I. INTRODUCTION

There is no place like cyberspace. It is vast, it has virtually no rules, and it is easy to get to. It is in high demand and everyone wants to stake a claim in this great new frontier. Of course, to pitch a flag, a domain name is needed.

Unfortunately, obtaining the right to use a domain name is not always easy. Sometimes the name you are looking for is already registered by someone else.1 Other times, if you are lucky enough to get the name you want, you may later face a lawsuit with a big company who is claiming you are unlawfully using “their name” in your domain. Not only does this cause frustration, but it also causes great confusion since the current laws have no straightforward answers to domain name entitlements.
Over the past few years, trademark owners have begun a strong fight to establish property rights in cyberspace. Courts and Congress have responded and are increasingly recognizing that property rights can exist in domain names under trademark and unfair competition law.\textsuperscript{2} Furthermore, the U.S. Patent and Trademark Office has recognized trademark rights in domain names and now allows federal registration of domain names.\textsuperscript{3} However, as the Lanham Act continues to expand and trademarks gain increased property protection, the time has come to reassess the purpose and benefits of protecting domain names as trademarks.

This paper discusses the impact domain names have had on trademark law. Part II describes how trademark laws apply to domain names. It briefly discusses the areas where trademarks and domain names overlap, as well as the areas where the two are completely inapposite. Part III categorizes the types of domain name disputes that commonly arise. This categorization facilitates understanding of how trademark laws can and cannot apply in domain name disputes. Part VI discusses the legal framework by which domain name disputes are currently resolved. Within that context, it discusses how trademark laws have been significantly broadened to resolve domain name disputes. Part V discusses problems with broadening trademark rights to fit domain name disputes. Finally, Part VI concludes that courts and administrative bodies deciding domain name disputes must be careful to insure that they do not stretch trademark law too far to obtain the results they desire. With a careful study of the types of disputes and the facts involved in each case, a new body of law can be formulated to effectively resolve domain name disputes without destroying the foundations of trademark law.

A trademark is “any word, name, symbol, or device, or any combination thereof” used “to identify and distinguish” goods “from those manufactured or sold by others and to indicate the source of goods, even if that source is unknown.”\textsuperscript{4} The law has recognized limited property rights in trademarks.\textsuperscript{5} Specifically, the law recognizes the right of a trademark owner to prevent others from using the mark in a manner that is likely to confuse consumers.\textsuperscript{6} More recently, the owners of “famous” trademarks have been given the additional right to exclude others from diluting, or “lessening the distinctive quality,” of their mark.\textsuperscript{7}

Trademarks have never been afforded the same broad intellectual property protections as patents and copyrights. Trademark owners do not enjoy a “right in gross” over their selected mark.\textsuperscript{8} This is partly because trademarks are not protected to reward or encourage the creation of more trademarks.\textsuperscript{9} Instead, they are protected to encourage investment in product quality and to prevent consumer deception.\textsuperscript{10} In accord with the purpose of protecting consumers, trademark rights are subject to several limitations. First, trademarks are only protected from commercial uses that infringe, meaning that they cause or are likely to cause consumer confusion, or dilute, meaning they lessen the distinctiveness of, the mark.\textsuperscript{11} Therefore, if someone takes the Coca-Cola logo and prints it on personal stationary without using it to market goods or services, there is no commercial use.

Second, trademark law allows concurrent use of the same mark, as long as the concurrent use does not confuse customers.\textsuperscript{12} Thus, both Delta Airlines and Delta Faucets can use the same trademark without any problems. Third, trademark protection is limited geographically. Under common law, trademarks are protected only in the area in which they are actually used.\textsuperscript{13} Federally registered trademarks are protected within the entire United States.\textsuperscript{14} There is no source of trademark law that provides international protection.\textsuperscript{15} Finally, trademark law allows “fair uses,” so others may use the trademark in its descriptive function, rather than its trademark function, as such use does not give rise to confusion.\textsuperscript{16}

Given the limited nature of trademark property rights, trademark owners do not have the “right” to use their trademark in a domain name.\textsuperscript{17} While trademark owners may use their mark in a domain
name, they generally do not have the right to exclude others from using the domain name unless the use gives rise to a likelihood of confusion or dilution.

However, as commercial markets have globalized, and technology has increased the world’s ability to communicate and advertise, trademark law has undergone significant changes. Specifically, the recognition of value in domain names has caused courts and Congress to stretch the trademark laws to give trademark owners more protection. In fact, in some instances, it appears trademark owners do have property rights in domain names.

Domain names are incredibly valuable because they allow millions of customers to access goods and services 24 hours a day at little to no cost. However, the fact that a domain name is valuable does not make it protectible property. Domain names warrant property protection only when they are recognized as trademarks. In some instances, domain names do serve as valuable source-identifying trademarks. Companies may register their trademarks in domain names and then establish web sites to provide goods and services with them. For example, CNN provides its news services at “www.cnn.com.” However, many times domain names are not used as trademarks. In some circumstances, the domain names are used merely as addresses, similar to telephone numbers. For example, CNN could register “www.cnn.com” and post only a picture of a monkey on the web page. The use of the domain name would not constitute trademark use since it is not used to identify CNN’s goods and services. Instead, it is just an address for people to use to access a picture of a monkey. Similarly, domain names are not used as trademarks when they consist of generic terms. For example, “www.wine.com” is generic, so it is not protectible as a trademark, even if it is used to identify the source of goods and services.

Yet even when domain names are also trademarks, they always serve as functional addresses. They are used by consumers to reach desired web pages, and to e-mail desired people. Additionally, domain names are used globally since they are associated with the Internet. Thus, the billion-dollar question arises – under what circumstances should domain names obtain protection as trademarks? To reach this answer, it is necessary to first analyze the types of domain name disputes that arise.

III. DOMAIN NAME DISPUTES

Domain name disputes are complex because different people register different types of domain names for different reasons. Domain names are acquired to set up businesses, to provide information to the public, to establish “personal” identities on the Internet, and even to “pirate” for a profit. Unfortunately, there are only a limited number of domain names, and it is difficult to ascertain who should be able to use what domain name. For example, who is entitled to use the domain name “www.atlas.com?” Should it go to ATLAS, a large publicly traded moving company who has expended millions of dollars advertising their name? Should it go to the “mom and pop” grocery store, ATLAS, because they have been in business six months longer than the moving company? Should it go to the two innovative kids who want to set up a mapping and climate information web site? Should it go to the famous actress named Cheryl Atlas? Should it go to anyone who wants it even if that person does not use it?

There are no existing laws that give exclusive “rights” in domain names. Furthermore, the nature and factual backgrounds of each dispute differ so greatly that there is no one way to resolve domain name disputes. To understand the proper legal framework surrounding these disputes, it is essential to categorize the type of disputes that arise.

