal principles of trademark law and the cutting edge technology of the next century.

Footnotes

[\[*\]](#)Adam Chase, J.D., University of Virginia School of Law, 1998. Adam Chase is a 1997-1998 recipient

of the Hardy Cross Dillard Fellowship for Legal Research and Writing and a 1997-1998 Editorial Board member of the Virginia Journal of Law and Technology. Adam graduated from Cornell University in 1996 with a bachelor's degree in American Studies, cum laude and with distinction in all subjects.

[1] Intermatic Inc. v. Toeppen, 947 F. Supp. 1227, 1229 (N.D. Ill. 1990). The District Court for the Northern District of Illinois adopted a magistrate judge's report and recommendation which began, "Welcome to cyberspace!"

[2] American Civil Liberties Union v. Reno, 929 F. Supp. 824, 831 (E.D. Pa. 1996).

[3] *Id.*

[4] Interestingly, the Internet is a product of the Cold War. Beginning in the 1960s, the Department of Defense wished to design a system that government authorities could use to communicate in the aftermath of a nuclear war. A researcher at RAND Corporation initially envisioned a "net" of communication by which the military, defense contractors, and university researchers conducting defense-related activities could correspond. The theory behind the concept was that if one portion of the net were eliminated, data could still reach its destination by another path on the same net. A message sent over a series of linked computers could take any number of different routes to reach its ultimate destination. In 1969, the Department of Defense's Advanced Research Project Association ("ARPA") first implemented the system, initially called ARPANET. As the network grew to include corporations and private citizens, it eventually became known as the "DARPA Internet," and finally, just the "Internet." By 1995, however, the government, through the National Science Foundation withdrew funding for the Internet. Today, private commercial carriers such as MCI and Sprint provide the high capacity lines that make up the Internet's technological backbone. *Id.*

[5] Reno, 949 F. Supp. at 831.

[6] *Id.*

[7] Kenneth Sutherlin Dueker, Note, Trademark Law Lost in Cyberspace: Trademark Protection for Internet Addresses, 9 HARV. J.L. & TECH. 483 (1996).

[8] Intermatic, 947 F. Supp. at 1229.

[9] Domain names are typically read from right to left and become increasingly specific. The ".edu" is known as a "top level domain" ("TLD") and usually corresponds to the generic type of organization that registered the domain name. For example, some common TLDs are ".edu" for educational institutions, ".com" for commercial entities, ".net" for networks, ".gov" for governmental bodies, and ".org" for organizations. The domain immediately to the left of the TLD is the "second level domain" ("SLD"). Any additional domains to the left of the SLD are, simply, "subdomains." Therefore, in "law.virginia.edu" the

TLD is ".edu." The SLD is "virginia" and "law" is simply a subdomain of "virginia."

[10] Dueker, *supra* note 7, at 492

[11] *Id.*

[12] *Id.*

[13] *Id.*

[14] *Id.*

[15] Dueker, *supra* note 7, at 496.

[16] *Id.*

[17] Gayle Weiswasser, Domain Names, the Internet, and Trademarks: Infringement in Cyberspace, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 137, 146 (1997).

[18] MTV Networks, Inc. v. Curry, 867 F. Supp. 202, 203-04 n.2 (S.D.N.Y. 1994).

[19] Daniel R. Mummery et al., Domain Name Registration: Who Should Administer?, N.Y. L.J., Dec. 2, 1996, at S8.

[20] A recent law review article discusses this nomenclature and other categories of domain name disputes. *See* Ira S. Nathenson, Comment, Showdown at the Domain Name Corral: Property Rights and Personal Jurisdiction Over Squatters, Poachers and Other Parasites, 58 U. PITT. L. REV. 911 (1997).

[21] Lanham Act § 2(d), 15 U.S.C. § 1052(d) (1994).

[22] To be sure, the companies could register "applerecords.com" and "applecomputers.com." However, since domain names are most valuable when a consumer may easily ascertain them, most companies wish to have the simplest, shortest way of expressing a trademark or trade name.

