Abstract

Stacey Knapp obtained her J.D. from Stetson University College of Law located in St. Petersburg, Florida. She is currently working as a sole practitioner in Galena, Illinois. Below, Ms. Knapp explores the conflict concerning the control of domain names (i.e. trademarks) as well as the relationship between businesses and non-mark holder uses under the Uniform Domain Name Resolution Policy (“UDRP”) which has advantaged trademark holders to the detriment of fair use, especially in parody and protest uses.

Part I of this article looks at the foundational concepts behind the UDRP and its current implementation by exploring the origins of trademark on the World Wide Web (“Web”). Part II deals with the fundamentals of cybersquatting and the evolution of Reverse Domain Name Hijacking (“RDNH”). Part III explores protest activity on the Web as well as the split within the UDRP panels due to disagreements concerning the validity of certain domain names. Part IV concludes this article with the examination of a strange case in which Chase Manhattan Bank attempted to register a domain name containing its mark name plus a pejorative in order to prevent others from doing the same, but was ultimately foiled by the protest site named “chasebanksucks.com.”

BALANCING THE CRUCIBLE: THE REVOLVING CONFLICT BETWEEN FAIR USE AND CORPORATE USE IN THE BATTLE TO CONTROL DOMAIN NAMES

Stacey Knapp

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I. Introduction

Because the World Wide Web (“Web”) has become global, competition for domain names among businesses, clubs, schools, organizations, and individuals interested in posting a website has also become global. This competition has opened the floodgates for disagreements over marks and translations of marks beyond the neighborhood, state, providence, and country to the rest of the world. Consequently, the race to the domain name has been fierce: increasing the number of legitimate contenders racing to obtain a name from a limited pool of words, characters, and symbols. Added to this mix is fair use. While the use of the same words inside and outside of commerce is possible in the real world, it is not always easy in the restrictive world of the domain name where businesses, clubs, schools, organizations, and people alike try to limit their names and Internet addresses to a relatively short combination of descriptive characters. These competing needs have been in conflict ever since businesses discovered the benefits of the Web. Consequently, the balancing of fair use with legitimate commercial use has resulted in an explosion of litigation due to these competing needs. While non-mark holders originally profited by abusing a system that benefited the pure race to the domain name, legislation and policies have been enacted attempting to curtail these acts. However, these legislative acts and policies have changed the balance of power to favor corporate use and abuse.

This paper analyzes the continuing struggle to control domain name usage. From civil courts struggling with the earliest cases of cybersquatting to arbitration decisions under the Uniform Domain Name Resolution Policy (“UDRP”) and the emerging recognition of Reverse Domain Name Hijacking (“RDNH”), the evolution of trademark and service mark litigation
within this microcosm remains dynamic and intense. With this tumultuous background in mind, recommended solutions to these problems include forcing the UDRP to adhere more truthfully to the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), and to allow those victimized by RDNH to recover damages significant enough to cause corporations to cease their scattergun approach to mark litigation. If the ultimate goal of legislators and international agreement makers centers on helping mark holders protect their marks within the limited world of domain names, then these bodies should also aid and protect private citizens outside of commerce or commercial endeavors using principals of fair use from the abuses of mark holders.

Part I of this article looks at the foundational concepts behind the UDRP and its current implementation by exploring the origins of trademark on the Web. Part II deals with the fundamentals of cybersquatting and the evolution of RDNH. Part III explores protest activity on the Web as well as the split within the UDRP panels due to disagreements concerning the validity of certain domain names. Part IV concludes this article with the examination of a strange case in which Chase Manhattan Bank attempted to register a domain name containing its mark name plus a pejorative in order to prevent others from doing the same, but was ultimately foiled by the protest site named “chasebanksucks.com.”

II. Defining Trademark

When a business entity utilizes a name in commerce, the entity can seek to protect the name so that it remains firmly tied to the entity’s use, product, and reputation.1 This does not preclude a business’s use of all target words or phrases contained in another business’s domain

name. Instead, it merely precludes that business from using the same or similar words in the course of the same or similar business.  

While recognizing the importance of reputation and products associated with a name, treaties between governments have evolved to protect and resolve conflicts between mark uses. One of the first treaties to recognize trademark rights between nations was the Paris Convention for the Protection of Industrial Property (“Paris Convention”) created in 1883 and revised periodically from 1900 through 1979. Countries following the Paris Convention are not restricted as to how they go about registering trademarks, but they are limited in the enforcement of foreign trademarks. Under Article 6bis of the Paris Convention, countries belonging to the Union are allowed to recognize marks registered in other countries of the Union. Members of the Union can refuse or repeal the registration of marks likely to cause confusion with a mark that has already been registered. Furthermore, paragraph 3 of Article 6bis notes that bad faith can be used without a time limit in the cancellation of a registered mark.

The Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods (“TRIPS”) adopted the provisions of the Paris Convention and further refined the rights conferred on registered owners. TRIPS defines a mark as “[a]ny sign...capable of distinguishing the goods or services of one undertaking from those of other

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2 Id.
3 Id. art. 1, para. 1.
4 Paris Convention, supra note 1.
5 Id. art. 2, para. 2.
6 Id. art. 2, para. 1.
7 Id. art. 6bis.
8 Id.
9 Id. para. 3.
11 Id. art. 1, para. 3 (defining the scope and purpose of TRIPS).
undertakings, shall be capable of constituting a trademark.”\textsuperscript{12} This provision extended the scope of trademark within the U.S. by determining a date of use for foreign marks as the date of registration of that mark, regardless of use.\textsuperscript{13} However, use is a general requirement for U.S. trademark registration.\textsuperscript{14} The rights conferred upon the holder of such a trademark include the ability to exclude all others from using the same or similar marks in the course of a same or similar trade.\textsuperscript{15} Confusion is acknowledged per se when the mark is the same and the goods or services offered are the same.\textsuperscript{16} If confusion is possible, the use of the trademark will be restricted if the use of the mark would likely indicate a connection between the trademark owner’s goods or services and the other entity’s goods or services.\textsuperscript{17}

\textbf{III. Defining Fair Use}

While TRIPS and the Paris Convention extend protection to like or similar names utilized in the course of business which offers like or similar services for those in member nations,\textsuperscript{18} neither TRIPS nor the Paris Convention allow trademark holders to restrict the use of words utilized as marks outside this realm.\textsuperscript{19} Consequently, Nike, the tennis shoes company, does not have a monopoly on the word Nike. Thus, classicists do not need to seek licensing every time they want to mention the Greek goddess, Nike, in a paper or presentation. Moreover, while Microsoft may have a monopoly on the term “Windows” as it relates to the computer operating system industry,\textsuperscript{20} Microsoft cannot prevent articles from being written that criticize the

\textsuperscript{12} \textit{Id.} § 2, art. 15, para. 1.
\textsuperscript{14} \textit{Id.} § 1051(d).
\textsuperscript{16} \textit{See supra} note 15.
\textsuperscript{17} TRIPS, \textit{supra} note 10, § 2, art. 16, para. 1.
\textsuperscript{18} \textit{Compare TRIPS, supra} note 10, § 2, art. 16, \textit{with} Paris Convention, \textit{supra} note 1, art. 6\textsuperscript{bis}.
\textsuperscript{19} Paris Convention, \textit{supra} note 1, art. 6\textsuperscript{bis}, para. 1.
\textsuperscript{20} Though this is in debate. Lindows, a program that allows Linux users to run Windows on a Linux platform and that derived its name from combining \textit{Lin}ux with \textit{Win}dows, is currently the focus of civil suit within the U.S.; see
platform. Nor can Microsoft stop a company specializing in window glass from using the word “Windows” in its company name or advertising. While such uses should be evident, this is not always the case. Fair use, a term of art in intellectual property, extends to other uses of a trademark. While there is no explicit statement defining fair use in trademark law, it is a concept understood through the protection extended to marks, preventing others from utilizing the same or substantially similar marks in a like or similar business. From the constraints placed on trademarks, to the protection within a like or similar business, the doctrine of fair use is implied to uses outside commerce or within differing commerce offerings of dissimilar goods and services.

