

## *Cyber-Gripping: Complain, But Don't Go Commercial*

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The freedom of speech granted by the U.S. Constitution gives us the right to complain. We are given the right to send a critical letter to our newspaper editor, express our displeasure in a television interview, or produce an entire movie critical of our government (e.g., "Fahrenheit 9/11").

On the Internet, it has become fashionable to register a domain name incorporating the trademark or company name of the target of one's ire. The domain name is then used to identify the location of web site content critical of a company's products, services, beliefs or business practices. Other common tactics have been to incorporate the target's trademark or company name as part of the critic's web site content, or into the meta-tags of computer code used to create a derogatory web site, so that search engines will find the sites when the target's trademark or company name is used as a search term. These practices have come to be known as "cyber-gripping". This phenomenon has become so prevalent that the web site <http://www.webgripesites.com> was established to collect links to numerous online grumblers.

Early trademark infringement and dilution actions against domain name and web gripe sites (*circa* 1997-1999) were brought generally under the Trademark Act, 15 U.S.C. §§ 1114(1), 1125(a), or the Federal Trademark Dilution Act ("FTDA"), 15 U.S.C. §§ 1125(c), 1127, and related state laws. In 1999, the Anti-Cybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d), was enacted specifically to target domain name related trademark claims. Lately, trademark owners seeking to use these statutes to take down critical web sites are encountering increased judicial resistance.

### *Early Successes Against Critical Web Site Content*

In some early Internet cases, plaintiff trademark owners were successful in their efforts to stamp out critical web site content. For example, in *Planned Parenthood Federation of America, Inc. v. Bucci*,<sup>1</sup> Richard Bucci ("Bucci"), an anti-abortion activist, established a web site under the domain name <plannedparenthood.com> with a banner appearing on the home page of the site that said "Welcome to the PLANNED PARENTHOOD HOME PAGE!" Planned Parenthood was a non-profit reproductive health care organization that disseminated information about family planning, birth control, and abortion. Bucci's web site, on the other hand, contained content disparaging

the practice of abortion. The court found that Bucci's unauthorized use of the PLANNED PARENTHOOD service mark created a significant likelihood of confusion,<sup>2</sup> and therefore issued a preliminary injunction enjoining Bucci's further use of the mark in this fashion.<sup>3</sup>

The court in *Planned Parenthood* found that Bucci's use of the PLANNED PARENTHOOD mark as a domain name and web site banner was a commercial use because: (i) Bucci's actions affected Planned Parenthood's ability to offer its own services; (ii) Bucci's web site was accessed by Internet users over nationwide telephone lines; (iii) Bucci quoted from and promoted a book entitled "The Cost of Abortion," which assisted the author in selling the book; (iv) Bucci was using the PLANNED PARENTHOOD mark to offer his own anti-abortion information services; and (v) Bucci's use of the mark was tied to his anti-abortion fundraising efforts.<sup>4</sup>

The *Planned Parenthood* court also rejected Bucci's parody and First Amendment/free speech defenses. Bucci's parody defense failed because his domain name and web banner use of the PLANNED PARENTHOOD mark did not depend on lack of confusion to make Bucci's point. Additionally, Bucci's use of the mark did not convey the simultaneous and contradictory messages that it was the original mark of Planned Parenthood and that it was a parody created by Bucci.<sup>5</sup> Bucci's First Amendment/free speech defense did not succeed because he did not use the mark as part of a communicative message, but rather to identify Bucci's anti-abortion information services.<sup>6</sup>

Similarly, in *Jews for Jesus v. Brodsky*,<sup>7</sup> Steven Brodsky ("Brodsky") was a professional web site developer who constructed a web page under the domain name <jewsforjesus.org> that disparaged the mission of Jews for Jesus ("JFJ"). Brodsky's web page also contained a disclaimer that it was unaffiliated with that organization. Brodsky's web page additionally contained a hyperlink to the web site of another organization, Outreach Judaism, which was a vocal opponent of JFJ.

