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MAKING THE MOST OF COMMERCIAL GLOBAL DOMAINS *

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SUMMARY:

... Hosts actually possess . . . a numeric "IP" [internet protocol] address such as 123.456.123.12, and an alphanumeric "domain name" such as microsoft. ... A domain name refers to a computer, and does not refer to a particular file, such as a web page. Instead, a particular file on the Internet, such as a web page, is identified by its Uniform Resource Locator ("URL"), which includes the domain name, identifies the file, ... "The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order. ... While the Anticybersquatting Consumer Protection Act does pose some risk of statutory damages ranging from \$ 1000 to \$ 100,000 per domain name, bad faith intent to profit is required. ... Besides the "HyperCD" trademark, BroadBridge held an RDN enabling its use of <hypercd.com> in both web and e-mail addresses such as <tech@hypercd.com>. ...

TEXT:

I. Introduction

What is now known as the Internet, or the net, was initially set up in 1969 to connect computers together for defense purposes. n1 The Internet was later expanded, under the supervision of the National Science Foundation ("NSF"), to include the research community. n2 The Internet continued to expand, and in 1992, NSF received authorization to permit commercial activities on the Internet. n3 Shortly thereafter, Judge McKenna, a United States District Court for the Southern District of New York, observed that "the Internet is the world's largest computer network . . . containing several million 'host' computers An estimated 25 million individuals have some form of Internet access, and this audience is doubling each year." n4 Only six years later, Professor Quinn of Barry University School of Law reported:

The growth of the Internet has been remarkable by any standard.

This truth is underscored by predictions from the Gartner Group that business to business e-commerce, which accounted for \$ 145 billion worldwide in 1999, will account for \$ 7.29 trillion worldwide by 2004. It is further highlighted by the fact that traffic on the Internet doubles every 100 days, with 1 billion people expected to be connected to the Internet by 2005. In short, the Internet is here to stay. n5

Remarkably, little of significance beyond the volume of traffic and the number of hosts and advertisements featuring Internet addresses has changed since Judge McKenna explained:

Each host computer . . . has a unique Internet address. Users seeking . . . a particular Internet host require the host's address in order to establish a connection.

Hosts actually possess . . . a numeric "IP" [internet protocol] address such as 123.456.123.12, and an alphanumeric "domain name" such as microsoft.com, with greater mnemonic potential. n6

In the absence of directories equivalent to those used to find phone numbers, Judge McKenna observed that users regarded nominal addresses n7 as valuable, particularly when they could be guessed. n8 Judge McKenna further noted that hosts regarded addresses that mirrored corporate names as being valuable for reaching customers. n9

Such advantages were not widely seen a few years ago, but today some people rely on nominal addresses more than on phone numbers. n10 Nominal addresses may even be traded online for high prices. n11 For example, it is reported that <business.com> sold for \$ 7.5 million and that <loans.com> sold for \$ 3 million. n12 Nominal addresses based on the names or marks n13 of well-known hosts are worth far more than either of those two generic nominal addresses. n14 Hence, it is not surprising that disputes between nominal address owners and owners of valuable marks are far more common than disputes over postal addresses and phone numbers ever were likely to have been.

While such Internet addresses may help users and suppliers of information, products and services find each other, the addresses are not without shortcomings. For example, as discussed below, domain name addresses are capable of generating source confusion, and can also inhibit competition. Despite echoing skepticism about the long-term prospects for commercial global

domains based in part on how they are governed, this paper concludes that nominal addresses are essentially a new form of intellectual property, to be viewed and managed in ways sometimes fundamentally different from trademarks and other indicia of commercial goodwill. In support, the article first reviews the domain name system ("DNS") under which nominal addresses may be registered. The article then outlines central principles of unfair competition law underlying the resolution of disputes within the United States. Finally, the article reviews how nominal addresses pose several new kinds of issues regarding dilution, genericism, territoriality, and governance.

II. Brief Overview of the DNS

The DNS governs the relationship between nominal addresses used by people and numerical addresses used by computers. n15 It is used to sort addresses by domain, much as zip codes are used to sort U.S. mail, or as area codes are used to sort phone numbers. n16 The DNS is based on a fundamental dichotomy. On one hand, almost 250 top level domains, called ccTLDs, correspond to countries or at least to semi-independent political entities. n17 Disputes regarding ccTLDs may be governed according to local laws. n18 On the other hand, top level domains spanning the globe are called gTLDs. n19

As mentioned earlier, users may be able to guess nominal addresses, but that is true only if the nominal addresses are short and simple. Consider these: <www.fire-department.ventura.ci.ca.us> and <www.fire-department.ventura.co.ca.us>. The "us" on the far right indicates the ccTLD for the U.S. n20 Terms separated by period punctuation ("dots") are called "levels" and are numbered right to left. n21 The second level domain "ca" indicates the state of California. n22 Two different third level terms distinguish Ventura the city "ci", from Ventura the county "co". n23 "Ventura" is the fourth level, and the fifth level is "fire-department," a term that may be registered by two different fire departments. n24 For simplicity, throughout this article, what may be registered will be called the registered domain name ("RDN").

The above examples should demonstrate the potential complexity of domain names and establish a key point of this paper: nominal addresses are not necessarily more easily typed or remembered than twelve-digit numerical addresses. Until users become far more sophisticated, it is equally unlikely that such complex addresses will be able to be guessed.

As explained by Judge Ellis in resolving a recent dispute, full gTLD addresses are also complex:

A domain name refers to a computer, and does not refer to a particular file, such as a web page. Instead, a particular file on the Internet, such as a web page, is identified by its Uniform Resource Locator ("URL"), which includes the domain name, identifies the file,

and indicates the protocol required to access the file. For example,

Roger Ebert's web page is located at the URL, <http://www.suntimes.com/ebert/index.html> . . . where (i) "http" refers to "Hypertext Transfer Protocol," the language required to access the web page, (ii) "www.suntimes.com" is the domain name for the Chicago Sun Times, and refers to the web server of the Sun Times, (iii) "ebert" refers to a particular directory on that server, and (iv) "index.html" refers to a particular file in that directory. n25

Yet, such complexity, elevated by right to left priority through the TLD, and left to right priority beyond, rarely presents difficulty. First, users need not enter "http://" into web browsers because it is assumed. n26 Second, "www" is often unnecessary too. n27 Moreover, unless a particular file is sought beyond the "home" default file, no "/" need appear to the right of the domain name. n28 Therefore, usually with the "www" inferred, such addresses will hereafter, for brevity, be called "URLs".