Fair use also includes the ability to use a mark in commercial marketing when it accurately identifies the source of goods offered for sale. Consequently, a shoe shop can advertise that one of the brands it sells is a Nike brand sneaker without being accused of improper use of a mark. Or, a software developer can assert that his product will work on Windows without infringing on the trademark holder’s rights.

In the United States, the Restatement (Third) of Unfair Competition persuades courts that an action can be brought against anyone using a trademark, or mark resembling a trademark, “to comment on, criticize, ridicule, parody, or disparage the other or the other’s goods…[or] services,…only if the actor’s conduct meets the requirements of a cause of action for defamation, invasion of privacy, or injurious falsehood.” This indicates that comments, criticism, ridicule
and parodies are a part of fair use as long as the disparagement does not cross the threshold into defamatory or other injurious tort.

One classic case dealing with defamation and injurious falsehood is *Hustler Magazine, Inc. v. Falwell*\(^{23}\) where Rev. Jerry Falwell sued Hustler Magazine over a parody ad replete with sexual double entendre as a caricature of Falwell talked about “his first time.”\(^{24}\) This parody was part of a series of such ads, but Falwell sued on grounds of injurious falsehood, intentional infliction of emotional pain, and invasion of privacy.\(^{25}\) The Supreme Court found that absent malice coupled with a false statement, parodies, no matter how distasteful, do not cross the threshold into these intentional torts.\(^{26}\) The First Amendment further precluded this form of commentary from the realm of intentional tort, especially when the target of the parody is a public figure or public entity.\(^{27}\)

Unfortunately, these are not the rules adhered to by the Internet Corporation for Assigned Names and Numbers (“ICANN”), World Intellectual Property Organization (“WIPO”), and the courts when dealing with domain names. Mark holders tend to garnish more rights within the domain name system than would be possible in a normal context, especially in the United States. Furthermore, legislation coupled with international policies has extended the rights of mark holders beyond their normal scope on the international level.


\(^{24}\) *Id.* at 48.

\(^{25}\) *Id.*

\(^{26}\) *Id.* at 52.

\(^{27}\) *Id.* at 54.
IV. The Limited World of the Domain Name

The Internet is a series of interconnected computers initially developed to share information among the military and academic institutions. Propagating a variety of services, the Internet grew, and commerce discovered one facet of the Internet, the World Wide Web, which inaugurated an explosive growth in the demand for this service and in Web use over all. With this boom, conflict is inevitable. One of the main areas of conflict exists in the realm of domain name regulation.

Web addressing exists in two contexts: the Internet Protocol (“IP”) address and the domain name. A web site must have an IP address, while a domain name is optional. While there is no real problem in creating a unique IP address, there are problems associated with creating a unique domain name.

An IP address is a series of numbers designating the node or location of an Internet address. The top level of an IP address is a series of four numbers, each ranging from zero to 255, separated by periods. To access a top level IP address, those four numbers consisting of

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29 These services include File Transfer Protocol, Internet Relay Chat, Gopher, BBS, and the World Wide Web, to name a few.
33 Id. at 24-26.
34 Id. at 672-74.
35 Id. at 669.
36 Id. at 392-93.
37 Id. at 669-74.
38 Id. at 672.
up to twelve digits can be entered into the address bar of a web browser, and the browser will find that address.\textsuperscript{39}

A domain name is the alphanumeric counterpart to an IP address.\textsuperscript{40} While it can be difficult to remember twelve digits, a logically ordered series of letters and numbers is much easier to recall.\textsuperscript{41} Furthermore, a plethora of domain names can be associated with one specific IP address.\textsuperscript{42} A domain name can also point to a specific subdirectory of an IP address’s subdirectory, creating a much briefer series of input needed to access specific content. While Earthlink, a popular Internet Service Provider (“ISP”), owns the IP addresses spanning from 63.173.11.112 to 63.173.11.127,\textsuperscript{43} and an Earthlink user can have a personal homepage located at “home.earthlink.net/~user_name,” that user can register a domain name and have that domain name point directly to his or her subdirectory within the Earthlink IP address span.

While multiple domain names can point to one IP address,\textsuperscript{44} the converse is not true. Once a domain name has been assigned, that same domain name cannot be used by anybody else to point to any other content. This can lead to confusion since companies and people with the same name can exist, but cannot use the same domain name.\textsuperscript{45} Most domain names are assigned

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\begin{itemize}
  \item \textsuperscript{39} Id. at 390.
  \item \textsuperscript{40} Id.
  \item \textsuperscript{41} Id.
  \item \textsuperscript{42} Id. at 394.
  \item \textsuperscript{43} See ARIN’s WHOIS database, at \url{http://www.arin.net/WHOIS/index.html} (last visited Dec. 27, 2003), and search under the word “earthlink.” While Earthlink has expanded to include DSL and other services, the IP address listed in this paper is the basic IP address for Earthlink.
  \item \textsuperscript{44} See \url{http://www.sucks500.com} (last visited Dec. 30, 2003) (the home address of several “sucks” pages. This is a general gripe site and the address to which a lot of Parisi registered DNSs point); see infra note 130 (among the notables include \url{http://lockheadmartinsucks.com} (last visited Dec. 30, 2003), \url{http://michaelbloombergsucks.com} (last visited Dec. 30, 2003), and \url{http://corporateamericasucks.com} (last visited Dec. 30, 2003)).
  \item \textsuperscript{45} See \url{http://www.survivor.com} (last visited Dec. 27, 2003) (the home page of Survivor software since at least 1995. Survivor produces several Mac specific business software titles and was running along smoothly until CBS started producing a TV program called “Survivor.” Consequently, the number of hits experienced by Survivor Software increased dramatically, choking their server with page requests and shutting down the site. While CBS has offered to take the domain name off the hands of Survivor Software, they have refused to pay for it, or acknowledge the problems they have caused, including publishing the site name as their own as part of a show contest rhyme).
\end{itemize}
on a “first come, first serve” basis. Consequently, if a person or company has a legitimate use for a specific domain name, primacy in registration precludes all other claims to that domain name.

Because the domain name can be easily recognized, remembered, and accessed, controversy has followed its use in a variety of realms; from controversies about vulgarity and profanity to problems with trademarks. The use of terms that can be recognized as trademarks has generated three specific problems. The first problem to be recognized was cybersquatting. Second, once the primacy of a mark owner over the first to register a domain name was established, some mark owners used their primacy to take over domain names used for legitimate purposes in a process referred to as RDNH. Third, some registrants have knowingly registered domain names containing marks plus a derogatory term. Mark owners have gone after these domain owners using policies developed by WIPO to divest owners of their interest in these marks.

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46 See infra note 54 (the only requirements to registering a domain name are filling out a form, agreeing to the UDRP procedure, and paying a fee. Those seeking to register a name are not required to provide proof that they have a legitimate reason or use for the domain name).

47 The primary remedy provided by the UDRP is the transfer of the domain name to the complaining party. If the complaining party does not prevail, and no subsequent action is brought, then the responding party retains the domain name as long as he continues paying the registration fees.

48 See Island Online, Inc. v. Network Solutions, Inc., 119 F. Supp. 2d 289 (E.D. N.Y. 2000) (holding that while Network Solutions’ restriction of domain names containing certain character strings is inappropriate, Island Online was not the first to attempt to register the vulgar domain names and was not entitled to register them at that juncture).

49 Johnson, supra note 31, at 476. Johnson asserts there are four misuses characterized as the Disparager, the Extortionist, the Free-Rider, and the Innocent. Id. While these are helpful classifications, they are made from the point of view of the malicious registrar. This article would rather deal with the problems themselves, rather than classification by intention.