A. Cybersquatter Disputes
The first and most well known type of domain name dispute involves cybersquatters. Cybersquatters register domain names for the express purpose of later selling the domain names to someone else for a profit.24 Some cybersquatting is perfectly legal. For example, registering the domain name “www.eat.com” in hopes to later sell the name is legal. The word “eat” is generic, so registering the name causes no trademark conflicts. This type of cybersquatting has turned into a very valuable practice. In fact, the domain name “business.com” was recently purchased for $7.5 million.25 However, it is illegal for cybersquatters to register domain names containing trademarks and trade names with the intent of later selling the domain name to the trademark owner.26

Some cybersquatters pirate personal names instead of trademarks.27 These disputes are even more difficult. Generally, cybersquatters register the names of celebrities, athletes and politicians in hopes that the person whose name is incorporated in the domain name will purchase the domain name for an incredibly high price. Problems arise when more than one person has the same name. For example, Michael Jordan is a former superstar basketball player. However, another Michael Jordan is the former CEO of Westinghouse.28 There are probably hundreds, if not thousands, of other Michael Jordans around the world. Should trademark law allow one to take the domain name “www.michaeljordan.com” over all the others? Current law gives celebrities, politicians, and athletes some protection under state right of publicity laws and the Lanham Act.29 However, these disputes require a careful balancing of free speech rights, private property rights and commercial interests before courts should allow famous people to stake claims in their domain names.

B. Competitor Disputes

The second type of domain name dispute involves competitor registrations. One commentator has called these “preemption” disputes.30 In these situations, people register domain names that contain the company name or trademarks of their competitors.31 Usually this is done either to block the competitor from using the domain name, or to link the domain name to their own company site so people looking for a competitor company will be drawn to the registrant’s company web site. Generally, courts can resolve these disputes under trademark infringement and unfair competition law.

C. "Palming Off" Disputes

The third type of domain name dispute involves domain names registered with the intent to “palm off” the fame and goodwill of someone else’s trademark.32 For example, a pet store could register the name “www.cocacola.com” and use it in connection with its company web site. Although the store has no interest in the name Coca-Cola, it uses the trademark as a domain name to attract people to the site. The pet store hopes once people get to its site, they will stay a while and see what the store offers. This way the pet store generates new viewers it never would have previously obtained. Palming off disputes also arise in the context of competitor disputes. In these situations, a company registers the domain name of its competitor and then links the domain name to its own company web site. This way consumers looking for the competitor will come to them first. Courts generally can resolve these disputes under unfair competition, trademark infringement, and dilution law.33

The fourth type of domain name dispute involves parodies.34 In these situations, someone registers a domain name that resembles a company name or trademark.35 The domain name is then used in connection with a web site that includes commentary or makes a political or satirical point about the company or trademark it resembles.36 The legality of this practice is questionable. In some cases, parody uses of trademarks are protected by the First Amendment.37 However, in other cases courts have allowed trademark rights to trump First Amendment rights, particularly when there are other avenues of expression that the defendant could use that do not infringe a trademark.38
These are significant disputes considering there are hundreds, if not thousands of “sucks” sites on the Internet. People frequently register domain names such as “companysucks.com” to voice their dissatisfaction with the company or its services. In response, many companies are registering these domain names themselves to prevent this type of parody use. The unresolved question is whether trademark owners can prevent critics from registering and using the domain names. These cases should be decided by balancing the First Amendment right of the domain name registrant against the likelihood of confusion resulting from the use of another’s trademark.

E. **Conflicting Interest Disputes**

The fifth type of domain name dispute involves legitimate conflicting uses. Despite all of the hype over cybersquatters, conflicting interest disputes are the most common. In these disputes, the domain name registrant has a legitimate reason for using the domain name it has chosen. Usually, a business registers a name that corresponds with its trade name or trademark. Unfortunately for the domain name registrant, another person may also have trademark interests in the domain name. For example, a small irrigation business could register the domain name “www.delta.com” to correspond with its trade name. A year later, DELTA Airlines may want to sue the small company asserting it has more of an interest in the name, and thus deserves the domain name as well. These cases are very problematic.

Traditional trademark law allows concurrent use of the same trademark. Therefore, there is nothing wrong with both the small irrigation company and the airline using the name “DELTA.” Problems arise only when the use of the same mark gives rise to a likelihood of confusion or dilution. Unfortunately, only one person or entity can use the domain name “delta.com,” even though there are hundreds of “DELTA” trademarks. Does one company deserve the domain more than the other?

The simple answer is probably not. Whoever was smart enough to register the name first should win. Unfortunately, in some cases owners of famous, or at least well financed, trademarks may try to overextend the scope of their trademark rights to take a domain name away from the owner of a weaker trademark. This is known as “reverse domain name hijacking.” Often times the owner of the weaker mark does not have the financial ability to fight the large trademark owner in court and is forced to give up its domain name.

There are also other legitimate conflicting uses that involve surnames and nicknames rather than trademarks. For example, the makers of Gumby and Pokey toys threatened to sue a 12-year-old boy who registered his nickname, “pokey.com.” Similarly, Archie Comics threatened a family that registered their newborn daughter’s name, “veronica.org.” and Ty Inc., the beanie baby creator, sued a man who registered his three-year-old son’s name in “ty.com.” To date, most of the lawsuits involving surnames have either been dropped or settled in favor of the domain name registrant.

While domain name disputes are not always easy to characterize, it is important to understand that the facts of each case may warrant completely different results in different circumstances. Particularly, it is essential to recognize that not all domain name disputes involve cybersquatters, even though those disputes are the most publicized and the most feared. In many cases, trademark owners claim they have property rights in a domain name. However, they often are not, and should not be, given the right without completely analyzing the circumstances.

IV. **THE LEGAL FRAMEWORK FOR RESOLVING DOMAIN NAME DISPUTES**

Because the types of domain name disputes vary considerably, resolving them has proven
to be a difficult task. Likelihood of confusion, unfair competition and dilution have all become recurrent themes in domain name disputes. More recently, two new theories have evolved in an attempt to deal with domain name disputes, the Anticybersquatting Consumer Protection Act and the ICANN Dispute Resolution Policy. This section will discuss the theories available to trademark owners and the problems involved in applying them.