[23] Dueker, *supra* note 7, at 493.

[24] Stuart D. Levi & Jose Esteves, The Domain Name System and Trademarks, 482 PLI/Pat 123, 126-130 (1997).

[25] *Id.*

[26] *Id.*

[27] *Id.*

[28] *Id.*

[29] *Id.*

[30] Dueker, *supra* note 7, at 505 (citation omitted).

[31] Nathanson, *supra* note 20, at 924,

[32] Levi & Esteves, *supra* note 24, at 130.

[33] Neal J. Friedman & Kevin Siebert, The Name is Not Always the Same, 20 SEATTLE U. L. REV. 631, 644 (1997).

[34] 15 U.S.C. § 1127 (1988). Friedman and Siebert trace the origin of trademarks and its somewhat ironic application to Internet disputes. "In Medieval times, British craftsmen who were members of guilds placed a mark on their goods to indicate the source and quality. Thus was born the first trademark. The principles of trademark law, first established when goods moved slowly by oxcart and sailing ship, persist today as marks fly through cyberspace in nanoseconds. Friedman & Siebert, *supra* note 26, at 631 (footnotes omitted). Similarly, Nathanson notes that, "New technology and historical developments, such as the invention of the printing press, tend to lead to changes in the concepts and rights involved in property. Similarly, the nationalization of commerce made nationally recognized business names feasible and presumably led in part to the Lanham Act. The globalization of communications via the Internet has led to a system where trademarks and trade names may be used as a method of communications, via domain names." Nathanson, *supra* note 20, at 950.

[35] Dueker, *supra* note 7, at 488 (citation omitted).

[36] 15 U.S.C §§ 1051-1127 (1994), also known as the United States Trademark Act of 1946.

[37] Friedman & Siebert, *supra* note 33, at 640.

[38] Weiswasser, *supra* note 17, at 143.

[39] *See generally* Dan L. Burk, Trademarks Along the Infobahn: A First Look at the Emerging Law of

Cybermarks, 1 RICH. J.L. & TECH. 1, 924 (1995) <<http://www.urich.edu/~jolt/v1i1/burk.html>>.

[40] 15 U.S.C. §§ 1114, 1125 (West Supp. 1996).

[41] Burk, *supra* note 39, at 25-27. Burk describes arbitrary marks as those which are well-known words that identify goods which are unrelated to the trademark name, such as Apple Computers. Fanciful marks are those invented by a trademark owner such as DuPont's Tyvek brand house-wrap. Suggestive marks distinguish goods by their very name. Descriptive marks simply describe a good. Generic marks usually describe a class of goods or services. *Id.*

[42] *Id.*

[43] Friedman & Siebert, *supra* note 33, at 641.

[44] *Id.*

[45] *Id.* at 641.

[46] 15 U.S.C. § 1114.

[47] *Id.*

[48] Dueker, *supra* note 7, at 490.

[49] Friedman & Siebert, *supra* note 33, at 642 (citation omitted).

[50] *Id.*

[51] Toys "R" Us, Inc. v. Akkaoui, 1996 WL 772709 at *3 (N.D. Cal. 1996).

[52] *Id.* This decision will receive further treatment in section IV of this paper.

[53] 15 U.S.C. § 1125(c).

[54] *Id.* The FTDA provides that: the owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. *Id.*

[55] Teletech Customer Care Management, Inc. v. Tele-Tech Co. Inc., 977 F. Supp. 1407 (C.D. Cal. May 9, 1997). This decision will receive further treatment in section IV of this paper.

[56] 15 U.S.C. § 1125(c).

[57] Friedman & Siebert, *supra* note 33, at 644.

[58] *Id.* at 661.

[59] *See* 15 U.S.C. §§ 1057(c), 1115(b)(5)-(6) (1994).

[60] Although a thorough analysis of this assertion is beyond the scope of this paper, there are some geographical TLDs. For example, there is a "yahoo.fr" for a France-based Yahoo! search. However, these geographical appendages to domain names are currently rarely used.