50 See infra note 87 and note 57; see also Sallen v. Corinthians Licenciamentos LTDA, 273 F.3d 14 (1st Cir. 2001).

51 See infra note 87.

52 See supra note 44.
A. Cybersquatting: History and Definition

With the boom of the Web in the early to mid-1990s, it did not take long for Web users to realize there was a profit to be made in owning the domain names of well-known companies. While it can take a while for a large company to move into new technologies, or to realize the importance of such technologies, it did not take long for certain individuals to begin registering those industry mark names in bulk. The result was a frustration of purpose. While businesses were scrambling to put together a Web presence, certain domain names they desired had already been purchased by what were later called “cybersquatters.” Although it became apparent that domain name owners had to possess some content and legitimate interest in the domain name, it still did not deter these cybersquatters from registering names in bulk. The idea was simple: register the domain name, associate it with an IP address containing some content, and then offer the domain name for sale to the company attempting to enter into the field.

A typical case of trademark infringement on the Web can be found in Yahoo! Inc. v. Akasha Arora,53 where Arora registered the domain name, “yahooindia.com.” Yahoo! registered its domain name in 1995 with Network Solutions, and had become a publicly held search engine with trademark registration or pending registration in sixty-nine countries at the time the case was resolved. Yahoo! had further distinguished itself by creating country specific portals by registering country specific domain names. Coupled with the widespread publicity generated by Yahoo! as it became one of the first global search engines on the Web, the court found that Yahoo! was both well-known and had a distinct reputation engendering goodwill associated with the name Yahoo!.

Arora had adopted not only the Yahoo! name, but the look and feel of the original Yahoo! site, right down to co-opting the source code for the layout of the site. Because the name was deceptively similar to Yahoo!’s name and because the services offered by Arora were the same or similar to that offered by Yahoo!, the court had no problem finding infringement. While ultimately successful, the process of litigation does not mitigate the potential damage caused by cybersquatting. Further, with domain names registered by people in multiple locations, in multiple countries, the litigation process can be even more extensive and complex.

Because the court process was expensive and time consuming, WIPO and ICANN developed the UDRP. The idea was to create a place to resolve conflict between parties participating in the UDRP process. Registering agents such as Network Solutions and Register require registrants to agree to arbitration in order to successfully register domain names.54 The arbitration procedure is meant to streamline domain name disputes among diverse parties, creating a simple resolution apparatus to prevent registration abuses. UDRP causes of action include bad faith registration and the registration of domain names that are confusingly similar to another service mark or trademark.55 While these causes of action are not defined by the UDRP as cybersquatting, they are similar enough to the concept of cybersquatting to effectively


represent the concept of bad faith registration and registration of confusingly similar marks as defined under the UDRP.\(^{56}\)

UDRP cybersquatting was seen in the case of *America Online, Inc. v. Johuathan Investments, Inc.*\(^{57}\) In this case, the respondent registered two disputed domain names: “aollnews.com” and “fucknetscape.com.”\(^{58}\) The respondent registered these names and created content for the associated IP addresses that consisted primarily of pornography and links to other pornographic sites.\(^{59}\)

In the case of the “aollnews.com” domain name, the UDRP arbitration panel determined the case’s outcome using the three-factor test asserted by section 4(a) of the UDRP.\(^{60}\) First, the panel looked at the name itself to determine whether it is the same or substantially similar to the complainant’s trademark.\(^{61}\) Second, they looked to see if the respondent has a right or legitimate interest in the name.\(^{62}\) Third, they determine whether the name was registered or used in bad faith.\(^{63}\)

The panel undisputedly decided that “aollnews.com” and “aolnews.com” are extremely similar. Additionally, the panel added to the validity of its finding by looking at the WHOIS registration information noting that the respondent had utilized an AOL email address for all

\(^{56}\) Cybersquatting as a concept has a popular definition indicative of registering a domain name for nefarious purposes. This differs from the U.S. cause of action under the Anti-Cybersquatting Act located in 15 U.S.C. § 1125(d) (2000).


\(^{58}\) Id. § 2.

\(^{59}\) Id. § 4.

\(^{60}\) Id. § 6.

\(^{61}\) Id.

\(^{62}\) Id.

\(^{63}\) Id.
Consequently, anybody looking into the validity of the site, along with the connection between AOL and the disputed site, would find the relationship confusing.

**B. Problems with Cybersquatting**

Cybersquatting occurs when an owner registers a certain domain name with the sole purpose of collecting funds from a business desiring that particular domain name. This unfair practice seems easy to identify. However, just the opposite is true because distinguishing between cybersquatters and fair use has become problematic. Two frequent fair use problems include parody sites and fan sites.  

Parody sites utilizing the domain names of well-known organizations have not fared well under cybersquatting rules. The classic example is “peta.org,” a domain name originally owned by Michael Doughney who changed the famous acronym to mean People Eating Tasty Animals. Mr. Doughney used the site in this form for about six months before getting shut down in 1996. The group People for the Ethical Treatment of Animals (“PETA”) took him to court and prevailed under theories of trademark infringement and cybersquatting. The court in *PETA v. Doughney* held that the site was not protected as a form of parody because a parody must impart two simultaneous meanings: that the subject is the real thing while at the same time imparting the meaning that the subject is not the real thing. The court stated that peta.org could

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64 Id.
65 A parody site is one that is a parody of the target site. According to the court in *PETA v. Doughney*, a parody site must contain two simultaneous meanings: that the site is the actual site while at the same time it is not the actual site. People for Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir. 2001). A fan site is a noncommercial site created by somebody who is a fan of a person, place, or thing that is usually famous. The site is generally dedicated to that person or group of persons’ passion about that particular subject matter. See infra note 85.
66 *PETA*, 263 F.3d at 362.
67 This website is now located at the IP address http://www.mtd.com/tasty/ (last visited Dec. 30, 2003). The hate mail received is one of the more interesting aspects of the site.
68 *PETA*, 263 F.3d at 363.
69 Id. at 371.
70 Id. at 364.
not be a parody because the dual meaning was not implied in the domain name, but merely in the site content.\footnote{Id. at 366.}

Under a trademark infringement theory, the court utilized a five-prong test. The plaintiff alleging a cause of action for trademark infringement and unfair competition must prove each element in order to prevail.\footnote{Id. at 364.} The test includes an assertion that the infringing party used the owner’s mark, that the owner had a right to the mark, the infringing party used the mark in commerce, this use was in relation to the sale of goods or services, and that this use was likely to cause confusion among consumers.\footnote{Id.}

The problem was trying to distinguish these fair uses from cybersquatting. ICANN formed the UDRP to resolve the issue through a three-prong test. Answering these three questions with “yes” is deemed to be against the UDRP, resulting in the loss (i.e. transfer) of the domain name to the mark holder. The three-prong test includes:

i. [respondent’s] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

ii. [respondent has] no rights or legitimate interests in respect of the domain name; and

iii. [respondent’s] domain name has been registered and is being used in bad faith.\footnote{Uniform Domain Name Dispute Resolution Policy, ICANN, Oct. 24, 1999, § 4(a), available at http://www.icann.org/udrp/udrp-policy-24oct99.htm (last visited Dec. 30, 2003).}

When an UDRP panel arbitrates a dispute, it utilizes this paradigm to determine whether the registration of the domain name constitutes an infringing use (i.e. cybersquatting). Once a registration has met the factors of this analysis, the panel can only then look at the fair use defenses outlined later in the policy.\footnote{Id. § 4(c) (stating that a respondent’s rights to and legitimate interest in the domain name in question can be established by demonstrating the following:} Since all domain name registrars are bound by the UDRP,
and since all registrants are bound by registration policies that include compliance with the UDRP, this three-prong test determines the validity of trademarks contained in domain names throughout the Web.