A. Traditional Trademark Theories Used in Domain Name Disputes

Since the very first domain name disputes, trademark owners have tried to assert rights in domain names under established trademark law. Many cases have been won and lost; yet little clarity has emerged on the issue of who is entitled to which domain names.54 This is partly because the traditional trademark doctrines do not adequately cover domain name disputes. Therefore, courts have often used an expedited form of analysis to reach ideal results.55 Unfortunately, this has created a harmful trend of overlooking many relevant issues, such as whether the domain name in question is actually being used as a trademark and whether it is being used in commerce. Additionally, courts have greatly expanded certain concepts, such as the definition of a “famous” mark. This section discusses trademark infringement, unfair competition and dilution. It then explains that they do not quite “fit” domain name disputes, but courts have broadened the doctrines to accommodate trademark owners.

i. Trademark Infringement

In some instances, trademark owners may challenge domain name registrations on the basis of trademark infringement. Owners of federally registered trademarks may use Section 32(1) of the Lanham Act to enjoin another from making infringing use of their trademark.56 A trademark owner has a cause of action if the registrant is using a domain name that incorporates the owner’s trademark or a term that is confusingly similar to the owner’s trademark to sell or promote goods or services that are related to the trademark owner’s goods and services.57 To determine whether the registrant’s use of the mark creates a likelihood of confusion, courts employ a multi-factor balancing test.58 The relevant factors include (1) similarity of the marks; (2) relatedness or proximity of the two companies’ goods and services; (3) strength of the plaintiff’s mark; (4) marketing channels used; (5) degree of care likely to be used by purchasers in selecting the goods; (6) defendant’s intent in selecting its mark; (7) evidence of actual confusion; and (8) plaintiff’s likelihood of expansion in product lines.59

Generally speaking, trademark infringement is most likely to occur in the context of competitor disputes and “palming off” disputes.60 However, the other types of domain name disputes usually do not involve trademark infringement because the marks involved are rarely used in interstate commerce, or in a manner that is likely to cause confusion. In fact, a recent study showed that only 12% of domain name disputes fit within the traditional trademark infringement framework.61 For example, parody disputes are unlikely to give rise to a likelihood of confusion because the domain names are used to provide information or comment about a product, not compete with it, or pass itself off as the original. Furthermore, in conflicting interest disputes, usually either the goods and services involved are not competing or there is no commercial use. Cybersquatting disputes seem far from the realm of trademark infringement as well because they usually do not involve “commercial use,” “trademark use,” and there is simply no likelihood of confusion. However, courts have not had any difficulty stretching the trademark infringement doctrine to reach the results they desire in domain name disputes.62

First, the “use in commerce” requirement is frequently not met in domain name disputes. For example, cybersquatters often do not actually use the domain names they register with a web site.63 Instead, they simply “hoard” the marks and wait for trademark owners to approach them with a buy-out offer.64 In cases where cybersquatters do establish web pages with the domain names, they frequently
make noncommercial use of the sites. Accordingly, cases under those scenarios would not fall within the Lanham Act because the marks are not used “in commerce.” However, some courts have been willing to stretch the meaning of “use in commerce” to stop cybersquatters. For example, in *Panavision v. Toeppen*, the Ninth Circuit held that conducting business as a cybersquatter constitutes commercial use. Even though the cybersquatter made noncommercial use of the web site used with the domain name, the court held that the cybersquatter acted “as a ‘spoiler,’ preventing Panavision and others from doing business on the Internet under their trademarked names unless they pay his fee.” Similarly, in *Planned Parenthood v. Bucci*, the Southern District of New York held that the interstate commerce element is met because the domain name registrant’s actions affect the trademark owner’s ability to offer services and information over the Internet. Furthermore, the court stated that the “in commerce” requirement is met for purposes of the Lanham Act simply by establishing a web page on the Internet, regardless of its content.

To date, courts have only stretched the “in commerce” requirement in cybersquatter cases, but there is no telling if the same analysis would be used in all domain name disputes, or even all trademark disputes. This is unnerving since there are many people who legitimately establish non-commercial web sites on the Internet or reserve domain names until they get a web site established and operational.

Second, domain names are not always used as trademarks in domain name disputes. As mentioned above, cybersquatters usually do not put their domain names to “trademark use.” Because cybersquatters rarely use their pirated names at all, they cannot possibly be used to identify the source of goods and services. Furthermore, when domain names are used in a non-commercial manner, they only indicate an address on the Internet and are not functioning as trademarks. For example, use of a domain name for e-mail seems not to be trademark use but merely use as an address. However, some courts completely skim over this requirement and simply assume that using a domain name is trademark use.

Courts have held that using domain names to lure people that are looking for the trademark owner’s company web site to gain new visitors to the domain name owner’s web site is trademark use. Accordingly, “palming-off” disputes and some competitor disputes may involve trademark use. In these cases, the domain name is used specifically to confuse consumers as to the source or affiliation of the domain name.

Finally, in many domain name disputes, consumer confusion is simply unlikely. When consumers type in a name looking for a specific company or product, and a different company or individual’s page loads, the customers are not likely to be confused about whose web site they are visiting. However, courts have created a new theory called “initial interest confusion,” which allows a finding of likelihood of confusion in these situations anyway. Initial interest confusion arises when a consumer types in the web site of a company looking for specific products or services. Instead of the company’s web site loading, a different company’s web site loads. Because the consumer likes what it sees at the web page, he stays there instead of continuing to search for correct web page it was looking for, even though he knows that he had not reached the intended web page. Thus, the domain name user gains a new customer by “appropriating the goodwill” of another’s trademark. This concept is rather vague, however. In one case, a court found initial interest confusion existed when a domain name was used with a web site that contained content that was similar to the services offered by the trademark owner. In another case, the court found that the goods and services were so different between the trademark owner and the domain name registrant that the “momentary confusion” was not “substantial enough to be legally significant.” So the question becomes, what is enough? If initial interest confusion arises only when both the domain name registrant and the trademark owner have competing goods and services, the initial interest doctrine does not seem necessary.
The courts have yet to determine the scope of this concept, but there is potential for extreme interpretation. For example, if a consumer is looking for the White House web page and types in “www.whitehouse.com,” the page that loads will contain pornographic information. The majority of consumers will not think the United States President created, or associated himself with, the web site. They would simply realize the White House web page was located somewhere else. However, this could be characterized as infringing under the “initial interest confusion” concept if the consumer stayed at the porn site instead of continuing a search for the real White House web page.

ii. Unfair Competition

Unfair competition is very similar to trademark infringement, but it covers a broader scope. Unfair competition law protects trade names, as well as trademarks. This provides a remedy for people whose trade names are used in domain names unlawfully, since trademark infringement does not extend to those situations. Section 43(a) of the Lanham Act generally protects against three types of misleading commercial behavior. First, it protects against the commercial use of “any word, term, name, symbol, device, or any combination thereof” that is likely to cause confusion, mistake or deception as to the “affiliation, connection, or association” of the domain name registrant with the trademark or trade name owner. Additionally, it protects against commercial use of a name or mark that creates confusion as to the “origin, sponsorship, or approval” of goods and services provided by the domain name registrant. Finally, it prohibits the commercial use of a name or mark in connection with false advertising.

The test for proving unfair competition is generally the same as the test used in trademark infringement. Like trademark infringement, there are specific instances where domain name registrants do engage in unlawful unfair competition. For example, “palming off” disputes may very well fall within the ambit of unfair competition because the domain name registrant is using someone else’s goodwill to attract consumers to its web site. Further, competitor disputes are likely to fall within the realm of unfair competition when the domain name registrant uses its competitor’s trademark in a domain name to sell its own goods and services, or to falsely represent that it is that company.