JFJ was a non-profit entity that advocated harmonious relations between Gentiles and Jews. JFJ conducted its activities under the service marks JEWS F\*OR JESUS and JEWS FOR JESUS.<sup>8</sup> The court determined that JFJ was likely to succeed on in federal and state claims for infringement, dilution and unfair competition.<sup>9</sup> In view of the irreparable harm to JFJ and the public's interest in not being deceived, the court issued a preliminary injunction enjoining Brodsky's further use of the JEWS FOR JESUS mark in connection with his Internet activities.<sup>10</sup>

The *Jews for Jesus* court found that Brodsky's use of the JEWS FOR JESUS mark as a domain name was a commercial use because his web site: (i) intended to intercept, through deceit and trickery, the audience sought by JFJ; (ii) conveyed the impression that JFJ was the site's sponsor; (iii) commercially disparaged JFJ; (iv) prevented JFJ from exploiting its own mark; (v) hyperlinked to the Outreach Judaism site, which provided its own viewpoints and offered products and services for sale; and (vi) prevented at least some Internet users from reaching JFJ's own web site.<sup>11</sup> In a mere

passing footnote, the court stated that the parties' "dispute d[id] ... not implicate rights granted by the First Amendment of the United States Constitution."<sup>12</sup>

In *OBH, Inc. v. Spotlight Magazine, Inc.*,<sup>13</sup> OBH, Inc. ("OBH") used the mark THE BUFFALO NEWS in connection with a print and online news publication serving the Western New York area, and also published an apartment rental guide known as *Apartment Finder*. Spotlight Magazine, Inc. ("Spotlight") was the publisher of an apartment rental guide serving Western and Central New York, entitled *Apartment Spotlight Magazine*. OBH published *Apartment Finder* in direct competition with *Apartment Spotlight Magazine*.<sup>14</sup>

Spotlight accused OBH of copying rental ads from *Apartment Spotlight Magazine*, and incorporating the copied ads into *The Buffalo News's Apartment Finder* publication. In apparent retaliation, Spotlight registered the domain name <thebuffalonews.com>, and established a web site under that domain name containing negative opinions and stories about *The Buffalo News*. The web site opened with the greeting, "Welcome to www.thebuffalonews.com." Spotlight's <thebuffalonews.com> site contained a disclaimer of its affiliation with OBH or *The Buffalo News*, links to other news web sites, and a link to Spotlight's own web site <buffalonyapartments.com>. The <buffalonyapartments.com> site was an online version of *Apartment Spotlight Magazine*.<sup>15</sup>

The court found that OBH was likely to succeed on its claims for infringement, dilution and unfair competition.<sup>16</sup> Because of the irreparable harm to OBH, the court preliminarily enjoined Spotlight's further Internet or other use of THE BUFFALO NEWS mark.<sup>17</sup>

The *OBH* court also found that Spotlight's use of THE BUFFALO NEWS mark as a domain name and web site greeting was a commercial use because: (i) Spotlight's web site contained a hyperlink to Spotlight's online version of *Apartment Spotlight Magazine*, operated for commercial purposes; (ii) of the national and international nature of the Internet itself; (iii) Spotlight's web site affected *The Buffalo News's* ability to offer its services in commerce; (iv) Spotlight prevented or hindered Internet users from accessing *The Buffalo News's* services on its own web site; and (v) Spotlight's web site was designed to, and did, harm *The Buffalo News* commercially.<sup>18</sup>

As in *Planned Parenthood*, the *OBH* court rejected Spotlight's parody and First Amendment/free speech defenses. Spotlight's parody defense was rejected because the <thebuffalonews.com> domain name and web page greeting did not depend on lack of confusion to make Spotlight's point, but rather created confusion among consumers. Additionally, Spotlight's domain name and web page greeting did not convey the simultaneous and contradictory messages that it was the original mark of OBH/The Buffalo News and that it was a parody created by Spotlight. An Internet user would only discover this after reading through Spotlight's web site.<sup>19</sup> Spotlight's First Amendment/free speech defense also was rejected because Spotlight did not use the

domain name and web page greeting as part of a communicative message, but rather as a source identifier that was deceptive to Internet users.<sup>20</sup>

In *People for the Ethical Treatment of Animals v. Doughney*,<sup>21</sup> People for the Ethical Treatment of Animals (“PETA”) was an animal rights organization that registered and used the acronym of its name as service mark. Michael Doughney (“Doughney”) registered the domain name <peta.org>, and used it to publish a web site entitled “People Eating Tasty Animals”. Doughney promoted his web site as a resource to businesses and organizations that held views generally antithetical to those of PETA (such as meat and fur vendors, and animal research facilities). After Doughney refused to voluntarily transfer the <peta.org> domain name to PETA, he was quoted in a print article encouraging PETA to “make him an offer” for the name.<sup>22</sup>

PETA then complained to the domain name registrar. Under its rules in effect at the time, the registrar placed the <peta.org> domain name “on hold” so that it could not be used for web site content. Doughney then moved his web site content to the URL <http://www.mtd.com/tasty>, and added a disclaimer of his web site’s affiliation with PETA.<sup>23</sup>