Arbitration panels will look at many facts and circumstances in making their determination under these prongs. One of the major ways to determine that a registrant does not have a legitimate interest in the domain name is to establish that bad faith exists.\textsuperscript{76} Bad faith can be found when a combination of factors exists, including whether or not content was developed\textsuperscript{77} or a plan for content was developed prior to the complaint.\textsuperscript{78} Also, bad faith can be found through a pattern of registering the trademarks of others to prevent the use of those domains,\textsuperscript{79} offering the domain name for sale,\textsuperscript{80} utilizing the domain name to deliberately divert potential

\begin{itemize}
\item[(i)] before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
\item[(ii)] you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
\item[(iii)] you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue).
\end{itemize}

\textsuperscript{76} Id. § 4(b) (defining bad faith for use in § 4(a). Bad faith is a four-prong test looking for evidence suggesting registration for the intent to sell the domain name, registering a domain name to prevent a mark holder from using the name, registering the domain name primarily to disrupt business, or doing business with the likelihood of creating confusion with the business of the mark holder).


\textsuperscript{79} Planned Parenthood Fed’n of Am., Inc. v. Bucci, 1997 U.S. Dist. LEXIS 3338 (S.D. N.Y. Mar. 24, 1997) (where the domain name owner provided content deriding those interested in the abortion services of Planned Parenthood, providing nothing but pro-life rhetoric).

customers to like or similar goods or services, utilizing the domain name to deliberately divert potential customers to pornography, or utilizing the domain name for commercial gain. Arbitration panels look at the combination of these factors as well as other facts in order to make their determination.

C. Reverse Domain Name Hijacking: It Does Not Matter What You Are Doing or Why It Is Still Mine

Reverse Domain Name Hijacking (“RDNH”) occurs when a registered trademark holder threatens a legitimate domain name owner with a lawsuit either through UDRP or through a civil suit. RDNH is defined by WIPO as using the UDRP in a bad faith attempt to deprive legitimately registered domain name registrants by “threatening to sue [these] legitimate domain name registrants who…[will] not give up the right to the registration” and transfer the name to the requesting party. Usually stated within a demand letter, domain name owners are told of their infringement and ordered to relinquish their domain name within a short period of time or otherwise face legal action.

While recognizing that trademark holders have had relatively free access to domain names utilizing their names, these holders attempt to run roughshod over owners demonstrating

82 America Online, supra note 57, § 6.
83 People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir. 2001) (finding commercial gain when the site, in addition to advocating the use of animal products, linked to vendors of animal related products).
84 Sallen v. Corinthians Licenciamientos LTDA, 273 F.3d 14, 17 (1st Cir. 2001) (noting Sallen unsuccessfully defended his registration through UDRP arbitration before taking the case to the U.S. District Court).
86 See Chilling Effects Clearinghouse, at http://www.chillingeffects.org (last visited Dec. 30, 2003) (a clearinghouse of information and a repository of cease and desist letters, some pertaining to DNS infringement cases. This is a wonderful site put together by the Electronic Frontier Foundation, http://www.eff.org, and a variety of other groups and schools dealing with issues such as these).
The legitimate use of these names. One such example is the case of Harry Potter, a popular character from a series of children’s novels that has spawned a number of fan websites. When Warner Brothers ("WB") bought the rights to the series, WB started going after the youthful owners of these sites. Rather than looking at the questioned sites to determine the nature of each owner’s use, WB took on the same tactics used by many other companies, and began a campaign to acquire the rights of these domain names regardless of the use or age of the owners. The tactic makes logical sense: WB can acquire the rights to a plethora of domain names through an unquestioned response to the demand. But, the threat itself is tenuous at best since fan pages and fan use is within the sphere of fair use. It is a shotgun approach to the acquisition of domain names that involves looking through WHOIS databases and filing against anybody with the audacity to register a domain name containing a mark. Generally, the content of the site is not considered until well after the demand letter stage. Even if the content is considered, clearly fair use practices are still litigated through the UDRP and civil litigation.

D. RDNH: The Problem of Interpretation

WIPO and ICANN have recognized the problem of RDNH, and have attempted to address the problem within their policies. Unfortunately, in practice there have been problems in defining the scope of the problem and offering resolutions to those affected by these baseless

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88 Id.

89 One example of these tactical maneuvers is demonstrated in the campaign to keep Barney pure. This campaign begun a couple of years ago when a second year associate of the firm representing Lyons Partnership, owners of Barney, the purple dinosaur that has mesmerized children and annoyed adults for years, started scouring the Web for any mention of the dinosaur. The campaign has not merely limited itself to domain names, but has extended itself to websites with any mention of Barney or descriptive terms like “purple dinosaur.” See ChillingEffects.org, at http://www.chillingeffects.org for an example of the demand letters mailed to those “infringing” on Barney, and the Electronic Frontier Foundation, at http://www.eff.org, for more details. See generally Declan McCullagh, Lawyers: Keep Barney Pure, WIRED NEWS, July 4, 2001, at http://www.wired.com/news/print/0,1294,44998,00.html (last visited Dec. 27, 2003).
threats. These problems can be found in the case of *Norm Thomas Outfitters v. Moran Publishing*.

On January 14, 2002, a UDRP arbitration panel decided the case of *Norm Thomas Outfitters v. Moran Publishing*, a case centering on the domain name “waterfrontliving.com.” The complainant had a catalog called “Waterfront Living,” which began national distribution on May 24, 1996. Through mail order, the company offered to the general public a series of outdoor gear, toys, food, collectibles, and other goods. The complainant then sought to register a corresponding domain name, “waterfrontliving.com,” in 1999. The respondent registered the domain name on November 13, 1996, corresponding to a forum developed on a preceding website, “boattalk.com.” The respondent’s focus was to continue to develop content centered around living on or near the water and to accomplish this by registering a generally descriptive term for this aspect of the business. The respondent had registered many descriptive nautical or boat related domain names, most being used through his original site, “boattalk.com.” In 1999, the complainant began soliciting the respondent in order to purchase the domain name in question. The respondent repeatedly refused to sell, offering to allow the complainant to sell its merchandise through respondent’s website, or by linking to respondent’s website.

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91 *Id.*
92 *Id.*
93 *Id.*
94 *Id.*
95 *Id.*
96 *Id.*
97 *Id.*
98 *Id.*
99 *Id.*
The complainant leveled a charge of cybersquatting at the respondent, asserting that the respondent registered numerous like or similar domain names and knew that third parties had a clear interest in those domain names and therefore, the respondent should fall within the purview of the UDRP section 4(a).\textsuperscript{100} The arbitration panel ran through its three-prong test to determine if this was a case of cybersquatting.\textsuperscript{101} First, the panel found that because the complainant had never registered “waterfront living” as a trademark because of its generally descriptive nature, there was no infringement on a trademark.\textsuperscript{102} Second, it found there was no secondary meaning given to the name through the use of that name between the period complainant began use of the name and the period when respondent registered the domain name.\textsuperscript{103} Because there was no secondary meaning, the respondent had a legitimate right to use the descriptive term.\textsuperscript{104} Third, the panel found that the respondent did not use bad faith in registering the DNS.\textsuperscript{105} Evidence supporting this conclusion included: the respondent had a plan for developing the site, there was no pattern of bad faith registration, and the offer to sell was a response to continual solicitation by the complainant with the intention of getting the complainant “off his back” by requesting an unreasonable price for the domain name.\textsuperscript{106} Furthermore, there was no evidence that, at the time of registration, the respondent knew of the complainant or of the complainant’s use of the name.\textsuperscript{107} While bulk registry of domain names, knowledge of another’s interest in those domain names, and the offer to sell the domain name can constitute infringement contrary to the UDRP,
such factors are not always dispositive. This is especially true when the names registered comply with a business plan outside of the complainant’s use, the suggestion of a sales price serves the sole purpose of dissuading a persistent complainant, and the interest of the complainant is nearly simultaneous with the interest created by the respondent.

