

Trademarks and the Internet (Ch. 11, mostly)

Lanham Act § 43(d) (15 U.S.C. §§ 1125(c), 1125(d))
Restatement (Third) of Unfair Competition § 25
AntiCybersquatting Consumer Protection Act (ACPA)

CB 307-311, 431-440 (& supp 47-49)

Intro: A few words on toplevel domains and what they do.

(Absolutely not required: If you care about this topic, you might want to read *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 Duke L.J. 17 (2000), available online <http://www.law.miami.edu/~froomkin/articles/icann.pdf> . If you are particularly interested in how trademarks are regulated in cyberspace, you might want to look at *ICANN's "Uniform Dispute Resolution Policy" -- Causes and (Partial) Cures*, 67 Brooklyn Law Review 605 (2002), available online <http://personal.law.miami.edu/~froomkin/articles/udrp.pdf>)

New gTLDs introduced by ICANN
.info .biz .name .pro .museum .aero .coop

Can domain names be registered as trademarks?

DN must function as source identifier to be registerable...

Initial interest confusion on the Internet

Brookfield adopted the initial interest confusion test for web sites domain names. It's not clear to me that this is at all sensible.

The Newtork Newtork v. CBS, Inc. (CD Cal. 2000) [431]

P, holder to tnn.com filed for declaratory judgment that it has a right to the DN and CS

P & D are in very different businesses (consulting vs. TV).

Record shows folks briefly visiting web site, some misdirected email

Court distinguishes *Insterstellar Starship v. Epix* on grounds that in that case there was at least tangential overlap of goods, hence possible to say that there might be 'lingering' confusion leading to lost sales.

Distinguishes *Brookfield* (moviebuff.com) case - similar goods, plus that was an initial interest confusion case -- requires that there be *competition* between the goods. That's because the essence of the offense is the Jr. user "capitalizing on the sr user's goodwill".

QUERY: is there a dilution claim here?

Promatek Insus v. Equitrac Corp [Supp 47]

D provides maintenance and service on P's COPITRACK equipment. D put the word "Copitrack" name into its metatags on its web page.

P sued D. D removed the metatags and contacted search engines to remove links. P pressed on for injunctive relief.

Seventh Cir. held that injunction requiring D to place language on it's page directing people to P was proper since (1) there was a strong case for likelihood of (initial interest) confusion, citing *Brookfield* and (2) "Equitrac cannot unring the bell".

[Note, however, that putting this language on the page will have some effect on search engine behavior... ;>]

QUERY: Suppose Ted's Repair does not sell but merely fixes Copitrack equipment. Can it say so on its web page? Can it put the term in a metatag? Why?

Playboy Ent. v. Netscape [438]

Issue is that Netscape runs a search engine and sells banner ads keyed to search engine terms including P's marks.

Held, that's ok -- in part because the words have common meanings other than as P's marks; in part because the use is not an infringing use - just gives an alternative link as well ...

Playboy v. Universal Tel-A-Talk (ED Pa. 1998) [439]

Website adult-sex.com incorporated P's marks to invite subscription to P's authorized, authentic, site. Held, hyperlink to P's site caused source confusion and was an attempt to capitalize on P's reputation.

Issue: what's the harm? It's not unfair competition - P gets the \$

Harm, if it is one, is somehow suggesting sponsorship or authorization by P.
Not exactly unfair competition, though, is it?