PETA sued Doughney seeking to enjoin him from using the PETA mark and for an order requiring him to transfer the <peta.org> domain name. PETA asserted claims for infringement, dilution, unfair competition and violation of the ACPA. Doughney defended the action by asserting the parody defense. The district court rejected this defense, and entered summary judgment in PETA’s favor.<sup>24</sup>

The Fourth Circuit Court of Appeals determined that Doughney failed to raise a genuine issue of material fact regarding PETA’s infringement and unfair competition claims. The Court also found unavailing Doughney’s arguments against the district court’s finding of liability under the ACPA. The Fourth Circuit therefore affirmed the district court’s entry of summary judgment on these grounds without considering PETA’s dilution claim.<sup>25</sup>

The Fourth Circuit affirmed the district court’s findings that Doughney’s use of the PETA mark as a domain name and as part of web site content were commercial based on the following facts: (i) Doughney’s web site would likely prevent Internet users from accessing PETA’s own web site; (ii) Doughney’s web site provided hyperlinks to the sites of several commercial operations that offered their own goods and services; and (iii) Doughney’s statements to the press and on his web site encouraging PETA to “make him an offer” for the domain name evidenced his bad faith profit motive.<sup>26</sup>

The Fourth Circuit additionally affirmed the district court’s rejection of Doughney’s parody defense. His parody defense was rejected because the <peta.org> domain name, by itself, did not convey the simultaneous and contradictory messages that it was the original mark of PETA and that his site was a parody created by Doughney. That an Internet user would discover the parody upon reading through Doughney’s web site was insufficient.

*More Recent Efforts to Disable Critical Web Sites Have Been Less Successful*

The early cyber-gripping opinions finding in favor of plaintiff trademark owners are fading into case law history. Recently, the courts have been much less willing to allow use of the Trademark Act to silence free and open critical expression.

One of the lone cyber-gripping opinions of the late 1990s finding in favor of the defendant cyber-griper was *Bally Total Fitness Holding Corp. v. Faber*.<sup>27</sup> In this case, Bally Total Fitness (“Bally”) was the owner and user of the marks BALLY, BALLY’S TOTAL FITNESS, BALLY TOTAL FITNESS and others in connection with health club services. Andrew Faber (“Faber”) was a web site designer who posted his web site content under numerous sub-domains from his main domain name <compupix.com>. One such sub-domain was the URL <http://www.compupix/ballysucks>. On his “Bally Sucks” web site, Faber posted information dedicated to complaints about Bally’s health club chain. Bally’s mark appeared prominently on Faber’s site with the word “sucks” superimposed over it. The site also stated that it was “unauthorized”.<sup>28</sup>

Seeking to halt the derogatory postings on Faber’s web site, Bally sued Faber for trademark infringement, trademark dilution and unfair competition. The court, however, found no liability as a matter of law, and ruled in Faber’s favor on summary judgment.<sup>29</sup>

In the course of its opinion, the *Bally* court noted that the manner in which Faber used the BALLY mark on the Internet was not commercial in nature. Faber did not use the BALLY mark to sell his services or to promote his goods in commerce, but rather to express his views of Bally’s business practices.<sup>30</sup> The *Bally* court also opined that Bally was asserting its trademark rights in a manner that would “eclipse [Faber’s] First Amendment rights.”<sup>31</sup>

For a while, the *Bally* decision was one of the few cyber-gripping cases in which a defendant cyber-griper had prevailed.<sup>32</sup> In the last several years, however, the *Bally* opinion has been joined by an ever-growing number of decisions finding in favor of the right to express critical online content.

In *Bihari v. Gross*,<sup>33</sup> Marianne Bihari (“Bihari”) was a well-known, high-end interior designer who served the New York City market under the mark BIHARI INTERIORS. Craig Gross (“Gross”) contracted for Bihari’s services, but their relationship soured and the contract for services was never completed. Dissatisfied with Bihari’s business practices, Gross registered four domain names, <bihari.com>, <bihariinteriors.com>, <designscam.com>, and <manhattaninteriordesign.com>, and at various times posted content to web sites under these domain names that disparaged Bihari. Shortly after being served with Bihari’s Complaint, Gross relinquished his registrations of the <bihari.com> and <bihariinteriors.com> domain names. Gross, however, continued posting his disparaging content to the other two web sites, and also embedded the phrase “Bihari Interiors” within the meta-tags of his web sites so that Internet search engines would locate these sites when the phrase was used as a search term.<sup>34</sup>