The respondent attempted to have the panel address RDNH by asserting “that complainant knew, at the time of filing of this Complaint, that respondent had registered the disputed domain names before complainant had ever filed for a trademark. This constitutes abuse of the administrative process.” However, the panel refused to deal with the issue by stating, “Having found in favor of the respondent, there is no need to address respondent's claim of reverse domain name hijacking.” This failure to address respondent’s RDNH claim seems contrary to the purpose of section 15(e) of the UDRP. According to the section dedicated to RDNH, consideration of bad faith or harassing arbitration should be axiomatic. Therefore, having found bad faith in the complainant’s action, the panel should have performed a RDNH analysis. This panel seemed confused as to the purpose of the RDNH provisions.

108 Id.
109 Id.
110 Id.
111 Id.
112 Id.

Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. (emphasis added).
With the UDRP recognizing the practice of RDNH,\textsuperscript{114} coupled with the inability of panel decisions to address these provisions,\textsuperscript{115} RDNH will continue to be a major problem. With the UDRP virtually ignored, there are no consequences for a trademark holder when it comes to disputes of the use of a mark made by another. Even when a panel finds RDNH\textsuperscript{116} under the UDRP, the panel is limited to merely noting its finding in its decision.\textsuperscript{117} There are no remedies available through the arbitration process for RDNH.\textsuperscript{118}

In this sense, the UDRP differs from TRIPS. While the UDRP looks first to infringement before fair use, TRIPS defines infringement as something that occurs not only in the course of commerce, but also in the course of commerce offering like or similar goods or services.\textsuperscript{119} Perhaps if the UDRP altered its analysis by first looking at the content and purpose of the site and allow victims of RDNH to recover punitive damages, mark holders would not be so quick to threaten innocent domain name owners.

TRIPS also allows recovery for abuse of authority and abuse of enforcement procedures, allowing an injured party to recover any monetary damages resulting from such abusive practices, including attorneys’ fees.\textsuperscript{120} To curtail these abuses, ICANN should incorporate this approach or a similar approach which allows victims of RDNH to recover damages for the time

\begin{footnotes}
\footnotetext{114}{Uniform Domain Name Dispute Resolution Policy, ICANN, Oct. 24, 1999, § 1, available at \url{http://www.icann.org/udrp/udrp-policy-24oct99.htm} (last visited Dec. 30, 2003).}
\footnotetext{117}{Uniform Domain Name Dispute Resolution Policy, ICANN, Oct. 24, 1999, § 15(e), available at \url{http://www.icann.org/udrp/udrp-policy-24oct99.htm} (last visited Dec. 30, 2003).}
\footnotetext{119}{TRIPS, \textit{supra} note 10, § 2, art. 16, para. 1.}
\footnotetext{120}{\textit{Id.} § 2, art. 48, para. 1.}
\end{footnotes}
they spend in litigation as well as the time their domain name is disabled (if ever). Appropriate attorneys’ fees should also be granted to those victims that prevail in their RDNH claim.

E. The Muddle Continues: Ford, Fair Use, and RDNH

With precedent set by decisions like Waterfrontliving.com and the tendency of others to pass disputed domains to trademark holders without much of a fight, other companies are taking advantage of the mess made out of fair use by attempting to garner all domain names containing that particular business’s name or names related to its product line.\(^{121}\) For example, companies like Ford are taking advantage of this mess by using litigation to garner all domain names containing the term “Ford” or any other Ford related trade name. Ford initiated trademark litigation\(^{122}\) against a group of defendants supported by the Electronic Frontier Foundation (“EFF”).\(^{123}\) The EFF defendants all own domain names containing Ford related trademarks, ranging from “lincolntrucks.com,” a site dedicated to a truck dealership in Lincoln, Nebraska, to “jaguarcenter.com,” a site dedicated to jaguars, the large cats, not the cars.\(^{124}\) Ford has been attacking owners of sixty some domain names for infringement on the Ford name, and the names of Ford related products, including Jaguar.\(^{125}\) While most domain name owners are U.S. citizens, some are from places such as the U.K., and Ford has been battling it out with third generation auto mechanics and thirteen-year-old jaguar (the large cat) fans since 1999.\(^{126}\)

\(^{121}\) See supra note 87.
\(^{124}\) EFF Wins a Partial Victory in Ford Case, supra note 122.
\(^{125}\) Id.
\(^{126}\) Id.
Ford bypassed the UDRP by opting to file in Michigan federal court in order to utilize a less evolved set of common law standards based in U.S. anti-cybersquatting law.\(^{127}\) However, the fact that ICANN and the UDRP have not dealt with this particular case just adds fodder to the overall problem this litigation has caused. While it should be obvious that a thirteen-year-old girl has a right to register and use a domain name dedicated to her favorite wild cat, the litigation nonetheless continues. Furthermore, because there are no repercussions for RDNH and because panels are not utilized to apply an RDNH analysis to these suits, there is nothing to dissuade mark holders from leveling claims of infringement against domain name owners well outside of commerce, and those that are well within fair use. Fortunately, Ford dismissed its trademark lawsuit against the defendants, and each side has been ordered to pay their own attorneys, fees.\(^{128}\) However, suits like this one will continue to arise as long as ICANN and the UDRP are not utilized or given deference in these types of commercial domain name disputes.

V. “Sucks.com”: Looking at Protest on the Web

UDRP arbitration panels have been split in interpreting the validity of “sucks” domain names. Some panels have found that “sucks” sites cause confusion, forcing respondents to divest their interest in such domain names.\(^{129}\) Others have found no problem in recognizing the validity of this form of commentary.\(^{130}\)

\(^{127}\) Arbitration results under the UDRP allow ten days to comply with panel findings or filing an action with another court. Judge Hilton, in the recent case of Barcelona.com, Inc. v. Excellentísimo Ayuntamiento De Barcelona, thoroughly described the level of deference a U.S. court must give findings under the UDRP. In this decision, he stated that the proper standard for review of a conflict resolved under the UDRP was de novo, and while U.S. courts should read the UDRP decisions, they are not required to give deference to decisions under the UDRP; see infra note 147.


The panels that hold “sucks” sites cause confusion usually base their decisions on a two-part criteria derived from the idea that the addition of terms such as “sucks” does not per se notify users that the site is not owned by or approved of by the trademark holder. First, confusion is caused because the predominant language online is English. Consequently, since non-native speakers might be confused by the addition of “sucks” to the domain name, such domain names are inherently confusing to the portion of the online community unfamiliar with the use of this term. Second, confusion is caused because the trademark holder might have an inherent need to use such a domain name to register complaints, gripes, and commentary. They feel that the addition of “sucks” would lead users to believe that the “gripe site” is a site that has been approved by the trademark holder as a place to express grievances with the business. This confusion, coupled with the interest the trademark holder has in the trade name, creates a problem that panels repeatedly remedy by ordering the transfer of the domain name to the trademark holder.


A. Confusion and the English Language

Courts and UDRP panels have long held that confusion can be found in alternative spellings of trademark names. Thus, “aollnews.com” is confusingly similar to “aolnews.com.” Furthermore, confusion is found when the domain name is similar to the original domain name and when the site offers like or similar services. The addition of terms antithetical to the trademark has also been found to cause confusion because of a perceived lack of sophistication with the English language. Consequently, UDRP panels have found “accorsucks.com” and “antiphillips.com” to be confusing, requiring the transfer of these domain names to the trademark holder.

The analysis revolves around the English language and character sets utilized by users necessary to the finding of specific content on the Web. The basic UDRP argument revolves around the lack of sophistication a non-English speaker may have with pejorative terms. While some UDRP panels have found this to be ridiculous, the issue must still be addressed since other panels are utilizing these criteria to rule against the claim.

131 See e.g., supra note 87 (noting aollnews.com was confusingly similar in spelling). Compare Paris Convention, supra note 1, art. 6 (any mark that is confusingly similar and used in commerce for like or similar goods or services), with Lanham Act, 15 U.S.C. § 1114(1)(a) (2000) (any use of a mark that is a reproduction likely to cause confusion is cause for civil liability).