However, most domain name disputes do not fall within unfair competition laws. Therefore, it is essential to look at the facts involved and whether the behavior actually fits within the confines of the statute when unfair competition is alleged.

iii. Dilution

Since January 1996, trademark owners have also been able to use the trademark dilution doctrine against domain name registrants. Dilution is easier to apply to domain name disputes because trademark owners do not have to show likelihood of consumer confusion or competition between the two parties. Instead, to prevail on a dilution claim, the trademark owner must show (1) that it owns a famous mark (2) defendant is making commercial use of the mark; (3) the defendant’s use began after the mark became famous; and (4) the defendant’s use of the mark in the domain name dilutes the quality of the mark by diminishing the mark’s capacity to identify and distinguish goods and services.

The dilution doctrine itself has created a large shift in trademark law by granting owners of “famous” marks a right similar to a right-in-gross. This is even more true when the dilution doctrine is applied to the Internet. For example, if dilution laws allow one trademark owner to prevent others from using “www.famousname.com,” concurrent use of trademarks on the Internet could be wholly eliminated. That would provide the trademark owner with a substantial property right – a right-in-
As if the concept of rights-in-gross for certain famous mark owners was not enough, courts have already broadened the doctrine beyond its intended scope. As with trademark infringement, courts have stretched the “use in commerce” requirement to allow dilution claims to reach cybersquatters. Courts have held that “use of the Internet is sufficient to meet the ‘in commerce’ requirement” of the Lanham Act.

Further, courts have construed the meaning of “famous” very broadly. The Lanham Act lists several factors that should be used to determine whether a mark is famous. Only a small fraction of marks are indeed famous. These marks include Xerox, Exxon, and Coca Cola. However, courts have been willing to place the “famous” label on otherwise-not-so-famous marks to stop cybersquatters. For example, does holding the mark “Intermatic” is famous really pass the “straight-face” test?

The dilution doctrine has been invoked by many large companies with well-known trademarks to recover domain names containing their trademarked words. Unfortunately, this is often used as leverage by large companies, regardless of the merits of their anti-dilution case. The big companies can afford to invoke costly litigation, while frequently the small company domain name user cannot afford to fight over the name. The same is true for trademark infringement and unfair competition claims.

B. New Developments

By the end of 1999, little clarity existed in the realm of domain name disputes. Thus, the Internet Corporation for Assigned names and Numbers (“ICANN”) and Congress took steps to clarify the domain name battlefield. Specifically, the steps taken by Congress and ICANN were aimed at curtailing cybersquatting on the Internet. Unfortunately, both the ICANN policies and the new legislation promulgated by Congress have greatly expanded trademark law in their attempt to combat cybersquatting.

i. ICANN Uniform Domain Name Dispute Resolution Policy

ICANN recently established a Uniform Domain Name Dispute Resolution Policy specifically aimed at curtailing and resolving domain name disputes. The mandatory dispute resolution policy (“ICANN Policy”) sets forth a fast-track arbitration procedure whereby trademark owners may contest certain domain name registrations. In this process, a neutral arbitrator is selected to decide the case within 45 days. This provides trademark owners with interests in domain names a quick and cheap alternative to costly litigation. Furthermore, the procedure is implemented on a global scale, so international disputes can be easily resolved without jurisdictional or choice of law problems.

To invoke the ICANN proceedings, the challenger must show (1) the registrant’s domain name is identical or confusingly similar to a trademark or service mark that the third party has rights in; (2) the registrant has no rights or legitimate interests in the domain name; and (3) the registrant registered and used the domain name in bad faith.

The ICANN Policy enumerates four particular circumstances that provide evidence of registration and use in “bad faith.” First, bad faith is present where it appears that the registrant acquired the domain name for the primary purpose of selling or leasing the domain name to the owner of the trademark or to a competitor of the trademark owner for a profit. Second, bad faith may be inferred where it appears that the registrant acquired the domain name to prevent the trademark owner from using it. This inference arises when the registrant has engaged in a pattern of such conduct. Third, bad faith is present when the domain name is registered “primarily for the purpose of disrupting the business of a
competitor.” Finally, bad faith occurs when the domain name is used to intentionally attract Internet users to the site for commercial purposes by creating a likelihood of confusion with the complainant’s mark. The ICANN Policy states that the enumerated circumstances are not exhaustive. Thus, the panel has discretion when finding bad faith.

The ICANN Policy also enumerates the ways a domain name registrant can demonstrate that they do have legitimate rights and interests in their domain name. A registrant may show that before notice of the trademark dispute was received, the registrant used the domain name, or a name similar to the domain name in connection with a bona fide offering of goods or services. A registrant may also show that he or she has been commonly known by the domain name. Additionally, a registrant may show that the domain name was used for legitimate noncommercial or fair use purposes without intending to make commercial gain by misleading customers or tarnishing the complainant’s trademark or service mark.

Remedies under the ICANN Policy are limited to cancellation of the domain name, or a transfer of the domain name registration to the complainant. Complainants with disputes can submit the case to a court of competent jurisdiction before using the ICANN Policy, and all decisions under the ICANN Policy may be appealed in court.

Several cases have already been decided under the ICANN Policy. While many of the cases seem to be clear-cut cybersquatting cases, there are other cases that are more questionable. Specifically, the interpretation of “registration and use in bad faith” has already been greatly expanded. In the very first case decided under the ICANN Policy, the panel held that the bad faith use requirement was met when “respondent offered to sell the domain name to complainant ‘for valuable consideration in excess of’ any out-of-pocket costs directly related to the domain name.” The panel concluded that it should look to prior judicial decisions defining what constitutes a use in bad faith. It used the definition of “use in commerce” from the Panavision and Intermatic cases to come to this definition of the bad faith requirement. This definition seems reasonable since both of those cases were attempts to combat cybersquatters. However, the bad faith use requirement was recently expanded. In Telestra Corp. Ltd. v. Nuclear Marshmallows, the panel found bad faith even though there was no evidence of bad faith, and none of the enumerated circumstances existed. In Telestra, the challenger owned the mark TELESTRA, and challenged the respondent’s domain name “telestra.org.” To prevail, Telestra was required to prove both “use in bad faith” and “registration in bad faith.” However, Telestra did not know who the domain name registrant was, and there was no web site used with the domain name. Without this information it would appear to be nearly impossible to show either use or registration in bad faith under the ICANN Policy. Accordingly, Telestra’s claim for bad faith was tenuous at best. The panel allowed Telestra to side step the requirement, however, by stating that bad faith can be inferred through inaction. The panel allowed Telestra to prove bad faith registration and use of the domain name by merely asserting that the registrant did not use the domain name, and therefore the registrant could not possibly have a good faith reason for registering it. Thus, the Telestra decision almost seems to allow Trademark owners to win by default if the domain name registrant cannot be contacted.