Bihari sued Gross, alleging violations of the ACPA, trademark infringement, and state law claims for dilution, unfair competition, interference with prospective business relations, and common law libel. The district court denied Bihari's motion for a preliminary injunction on her federal claims and on her state law claim for libel.<sup>35</sup>

Gross's sites themselves did not offer commercial transactions. Gross was not an interior designer, and did not purport to sell web site visitors any products or services. However, Gross's web sites contained hyperlinks promoting the services of other interior designers. Gross admitted that he designed his web site to steer potential customers away from Bihari and toward her competitors. The *Bihari* court therefore concluded that Gross had "transform[ed] his otherwise protected speech into a commercial use."<sup>36</sup>

On the other hand, the *Bihari* court found that any likelihood of confusion created by Gross's web sites was minimal, and that Bihari failed to prove a likelihood of initial interest confusion. Confusion was unlikely because the disparaging content of Gross's web sites made it unlikely that Internet visitors would believe the sites were sponsored by Bihari.<sup>37</sup> Gross's meta-tag use of "Bihari Interiors" was not a bad-faith attempt to trick Internet users into visiting his web sites, but rather a means of cataloging the content of those sites. Therefore, Gross did not engage in conduct that would create a likelihood of initial interest confusion.<sup>38</sup>

The *Bihari* court also found Gross's meta-tag use of "Bihari Interiors" to be protected fair use. Gross did not use "Bihari Interiors" in a trademark manner, but rather in a descriptive sense to identify and catalog the content of his web sites for Internet search engines. That Gross had prior knowledge of "Bihari Interiors" as a trademark did not detract from his good faith meta-tag use.<sup>39</sup> The *Bihari* court upheld Gross's fair use defense in part on First Amendment/free speech grounds.<sup>40</sup> The court also found Bihari's requested preliminary injunction for libel would be an unconstitutional prior restraint on Gross's free speech rights.<sup>41</sup>

In *The Taubman Company v. Webfeats*,<sup>42</sup> The Taubman Company ("Taubman") was in the process of building a shopping mall to be called "The Shops at Willow Bend". Henry Mishkoff ("Mishkoff") was a web designer who did business under the trade name "Webfeats." Upon hearing that Taubman was erecting The Shops at Willow Bend shopping mall near his home, Mishkoff registered the domain name <shopsatwillowbend.com>. On his web site under that domain name, Mishkoff featured information about the mall and its individual stores. Mishkoff used a prominent disclaimer on his site stating that it was "unofficial". Mishkoff also provided a link to Taubman's official web site for the mall. Additionally, Mishkoff posted links to the web site of his girlfriend's business, <shirtbiz.com>, and to the web site for his own business, Webfeats.<sup>43</sup>

Taubman sued Mishkoff for, *inter alia*, infringement and cybersquatting under the ACPA, seeking a transfer of the <shopsatwillowbend.com> domain name. After Taubman commenced its lawsuit, Mishkoff registered five additional domain names using combinations of the terms "taubman" or "willowbend" followed by the word

“sucks”. Mishkoff’s “sucks” sites all linked to the same content; his running commentary about, and a posting of pleadings relating to, Taubman’s lawsuit.<sup>44</sup>

The district court granted Taubman’s two preliminary injunction motions, the first enjoining Mishkoff’s use of the <shopsatwillowbend.com> domain name and the second enjoining Mishkoff’s use of the “sucks” domain names.<sup>45</sup> The Sixth Circuit Court of Appeals reversed the district court and dissolved both injunctions.<sup>46</sup>

The Sixth Circuit determined that the links Mishkoff established between the <shopsatwillowbend.com> site and the <shirtbiz.com> and Webfeats sites were commercial. However, Mishkoff had removed the <shirtbiz.com> link prior to the issuance of the district court’s injunction (what, if anything, Mishkoff had done about the Webfeats link was unclear). The Sixth Circuit concluded that so long as Mishkoff had no links to commercial web site content advertising any goods or services, the Trademark Act could not be used to enjoin the <shopsatwillowbend.com> site.<sup>47</sup>

The Sixth Circuit additionally found that the parties’ unsuccessful negotiations for Taubman to buy the <shopsatwillowbend.com> domain name did not render Mishkoff’s use of the domain name commercial, because the negotiations commenced with an offer by Taubman, not Mishkoff.<sup>48</sup> Further, Mishkoff’s use of a disclaimer and a link to Taubman’s official web site effectively dispelled any likelihood of confusion.<sup>49</sup>