134 One UDRP panel found that confusion may be caused by a legitimate use of the word “sucks” within a domain name. Relying on an Electrolux jingle, the panel found that Electrolux may have a legitimate commercial use for the domain name <electroluxsucks.com> positing the vacuum cleaner may be properly served by advertising that its vacuums truly suck. While this is an interesting argument, it is dubious at best. With Electrolux, a U.S. company, probably familiar with English slang, the juxtaposition of the trade name with the pejorative is unlikely at best. The UDRP panel also found a legitimate use of the pejorative with the band Primus, which holds the domain name <primussucks.com> concerning one of their albums, Suck on This. While this is the needle in the haystack, the more appropriate argument may be that use of the pejorative can cause confusion between the pejorative and
Computers can recognize more than the English language, and more than the standard English character set. Sites appear sporting Cyrillic, Japanese, Arabic, and a variety of other scripts. A brief glance through UDRP arbitration decisions will attest to the proliferation of non-Latin alphabet based scripts online. While the vast majority of U.S. users have not configured their computers to understand or recognize the umlauts of Norwegian, Norwegian speakers are still contesting websites demonstrating practices antithetical to the UDRP policies. Under the Paris Convention, which has been incorporated into TRIPS, the standard for determining if a derivative name, i.e. one in translation, infringes upon the use of another is whether the mark is a translation, reproduction, or imitation likely to cause confusion. The terms relevant in the Paris Convention include translation, reproduction, and imitation when coupled with use in propagating like or similar goods or services.

The question becomes whether appending a pejorative to a known mark constitutes the use of a mark likely to cause confusion in the course of criticizing the goods or services of the mark holder. While the Paris Convention talks of translation, reproduction, or imitation, it does not directly address the addition of pejoratives. Rather, the concern of the panels has revolved around the English capabilities of those who might access such a site thinking it is the homepage of the mark holder. Disregarding the issue of the simultaneous existence of domain names containing only the mark name, and disregarding a non-native English speaker’s ability to utilize translation software to discern meaning, the primary problem involves the lack of


135 Paris Convention, supra note 1, art. 6bis, para. 1.
136 See supra note 45.
137 See Babblefish.com, at http://www.babblefish.com (last visited Dec. 27, 2003) (provides links to translators capable of translating a wide variety of languages. They are not restricted to a “to English” format, and sites and content can be converted into a variety of languages, even those requiring character sets not supported by the user’s
translation of a pejorative and the effect that the lack of translation can have on non-English users. Indeed, the Accor court noted that “sucks” is American English slang, and since the trademark precedes the pejorative, the implication is clear; the site must be owned by the mark owner. The court stated this was a result of both the combination of a lack of familiarity with English slang and the formulation of the domain name. The Phillips panel further reinforced this concept by stating the addition of “anti” to the trade name “Phillips” was not enough to distinguish the site. Consequently, because some users may view the site as the mark owner providing a gripe service, this form of domain name squarely infringes upon the mark owner’s rights.

There are multiple problems with this analysis. First, there is the attribution of a service to the mark holder. The Paris Convention talks about “like or similar goods or services.”

computer. The author has used these features to better understand the panel decision in Accor. While these translations are not authoritative, they are capable of conveying general meaning to someone illiterate in the parent language).


139 Id. (stating “Ayant la conviction que le public en général et les internautes en particulier, n’étant pas tous anglophones et/ou avertis du sens du terme "sucks" dans le monde d’Internet, auront, pour certains, plutôt le sentiment que "sucks" est un ajout banal et obscur à la marque "accor" passablement connue et que, dès lors, <accorsucks.com> réfère à un service du Groupe Accor, la commission constate que l’exigence du paragraphe 4 (a), (1) des Principes directeurs est satisfaite”).

140 Koninklijke Philips Elecs. v. Kang, No. D2001-0163, § 6, WIPO Arbitration and Mediation Center (Mar. 27, 2003) (Barker, Arb.), available at http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0163.html (last visited Dec. 30, 2003) (holding the addition of “anti” was a “[c]rude attempt to tarnish the mark” and did “nothing to deflect the impact on the viewer of the mark”). While “sucks” is arguably American slang, “anti” is a Greek root common to most languages with Greek backgrounds including English, Russian, and Arabic.


142 Paris Convention, supra note 1, art. 6bis, para. 1.
While Accor, Wal-mart, and Canadian Tires may produce goods or services, they generally do not produce services whereby people are allowed to freely criticize and compare notes about those goods and services. There is a great difference between the ancillary request to fill out a “How was your service?” form and dialoguing with other disgruntled customers or interested parties by comparing notes. Just as a picket line outside Wal-mart differs from the goods and services provided by Wal-mart, criticism of goods or services differs from the goods and services themselves.

Second, while the Web expects users to understand some English as well as English convention, such an interpretation places a limit on that level of understanding. Such a line will antithetically effect potential regulation. For example, users are expected to understand that “.gov” indicates the site is a governmental site no matter how that person’s native language translates the word “government.” Under an analysis similar to Accor and Philips, ICANN should withdraw such top level domain names because they might cause confusion for non-English speakers. Because the native language does not perceive “.gov” as an abbreviation for “government,” a user might mistakenly go to a governmental site thinking it is a commercial,


146 Worse yet, “top level domain names” (“TLD”) are all based upon the English language. The .com TLD means commercial, .edu stands for educational institution, and .org indicates a non-profit organization. Furthermore, the newest TLDs are also dependant on an understanding of English: .name means just that, a person’s name, with llamo, the Spanish equivalent, excluded from the mix. Even worse, .info is a proposed TLD indicating the site is information only. Utilizing “info” for this TLD is utilizing both English and American slang.
military, informational, educational, or nonprofit organization site. Under such analysis, a mark holder can claim all domain names containing the mark, or anything close to the mark.

Similarly, the Accor analysis, depending greatly on the order of the mark in relation to the pejorative, would effectively negate fan sites. Thus, Harry Potter fans could not incorporate any Harry Potter term with a fan related term, because the order of the terms would indicate the site is sponsored by Warner Brothers, the parent company. Furthermore, predicating the mark with any other sequence of words would be apt to cause similar confusion for those who read right to left.

Confusion analysis would also negate the ability to create parody domain names under the PETA decision. For example, one of the requirements for parody is to convey two simultaneous meetings, both that the site is the original and that it is not the original. Because there would always be the possibility of confusing non-native speakers of the parody domain

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147 Indeed, there is some confusion over the right to domain names in English speaking court systems. In Barcelona.com, Inc. v. Excelentisimo Ayuntamiento De Barcelona, 189 F. Supp. 2d 367 (E.D. Va. 2002), <Barcelona.com> was given to the City of Barcelona because of the confusion prospective visitors would have when they attempted to access sites concerning tourism in that country. Utilizing Spanish law, the court reasoned that visitors at a <.com> site involving tourism would presuppose that the site was sponsored by the City of Barcelona. The court failed to recognize the meaning of the <.com> top level domain name, a designation that the site is commercial in origin and not governmental (<.gov>) or originating in Spain (<.sp>). It would appear on its face that a commercial endeavor should have a greater claim to the <.com> level domain name. While the City of Barcelona, intent on promoting tourism and promoting the commercial endeavors of its businesses, would have a greater claim to <.gov> or <.sp> domain names. Instead, the Eastern District of Virginia trumped the rights of a commercial site to a commercial domain name with the rights of a city, potentially expanding the control of geographies over all top level domain names containing the geographical indicator in the second level domain name. See Barcelona.com, Inc. v. Excelentisimo Ayuntamiento De Barcelona, 330 F.3d 617, 630 (4th Cir. 2003) (holding that the district court's ruling which denied Barcelona.com, Inc. relief under 15 U.S.C § 1114(2)(D)(v) (2000) is reversed and remanded for further proceedings to determine and grant the appropriate relief under the statute).