The "dot-com" domain has generated the most disputes, but all gTLDs share one feature that has remained essentially unchanged since 1994. Most RDNs are still obtained "under a very simple rule: First come, first served." n29 Although many different parties can have a stake in an RDN, each address must be unique, therefore, only one party can "own" a particular RDN. n30

From 1993 until 1998, Network Solutions, Inc. ("NSI") was the sole registry of global commercial domains. n31 Attempting to satisfy firms that were distressed upon learning that unaffiliated parties had registered their company names or trademarks as RDNs, NSI soon developed a dispute resolution system. n32 NSI's system has since been replaced, n33 but the NSI dispute resolution system governed several of the cases that are discussed below. Basically, the NSI system required protesters to notify registrants that they were violating the protestor's intellectual property rights. n34 Protestors were also required to provide evidence of their trademark registrations. n35 If registrants could not show that their RDNs were also their registered trademarks, NSI would suspend use of their RDNs. n36 If however, either a registrant or a third party took a dispute to court, NSI would wait for the court dispute to be settled before it suspended use of the RDN. n37 As explained below, this enabled NSI to stand aside and avoid many disputes, since many of the disputes submitted to NSI were also taken to court.

In one case, where NSI itself was the litigation target, the Ninth Circuit echoed the district court in affirming an award of summary judgment in NSI's favor, partly because:

Where domain names are used to infringe, the infringement does not result from NSI's publication of the domain name list, but from the registrant's use of the name on a web site or other Internet form of communication in connection with goods or services. . . . NSI's involvement with the use of domain names does not extend beyond registration. n38

Furthermore, the Court of Appeals saw fit to add:

NSI's role differs little from that of the United States Postal Service: when an Internet user enters a domain-name combination, NSI translates the domain-name combination to the registrant's IP Address and routes the information or command to the corresponding computer. Although NSI's routing service is only available to a registrant who has paid NSI's fee, NSI does not supply the domain-name combination any more than the Postal Service supplies a street address by performing the routine service of routing mail. n39

Since that time, registry liability seems to be unchanged. If anything, recent anticyberpiracy legislation n40 may reduce it. "The domain name registrar or registry or other domain name

authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order." n41

III. Unfair Competition and Dilution

A general understanding of unfair competition and related law is necessary to appreciate how most cyberspace disputes are resolved. Owners of trademarks have long been able to stop competitors' use of identical or similar marks on identical or similar goods. n42 If a seller misrepresents that his goods or services originate with, or are sponsored by, another, injury to the latter party is generally clear. n43

To prevail in a trademark infringement action, a plaintiff must usually show either inherent distinctiveness or acquired distinctiveness. n44 Acquired distinctiveness is also called secondary meaning. n45 The plaintiff must also usually demonstrate that some relevant part of the public is, or is likely to be, confused by the defendant's use of the trademark. n46 Once those conditions are met, it is irrelevant whether the defendant intended to mislead anyone. If however, a defendant intentionally misrepresents that the plaintiff is the source of the defendant's goods or services, courts may well presume both distinctiveness and likelihood of confusion. n47

In a modest expansion of that proposition, owners may sometimes stop the use of famous marks on dissimilar goods or services, despite lack of competition. n48 In such circumstances, the public may be misled, at least in the short term, as to who made or sponsors the product. n49 Perhaps more importantly, both consumers and owners may suffer in the long term from an eroded capacity to distinguish sources based on trademarks. Dilution statutes may help, but it is unclear how much, particularly when marks differ. n50 Fame however, is not something a mark either does or does not have. Rather, fame is distributed along a spectrum that controls the scope of injunctions granted when another impermissibly uses a mark.

In contrast to famous marks, generic terms usually confer no exclusivity with respect to the named goods or services. n51 Indeed, famous marks can become essentially useless after the public comes to regard them as the common, or generic, name of certain goods or services. n52 In such circumstances, the most that a plaintiff can expect to get is an injunction addressing possible differences in quality, n53 or an injunction requiring the defendant to affirmatively disclose the source of its goods or services. n54

Some terms lack the initial capacity to indicate source, but may become protected as trademarks once the public perceives them as source indicators. n55 Such terms include geographically descriptive, or otherwise descriptive, adjectives and surnames; which are denied federal registration absent evidence of distinctiveness. n56 Once distinctiveness of a term is accomplished, such terms may even become incontestable as trademarks. n57 However, others may still be allowed to use such trademarks "fairly." n58 This is true even for trademarks that have historically been regarded as among the strongest; thus Apple Computer, Inc. cannot prevent an orchard from advertising that it sells MacIntosh apples, nor any other type of apples.

Suggestive terms make good trademarks, and they may be registered in the U.S. without evidence of distinctiveness. n59 The term "Whopper," for example, suggests something large, n60 but any connection to Burger King's sandwich was remote when the trademark was first used. However, now that the term "Whopper" has become known as the name of a Burger King sandwich,

it is difficult to see how any other party could justify prominent use of the term "Whopper" without evidence that they used the trademark before Burger King did. n61

Finally, coined terms, such as Kodak or Exxon, make the strongest trademarks. While marketing departments may resist using coined terms as trademarks because of the cost required to get the public to associate them with their goods, it is nearly impossible for strangers to justify use of such trademarks -- except to indicate goods originating with owners of those trademarks. n62

Once a trademark is chosen, measures must be taken to preserve its strength. n63 Despite any other characteristics of a trademark, the weakest terms are those that are widely used. Geographical terms, such as "DelMarVa," suggesting that a firm straddles the borders of Delaware, Maryland and Virginia, or "Granite State," which is the official nickname of New Hampshire, are both extremely common. n64

Once a good trademark is selected, it must be policed. Consider, for example, the famous 1947 Sunkist case. n65 Remarkably, this lawsuit was brought by two independent plaintiffs, each whom had substantial goodwill at stake. n66 One had invested over forty million dollars advertising the "Sunkist" trademark, and had sold over two billion dollars worth of citrus fruits, oils and acids, and citrus-flavored beverages. n67 It had also registered the "Sunkist" trademark for those goods with the United States Patent and Trademark Office. n68 The second plaintiff had spent over \$ 350,000 advertising its "Sun-Kist" trademark, and had sold about fifty million dollars worth of canned and dried fruits and vegetables, milk, butter, catsup, pickles and a wide variety of other groceries. n69 This plaintiff, too, had federally registered its trademark. n70

Presumably in settlement of an earlier dispute, the two plaintiffs had agreed to recognize each other's exclusive rights in the "Sunkist" mark in their respective, yet similar, lines of trade. n71 Yet, that agreement led to the undoing of the two plaintiffs when they both protested a baker's use of essentially the same mark. n72 Not only did the court refuse to give the two plaintiffs relief, but the court also appeared to be upset about the prior agreement. n73 The court even stated that "granted the plaintiffs had a right to contract away the public's likelihood of confusion . . . but their cry that there is a likelihood of confusion of the source of a loaf of bread . . . is hardly audible to us." n74

In some ways, the situation later faced by McGregor-Doniger was very similar. n75 Owning the mark "Drizzler" for use on inexpensive golf jackets, McGregor-Doniger protested another's use of the mark "Drizzle" for use on much more expensive women's coats. n76 McGregor-Doniger lost. n77 Since this situation was allowed to continue, it is difficult to imagine how others selling even less similar goods can be halted.

