

Cybersquatting: Trademarks and the Internet

Digital Law
Villanova Graduate Law
Professor Kenneth P. Mortensen

Headlines

- sting.com
 - Court found that the artist's name was too much of a common word.
 - No finding of "bad faith"

Headlines

- candyland.com
- Both Hasbro and an adult entertainment provider desired the candyland.com domain name. Hasbro was too late to register the name itself, but it did sue. The domain name is now safely in the hands of Hasbro.

Headlines

- mcdonalds.com
- This domain name was taken by an author from who was writing a story on the value of domain names. In exchange for returning the domain name to McDonalds, the author convinced the company to make a charitable contribution.

Headlines

- micros0ft.com
- The company Zero Micro Software obtained the registration, but the registration was suspended after Microsoft filed a protest. When the domain name went abandoned for non-payment of fees, the domain name was picked up by someone else, Vision Enterprises of Roanoke, TX

Headlines

- mtv.com
- The MTV domain name was originally taken by MTV video jockey Adam Curry. Although MTV originally showed little interest in the domain name or the Internet, when Adam Curry left MTV the company brought a federal court action, which was settled out of court.

Headlines

- peta.org
- An organization entitled "People Eating Tasty Animals" obtained the peta.org and not People for the Ethical Treatment of Animals. This domain name was suspended, but as of May 2000 the domain name was still registered in the name of People Eating Tasty Animals.

Headlines

- roadrunner.com
- When NSI threatened to suspend the roadrunner.com domain name after a protest by Warner Brothers, the New Mexico Internet access provider who was using the domain name filed suit to prevent the suspension. The suspension was stopped but a joint venture company eventually obtained the domain name.

Headlines

- taiwan.com
 - The mainland China news organization Xinhua was allowed to register the domain name taiwan.com, much to the disgust of the government of Taiwan.

Anticybersquatting Consumer Protection Act of 1999

- Amendment to the Trademark Act of 1946
- Provides for civil liability
- Bad Faith requirement
- Remedies
 - injunctions
 - damages
- Limitation of liability for Domain Registrars
- Study to be conducted.

Statutory Factors

- Does the domain name holder have trademark rights in the domain name?
- Is the domain name the legal name of the domain name holder, or some other name that is otherwise commonly used to identify that person?

Statutory Factors

- Has the domain name holder made use (prior to the dispute) of the domain name in connection with a bona fide sale of goods or services?
- Is the domain name holder using the mark in a bona fide noncommercial or fair use way at a web site accessible at the domain name?

Statutory Factors

- Is the domain name holder attempting to divert consumers from the trademark owner's web site in a confusing way, either for commercial gain or in an attempt to tarnish or disparage the trademark mark?

Statutory Factors

- Has the domain name holder offered to sell the domain name to the trademark owner (or anyone else) for financial gain without having any intent to use the mark with the sale of goods or services?

Statutory Factors

- Has the domain name holder behaved in a pattern of registering and selling domain names without intending to use them in connection with the sale of goods or services?
- Did the domain name holder provide false information when applying for the registration of the domain name (or do so in connection with other domain names)?

Statutory Factors

- Has the domain name holder registered domain names of other parties trademarks?
- How distinctive and famous is the trademark owner's trademark?

Study under Act

- Protection of Personal Names
- Protection from bad faith use
- Protection from use of Public or Official names
- Review of Current Law
- Review and collaborate with ICANN

Uniform Domain-Name Dispute-Resolution Policy

- Trademark Owner must show:
 - that the trademark owner owns a trademark (either registered or unregistered) that is the same or confusingly similar to the registered second level domain name, and;
 - that the party that registered the domain name has no legitimate right or interest in the domain name, and;
 - that the domain name was registered and used in bad faith.

UDRP

- Showing of legitimate right to keep domain
 - use or preparations to use the domain name in connection with a bona fide offering of goods or services prior to any notice of the dispute;
 - that the domain name owner has been commonly known by the second level domain name; or

UDRP

- that the domain name owner is making legitimate noncommercial or fair use of the domain name, without intent of (i) commercial gain, (ii) misleadingly diverting consumers, or (iii) tarnishing the trademark at issue

Bad Faith Showing

- The registrant
 - registered the name primarily for the purpose of selling or transferring the domain name to the trademark owner or a competitor of the trademark owner for a price greater than out of pocket costs;
 - engaged in a pattern of registering trademarks of others to prevent the use of the domain name by the trademark owner;

Bad Faith Showing

– registered the domain name primarily to disrupt the business of a competitor; or is attempting to attract users to a web site for commercial gain by creating a likelihood of confusion with the trademark owner's trademark.
