

Web Site Story 3 - The Emerging Tort of Domain Name Infringement

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Since the first installment of this series, it has become evident that obtaining and protecting domain names will be controlled by trademark law. With a twist. To shape trademark law into a tool to handle domain name disputes, the courts have whittled away the requirement, for a dilution claim, of "commercial use" of a trademark under the Lanham Act, creating a version of trademark infringement that might be called "domain name infringement."

While the courts have applied trademark principles to resolve these disputes, this approach was not inevitable. A domain name is also like a corporate name or like an "800" telephone number, and the rules governing allocation of rights in those areas could have been applied. And, as noted later, trademarks differ from domain names in that several companies can use the same trademark (e.g., for different products), while only one can use a given domain name. A domain name is a Web site host's address on the Internet. The domain name typically identifies the entity that owns the Web site. Many domain names contain the name of the Web site host.

A domain name containing the name of the Web site host assists Internet users in locating the Web site quickly and easily. Since there is no directory assistance on the Internet, and key-word searches on Internet search engines can yield thousands of sites, Internet users often attempt to locate a business's Web site by entering the business's name, e.g., "www.abccorp.com". Consequently, having a domain name containing a company's name has become crucial.

Domain name disputes are typically caused by the restriction that only one Web site can operate on the Internet using a particular domain name. The basic problem arises when a company-call it ABC Corp.-attempts to register its company name as a domain name with Network Solutions, Inc., the company that administers the assignment of domain names on the Internet, only to discover that someone else has already registered "www.abccorp.com" as a domain name.

Courts require the registrant of a domain name to surrender it when another party can show that, as between the parties to the action, it is the sole and rightful owner of the trademark embodied in the domain name. Rather than requiring a showing that the registrant is making "commercial use" of the domain for there to be dilution as a basis for relief, courts seem to be bending traditional trademark principles and equating "commercial use" to any use of a domain name.

In one of the seminal "domain name infringement" cases, *Panavision Int'l, L.P. v. Toepfen*, 945 F. Supp. 1296 (C.D. Cal. 1996), the court found that, while the "[r]egistration of a trade[mark] as a domain name, without more, is not a commercial use of the trademark," the mere attempt to sell that domain name ("www.panavision.com") to the trademark owner was a commercial use. This sufficed to bring trademark rights into play and to compel the registrant to forfeit the domain name.

A recent decision of the Southern District of New York, *Planned Parenthood Federation of America, Inc. v. Bucci*, 1997 WL 133313 (S.D.N.Y. March 24, 1997) loosened the commercial use requirement to the point of applying it to what is, by any reasonable standard, a non-commercial use for the dissemination of political speech. In *Planned Parenthood*, defendant registered the domain name www.plannedparenthood.com". Defendant, however, was actually a Planned Parenthood opponent who used his Web site to direct visitors, who obviously were expecting to reach the Web site of the famous organization by that name, away from birth control and abortion information. Bringing defendant's conduct within the scope of trademark dilution, the court found defendant's Web site, containing pure political speech, to be a "commercial use" of the trademark. As the court explained, the

defendant's use is commercial because of its effect on plaintiff's [Planned Parenthood's] activities. First, defendant has appropriated plaintiff's mark in order to reach an audience of Internet users who want to reach plaintiff's services and viewpoint, intercepting them and misleading them in an attempt to offer his own political message. Second, defendant's appropriation not only provides Internet users with competing and directly opposing information, but also prevents those users from reaching plaintiff and its services and message. In that way, defendant's use is classically competitive: he has taken plaintiff's mark as his own in order to purvey his Internet services-his Web site-to an audience intending to access plaintiff's services.

This broad definition of "commercial use" in the domain name context enables trademark owners to overcome what would seem to be at least an arguable First Amendment defense. In particular, despite the apparent exception to the Dilution Act for "non-commercial," constitutionally protected speech (such as parodies, consumer product reviews, and editorials) described by the California court in *Panavision*, courts have never found the use of another's registered mark as a domain name to be protected speech.

It remains to be seen whether this trend will similarly affect trademark and constitutional analyses of the Web sites' content. From the decisions in the domain name context, Web site domain names and Web site content appear to be divorced. But, based on *Planned Parenthood*, it seems possible for a trademark owner to argue that a Web site using a trademark but containing pure political speech is still a "commercial" use merely because a Web site itself is a product or service and therefore is inherently commercial speech or because of its effect on the commercial activities of others, and therefore entitled to a lower standard of protection under the First Amendment. This opens the door to corporate attacks on antagonistic Web sites, even where the sites would be, under a traditional assessment, political, non-commercial uses. This wrinkle has not yet been fully ironed out.

The other major domain name wrinkle remaining to be ironed out is the problem of conflicting trademarks. Since trademark law permits multiple businesses to use the same mark for different goods and services, how will the courts determine who has priority in the corresponding domain name? Aside from increasing the number of available top-level domains, a proposed partial solution, this conundrum awaits adjudication.

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