By the time McGregor-Doniger discovered defendant's use of the "Drizzle" mark, the defendant had already been using the mark for about five years. n78 In general, firms that intend to free ride on others' goodwill generally, and a priori, are unlikely to sell more expensive products. Therefore, it is very unlikely that the defendant in this case was aware of McGregor-Doniger's trademark. Because, as this case makes clear, U.S. law does not require trademark searches to be performed before parties adopt a trademark, a heavy duty falls on trademark owners. Had the defendant in this case been aware of McGregor-Doniger's trademark earlier, the defendant probably would have adopted a different trademark. Moreover, the Court of Appeals wondered how defendant's use of its trademark, when both parties were located in Manhattan, could have possibly escaped McGregor-Doniger's attention for such a long time if confusion was so likely. n79 It is difficult to imagine

how either party, much less both, could later argue that the use of "Drizzle" or "Drizzler" on similar goods would be likely to confuse the public.

One last aspect of unfair competition law also warrants close attention here, particularly in the context of Internet commerce. To prevail in litigation, trademark owners must have priority within the disputed territories. At common law, such priority was based on use, as demonstrated in this classic articulation:

Where two parties independently are employing the same mark upon goods of the same class, but in separate markets wholly remote the one from the other, the question of prior appropriation is legally insignificant, unless at least it appear that the second adopter has selected the mark with some design inimical to the interests of the first user, such as to take the benefit of the reputation of his goods, to forestall the extension of his trade, or the like.

...

But this is not to say that the proprietor of a trade-mark, good in the markets where it has been employed, can monopolize markets that his trade has never reached and where the mark signifies not his goods but those of another. n80

U.S. trademark law now allows firms to reserve currently unoccupied territory through federal registration. n81 However, this does not divest other parties rights that arise from earlier use. n82

III. When Worlds Collide

A. New Problems Related to Dilution

First, it is useful to consider a dispute between two firms where one firm apparently had above-average knowledge of trademarks and below-average knowledge of the Internet, and the other firm apparently had opposite levels of understanding, respectively. n83 The former was Juno Lighting; a manufacturer and retailer of light fixtures that held two federal trademark registrations for "Juno," but apparently held no RDNs. n84 Conversely, the latter, Juno Online, had registered the domain name <juno.com> in 1994 without efforts to secure protection for any trademarks. n85

Juno Online was quite successful; in January 1997, alone, it opened 250,000 new accounts, and its free e-mail accounts soon represented 5% of the U.S. market. n86 Nevertheless, Juno Online continued undiscovered by Juno Lighting until mid-1995, when applications were filed for federal registration of Juno Online's trademarks. n87 Now alerted to another firm's use of "Juno," Juno Lighting not only opposed Juno Online's registrations, but also asked NSI to cancel Juno Online's RDN. n88

In response, Juno Online filed suit against both Juno Lighting and NSI, but latter dropped the suit against NSI when NSI agreed not to suspend Juno Online's RDN until Juno Online's suit against Juno Lighting was decided. n89 Juno Lighting, adding an interesting twist to the dispute, further upset Juno Online by registering <juno-online.com> with NSI. n90 However, the court refused to find Juno Lighting's actions improper, n91 and matters were apparently later resolved to both Juno Online's and Juno Lighting's mutual satisfaction. n92

A later suit brought by Lockheed offers an interesting contrast to the Juno case in two respects. First, consider the facts of the Lockheed case, as set forth by the 9th Circuit:

Lockheed owns and operates "The Skunk Works," an aircraft design and construction laboratory. Since 1943, The Skunk Works has developed prototypes of this country's first jet fighter, the U-2 and SR-71 spy planes, and the F117 and F-22 fighter planes. The Skunk Works is currently involved in designing a possible replacement for the space shuttle. "Skunk Works" is a registered and incontestable service mark. n93

Lockheed's core grievance was that "third parties, not involved in this litigation, have registered domain-name combinations with NSI which are variations on the phrase "skunk works." These RDNs include: <skunkworks.com>, <skunkworks.net>, . . . and <skunkworks.org>." n94

After convincing two different registrants to give up <skunkworks.com> and <skunkworks.net>, Lockheed was upset by NSI's failure to cancel those registrations promptly. n95

The parties in Juno may have been satisfied with NSI's dispute resolution system, but Lockheed found NSI's dispute resolution system unhelpful. n96 Lockheed was surely even more distressed when NSI later allowed still another stranger to register <skunkworks.com>. n97 Lockheed sued NSI instead of having to cancel many spurious RDNs one-by-one, and instead of having to hold all variations of "skunkworks" RDNs so that other parties could not register them. n98 However, NSI won this suit for reasons given earlier: "infringement does not result from NSI's publication . . . but from the registrant's use of the name on a web site." n99 Furthermore, NSI "does not supply the domain-name combination any more than the Postal Service supplies a street address." n100 The court therefore held that "NSI is not liable for contributory infringement as a matter of law." n101 The upshot, as far as NSI was concerned, was that firms that were aggrieved by multiple registrations by different parties could not deal with them en masse.

Nothing has since changed. While the Anticybersquatting Consumer Protection Act n102 does pose some risk of statutory damages ranging from \$ 1000 to \$ 100,000 per domain name, n103 bad faith intent to profit is required. n104 It seems unlikely that Lockheed would have been helped by the ACPA; it seems to have been beset by strangers more aptly characterized as fans than pirates.

One last case shedding light on problems unique to RDN registration also illustrates the territorial implications of gTLDs, and the potential flexibility of the ACPA. n105 More than four years before filing, plaintiff BroadBridge offered its clients, major record labels and other Compact Disc ("CD") publishers, an Internet-based system for controlling their consumers' use of CD contents. n106 BroadBridge also held a federal registration for the "HyperCD" trademark. n107

Besides the "HyperCD" trademark, BroadBridge held an RDN enabling its use of <hypercd.com> in both web and e-mail addresses such as <tech@hypercd.com>. n108 This RDN was critical to BroadBridge as it had promised to provide technical support to purchasers of over 4.5 million CDs on which the RDN and e-mail address appeared. n109 Despite that, "through inattentiveness and inadvertence," n110 BroadBridge did not renew its registration for the RDN by March 1, 2000, and the RDN was terminated. n111

Meanwhile, Henderson, a Canadian, had chosen "HyperCD" as an apt name for a similar technology that was soon to be offered by his firm. n112 Finding <hypercd.com> available,