The Sixth Circuit also held that the content on Mishkoff’s “sucks” sites was purely an exhibition of his free speech rights. Further, Mishkoff’s use of the term “sucks” in the domain names of these sites removed any confusion as to source. On these facts, the Sixth Circuit determined that the First Amendment protected Mishkoff’s use of the Internet for critical commentary when there was no confusion as to source. To the extent that *Planned Parenthood* held to the contrary, the Sixth Circuit stated that the decision (i) was not binding upon it, and moreover (ii) was distinguishable because it involved a domain name that did not include the term “sucks”.<sup>50</sup>

In *Mayflower Transit, LLC v. Prince*,<sup>51</sup> Mayflower Transit, LLC (“Mayflower”) was an interstate moving company. With few exceptions, Mayflower was not licensed to provide intrastate moving services. Mayflower’s various agents, however, could and did provide intrastate moving services using the MAYFLOWER service mark with Mayflower’s permission.<sup>52</sup>

Brett Prince (“Prince”), allegedly by referral from a Mayflower sales manager, engaged one of Mayflower’s agents, Lincoln Storage Services (“Lincoln”), to provide moving and storage services for a move wholly within the State of New Jersey. The truck and boxes for, and some of the paperwork associated with, the move bore the MAYFLOWER trademark. While Prince’s possessions were stored in one of Lincoln’s trucks overnight, many of them were stolen. Prince sued Lincoln and its insurance carrier in state court, and that matter ultimately was settled..<sup>53</sup>

After the unfortunate moving incident, Prince registered the domain name <mayflowervanlinebeware.com> and posted a web site under this name containing content critical of Mayflower, Lincoln, and their businesses. Later, Prince registered the domain names <mayflowervanline.com> and <lincolnstoragewarehouse.com> containing identical critical content. At some point thereafter, Prince discontinued using the <mayflowervanlinebeware.com> domain name, but continued using the latter two domain names for his disparaging web site content. In ensuing communications between Mayflower and Prince, Mayflower claimed it had no responsibility for the move conducted by Lincoln. Prince responded that he would not change his web site content until he received a satisfactory settlement from Mayflower.<sup>54</sup>

Mayflower sued Prince, alleging violations of the ACPA, trademark dilution, and state law claims for libel and trade libel. The parties both moved for partial summary judgment on Mayflower's ACPA and libel claims.<sup>55</sup> The court granted Prince's motion on Mayflower's ACPA claim, but denied his motion regarding Mayflower's state law libel claims because of unresolved issues of material fact. The court denied Mayflower's motion in its entirety.<sup>56</sup>

The court found in favor of Mayflower on the first two of the three prongs of its ACPA claim. The MAYFLOWER mark was distinctive for Mayflower's services, and Prince's <mayflowervanline.com> domain name was confusingly similar to the MAYFLOWER mark.<sup>57</sup> However, as to the third element, the court held that Prince did not have a bad faith intent to profit from his registration of this domain name and thus escaped liability.<sup>58</sup>

Central to the court's decision in Prince's favor was that his use of the <mayflowervanline.com> domain name was non-commercial and for the purpose of critical commentary that Prince had reasonable grounds to believe was lawful.<sup>59</sup> Moreover, nothing contained on Prince's web site nor any of his other accused actions (including his refusal to change his web site content until he obtained a satisfactory settlement) showed that he registered the domain name for the purpose of selling it to Mayflower or anyone else. Additionally, none of Prince's web sites contained advertising or commercial offers to sell anything for a profit.<sup>60</sup>

In *Bosley Medical Institute, Inc. v. Kremer*,<sup>61</sup> Bosley Medical Institute, Inc. ("Bosley") provided hair transplantation and restoration services. Michael Kremer ("Kremer") was a dissatisfied former patient. Kremer brought a medical malpractice claim against Bosley, which was dismissed on summary judgment.<sup>62</sup>

Kremer then registered the domain names <bosleymedical.com> and <bosleymedicalviolations.com>. Bosley claimed that Kremer threatened in writing to publish commentary critical of Bosley's medical practice on these web sites unless Bosley complied with Kremer's demands for money. Ultimately, Kremer used the domain names to establish web sites under the domain names that contained content critical of Bosley's medical business practices.<sup>63</sup>

Bosley brought an administrative complaint before the World Intellectual Property Organization (“WIPO”) Arbitration and Mediation Center, seeking transfer of the domain names. The WIPO panel denied the Complaint because Kremer did not register the domain names for a commercial purpose.<sup>64</sup> Bosley thereupon brought a civil action against Kremer asserting claims for trademark infringement, unfair competition, dilution, cybersquatting, and related state law claims.<sup>65</sup>