[61] Mike O'Connor, *television.com* (visited Mar. 10, 1998) <<http://www.television.com>>.

[62] *Id.*

[63] Mike O'Connor, *This domain name is for sale* (visited Mar. 10, 1998) <<http://www.television.com/salespitch.html>> (italics in original).

[64] *Id.*

[65] *See generally*, Nathanson, *supra* note 20. Nathanson posits three categories of domain name disputes, squatters, parasites, and twins/poachers.

[66] MTV, 867 F. Supp. at 202.

[67] *Id.* at 203-4.

[68] *Id.* at 204.

[69] Friedman & Siebert, *supra* note 33, at 647 (footnote omitted).

[70] *Id.*

[71] MTV, 867 F. Supp. at 203-4 n.2.

[72] Friedman & Siebert, *supra* note 33, at 645.

[73] *Id.* at 656-646.

[74] *Id.* at 646.

[75] *Id.*

[76] *Id.*

[77] *Id.*

[78] Please note that, in the summer of 1996, the author of this paper worked for Kaplan.

[79] Friedman & Siebert, *supra* note 33, at 646.

[80] Dueker, *supra* note 6, at 502.

[81] Friedman & Siebert, *supra* note 33, at 646.

[82] *Id.*

[83] Dueker, *supra* note 7, at 502.

[84] *Id.*

[85] Intermatic, 947 F. Supp. at 1233.

[86] Panavision Int'l. v. Toeppen, 938 F. Supp. 616, 619 (C.D. Ca. 1996); Friedman & Siebert, *supra* note 26, at 663 n.142.

[87] Intermatic, 947 F. Supp. at 1230.

[88] Dueker, *supra* note 7, at 500-501 (footnote omitted).

[89] Friedman & Siebert, *supra* note 33, at 663 n.112. Microsoft sent Zero Micro a cease and desist letter, claiming that Zero Micro's site would confuse consumers and dilute Microsoft's trademark. Zero Micro ceased using the site. *Id.*

[90] Intermatic, 947 F. Supp. at 1227.

[91] Panavision Int'l. v. Toeppen, 945 F. Supp. 1296 (C.D. Cal. 1996).

[92] American Standard Inc. v. Toeppen, 1996 U.S. Dist. LEXIS 14451 (C.D. Cal. Sept. 3, 1996).

[93] Nathanson, *supra* note 20, at 975.

[94] Dueker, *supra* note 7, at 507.

[95] Coach Leatherware Co. v. Ann Taylor, Inc., 933 F.2d 162, 171 (2d Cir. 1991) (quoted in Dueker, *supra* note 6, at 505).

[96] Intermatic, 947 F. Supp. at 1227.

[97] *Id.* at 1232. Friedman and Siebert have surmised a potential motive for the sudden shift in "intermatic.com" content. "He apparently wished to avoid continuing his outright infringement while still demonstrating enough control over the site to force Intermatic to compensate him for relinquishing the address." Friedman & Siebert, *supra* note 26, at 663 n.146.

[98] Intermatic, 947 F. Supp. at 1233.

[99] *Id.* at 1230.

[100] *Id.* at 1227.

[101] *Id.* at 1229.

[102] *Id.* at 1238-39.

[103] *Id.* at 1240.

[104] *Id.* at 1232.

[105] *Id.* at 1240.

[106] *Id.*

[107] Panavision, 945 F. Supp. at 1300.

- [108] *Id.*
- [109] *Id.* at 1306.
- [110] *Id.* at 1304.
- [111] *Id.*
- [112] *Id.* at 1303.
- [113] *Id.* at 1306.
- [114] *Id.* at 1304.
- [115] *Id.*
- [116] *Id.* The decision contrasted Toeppen against a hypothetical citizen of Pana, Illinois who used the "panavision.com" domain name in order to provide a community forum.
- [117] American Standard Inc., 1996 U.S. Dist. LEXIS 14451, at *1 .
- [118] *Id.*
- [119] 1996 WL 84853 (W.D. Wash. Feb. 9, 1996).
- [120] Jonathan Rosenoer, *Cyberlaw -- Famous Trademarks*, (visited Dec. 2, 1997) <<http://www.cyberlaw.com/cylw0296.html>>.
- [121] *Id.*
- [122] *Id.*
- [123] *Id.*
- [124] *Id.*
- [125] Hasbro, 1996 WL 84853, at *1.