Henderson paid \$ 70 to register the RDN. n113 Ironically, Henderson was contacted by BroadBridge's president the very next day. n114 After several fruitless exchanges, BroadBridge filed a complaint under the then-current ICANN dispute resolution system. n115 Two days later, BroadBridge also filed an ACPA action in federal court. n116

The ACPA action was filed in rem, i.e, against the RDN only. n117 While such an action requires a lack of in personam jurisdiction over owners of offending RDNs, Henderson had notice, filed papers and appeared through counsel at the in rem proceeding. n118 The non-judicial ICANN dispute resolution proceeding had been suspended pending the outcome of the judicial case, n119 so Henderson's argument that the ICANN dispute resolution proceeding afforded the sole avenue of review was rejected, n120 and the court assumed jurisdiction over this matter. n121

Although the record does not suggest that Henderson had copied BroadBridge's mark, or that his registration was in bad faith according to any of nine statutory factors of the ACPA, n122 the plaintiff here nevertheless managed to recover "his" RDN. n123 The court found that Henderson acted in bad faith by holding the RDN hostage while trying to negotiate an exorbitant amount of money from BroadBridge before releasing the RDN. n124 Stressing the relationship between trademarks and RDNs, the court gave still another reason for ordering that BroadBridge's nominal address be returned:

While not a factor relevant to Henderson's bad faith, I note that inevitably future trademark litigation would arise should Henderson use <hypercd.com> in the way he proposes. To the extent Congress enacted the ACPA intending to give trademark owners inexpensive and effective legal remedies that were uncertain and expensive under then-existing trademark law . . . Henderson's proposed use of the domain name which is nearly identical to plaintiff's trademark is certain to engender a presumptively meritorious yet expensive trademark action against him. n125

To succeed, however, a trademark action would have had to have been brought in Canada, where BroadBridge could secure personal jurisdiction over Henderson. n126 While nothing in the court's opinion explains the substantive basis for such a suit, it is nevertheless unlikely that Henderson could secure trademark rights superior to those available to BroadBridge since Henderson had not yet used his technology, nor the "HyperCD" name.

B. New Problems Related to Genericism

Given the nature of RDNs and the way they are registered, firms could conceivably register all common names for a product or service. For example, a registrant could apply for variations on the term "toy" to include "toys" and variations based on terms such as "cyber" and "e-." As prices per RDN drop, n127 the potential for registration of such domain names increases dramatically. If such registrations were undertaken to block competitors, such actions would eventually violate United States antitrust laws, n128 but an order would be a nightmare to write and administer. What can be done in the meantime? Who has standing to challenge such RDNs, and on what basis?

Conversely, recall that <business.com> sold for \$ 7.5 million, and that <loans.com> sold for almost half of that amount. n129 If a purchaser spends heavily to advertise such a term, how much difference should that make? In any event, until a firm predominates a market, it is difficult to regard the use of <gettaloan.com>, <loan.com>, <e-loans.com> or <myloans.com> as cyberpiracy.

n130 Depending on the extent to which that strategy was successfully pursued, it too might cause antitrust problems. n131

Some parties that are aware of the outcome of a recent dispute between <E-Cards.com> and <Ecards.com>, n132 may reach unwarranted conclusions. Although <E-Cards.com> is reported to have won a \$ 4 million judgment, it nevertheless agreed to settle. n133 Ecards.com Inc. agreed to change its company name and RDN, n134 but its president stated that changing its name to "Blab Media Inc." was already planned, partly because it believed generic names were going to become less useful than a "brandable identity." n135 Moreover, Ecards.com Inc. agreed to the name change only after it was allowed to have visitors to its old website be automatically bounced to its new website for a full six months. n136 Plaintiff's settlement, particularly in light of that condition, suggests little confidence of prevailing on appeal. n137

Before leaving this topic, one should also wonder about the possibility of Apple Computer being able to buy up all RDNs containing "apple" or to stop firms selling fruit from calling themselves, for example, <e-apple.com> or <macintoshorchards.com>. Similar queries might be made about a host of otherwise excellent marks such as <avon.com> and <amazon.com>, which are both potentially subject to legitimate geographical claims. n138

C. New Problems Related to Territory

Mail order sales and the like occasionally strain unfair competition principles, n139 but gTLDs make unfair competition principles almost impossible to apply, even within the United States. What is to be done when parties each have indisputable rights, in distinct areas, to use a term for the same goods or services? If either uses that mark in a gTLD, consumers in the others' market area may be confused. Should the other firm also use some variation of the same mark in its RDN, n140 consumers may not know which firm's mark they are guessing, or selecting from lists generated by search engines, n141 until they see a web page. Even then, they may be unaware of a second firm on the Internet n142 -- much less one located physically closer.

When two independent firms, both having exclusive rights to "Scrabble" in different areas faced such a problem, they apparently agreed to share the RDN. n143 This seems better than <firm1-mark.com> and <firm2-mark.com>. Not only does sharing <scrabble.com> minimize consumer confusion, but the domain name remains short and easily guessed by consumers.

Compare that to the in rem action filed by Harrods, a U.K. firm, in Virginia. n144 This suit was based on twenty-three United States trademark registrations for "Harrods," as well as an involvement, through a licensee, in Harrods Online. n145 Through Harrods Online, United States and Canadian consumers could purchase products from the London-based Harrods Department Store. n146 Ironically, the plaintiff's target in this case was a former affiliate of the plaintiff, Harrod's (Buenos Aires) Ltd. ("HBAL"). n147

HBAL had, about eighty years earlier, registered "Harrods" in Paraguay, Uruguay, Brazil, Chile, Bolivia, Colombia, Peru, and Venezuela. n148 HBAL had actual notice of this suit, but was not within the jurisdiction of this court. n149 Thus, the nominal ACPA defendants were sixty RDNs that had been registered with NSI. n150 These defendants included: <harrodsbashing.net>, <harrodsbank.net>, <harrodsamerica.com>, <harrodsargentina.org>, <cyberharrods.com>, <shoppingharrods.com>, and <harrodsbrazil.com>. n151

Judge Brinkema dismissed all claims for relief. n152 He stated:

Because HBAL is not before this Court sic in personam, plaintiff cannot pursue any cause of action with the potential to impose personal liability. . . . The effect of a judgment in an in rem action is "limited to the property that supports jurisdiction and does not impose a personal liability on the property owner, since he is not before the court." n153

Concerning its request for in rem cancellation of the offending RDNs under ACPA, plaintiff argued that it was not required to prove HBAL's bad faith. n154 However, the court indicated that HBAL's failure to keep its "address current or to leave an accurate forwarding address," casts doubt on the defendant's intent, and therefore may help prove defendant's bad faith. n155

Had the court been able to establish personal jurisdiction over the defendants here, it is difficult to discern a basis for granting relief without HBAL's having an URL as blatant as, say, <harrods-uk.com>. Barring that, how could HBAL's conduct be regarded as any less "fair" than plaintiff's? Indeed, even with personal jurisdiction over both parties, a court could prevent confusion by ordering, perhaps on cross-motions, neither firm to use <www.harrods.com>. n156 Because plaintiff already held that RDN, n157 firms in similar cases should consider that risk. Absent agreement, each firm in such circumstances should at least consider whether the long-term costs of two firms having similar URLs do not offset the short-term costs of adopting new marks.