Furthermore, recent decisions imply that the bad faith requirement can be stretched to cases that clearly do not involve cybersquatters. For example, a recent case involved two companies, one operating in the United States under the trade name “Fiber-Shield Industries, Inc.,” the other operating in Canada as “Fiber Shield LTD.” Both companies had been operating under the FIBER SHIELD name without knowledge of the other. The United States company had a federal trademark registration for FIBER SHIELD and was the first to register the domain name “fibershield.com.” A while later, the Canadian company attempted to register the same name, but discovered it was already registered by the United
States company. Therefore, the Canadian company registered the domain name “fibershield.net” instead. The United States company found out about “fibershield.net” and invoked the ICANN Policy to strip the Canadian company of its domain name. Arguably, both companies have the right to use their name on the Internet. However, the panel disagreed, and found that the Canadian company registered “fibershield.net” in bad faith because they registered it after they became aware that the United States company registered “fibershield.com.” The decision did not mention exactly what the goods and services of the respective companies were, but even if the two companies offered the same services, is it fair to give the first company to register a domain name the rights to all domain names containing that mark? Furthermore, since Fiber Shield was clearly not a cybersquatting case, should the panel have decided it at all? Is this an attempt to apply United States trademark laws internationally?

While the purpose of the ICANN Policy is laudable, its application is questionable, and seems to expand trademark rights on the Internet just as much as the early court decisions.

ii. Anticybersquatting Consumer Protection Act

Congress has also lent its eyes and ears to the issue of cybersquatting. Approximately one month after the ICANN Policy was approved, President Clinton signed the Anticybersquatting Consumer Protection Act (“ACPA”) into law. The ACPA amends the Lanham Act to specifically prohibit cybersquatting.

The ACPA makes it illegal for any person with a bad faith intent to profit to register, traffic in, or use a domain name that contains a trademark that was distinctive or famous at the time of registration. This creates an entirely new doctrine of infringement, which departs from traditional trademark principles in several ways to effectuate its goal of combating cybersquatting.

First, like the ICANN Policy, the ACPA requires trademark owners to prove that the domain name was registered with a “bad faith intent to profit.” This is significant since the Lanham Act has always treated trademark infringement and dilution as strict liability torts. However, the ACPA requires bad faith, and enumerates several non-exhaustive factors for courts to consider when determining whether the domain name was registered in bad faith. Those factors include:

1. whether the domain name registrant has any trademark or other intellectual property rights in the domain name;
2. whether the domain name consists of the legal name or common name used to identify the registrant;
3. whether the registrant previously used the mark in connection with the bona fide offering of goods and services;
4. whether the registrant made noncommercial or fair use of a web site in connection with the domain name;
5. whether the registrant had an intent to divert customers from the trademark owner to harm the goodwill of the mark, either for the registrant's own commercial gain or to tarnish or disparage the mark by creating a likelihood of confusion as to the source, affiliation or sponsorship of the mark;
6. whether the registrant offered to sell or assign the domain name for a profit without ever using, or intending to use, the domain name in the bona fide offering of goods and services, or whether the registrant had a prior pattern of engaging in such conduct;
7. whether the registrant provided material and misleading false contact information when applying for the domain name;
8. whether the registrant acquired multiple domain names that the registrant knew were identical,
confusingly similar to distinctive marks, or dilutive of famous marks at the time they were registered, without regard to the goods and services of the parties;
9. whether the mark in the domain name is distinctive and famous under the statute.150

While these bad faith factors may be helpful, they also leave open areas that could be interpreted broadly. For example, the sixth factor addresses whether the registrant ever tried to sell the domain name for a profit.151 Imagine a scenario where an individual registers the name “newyorkknicks.com” to set up a fan web site. The individual spends hours of time developing his site but does not get it online before the New York Knicks send him a cease and desist letter, claiming he is infringing upon their famous trademark. He knows he cannot afford to fight the New York Knicks in court, but he does not want to hand over his domain name for nothing after all of his hard work. Therefore, he offers to sell the domain name to the New York Knicks for $500. Does this offer alone make him a “bad faith” registrant under the ACPA? Apparently some trademark owners think so, because many lawsuits similar to the scenario above have been recently filed under the ACPA.

Second, the ACPA has no general “use in commerce” requirement.152 While this allows courts to avoid stretching the Lanham Act to reach cybersquatters, this can be problematic if the courts extend the ACPA to situations that fall outside cybersquatting.

Third, the ACPA completely disregards the types of goods and services provided in connection with the trademark involved.153 This implies that Congress is willing to provide a much broader scope of trademark rights. Under the ACPA, the trademark will receive protection from someone who uses it in a domain name, no matter what the name is being used for.

Fourth, the ACPA protects not only “famous” trademarks, but also “distinctive” trademarks.154 This in and of itself is a huge leap for trademark owners. One of the biggest criticisms of applying the dilution doctrine to cybersquatting cases was that the marks involved were not really famous. Apparently it does not matter under the ACPA, because the mark will be protected as long as a court finds it is “distinctive,” a quality every registerable trademark has.

Fifth, the ACPA provides interesting remedies to trademark owners. Under the ACPA, the courts can cancel domain name registrations or transfer the domain name from the registrant to the trademark owner.155 Therefore, the court can not only declare that the domain name registrant does not have rights in the domain name but also that the trademark owner is entitled to use the domain name. Furthermore, trademark owners may elect statutory damages instead of having to prove actual damages and lost profits.156 Courts will award statutory damages between $1000 and $100,000 per domain name infringed.157

Sixth, the ACPA allows trademark owners to file in rem actions in certain instances.158 Generally, the ACPA allows in rem actions when the trademark owner cannot obtain in personam jurisdiction over the registrant or if the trademark owner cannot locate the domain name registrant after diligently trying to.159 The remedies in in rem actions are limited to cancellation or transfer of the domain name.160 This provision has already been used by Bell Atlantic to assume control of over 20 domain names.161 Bell Atlantic sued over 90 defendants who registered domain names incorporating Bell Atlantic trademarks.162 While most of the defendants relinquished the domain names to Bell Atlantic, 20 either refused or could not be located.163 Invoking the ACPA, a federal magistrate judge allowed Bell Atlantic to take all 20 of the domain names.164 This provision allows large trademark owners to sue for control of dozens of domain names at a time without having to sue each registrant separately. This allows trademark owners to assert their rights much more inexpensively and quickly. Furthermore, the in rem provisions allow trademark owners to sue domain name registrants in other
countries. They can simply state that they cannot obtain personal jurisdiction over the registrant, so they will sue the domain name instead. This provides an otherwise unavailable international remedy that will probably be very effective, since many international domain name registrants will not come to United States courts to fight for the domain.