Kremer’s web sites under the domain names <bosleymedical.com> and <bosleymedicalviolations.com> contained content critical of Bosley’s business, information about government investigations of Bosley and disciplinary proceedings brought against its founder, and commentary about Bosley’s lawsuit against Kremer.<sup>66</sup> While Kremer’s web sites did not contain any paid advertising or commercial content, they did contain links to sites that advertised the medical services of Bosley’s competitors.<sup>67</sup>

The court ultimately found no evidentiary support for Bosley’s allegations that Kremer used these web sites and their content for extortion or any other evidence of an intent to profit.<sup>68</sup> Adopting the reasoning of *Taubman*, the court also found no likelihood of confusion given Kremer’s use of a prominent disclaimer and a link to Bosley’s authorized web site.<sup>69</sup> Based upon these observations, the court granted Kremer’s motions to dismiss and for summary judgment on Bosley’s federal claims. In view of California’s anti-SLAPP (Strategic Lawsuit Against Public Participation) statute, lack of Kremer’s commercial use of the domain names, and the absence of a likelihood of confusion, the court also struck Bosley’s state law claims. The court denied Bosley’s cross-motion for summary judgment on its trademark infringement and dilution claims.<sup>70</sup>

In *TMI, Inc. v. Maxwell*,<sup>71</sup> TMI, Inc. (“TMI”) was a company that built houses under the mark TRENDMAKER HOMES. TMI advertised its services at a web site under the domain name <trendmakerhomes.com>. Joseph Maxwell (“Maxwell”) intended to buy a house from TMI, but he was unhappy with alleged misrepresentations about the availability of a certain model. Maxwell registered the domain name <trendmakerhome.com> and created a web site under that name containing the story of his experiences with TMI. Maxwell used a disclaimer on his site stating that it was unaffiliated with TMI. Maxwell received, through his web site, some e-mail intended for TMI, which Maxwell forwarded to TMI.<sup>72</sup>

Maxwell also provided a separate section of his web site called “Treasure Chest”, at which readers could share information about reliable contractors and trades people. The “Treasure Chest” only contained a single listing of one contractor who had previously done work for Maxwell.<sup>73</sup> Maxwell never charged money for a listing on the Treasure Chest, or for viewing it, or for any other use of his site. Maxwell’s site contained no advertising and no links to other web sites. Maxwell also was not in the business of selling domain names.<sup>74</sup>

Maxwell maintained the <trendmakerhome.com> domain name and web site for one year. After that time, he removed the site and let his domain name registration expire.

Shortly after Maxwell's registration expired, TMI sent him a letter demanding that he take down the site and transfer the domain name to it. Maxwell then tried to re-register the domain name, but TMI obtained the registration after Maxwell let it expire. Maxwell next registered the domain name <trendmakerhome.info>, prompting a lawsuit by TMI. Maxwell never posted any content to a web site under the <trendmakerhome.info> domain name.<sup>75</sup>

TMI's claims against Maxwell included trademark dilution and unfair competition, and a violation of the ACPA. After a bench trial, the district court found that Maxwell had violated the ACPA and had engaged in trademark dilution. The district court issued an injunction against Maxwell's use of marks or domain names similar to TMI's marks, and directed Maxwell to transfer the <trendmakerhome.info> domain name to TMI.<sup>76</sup> The district court later signed a judgment submitted by TMI, containing additional relief not discussed in the district court's prior opinion, including an expanded injunction, and imposing awards of monetary damages and attorneys' fees.<sup>77</sup>

On appeal, the Fifth Circuit Court of Appeals reversed the district court's judgment and issued its own judgment in Maxwell's favor.<sup>78</sup> The Fifth Circuit determined that, for TMI to obtain relief under the federal dilution act, Maxwell's use of the <trendmakerhome.com> or <trendmakerhome.info> domain names had to be commercial in nature.<sup>79</sup> The Fifth Circuit declined to decide, however, whether the ACPA required Maxwell's use of the domain names to be of a commercial nature. Rather, the ACPA only required proof of a bad faith intent to profit from the use of the domain names.<sup>80</sup>

The Fifth Circuit held that Maxwell's web site under the <trendmakerhome.com> domain name was not commercial in nature,<sup>81</sup> and the domain name was not used with a bad faith intent to profit.<sup>82</sup> Because the state dilution statute under which TMI sued did not cover non-trademark uses for comment, parody, or disparagement of another's goods or services, it did not apply to Maxwell.<sup>83</sup>

### *Concluding Thoughts and Observations*

Early cyber-gripping decisions showed a willingness by the judiciary to allow plaintiffs to use United States trademark law as a means of stamping out critical online content. These early decisions more readily found cyber-grippers to have engaged in online "commercial" activity, so as to bring unauthorized online uses of others' trademarks within the reach of the Trademark Act. Judicial efforts to curb unauthorized uses of trademarks on the Internet, whether as domain names, web site banners, or web site meta-tags, took precedence over First Amendment/free speech and fair use concerns. Disclaimer language posted on the cyber-griper web sites did not detract from the courts' zeal to find trademark liability. The significance of this early line of cases fashioning liability is diminishing with the passage of time.