D. The Current Governance Scheme is Unhelpful

Efforts to address problems are subject to several constraints, if progress is to be made. First, RDNs must be short and easily distinguished, or they serve little purpose. n158 Second, rights in RDNs must be unambiguous and stable, or firms cannot afford to invest in them. Finally, registration, policing, and dispute resolution should each be quick and inexpensive. However, tradeoffs are inevitable, as demonstrated by long-term efforts to minimize the aggregate costs of trademark registration and enforcement.

Within areas governed as single ccTLDs, many new unfair competition problems of the kind discussed above either disappear or are more easily solved. As Diane Cabell reported:

most nations require prior registration of a trademark to attain protection, so ignorance of a prior claim is not an excuse. Some national registries, like Norway, limit domain registrations to a company's official trade name Brazil cancels the domain if it isn't used within 6 months. Finland has a limit of one domain per company. Others, like Israel, strictly enforce the distinction between domain categories. n159

Yet, within global TLDs, many things are unclear, such as who owns the data that is needed to match RDNs with numerical addresses. n160 ICANN is in charge at some level, but its funding is uncertain despite the potential availability of large sums of money. n161 For example, at one time NSI could charge:

\$ 100 to register a domain name for a two year period and \$ 50 a year thereafter. Of the funds NSI collects . . . it keeps 70 percent; the remaining 30 percent is "placed into an interest-bearing account which will be used for the preservation and enhancement of the 'Intellectual Infrastructure' of the Internet in general conformance with approved Program Plans." . . . There are almost three million domain names currently registered under the four TLD's for which NSI handles the registration. n162

One court described ICANN as "a new, quasi-governmental internet-regulating body." n163 Still, beyond having the most elementary provisions for accrediting registries and a dispute resolution system that is difficult to characterize, commercial domains are essentially unregulated. Many parties prefer that. For example, the American Intellectual Property Law Association ("AIPLA") "has repeatedly stressed that any effort to design and implement a new Internet domain name system should include . . . a recognition that the private sector, rather than the government, is best equipped to administer and maintain the domain name system." n164

Is ICANN in the private sector? If so, and if it can nevertheless institute new gTLDs, n165 that may please some. Yet, instituting new gTLDs will create serious difficulties for others, including the public. Who can reconcile the competing interests of hosts in different territories with exclusive rights in single trademarks and lines of trade? Even cyberpiracy has proven difficult to define and address. n166 If it is so difficult to define and address something almost universally condemned, what can be expected of other practices, such as warehousing? If warehousing is to be actionable on grounds other than antitrust, who shall articulate them? ICANN? Under what authority?

Dispute resolution panels offer little more hope. Arbitration most aptly characterizes the process they serve. Not only are RDN owners arguably bound by contracts signed when registering their RDNs, but anyone who files a complaint also appears bound. Consider the following rule:

(b) The complaint shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form and shall:

. . .

(xiv) Conclude with the following statement followed by the signature of the Complainant or its authorized representative:

"Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the disputeresolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents."

"Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument." n167

How are public interests to be accommodated in that private process? n168 Beyond that, how are conflicts between panel decisions about the law as "extended by a good-faith and reasonable argument" to be resolved?

IV. Conclusion

It is difficult to understand the persistence of commercial gTLDs. They are creatures of a technically-cumbersome n169 and legally-bothersome scheme that rests on politically-difficult and normatively-suspect n170 foundations. Something in the nature of "yellow pages" n171 has long been urged:

We envision a telephone-type directory covering all gTLDs which would allow . . . interested parties, to search through multiple trademark, trade name or surname listings at a single Internet address where the users could then have direct linkage to the home page or Website corresponding to a given listing The domain name itself would then largely become irrelevant, because the directory would become the most common means of access. n172

Given the frequency and scope of problems at many levels, a replacement of the current RDN system seems inevitable. Most likely, as was true of the Internet itself in the incredibly recent past, the replacement will be something unforeseen and unforeseeable. n173

Meanwhile, if RDNs do not share all the attributes of realty or tangible personalty, n174 registrants nevertheless hold enforceable rights. Subject to likely dilution by new domains, as well as to a need to renew at prices and frequencies that are subject to change, RDNs represent a discrete, new form of intellectual property. RDNs are not only more alienable than trademarks and trademark registrations, n175 but they can also furnish ample basis for unfair competition actions.

Despite the many problems, the potential, and indeed the welcomed demise of RDNs, firms must meanwhile make the most of the situation. Their best strategy is certainly not to adopt generic RDNs. n176 Rather, the best strategy is to develop coined names at least as unique as "Kodak," n177 and to spend whatever it takes to fix these coined names in the public eye. If RDNs eventually come to be of little more importance than mnemonic telephone numbers (like 1-800-WESTLAW) are now, firms will find themselves in the enviable position of holding the best trademarks available, not an empty bag.

FOOTNOTES:

n1 See United States Dep't of Commerce, National Telecommunications and Information Administration, Management of Internet Names and Addresses, *63 Fed. Reg. 31,741, 31,741-42* (June 10, 1998) (providing a history of the domain name system).

n2 See *id. at 31,742*.

n3 See *id.*

n4 *MTV Networks v. Curry*, *867 F. Supp. 202, 203 n.1 (S.D.N.Y. 1994)*.

n5 Eugene R. Quinn, Jr., *The Evolution of Internet Jurisdiction: What A Long Strange Trip It Has Been*, 2000 *Syracuse L. & Tech. J.* 1, 1-2 (citations omitted) (emphasis added). See also World Intellectual Property Organization, *The Management of Internet Names and Addresses: Intellectual Property Issues*, Final Report of the WIPO Internet Domain Name Process, April 30, 1999, at <para> 9, available online at <<http://wipo2.wipo.int/process1/report/finalreport.html>> [hereinafter WIPO REPORT].

n6 *MTV Networks*, 867 *F.Supp.* at 203 n.2.

n7 The term "nominal" is used in lieu of the more common, but equivalent, terms "mnemonic" and "alphanumeric."

n8 *MTV Networks*, 867 *F. Supp.* at 203 n.2.

n9 See id.

n10 See Kathryn Balint, *Site Seer: Cyber Visionary Turn Dot Coms Into Gold*, San Diego Union-Trib., Sept. 7, 2000, at E1, available in 2000 *WL* 13984404.