Seventh, the ACPA protects personal names used in domain name registrations. The ACPA provides:

“Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action.”165

Violations of this section of the Lanham Act can result in cancellation or transfer of the mark, and in the court’s discretion, attorneys’ fees.166 This is also a vast departure from traditional trademark laws. Trademark laws do not protect surnames unless the names are used as trademarks and have acquired secondary meaning.167 However, the ACPA engrafts a right of publicity into the Lanham Act when domain names are involved. This raises several serious issues. As with trademarks, who is entitled to use their name in a domain name? There are many people with the same name, and there are also many fans and critics of celebrities, athletes and politicians. Apparently Congress decided that celebrities, athletes and politicians are the ones that deserve more protection than anyone else. To date, there have been many lawsuits filed under this provision as well.168

Finally, the ACPA codifies the case law rule that domain name registrars shall not be held liable for infringement in domain name disputes unless the registrant acted in bad faith.169 Accordingly, trademark owners may not sue those who issue domain name registrations.

Advocates of the ACPA argue that this new law is designed only to stop cybersquatters without having to expand the trademark doctrines any further. They say that the ACPA will only target cybersquatters and leave the rest of trademark law untouched. Unfortunately, looking at the cases already filed under the ACPA, many trademark owners are using the ACPA to claim sweeping rights in domain names and are threatening legitimate users of domain names. For example, the New York Yankees recently sued Brian McKiernan for registering the domain name “www.newyorkyankees.com”170 While McKiernan had not yet established a web site, he was planning to set up a personal fan page.171 The Yankees did not like the idea though and sued McKiernan under the ACPA. Shouldn’t a die-hard Yankees fan have a First Amendment right to set up a web page showing his love for his baseball team? The Yankees already have the domain name “www.yankees.com,” so why do they need another one? If anyone went to a fan page, he or she would almost assuredly know that it was not the Yankee’s “official site. From the facts disclosed to the media, McKiernan is not a cybersquatter, and his actions do not constitute a likelihood of confusion or dilution. Perhaps the New York Yankees are just going too far.

To date, only one case applying the ACPA has been reported.172 The case dealt with a competitor dispute where the domain name was registered merely to prevent a competing company from using the name.173 While the case was not a typical “cybersquatting case,”174 the court held that the ACPA applied because the domain name Registrant was acting in “bad faith.”175 How far the courts will extend the ACPA beyond actual cybersquatting disputes is yet to be determined.

Many critics also worry that the ACPA will undermine the inexpensive and quick procedures established by the ICANN Policy.176 Trademark owners are unlikely to file under the ICANN Policy.
when they can use the ACPA to obtain damages and to threaten the domain name registrant with a long, and costly, process.

V. THE PROBLEM WITH BROADENING TRADEMARK RIGHTS

As shown, trademark law has recently drastically broadened to accommodate domain name disputes. While in some instances it is appropriate to apply trademark law to these disputes, there are many times that it should not. For example, if there is a genuine likelihood of confusion or dilution, trademark law certainly applies. Additionally, in clear cybersquatting cases, the ICANN Policy and the ACPA should apply. However, trademark law should not be broadened to give trademark owners rights that they otherwise are not entitled to.

While “domain name law” develops, a clear trend is emerging. The law is giving more protection to trademark owners. The question is whether the law will eventually give large trademark owners property rights in domain names, i.e. the ability to exclude others from using them. In determining whether the trademark laws should reach this far, perhaps it is necessary to revisit the purpose of trademark protections. Trademarks are protected to provide consumers with accurate information about the goods and services the marks represent, and to give companies incentives to invest in their marks and increase quality control. Trademarks therefore lower consumer search costs and promote the economic functioning of the market. Marks themselves are not protected, but the law protects the goodwill the marks embody.

In some circumstances, giving monopolies in domain names can lower consumer search costs. It is well known that if a consumer is looking for a company online, their first search will be typing in “www.companyname.com.” This can be very effective when there is only one company with that name. For example, it may lower search costs for people looking for the Xerox Company, since there are probably no other companies that use that name. However, it is very inefficient for customers looking for a company that uses a mark that many other companies also use. For example, if a customer is looking for the irrigation company Delta, or the Delta faucet company and types in “delta.com” only to find Delta Airlines, consumer search costs are not lowered at all.

Furthermore, allowing monopoly rights in domain names will discourage companies from using names that are already taken. Traditional economic justifications for trademark law rest on the premise that there are an infinite number of marks available. However, there are only a limited number of domain names available. Recent estimates indicate that 97% of the names in the Webster's Dictionary have already been registered as domain names. If trademark owners are given a right in gross over domain names, concurrent uses of trademarks will become economically infeasible. For example, if a startup company knew it could never use any variation of the word DELTA in a domain name, it certainly would not adopt such a mark to use in connection with its goods and services.

Another area of concern with such a right is that it would allow trademark owners to preclude others from using not only one but several marks. It is becoming common practice for companies to register all the domain names they can think of that contain their company name. For example, Exxon currently holds the rights over more than 120 domain names incorporating the word “EXXON.” Accordingly, it is possible for Delta Airlines to register, “www.delta.com,” “delta.org,” “delta.net,” “flydelta.com,” “deltaonline.com,” and “deltasucks.com” and link them all to the same company web
page. But is it really fair to allow Delta Airlines to have a complete monopoly over all these names when there are hundreds of other companies that have an interest in the name DELTA? This hardly seems to promote “consumer differentiation among products.” Instead, it seems to promote protection of large companies who want rights in every possible variation of their name.

From a realistic point of view, the current expansion in laws gives trademark owners a significant amount of leverage. For example, many times people with legitimate interests in their domain names cannot afford to fight trademark owners. Litigation over domain names can cost from $100,000 to $250,000 and may take a very long time. Additionally, these cases are often very uncertain and can lead to unpredictable results. Naturally, this will force many to simply turn over their rights in order to avoid “corporate bullying.”

VI. CONCLUSION

Domain name disputes can and should fit within established trademark law. However, these doctrines should not be broadened to come to results-based decisions. The way the current Lanham Act and ICANN Policy are written, all legitimate claims trademark owners may have can be addressed properly if the facts involved in each dispute are carefully considered. However, the laws can also be broadened drastically to give trademark owners near rights in gross over their trademark in domain names if courts and administrative panels decide these cases too quickly. Courts and administrative panels deciding these cases should be aware of the problems such broad interpretations can create, and should avoid stretching these rights.

1. Domain names are registered on a “first come first served” basis. See e.g., Network Solutions, Network Solutions' Domain Name Dispute Policy (visited Mar. 8, 2000) <http://www.networksolutions.com/legal/dispute-policy.html>. They can be registered for $70 for two years if the registrant already has a web site ready to be used in connection with the domain name or if the registrant wishes to develop the site immediately. See id. Otherwise, a domain name can be reserved without any use requirement for $119. See id.

2. Courts have recognized trademark rights in domain names through trademark laws. They have allowed trademark owners to prevent uses of the marks in domain names that are likely to cause confusion or dilution. See discussion infra Section IV(A). Furthermore, Congress has established a right of trademark owners to prevent others from “cybersquatting.” See 15 U.S.C. §1125(d); see also discussion infra Section IV(B)(ii).