Cyber-gripping decisions of more recent vintage have come to opposite conclusions. Where the accused web site does not post advertising or invite sales activity,

and does establish links to other web sites that engage in commercial pursuits, trademark liability will not arise. If all that the cyber-griper does, using the plaintiff's trademark online, is post content critical of the trademark owner's products, services, beliefs or business practices, First Amendment/free speech and fair use concerns will be paramount over the trademark owner's rights. The judiciary also is placing greater importance upon an accused party's use of a disclaimer to ameliorate possible confusion among web site visitors.

"[W]hen complaints are freely heard, deeply considered, and speedily reformed, then is the utmost bound of civil liberty attained that wise men look for."<sup>84</sup> The judiciary appears to have taken Milton's seventeenth century admonition to heart. The right of free expression has taken on greater importance over a trademark owner's efforts to control the use of its trademarks on the Internet. When the conduct does not involve matters of unfair competition or the improper usurpation of customer goodwill bound up in trademark rights, but rather the Constitutional right to be heard, cyber-gripping is phenomenon that trademark owners may have to live with in the future.

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<sup>1</sup> 1997 U.S. Dist. LEXIS 3338 (S.D.N.Y. 1997), *aff'd*, 1998 U.S. App. LEXIS 22179 (2d Cir.), *cert. denied*, 525 U.S. 834 (1998).

<sup>2</sup> 1997 U.S. Dist. LEXIS 3338 at \*30.

<sup>3</sup> 1997 U.S. Dist. LEXIS 3338 at \*40.

<sup>4</sup> 1997 U.S. Dist. LEXIS 3338 at \*11-\*13 and \*19.

<sup>5</sup> 1997 U.S. Dist. LEXIS 3338 at \*32-\*34.

<sup>6</sup> 1997 U.S. Dist. LEXIS 3338 at \*35-\*39.

<sup>7</sup> 993 F. Supp. 282 (D. N.J.), *aff'd without op.*, 159 F.3d 1351 (3d Cir. 1998).

<sup>8</sup> 993 F. Supp. at 288-292.

<sup>9</sup> 993 F. Supp. at 305, 308, 310-311.

<sup>10</sup> 993 F. Supp. at 311-313.

<sup>11</sup> 993 F. Supp. at 308-310.

<sup>12</sup> 993 F. Supp. at 286, n. 1.

<sup>13</sup> 86 F. Supp.2d 176 (W.D.N.Y. 2000).

<sup>14</sup> 86 F. Supp.2d at 181-182.

<sup>15</sup> 86 F. Supp.2d at 182-183.

<sup>16</sup> 86 F. Supp.2d at 197.

<sup>17</sup> 86 F. Supp.2d at 198.

<sup>18</sup> 86 F. Supp.2d at 185-186 and 192.

<sup>19</sup> 86 F. Supp.2d at 191.

<sup>20</sup> 86 F. Supp.2d at 197-198.

<sup>21</sup> 263 F.3d 359 (4<sup>th</sup> Cir. 2001).

<sup>22</sup> 263 F.3d at 362-363. A domain name owner's explicit or implicit offer to sell its domain name to the trademark owner for a profit often is an indication of bad faith registration and use of a domain name.

<sup>23</sup> 263 F.3d at 363.

<sup>24</sup> 263 F.3d at 362-364.

<sup>25</sup> 263 F.3d at 367-369 and 371, n.3.

<sup>26</sup> 263 F.3d at 366 and 368.

<sup>27</sup> 29 F. Supp.2d 1161 (C.D. Calif. 1998).

<sup>28</sup> 29 F. Supp.2d at 1162-1163.

<sup>29</sup> 29 F. Supp.2d at 1162, 1166 and 1168.

<sup>30</sup> 29 F. Supp.2d at 1167.

<sup>31</sup> 29 F. Supp.2d at 1166.