n11 See GreatDomains.com (where domain names are traded) (visited Nov. 6, 2000) <<http://www.greatdomains.com>>.

n12 See Balint, *supra* note 10. See also Tamara E. Holmes, *Sell Your Good Domain Name for Hard Cash*, USA Today, Sept. 11, 2000, available in 2000 *WL* 5789209.

n13 This terms "mark" or "trademark" in this article are intended to cover service marks as well as trademarks. It may also cover logos and trade dress, but source identifiers other than sets of alphanumeric characters are of no concern in this article.

n14 Consider, for example, the likely value of the well-known "Coca-Cola" mark. See *Coca-Cola Co. v. Busch*, 44 *F. Supp.* 405, 411, 52 *U.S.P.Q. (BNA)* 377, 383 (*E.D. Pa.* 1942) (noting that Coca-Cola was allowed to stop the defendant from using "Koke-Up" even before Coca-Cola adopted "Coke" as a mark since consumers associated the term "Coke" with Coca-Cola).

n15 See United States Dep't of Commerce, National Telecommunications and Information Administration, *Management of Internet Names and Addresses*, 63 *Fed. Reg.* 31,741, 31,741 (June 10, 1998).

n16 See *MTV Networks v. Curry*, 867 *F. Supp.* 202, 203 n.2 (*S.D.N.Y.* 1994).

n17 See, e.g., Country Codes (ccTLDs) file (visited Nov. 6, 2000) <<http://www.urlmerchant.com/cctlds.html>>.

n18 See United States Dep't of Commerce, National Telecommunications and Information Administration, *Management of Internet Names and Addresses*, 63 *Fed. Reg.* 31,741, 31,742, 31,744 (June 10, 1998).

n19 See id. These are often called "generic" TLDs, but global TLDs seems more apt.

n20 See Official United States Domain Registry (US), *The US Domain Overview, Naming Structure --Locality Names* (visited Nov. 6, 200) <www.nic.us/overview/locality.html>.

n21 See id.

n22 See id.

n23 See *id.* As also indicated, hosts need not be located in the designated geographical area. See *id.* Thus, nothing seems to prevent a resident of New Hampshire, or Korea for that matter, from registering <her-name.ventura.ci.ca.us> if they were so inclined. See *id.*

n24 See *id.*

n25 *America Online, Inc. v. Huang*, 106 F. Supp. 2d 848, 851 n.5, 55 U.S.P.Q.2d (BNA) 1560, 1563 n.5 (E.D. Va. 2000).

n26 However, when a different file transfer protocol, such as FTP, is involved, it must be entered.

n27 For example, while <scrabble.com> is adequate, <harrods.com> is not; <www.harrods.com> must be used.

n28 See *id.*

n29 *MTV Networks v. Curry*, 867 F. Supp. 202, 204 n.2 (S.D.N.Y. 1994).

n30 Yet, the party does not even need to have an actual stake in the RDN, nor do they even have to use the RDN. See, e.g., *EmpireState.com* (visited Apr. 5, 2001) <www.empirestate.com> or <empirestate.com>. Many parties have a stake in that term, but the web page merely offers the RDN for sale.

n31 See ICANN, Registrar Accreditation: History of the SRS (visited Nov. 6, 2000) <www.icann.org/registrars/accreditation-history.htm>. See also *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 392 (S.D.N.Y. 1999).

n32 See *Juno Online Services, L.P. v. Juno Lighting, Inc.*, 979 F. Supp. 684, 686, 44 U.S.P.Q.2d (BNA) 1913, 1915 (N.D. Ill. 1997).

n33 See ICANN, Rules for Uniform Domain Name Dispute Resolution Policy (visited Nov. 6, 2000) <www.icann.org/udrp/udrp-rules-24oct99.htm>.

n34 See *Juno Online*, 979 F. Supp. at 686, 44 U.S.P.Q.2d at 1915.

n35 See *id.*

n36 See *id.* That posed a serious problem for firms that had legally-protectable goodwill, but no trademark registration.

n37 See *id.*

n38 See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 985, 52 U.S.P.Q.2d (BNA) 1481, 1484 (9th Cir. 1999) (quoting *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 958, 44 U.S.P.Q.2d (BNA) 1865, 1873 (C.D. Ca. 1997)) (emphasis added).

n39 *Id.* at 984-85, 52 U.S.P.Q.2d at 1484.

n40 Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, § § 3001-10, 113 Stat. 1501A-545, 1504A-545 to 1504A-552 (1999) (codified as amended in scattered sections of 15 U.S.C. (1994 & Supp. V 1999)) [hereinafter ACPA]. The first appellate case to apply the ACPA was *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 53 U.S.P.Q.2d (BNA) 1570 (2d Cir. 2000).

n41 15 U.S.C. § 1125(d)(2)(D)(ii) (Supp. V 1999).

n42 See, e.g., *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415-16 (1916).

n43 15 U.S.C. § 1125(a)(1)(A) (1994).

n44 See Restatement (Third) of Unfair Competition § 13 cmt. e (1995). Few words have only two meanings. In the context of unfair competition and trademark cases, the term "secondary meaning" signifies that something has come to indicate a particular commercial source.

n45 See *id.*

n46 See, e.g., *McGregor-Doniger Inc. v. Drizzle*, 599 F.2d 1126, 1130, 202 U.S.P.Q. (BNA) 81, 86 (2d Cir. 1979).

n47 See, e.g., *My-T Fine Corp. v. Samuels*, 69 F.2d 76, 77 (2d Cir. 1934), *American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 562, 99 U.S.P.Q. (BNA) 362, 365 (1953).

n48 Compare *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 493, 128 U.S.P.Q. (BNA) 411, 412 (2d Cir. 1961) (holding that Polaroid was not able to stop Polarad's use of the name "Polarad" due to laches and differing fields of activity) with *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 411 (2d Cir. 1917) (holding that plaintiff was able to stop defendant's use of the "Aunt Jemima" mark on pancake syrup even though plaintiff only used the mark on self-rising flour).

n49 See *Aunt Jemima*, 247 F. at 410.

n50 See, e.g., *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1032, 10 U.S.P.Q.2d (BNA) 1961, 1966 (2d Cir. 1989) (holding that "Lexus" for automobiles did not dilute "Lexis" for computerized legal research services under the N.Y. state antidilution statute).

n51 See, e.g., *DuPont Cellophane Co. v. Waxed Prod. Co.*, 85 F.2d 75 (2d Cir. 1936).

n52 See 15 U.S.C. § 1064(3) (1994 & Supp. V 1999) (noting that a registered mark may be cancelled "(a)t any time if the registered mark becomes the generic name of the goods or services . . .").