3. See United States Patent and Trademark Office, EXAMINATION GUIDE NO. 2-99 (Sept 29, 1999) [hereinafter EXAMINATION GUIDE]. Second level domain names may be registered as trademarks. See id. Domain names can be broken down into different parts. For example, “http://www.cats.com” contains four parts. The first part, “http://” refers to the protocol used to transfer information. The second part, “www” refers to the World Wide Web. The third part, “cats” is the second-level domain. This portion reflects company names, topics, last names, or whatever else the domain name registrant chooses to use. Sometimes people may have trademark rights in the second-level domain, or perhaps the second level domain is their name. It is the second-level domain that usually constitutes the heart of domain name disputes. Finally, the fourth part, “.com” is the top-level domain (“TLD”). The top-level domains refer to the categories the domain name is registered in. For example, “.com” is the most frequently sought after TLD because it refers to a commercial site. See GreatDomains.com Issues Criteria to Value Domain Names, With Values From Worthless up to $10 Million, BUSINESS WIRE, Aug. 2, 1999. Other examples include “.edu” for four-year universities; “.gov” for U.S. government agencies; and “.us” for addresses geographically reflecting the United States county code. See id.

4. 15 U.S.C. §1127. Marks that cover services rather than goods are known as “service marks.” See id.
5 See Walt-West Enter., Inc. v. Gannett Co., Inc., 695 F.2d 1050, 1057 (7th Cir. 1982).

6 See 15 U.S.C. §§ 1114(a) and 1125(a).


10 See id. at 1688.


13 See e.g., Dawn Donut Co. v. Hart’s Food Stores, Inc., 267 F.2d 358 (2nd Cir. 1959).


15 This causes difficulty in applying trademark law to domain names and the Internet.

16 See Blair & Cotter, *supra* note 11, at 15.


18 See id. at 1687.


20 See Nathenson, *supra* note 19 at 949.

21 See e.g., id. at 950-51; Davis, *supra* note 19, at 618.

22 Generic terms are not protectible as trademarks. See e.g., Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co., 408 F.Supp. 1219 (D. Col. 1976).


24 See Nathenson, *supra* note 19, at 925.


29 See *id.* Right of publicity laws are available but vary greatly from state to state. Recently, the Lanham Act was amended to add a civil cause of action against “any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without the person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party.” 15 U.S.C. §1129(b)(1)(A).


32 See *e.g.*, Hasbro, Inc. v. Internet Entertainment Group, Ltd., 40 U.S.P.Q.2d 1479 (W.D. Wash. 1996) (defendant preliminarily enjoined from using “candyland.com” in connection with pornography web site that was likely to dilute plaintiff’s famous mark CANDYLAND used in connection with children’s board games); Toys “R” Us v. Akkaoui, 40 U.S.P.Q.2d 1836 (N.D. Cal. 1996) (holding that domain name “adultsrus.com” used in connection with a pornography web site diluted plaintiff’s Toys “R” Us trademark).

33 However, these disputes may also now fall under trademark infringement and “initial interest confusion.” See discussion *infra* Section IV(A)(i).


35 See *id*.

36 See *id*.

37 See *e.g.*, Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g. Group, Inc., 886 F.2d 490, 497 (2nd Cir. 1989) (Parody cover of SPY NOTES, that conjures up the CLIFFS NOTES trademark a fair use that outweighs the slight risk of consumer confusion); Bally Total Fitness Holding Corp. v. Faber, 29 F.Supp.2d 1161 (C.D. Cal. 1998) (Defendant’s web page called “Bally Sucks” was protectible consumer commentary, not unfair competition or dilution of plaintiff’s health club marks).

38 See *e.g.*, Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 402 (8th Cir. 1988) (Since there are other avenues of expression that do not infringe a trademark, injunction does not deprive the public or the defendant.).

39 See *e.g.*, Lee Copeland, *Cyberbashers Proliferate: Even as Threat of Cybersquatting Eases*, COMPUTERWORLD, Feb. 21, 2000, at 32.

40 One commentator has dubbed these disputes as “twins.” See Nathenson, *supra* note 19, at 928.

41 See Mueller, *supra* note 30. A recent study suggests that 49% of domain name disputes involve conflicting interest, or “character-string” conflicts. See *id*. Cybersquatter disputes constituted 35%, while actual infringement only occurred in 12% of cases. See *id*.

42 See *id*.

43 See generally *id*.

45 See Blair & Cotter, supra note 11, at 40.

46 Currently there are 487 federally registered trademarks that contain the word “Delta.” Additionally, 132 marks containing the word “Delta” are pending federal registration. See U.S. Patent and Trademark Office, Trademark Text and Image Database (searched on Mar. 28, 2000) <http://trademarks.uspto.gov/access/search-mark.html>.

47 See NATHENSON, supra note 19, at 928.


49 See DAVIS, supra note 19, at 610.

50 See NATHENSON, supra note 19, at 928.


52 See Keith Rodes, A Rose is a Rose is a Rose.com, THE CALIFORNIA AGGIE UNIVERSITY WIRE, Jan. 20, 2000.


54 See DAVIS, supra note 19, at 614-15.

55 For example, some courts seem to assume that merely registering and holding a domain name is illegal, without exploring or exposing any legal basis for the assumption. See id. at 618.

56 15 U.S.C. §1114 (1). Owners of non-registered trademarks can look to state common law, or can use Section 43(a) of the Lanham Act, which prohibits unfair competition.

57 See id. See also Marcus J. Millet, Same Game in a New Domain – Some Trademark Issues On The Internet, NEW JERSEY LAWYER, Aug. 1999, at 32. To prevail, the trademark owner must prove that: it owns prior rights in the registered trademark; the defendant is using the same or similar mark in interstate commerce; in connection with the sales, advertising, distribution or offering of goods or services; in a manner that creates a likelihood of confusion, deception or mistake. See 15 U.S.C. §§ 1114(1)(a).

58 The actual test employed varies from jurisdiction to jurisdiction.

59 See Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1053-54 (9th Cir. 1999).

60 See, e.g., Brookfield, 174 F.3d 1036, 1066 ("When a firm uses a competitor’s trademark in the domain name of its web site, users are likely to be confused as to its source or sponsorship."); Green Products, 992 F.Supp. 1070 (court found likelihood of confusion when firm registered the domain names of competitors although the domain name was never actually used); Cardservice Int’l., Inc. v. McGee, 950 F.Supp. 737 (E.D. Va. 1997) (holding that the defendant’s use of “cardservice.com” infringes competitor’s trademark, Cardservice International).

61 See Stewart Deck, Big Firms Have a Leg Up in Domain Name Disputes, COMPUTERWORLD, Jun. 26, 1998; see also MUELLER, supra note 30.