149 People for Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir. 2001).
name, there could be no parody domain names. Consequently, this could be the basis for ridding
the world of an ancient form of comedy and criticism all because some users might not be
sophisticated enough to discover the meaning of a single word.\footnote{While this is probably an overreaching conclusion, it is the foundation by which all content that has the possibility to be offensive can be eradicated through civil litigation, i.e. it sets a dangerous precedent.}

Contrary to this position, other panels have ruled that appending “sucks,” and similar
terms, do not cause confusion. The panel in \textit{America Online, Inc. v. Johnathan Investments}
addressed this in relation to the “fucknetscape.com” domain name by stating that if any
confusion does arise it is because a user who expected to log onto a protest site, found nothing
but a pornography site.\footnote{America Online, Inc. v. Johnathan Inv., Inc., No. D 2001-0918, WIPO Arbitration and Mediation Center (Sept. 14, 2001) (Willoughby, Arb.), available at \url{http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0918.html}.} Additionally, the panels in \textit{Lockheed Martin v. Parisi} and \textit{Wal-mart v. Walmartcanadasucks.com} found that the plain reading of the word “sucks” indicates that the
names were clearly not confusing.\footnote{See supra note 130.}

The panel in \textit{Bloomberg v. Secaucus Group} found that a search on the mark name would
produce both the mark owner’s domain name, if any, along with the “sucks” site. This panel did
not stop its inquiry with the potential for confusion. Relying on the UDRP, section 4(c)(iii),\footnote{Uniform Domain Name Dispute Resolution Policy, ICANN, Oct. 24, 1999, available at \url{http://www.icann.org/udrp/udrp-policy-24oct99.htm}.} the court found that the addition of such a word to a mark necessitates a fair use analysis,
something specifically allowed under this UDRP provision. Under this defense, the domain
name is legitimate if the owner is not using it in a commercial context. Panels have held that

\footnote{E.g. Aristophanes, The Collected Plays of Aristophanes.}
sites falling under this provision coupled with the argument that the site is an exercise of free speech should be enough to negate the claim of bad faith.

B. Confusion and the Origins of the Site

The use of the pejorative “sucks” has been held to cause confusion as to the origins of the site, i.e. there is an implication that the owner of the trademark endorses, or is otherwise associated with, the gripe site. Other panels have held that confusion cannot be found because the use of pejoratives negates any implication that the trademark owner has anything to do with the site. While some non-English speakers may find it difficult to distinguish between “Microsoftsucks.com” and “Microsoft.com,” it stands to reason that those few who mistakenly wind up at the gripe site will quickly discover it is not the home of Microsoft. The lack of product support and sales may be a give away, as well as the prevalence of negative Microsoft humor and comments. Additionally, since these sites do not generally link to the trademark site, an individual attempting to reach Microsoft will quickly discover that the particular site is not connected with the software company. Furthermore, because most companies with an international presence develop content for geographically specific regions as well as the linguistic constructs and character sets used by those regions, the chances for overall confusion seem minimal.

While it may be logical for some panels to conclude that mark holders would want to provide gripe sites to their customers or potential customers,\textsuperscript{155} it is not logical for a user to conclude that such a site is sponsored by the mark holder. First, the vast majority of mark holding companies do not allow for public airing of grievances. Second, gripers are not apt to post to corporate sites for fear of censorship. The perception of corporate biasness in a site

\textsuperscript{155} See \textit{supra} note 129.
sponsored by the mark holder would essentially negate the effectiveness of the grievance procedure. An independent site administrator is perceived to be a bit more judicious when it comes to true grievances, with the bias aimed more towards actual grievance and anger than the corporate line.

C. Confusion and Corporate Use of “Sucks”

Under TRIPS, a confusion analysis is not applicable when the website does not offer like or similar goods or services. While most websites allow users to register comments or complaints via email, few dedicate pages in order to negative comments or complaints. Even fewer go out of their way to register unique domain names for the specific purpose of publishing negative comments, gripes, or complaints.

A brief tour through InterNIC and WHOIS databases demonstrates that many corporations do own “sucks” sites. Companies like Chase Manhattan Bank, Dell Computer, Verizon, Dominos Pizza, Sony, GE, and Toyota own “sucks” domain names. While this

156 While it is unclear who created the first instance of these domain names, none of them have been litigated through the UDRP procedure. Searches on both Westlaw and Lexis have produced no results (though this is not always conclusive). Some basic assumptions can be made, however. When a bulk of such domain names are all registered on the same date, chances are the acquisition was not a result of RDNP, but instead a protective, preemptive step taken by corporations. Absent litigation, the origins of singular domain names remains unclear since the record does not indicate transfer, just recording the date of the last update of file records. File records can be updated for a myriad of reasons ranging from natural, employment turnover related changes in contact points to changes in service providers to relinquishing a domain name in concert with a cease and desist letter.

157 According to the WHOIS databases at Network Solutions, at http://www.netsol.com, and the Register.com, at http://www.register.com, the following registrations are valid:

Chase Manhattan Bank owns <www.chasesucks.com>, created on January 14, 1998; Verizon owns <www.verizonsucks.com>, created on November 11, 1999;
GE owns <www.gesucks.com>, created on June 30, 1998;
Sony owns <www.sonysucks.com>, created on June 9, 1998 and <www.ihatesonycomputerentertainment.com>, created and last updated on September 13, 2000;
Dell Computers owns <www.dellcomputerssucks.com>, created on May 10, 2000;
Toyota owns <www.toyotamodelnamesucks.com>, an example of which is <www.toyota4runnersucks.com>, created on November 23, 1999;
Dominos Pizza owns a variety of names including <www.dominosucks.com>, created on February 17, 2000 and <www.dominos-pizza-sucks.com>, created on February 17, 2000 and <www.dominos-pizzasucks.com>, created on February 17, 2000 and <www.dominos-sucks.com>, created on February 17, 2000 as well as
would support the contention of confusion and identification with the trademark holder, the problem is one of implementation. Of the seven companies mentioned, not one actively uses the domain name to point to a gripe site. Toyota, like Verizon, GE, Dominos Pizza, Sony, and Chase Manhattan owns pejorative domain names unassociated with actual websites. Toyota owns a wide variety of such domain names having registered “toyotamodelnamesucks.com” fifteen times. Dominos also participates in this preemptive ownership by owning seven of eight domain names containing the words “domino” and “sucks.” The eighth site, “lotusdominosucks.com,” does not fall under their purview and has an independent owner. Otherwise, Dominos would have a near monopoly on these types of names. Like Toyota, these domain names are not in use despite the creation dates of fourteen or more months.

Since these domain names are unassociated with actual websites, the question becomes one of how commercial domains attempt to deal with complaints. Perusing the parent website is necessary to discover a vehicle by which users can complain. All companies receive email via forms. None specifically request complaints, and none publish complaints with responses. Toyota demonstrates its interest in complaints through its form, which does not even include a


\[158 \text{ According to the WHOIS registry of Register.com, at http://www.register.com, they have owned some fifteen domain names since 1999. All have the same contact information which corresponds with the contact information for the parent corporation and its legitimate domain names.} \]


\[160 \text{ See http://www.toyota.com/toyota/LoadSurvey?surveyID=1;} \]

\[\text{http://www22.verizon.com/customersupport/contactus/other/recentexperience/;} \text{and} \]

\[\text{http://www.chase.com/chase/gx.cgi/FTcs?pagename=Chase/Href&urlname=chase/cc/contactus/banking/onlinebankingemail (last visited Dec. 30, 2003).} \]

\[161 \text{ Id. Looking through the site map reveals that the only way to give input is through the relevant “contact us” page links. Usually, this is a multi-step process that involves choosing a specific division, then choosing a specific service area or product, and then choosing a specific reason or concern (“send me more information about…,” “open}


Instead, the user is limited to a series of check boxes and radio buttons. Since it is not pro forma for a trademark holder to solicit complaints or set up complaint message boards, the idea that confusion could stem from a misplaced association of a “sucks” domain name with the trademark holder’s desire to provide customer service seems highly unlikely.