n53 See, e.g., *Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, 559 F. Supp. 1270, 1281-82, 218 U.S.P.Q. (BNA) 71, 81 (S.D.N.Y. 1983) (allowing use of a generic term subject to meeting an originator's specifications).

n54 See *DuPont Cellophane Co. v. Waxed Prod. Co.*, 85 F.2d 75, 82 (2d Cir. 1936) (requiring a firm that was allowed to use a well-known name to clearly label itself as the source of the product).

n55 See 15 U.S.C. § 1052(f) (1994 & Supp. V 1999).

n56 See 15 U.S.C. § 1052(e-f) (1994 & Supp. V 1999).

n57 See, e.g., *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 205, 224 U.S.P.Q. (BNA) 327, 334 (1985).

n58 See 15 U.S.C. § 1115(b)(4) (1994) (excluding from trademark infringement uses, other than as a mark, a "party's individual name in his own business" or of a term "descriptive of and used fairly and in good faith only to describe . . . his goods or services").

n59 See 15 U.S.C. § 1052 (1994 & Supp. V 1999).

n60 A "whopper" is also "a gross or blatant lie." The Concise Oxford Dictionary 1634 (10th ed. 1999). Firms must be alert to the full range of formal and informal meanings of words.

n61 See *15 U.S.C. § 1115(b)(5)* (1994).

n62 However, even Kodak must tolerate some uses of trademarks similar to its own. See, for example, the Alaska WeatherCams' use of "Kodiak" at <http://akweathercams.faa.gov/Kodiak/Kodiak.html> (visited Mar. 29, 2001).

n63 See Thomas G. Field, Jr., *Trademarks & Business Goodwill* (visited Nov. 6, 2000) www.fplc.edu/tfield/trademk.htm (suggesting strategies for choosing good marks and avoiding bad ones).

n64 A search for "DelMarVa" produced 34,922 different listings. See <http://www.altavista.com/cgiin/query?q=delmarva&kl=XX&pg=q&Translate=on> (visited Apr. 5, 2001). A search for "Granite State" produced 23,482 different listings. See <http://www.altavista.com/cgibin/query?q=granite+state&kl=XX> (visited Apr. 5, 2001).

n65 *California Fruit Growers Exch. v. Sunkist Baking Co.*, 166 F.2d 971, 76 U.S.P.Q. (BNA) 85 (7th Cir. 1947).

n66 See *id.* at 972, 76 U.S.P.Q. at 85.

n67 See *id.*

n68 See *id.*

n69 See *id.* at 972, 76 U.S.P.Q. at 86.

n70 See *id.*

n71 See *id.*

n72 See *id.* at 975, 76 U.S.P.Q. at 88-89.

n73 See *id.*

n74 *Id.*

n75 See *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 U.S.P.Q. (BNA) 81 (2nd Cir. 1979).

n76 See *id.* at 1129, 202 U.S.P.Q. at 85.

n77 See *id.* at 1140, 202 U.S.P.Q. at 94.

n78 See *id.* at 1129, 202 U.S.P.Q. at 85.

n79 See *McGregor-Doniger*, 599 F.2d at 1136 n.6, 202 U.S.P.Q. at 91 n.6.

n80 *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415-16 (1916). While the Court focused on the territorial limits to unfair competition, note that the Court anticipated dilution by acknowledging the potential to halt a firm's efforts "to take the benefit of the reputation" of another's goods. *Id.* at 415.

n81 See *15 U.S.C. § 1051(b)* (1994 & Supp. V 1999).

n82 See *15 U.S.C. § 1115(b)(5)* (1994 & Supp. V 1999).

n83 See *Juno Online Serv. v. Juno Lighting, Inc.*, 979 F. Supp. 684, 684, 44 U.S.P.Q.2d (BNA) 1913, 1913 (N.D. Ill. 1997).

n84 See *id.* at 685, 44 U.S.P.Q.2d at 1914.

n85 See *id.* at 685-86, 44 U.S.P.Q.2d at 1914-15.

n86 See *id.* at 686, 44 U.S.P.Q.2d at 1915.

n87 See *id.*

n88 See *id.*

n89 See *id.*

n90 See *id.*

n91 See *id.* at 691-92, 44 U.S.P.Q.2d at 1920.

n92 Juno Lighting has a web site at <junolighting.com> (visited Nov. 6, 2000) and a firm named simply "Juno" offers free e-mail and other Internet services at <juno.com> (visited Nov. 6, 2000).

n93 *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 982, 52 U.S.P.Q.2d (BNA) 1481, 1483 (9th Cir. 1999).

n94 *Id.* at 983, 52 U.S.P.Q.2d at 1483. Others included <theskunkworks.com>, <skunkwear.com>, <theencryptedskunkworks.com>, <skunkworx.com>, <skunkworks1.com>, <the-skunkwerks.com>, <skunkwerks.com>, <skunkwurks.com>, and <skunkwrks.com>. See *id.* at 983, 52 U.S.P.Q.2d at 1483.

n95 See *id.*

n96 See *id.* (noting that Lockheed sued NSI).

n97 See *id.*

n98 See *id.*

n99 *Id.* at 985, 52 U.S.P.Q.2d at 1484.

n100 *Id.* at 984-95, 52 U.S.P.Q.2d at 1484.

n101 *Id.* at 987, 52 U.S.P.Q.2d at 1486.

n102 See ACPA, *supra* note 44.

n103 See 15 U.S.C. § 1117(d) (Supp. V 1999).

n104 See 15 U.S.C. § 1125(d)(1)(A)(i) (Supp. V 1999).

n105 See *BroadBridge Media, L.L.C. v. Hypercd.com*, 106 F. Supp. 2d 505, 55 U.S.P.Q.2d (BNA) 1426 (S.D.N.Y. 2000).

n106 See *id.* at 507, 55 U.S.P.Q.2d at 1427.

n107 See *id.*

n108 See *id.*

n109 See *id.* at 506-07, 55 U.S.P.Q.2d at 1427.

n110 *Id. at 507, 55 U.S.P.Q.2d at 1427.* The opinion does not explain whether any notice was given by the registrar. See *id.*

n111 See *id.*

n112 See *id.*

n113 See *id.*

n114 See *id.*

n115 See *id. at 508, 55 U.S.P.Q.2d at 1428.*

n116 See *id.*

n117 See *id.*

n118 See *id.*

n119 See *id. at 509 n.4, 55 U.S.P.Q.2d at 1429 n.4.*

n120 See *id. at 508-09, 55 U.S.P.Q.2d at 1428-29.*

n121 See *id. at 509, 55 U.S.P.Q.2d at 1429.*

n122 See *15 U.S.C. § 1125(d)(1)(B)(i)* (Supp. V 1999).