See, e.g., Jennifer Golinveaux, What’s In a Domain Name: Is “Cybersquatting” Trademark Dilution?, 33 U.S.F. L. REV. 641, 652 (summer 1999); MUELLER, supra note 30; MILLET, supra note 57, at 35.

See MUELLER, supra note 30.

For example, in Panavision Int’l., L.P. v. Toeppen, the cybersquatter registered the domain name “Panavision.com” and placed only aerial view photographs of Pana, Illinois on the web page. 141 F.3d 1316, 1325 (9th Cir. 1998).


See Panavision, 141 F.3d at 1325.

See id. (citing Panavision Int’l. L.P. v. Toeppen, 938 F.Supp. 616, 621 (C.D. Cal. 1996)).

See Planned Parenthood, 42 U.S.P.Q. 2d at 1434.

(The use in commerce requirement is met because “Internet users constitute a national, even international audience, who must use interstate telephone lines to access defendant’s web site on the Internet. The nature of the Internet, for access to all users, would satisfy the Lanham Act’s “in commerce” requirement.”)

Courts have granted several preliminary injunctions under the mere assumption that domain names are trademarks. See DAVIS, supra note 19, at 616.

73 See id. at 620.

74 See id. at 616.

75 See id.

76 See id. at 621; see also Planned Parenthood, 42 U.S.P.Q. 2d at 1432.

77 See id.

See Brookfield, 174 F.3d at 1057. Although the court did not dub the type of confusion “initial interest confusion” until it discussed meta tag infringement, the court explained the concept in the context of trademark infringement as well. See generally id. at 1057 and 1062.

79 See id. at 1057.

80 See id.

81 See id.

82 See id.

83 See Richard Levh, Cybersquatting in Focus; Are New Rules Needed or Will Existing Laws Sufice?, NEW YORK LAW JOURNAL, Jan. 18, 2000, at S4; see also Brookfield, 174 F.3d at 1058.

84 See LEHV, supra note 83; see also Hasbro, 1999 U.S. Dist. LEXIS 13848.

85 That scenario would seem to fall within the established likelihood of confusion analysis.

87 The White House web page is at <http://www.whitehouse.gov>.


89 Trade names are not federally registerable as trademarks and are therefore not protected from trademark infringement.


91 Id.


93 See NATHENSON, supra note 19, at 951.


95 See GOLINVEAUX, supra note 63, at 654.

96 Panavision, 141 F.3d at 1324.

97 See Golinveaux, supra note 63, at 654.

98 See Nathenson, supra note 19.


100 See supra Section VI(A)(i).


104 See Davis, supra note 19, at 609.

105 ICANN is a non-profit, private sector corporation that was formed in October 1998 by a broad coalition of the Internet's business, technical, and academic communities. See Internet Corporation for Assigned Names and Numbers, ICANN Fact Sheet (last modified Jul. 16, 1999) (<http://www.icann.org/general/fact-sheet.html>). ICANN was established after the Clinton Administration published an executive order in July 1997 calling for privatization of the Internet Domain Name System (DNS) and after the publication of a document entitled "Management of Internet Names and Addresses," commonly known as the White Paper, in June, 1998. See Internet Corporation for Assigned Names and Numbers, Frequently Asked Questions (FAQ) (visited Mar. 7, 2000) (<http://www.icann.org/general/faq1.htm>). The objective was to create a private corporation representing the broad and diverse interests of the global Internet community that could develop uniform policies for the management of DNS. See generally id. Accordingly, ICANN’s members include volunteer representatives from all over the globe. See id. The United States government has designated ICANN to serve as the global consensus entity that is responsible for coordinating key functions for the Internet, including management of the DNS with regard to all .com, .net, and .org top-level domains. See id.


See id.

See id.

See id. at §4(a).

See id. at §4(b).

See id. at §4(b)(i).

See id. at §4(b)(ii).

See id.

See id. at §4(c)(iii).

See id. §4(b)(iv).

See id. at §4(a).

See id. at §4(c).

See id. at §4(c)(i).

See id. at §4(c)(ii).

See id. at §4(c)(iii).

See id. at §4(i).

See id. at §4(k).

ICANN publishes its Uniform Dispute Resolution Policy decisions at <http://www.icann.org/udrp/proceedings-list.htm>.


See World Wrestling Federation, Case No. D99-0001, 6.3.

171 F.3d 1316 (9th Cir. 1998).


See World Wrestling Federation, Case No. D99-0001, 6.3.


Id. at 4.2 and 4.6.

See id. at 5.2, 7.3 - 7.11.
In claiming that the respondent acquired the domain name in bad faith, Telestra alleged: (1) the respondent never registered its trading name as a business name as required under Australian business law; (2) respondent provided false address information in its domain name registration; (3) Telestra is a well-known mark so it is “inconceivable” that the respondent would not be aware of the Telestra mark; (4) because the Telestra mark is so well-known, members of the consuming public would likely think the domain name was owned by Telestra or associated in some way with Telestra; and (5) any “realistic use of the domain name must misrepresent an association” with Telestra and its goodwill.

See generally id.


See id.

See id.

See id.

See id.


The Lanham Act precludes registration of a mark that is “primarily merely a surname.” See 15 U.S.C. §1052(e)(4). Only surnames that have acquired secondary meaning and are recognized by the public to distinguish goods and services are protectible.

For example, John Tesh, Kenny Rogers, and Brad Pitt have all sued people that registered their names in domain names. To date, none of these lawsuits have been decided.


See David King, Dot.squatters Law Doesn’t Hamper All, SAN ANTONIO EXPRESS NEWS, Jan. 16, 2000, at 1C.

See id.


In Sporty’s Farm, the defendant registered the domain name “sportys.com,” knowing that SPORTY’S was a “famous” trademark used in connection with aviation products. See id. The court found that the defendant had no interest in the name SPORTY’S. See id. at 23. Further, the court concluded that the ACPA applied because the defendant acted with a “bad faith intent to profit” when it registered the name because (1) the defendant had no intellectual property rights in the name when it registered it; (2) the defendant’s company, SPORTY’S FARM, was not formed until nine months after registering the name, and did not begin operations until after the lawsuit was filed; and (3) the defendant was planning to enter the aviation product market and it appeared that the name was registered to prevent the trademark owner from using it. See id. at 23-26.

As discussed supra Section III(A), cybersquatters generally register domain names with the specific purpose of later selling them to the trademark owner for a profit.


See e.g., Susan J. Kohlmann, et. al., Cyberpiracy Remedies and New Dispute Resolution Procedures, THE METROPOLITAN CORPORATE COUNSEL, Feb. 2000, at 8; Grossman, supra note 51.

See e.g., Lemley, supra note 9 at 1688-1690.

See id.


See id. at 760.

See e.g., Davis, supra note 19, at 607; Golinveaux, supra note 63, at 643.

See Rodes, supra note 52.

184 See id. at 608.

185 See Davis, *supra* note 19, at 608.

186 See id. at 614.