Toyota is typical of mark holders who bulk register pejorative domain names. Toyota is the registrar of record for fifteen of nineteen “sucks” domain names that contain the word “Toyota.” Other companies such as Mattel and Champion Mortgage have followed this model. Like other mark holders with pejorative registrations, none of these sites are attached to actual content. Champion Mortgage has even claimed domain names twisting one of their slogans, registering “championmortgagesaidno.com” and the variant “championmortgagesaysno.com.” Matel has gone to the extreme of registering not only all possible variants of “matelsucks.com,” but also several sites combining product names with “sucks.” Again, these domain names do not lead to content.

Unlike mark holders who also own “sucks” sites, “sucks” domain owners who do not hold the associated mark actually use their registration. Actual sites exist or link to sites such as

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a new account,” etc), and lastly, accessing a form that may or may not include a text box area to input something other than preformatted choices.


163 Check boxes and radio buttons are standard web-based form interfaces used to garnish information from preset choices. Radio buttons differ from check boxes in function in that radio buttons are exclusive, indicating that only one choice is possible, while check boxes allow users to choose more than one item in a list. As an example of these uses, a form requesting your gender or salary level usually sports radio buttons, while a section asking about your hobbies would usually sport check boxes.


165 See generally <chasebanksucks.com>, <dellcomputerssuck.com> (as opposed to <dellcomputerssucks.com>), and <sucks500.com>.
as “sucks500.com.” Independent people also own “sucks” domain names which include the trade names of colleges and universities. The need to gripe takes on many forms, and people will continue to come up with numerous methods to circumvent unused corporate owned “sucks” domain names.

The logical conclusion is that UDRP panels which hold that confusion can occur because mark holders might have a legitimate use of the name to promote their own gripe site are erroneous. From the standpoint of use, mark owners generally do not use these domain names when they own them. The fact that many of these domain names have been in existence for over two years and the domain names still do not align with an Internet Protocol address or any discernable content, indicates that the vast majority of mark owners do not want to use these domain names, and have no interest in generating independent gripe sites. Therefore, it is obvious that the assumption should more accurately reflect a gripe site owned and operated by somebody other than the mark holder, and not the other way around.

VI. The Strange Case of Chase Manhattan

Chase Manhattan has gone to great lengths to prevent websites containing its trade name plus a pejorative. Since 1998, Chase has owned the domain name “chasesucks.com,” and registered domain names such as “chaseonlinesucks.com” in 1999. Unfortunately, “chasebanksucks.com” was registered more than six months after “chasesucks.com” was

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166 sucks500.com is an amalgamation of Dan Parisi and is the base site for such domain names as <michaelbloombergsucks.com>, <lockheedmartsucks.com>, and many other names dealing with corporate America, American politics, and complaints.

167 See generally Stetson Sucks, at http://www.stetsonsucks.com (last visited Dec. 30, 2003), as an example of such a site. You can also substitute just about any college or university for Stetson and find content.

168 See supra note 157.

169 Network Solutions’ records indicate that this domain was registered by Chase Manhattan Bank (CHASESUCKS-DOM). The record was created on January 14, 1998. See http://www.netsol.com to run a search for this domain name (last visited Dec. 30, 2003).
The owner then created content that included multiple message boards with threaded messages on a variety of topics ranging from credit cards to human resources to experiences with poor customer service. The site has become hugely popular, garnishing recognition in publications such as CNET and the New York Times. The site has received more than 300,000 hits, with more than 400 posts to its message boards.

Under the theory that typing a domain name should elicit a site that clearly relates to the content specified by the domain name (i.e. peta.org and plannedparenthood.org), it would help if the simple names were available. Somebody interested in griping about Chase, and wanting to look for a Chase gripe site, could not simply type in “chasesucks.com,” but would have to actively look for some combination of “chase” coupled with a pejorative. Consequently, a person seeking to gripe must use a search engine to specifically look for a combination of “chase” and “sucks” to discover if there is an actual gripe site. Utilizing only the official Chase sites, the griper would be stuck filling out a form and sending many pieces of

170 Network Solutions’ records indicate this domain name was registered by Chase Manhattan Bank (CHASEONLINEBANKING-DOM). The record was created on January 27, 1999; see http://www.netsol.com to run a search for this domain name (last visited Dec. 30, 2003).
171 Network Solutions’ records indicate that this web site was registered by Tallas Enterprises (CHASEBANKSUCCS-DOM), the record created on June 25, 1998; see http://www.netsol.com to run a search for this domain name (last visited Dec. 30, 2003).
174 See Chasesucks.com, http://www.chasesucks.com. If the counter is to be believed, as of January 13, 2002, it showed more than 300,000 visitors. Adding the number of posts to each folder had exceeded 400 at the time of the visit on January 13, 2002. However, the counter reads more than 500,000 visitors as of December 30, 2003.
175 See supra Part III, subheading B of this article.
177 Utilizing the Google Search Engine, at http://www.google.com, and inserting “chase” and “sucks” elicits about 72,200 web pages, adding “bank” to the equation drops the hits down to just over 9,900 with <chasebanksucks.com> heading the list. Parenthetically, the banner ad accompanying the search results lead to Bank of America. This search was conducted on January 13, 2002.
The griper would not be able to read about other people’s experiences, or commiserate with others. Because Chase has monopolized the majority of domain names combining its mark with a pejorative, finding a domain name with content that addresses this obvious need is more difficult, involving a search through a search engine as well as wading through thousands of hits. Because Chase, like most companies, refuses to develop content with these domain names, a great many domain names are out of circulation. In the limited world of domain names, trademark protection allows mark holders to sit on these domain names without consequence.

While Chase has gone to great lengths to prevent people from posting their own complaints or reading about the experiences of others, some intrepid soul, seeing a need that has gone unaddressed, has gone to the trouble of providing the general populous with these services. These services do not compete with Chase. They are not financial in nature. These services do not compete with any ancillary services offered by Chase, nor does Chase post negative user comments on its website. This site, like most other gripe sites, is sponsored by somebody other than Chase. This gives more credence to the site and the site content simply because it is not connected with Chase and, thus, there is no Chase censorship.

VII. Conclusion

While WIPO, through the UDRP, has created a tool to defeat the primacy of the race to register, the UDRP has generated a new line of problems. By refusing to enact a method whereby the victims of RDNH can obtain satisfaction for their struggle, conflict over domain names will continue to rise. Empowered by arbitration panel decisions avoiding the issue of

RDNH, coupled with the lack of consequences, mark owners are encouraged to bring litigation against even the most innocent of fair use. Moreover, with RDNH precedent, the state of protest through domain names is tenuous at best.

While a domain name generally describes the content of the site, restriction on the fair use of a mark in conjunction with the nomenclature of protest curtails one of the methods by which web users can participate with the Web. While professing to allow for the free flow of ideas, regulation does not dissuade illegitimate suits, but instead encourages it. These regulations afford mark owners greater protection than what is reasonable, thus curtailing the free flow of ideas. Arbitration panels and courts need to be forced to change their paradigm, looking first to the use of the domain name, and then applying principles of fair use to the owner. Furthermore, if the litigation fails to satisfy the UDRP three-prong test, the complaining party should face legitimate consequences.

The competing interests of businesses and users need to be balanced, or innocent individuals will be forever faced with suit for demonstrating an interest, and attempting to share that interest, with others through the Web. Further, arbitration panels should look at the empirical evidence available before ruling that protest on the web is analogous with customer care. While the limited world of domain names creates an artificially strained relationship between commerce and the limits of character representation, it does not create a system whereby mark owners can prevent fair use, especially in the form of protest or complaint. By sitting on these domain names, preventing their use, and attempting to frustrate the use of these names by others, mark holders are doing a disservice to the system and their users by abusing the very system created to help them maintain their legitimate interests.