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<sup>32</sup> It also may be observed that Faber was not engaging in “domain name type” infringement, because the BALLY trademark was not incorporated as part of Faber’s main domain name, but rather inserted in the sub-domain path for the URL pointing to the web page where Faber’s critical content was located. In this connection, see *Interactive Products Corp. v. A2Z Mobile Office Solutions, Inc.*, 326 F.3d 687, 698 (6<sup>th</sup> Cir. 2003) [“Because post-domain paths do not typically signify source, it is unlikely that the presence of another’s trademark in a post-domain path of a URL would ever violate trademark law.”].

<sup>33</sup> 119 F. Supp.2d 309 (S.D.N.Y. 2000).

<sup>34</sup> 119 F. Supp.2d at 312-314.

<sup>35</sup> 119 F. Supp.2d at 311 and 327.

<sup>36</sup> 119 F. Supp.2d at 318.

<sup>37</sup> 119 F. Supp.2d at 319.

<sup>38</sup> 119 F. Supp.2d at 319-321. For a further discussion of initial interest confusion in the context of web site meta-tags, see *Brookfield Comms., Inc. v. West Coast Enter. Corp.*, 174 F.3d 1036, 1062-1063 (9<sup>th</sup> Cir. 1999)[“the [Trademark] ... Act bars [Defendant] ... from including in its meta[-]tags any term confusingly similar with [Plaintiff’s] ... mark.”].

<sup>39</sup> 119 F. Supp.2d at 321-324.

<sup>40</sup> 119 F. Supp.2d at 323.

<sup>41</sup> 119 F. Supp.2d at 324-327.

<sup>42</sup> 319 F.3d 770 (6<sup>th</sup> Cir. 2003).

<sup>43</sup> 319 F.3d at 771-772.

<sup>44</sup> 319 F.3d at 772.

<sup>45</sup> 319 F.3d at 773.

<sup>46</sup> 319 F.3d at 780.

<sup>47</sup> 319 F.3d at 775.

<sup>48</sup> 319 F.3d at 776.

<sup>49</sup> 319 F.3d at 776-777.

<sup>50</sup> 319 F.3d at 777-778.

<sup>51</sup> 314 F. Supp.2d 362 (D.N.J. 2004).

<sup>52</sup> 314 F. Supp.2d at 365.

<sup>53</sup> *Id.*

<sup>54</sup> 314 F. Supp.2d at 366.

<sup>55</sup> *Id.*

<sup>56</sup> 314 F. Supp.2d at 379.

<sup>57</sup> 314 F. Supp.2d at 367.

<sup>58</sup> 314 F. Supp.2d at 372.

<sup>59</sup> 314 F. Supp.2d at 369.

<sup>60</sup> 314 F. Supp.2d at 371.

<sup>61</sup> 2004 U.S. Dist. LEXIS 8336 (S.D. Calif. 2004).

<sup>62</sup> 2004 U.S. Dist. LEXIS 8336 at \*2 - \*3.

<sup>63</sup> 2004 U.S. Dist. LEXIS 8336 at \*3 - \*4.

<sup>64</sup> 2004 U.S. Dist. LEXIS 8336 at \*4.

<sup>65</sup> 2004 U.S. Dist. LEXIS 8336 at \*4 - \*5.

<sup>66</sup> 2004 U.S. Dist. LEXIS 8336 at \*14 - \*16.

<sup>67</sup> 2004 U.S. Dist. LEXIS 8336 at \*24.

<sup>68</sup> 2004 U.S. Dist. LEXIS 8336 at \*26 - \*27.

<sup>69</sup> 2004 U.S. Dist. LEXIS 8336 at \*27 - \*30.

<sup>70</sup> 2004 U.S. Dist. LEXIS 8336 at \*30 - \*34.

<sup>71</sup> 368 F.3d 433 (5<sup>th</sup> Cir. 2004).

<sup>72</sup> 368 F.3d at 434-435.

<sup>73</sup> 368 F.3d at 435.

<sup>74</sup> 368 F.3d at 438.

<sup>75</sup> 368 F.3d at 435.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> 368 F.3d at 440.

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<sup>79</sup> 368 F.3d at 436.

<sup>80</sup> 368 F.3d at 436-437.

<sup>81</sup> 368 F.3d at 437-438.

<sup>82</sup> 368 F.3d at 438-440.

<sup>83</sup> 368 F.3d at 440.

<sup>84</sup> John Milton, *Areopagitica*, at 4 (1644), reprinted in *The Oxford Dictionary of Quotations*, at 475:2 (4<sup>th</sup> ed. 1996).