[126] [Rosenoer](#), *supra* note 120.

[127] *Id.*

[128] *Id.*

[129] *Id.*

[130] *Id.*

[131] [Hasbro](#), 1996 WL 84853, at *1.

[132] *Id.*

[133] *Id.*

[134] 1996 WL 772709 (N.D. Cal. Oct. 29, 1996).

[135] *Id.* at *1.

[136] *Id.*

[137] *Id.*

[138] *Id.*

[139] *Id.* at *2

[140] *Id.* at *3.

[141] *Id.*

[142] 1997 WL 133313 (S.D.N.Y. March 24, 1997).

[143] *Id.* at *1.

[144] *Id.* at *1.

[145] *Id.* at *1-2.

[146] *Id.*

[147] *Id.*

[148] *Id.* at *3.

[149] *Id.*

[150] *Id.*

[151] *Id.* at *3.

[152] *Id.* at *7.

[153] The Second Circuit's criteria are substantially similar to those enumerated in pages 7-8 of this paper. In the Second Circuit, "those factors include: the strength of plaintiff's mark, the degree of similarity between the two marks, the competitive proximity of the products or services, the likelihood that the plaintiff will bridge the gap between the two markets, the existence of actual confusion, the defendant's good faith in adopting the mark, the quality of the defendant's product, and the sophistication of the purchasers." *Id.* at *7 (*citing* Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 495 (2d Cir. 1961)).

[154] *Id.* at *10.

[155] *Id.*

[156] *Id.*

[157] *Id.* at *12.

[158] Friedman & Siebert, *supra* note 33, at 648.

[159] 1996 WL 376600 (C.D. Cal. Apr. 26, 1996).

[160] *Id.* at *1.

[161] *Id.*

- [162] *Id.*
- [163] ActMedia, Inc. v. Active Media Int'l, Inc., 1996 WL 466527 (N.D. Ill. Jul. 17, 1996).
- [164] *Id.* at *1.
- [165] *Id.*
- [166] *Id.* at *2.
- [167] *Id.*
- [168] Teletech Customer Care Management (California), Inc. v. Tele-Tech Co., Inc., 977 F. Supp. 1407 (C.D. Cal. May 9, 1997).
- [169] *Id.* at 1408. The Lanham Act and courts generally treat servicemarks the same as trademarks.
- [170] *Id.*
- [171] *Id.* at 1413.
- [172] *Id.* at 1409.
- [173] *Id.* at 1410.
- [174] *Id.*
- [175] *Id.*
- [176] *Id.*
- [177] *Id.* at 1414.
- [178] *Id.* at 1407.
- [179] Cardservice International, Inc. v. McGee, 950 F. Supp. 737, 738 (E.D. Va. Jan. 16, 1997).
- [180] *Id.* at 738.

[181] *Id.*

[182] *Id.* at 739.

[183] *Id.*

[184] *Id.*

[185] *Id.*

[186] *Id.*

[187] *Id.* at 740.

[188] *Id.*(citation omitted).

[189] *Id.* at 741.

[190] *Id.* The court noted that access to a particular domain name is especially crucial due to "the fact that there is nothing on the internet equivalent to a phone book or directory assistance. A customer who is unsure about a company's domain name will often guess that the domain name is also the company's name....Thus, a domain name is more than a mere internet address. It also identifies the internet site to those who reach it, much like a person's name identifies a particular person, or, more relevant to trademark disputes, a company's name identifies a specific company." *Id.*

[191] *Id.* at 741.

[192] *Id.*

[193] *Id.*

[194] *Id.* at 742.

[195] *Id.* 742-743.

[196] Friedman & Siebert, *supra* note 33, at 661.

[197] Intermatic, 947 F. Supp. at 1228-29.