n123 See *Broadbridge, 106 F. Supp.2d at 512, 55 U.S.P.Q.2d at 1431.*

n124 See *id.*

n125 *Id.*

n126 See *id. at 508, 55 U.S.P.Q.2d at 1428* (noting that Henderson is a Canadian resident).

n127 Although NSI was originally the sole registrar of domain names, many such registrar's now exist. Several of these registrar's even offer bulk registrations. For example, see www.register-domain-names.com/multiple.htm (visited Nov. 4, 2000) (offering a 40% discount if you register 100 or more domain names).

n128 See *15 U.S.C. § 2* (1994).

n129 See Balint, *supra* note 10.

n130 See *15 U.S.C. § 2* (1994).

n131 See *id.*

n132 See John Partridge, *Ecards.com loses name* (Oct. 7, 2000) www.globetechnology.com/archive/gam/News/20001007/RCARD.html.

n133 See *id.*

n134 See *id.*

n135 *Id.*

n136 See *id.*

n137 Yet, precedents for such relief have been previously discussed. See *Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, *559 F. Supp. 1270, 1281-82, 218 U.S.P.Q. (BNA) 71, 81 (S.D.N.Y.*

1983) (allowing use of a generic term subject to meeting an originator's specifications); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936) (requiring a firm that was allowed to use a well-known name to clearly label itself as the source).

n138 See 15 U.S.C. § 1115(b)(4) (1994). For example, <www.avon.co.uk> (visited Nov. 2, 2000) states "USP Networks have forwarded you to this page to show that, although the owner has not yet developed the site, the name has been registered."

n139 See *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1393, 225 U.S.P.Q. (BNA) 1104, 1110 (3d Cir. 1985).

n140 As with phone numbers, each RDN must be unique.

n141 Some common search engines include <google.com> (visited Nov. 4, 2000) and <altavista.com> (visited Nov. 4, 2000).

n142 See *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1209, 53 U.S.P.Q.2d (BNA) 1652, 1659 (9th Cir. 2000).

n143 See The Official Worldwide Scrabble Home Page at <scrabble.com> (visited Apr. 5, 2001).

n144 See *Harrods Ltd. v. Sixty Internet Domain Names*, 110 F. Supp. 2d 420, 421-22, 56 U.S.P.Q.2d (BNA) 1048, 1049 (E.D. Va. 2000).

n145 See *id.* at 421, 56 U.S.P.Q.2d at 1049.

n146 See *id.*

n147 See *id.* at 421-22, 56 U.S.P.Q.2d at 1049. Since 1963, however, there has been no further ownership connection between the plaintiff and defendant. See *id.*

n148 See *id.* at 421, 56 U.S.P.Q.2d at 1049.

n149 See *id.* at 422, 56 U.S.P.Q.2d at 1049.

n150 See *id.* at 422, 56 U.S.P.Q.2d at 1050.

n151 See *id.* at 422, 56 U.S.P.Q.2d at 1049.

n152 See *id.* at 421, 56 U.S.P.Q.2d at 1049.

n153 *Id.* at 423, 56 U.S.P.Q.2d at 1050.

n154 See *id.* at 424, 56 U.S.P.Q.2d at 1051.

n155 See *id.* at 426-27, 56 U.S.P.Q.2d at 1053.

n156 See *Manhattan Indus., Inc. v. Sweater Bee by Banff, Ltd.*, 627 F.2d 628, 631, 207 U.S.P.Q. (BNA) 89, 91 (2d Cir. 1980). The court gave neither party exclusive rights over a mark the public had come to associate with a third firm. See *id.* A functionally equivalent result would be easier to achieve on cross-motions to prohibit use.

n157 See *Harrods*, 110 F. Supp. 2d at 421, 56 U.S.P.Q.2d at 1049.

n158 See WIPO REPORT, *supra* note 5, at <para> 347.

n159 Diane Cabell, *Foreign Domain Name Disputes 2000*, 17 *Computer & Internet Law*. 5 (2000), available online at <www.mama-tech.com/foreign.html>.

n160 See Letter from Robert P. Murphy, General Counsel, U.S. General Accounting Office, to United States Senate and House of Representatives (July 7, 2000), available online at <<http://www.gao.gov/new.items/og00033r.pdf>> [hereinafter GAO LETTER]. The letter addressed the relationship between the Department of Commerce and ICANN. *Id.* Several issues were raised, most notably for present purposes, "whether the Department has the legal authority to transfer control of the authoritative root server to ICANN." *Id.* at 2. ICANN's authoritative root server appears to be the same as NSI's WHOIS database, which "contains information about networks, networking organizations, domain names, and the contacts associated with them for the com, org, net, edu, and ISO 3166 country code top-level domains." NSI Glossary (visited Nov. 4, 2000) <networksolutions.com/cgi-bin/glossary/lookup?term=Whois>. The database page also contains a notice stating in part "compilation, repackaging, dissemination, or other use of the WHOIS database in its entirety, or of a substantial portion thereof, is not allowed without NSI's prior written permission. By submitting this query, you agree to abide by this policy." WHOIS Lookup (visited Nov. 4, 2000) <networksolutions.com/cgi-bin/whois/whois>.

n161 See GAO LETTER, *supra* note 175, at 21-24, 43-44 (discussing ICANN's funding and current budget proposal).

n162 *PGMedia, Inc. v. Network Solutions, Inc.*, 51 *F. Supp. 2d* 389, 392-93 (S.D.N.Y. 1999). See also *Thomas v. Network Solutions, Inc.*, 176 *F.3d* 500, 511 (D.C. Cir 1999) (upholding NSI's ability to collect fees).

n163 *Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply, Inc.*, 54 *U.S.P.Q.2d* (BNA) 1766, 1767 (N.D. Ill. 2000).

n164 Comments of the American Intellectual Property Law Ass'n on the Proposed Rule on the Improvement of the Technical Management of Internet Names and Addresses, available online at (visited Nov. 7, 2000) <www.ntia.doc.gov/ntiahome/domainname/130dfthmail/AIP LA.htm> [hereinafter AIPLA COMMENTS].

n165 See Internet Corp. for Assigned Names & Numbers, New TLD Program <www.icann.org/tlds> (visited Nov. 2, 2000).

n166 See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 *F. Supp.* 949, 968, 44 *U.S.P.Q.2d* (BNA) 1865, 1881 (C.D. Ca. 1997).

n167 Internet Corp. for Assigned Names and Numbers, Rules for Uniform Domain Name Dispute Resolution Policy, Rule 3(b)(xiv) (emphasis added) (approved Oct. 24, 1999)

< <http://www.icann.org/udrp/udrp-rules-24oct99.htm>>.

n168 See generally Thomas G. Field, Jr., Patent Arbitration: Past, Present and Future, 24 *IDEA* 235, 235-48 (1984) (discussing another area that posed concern about accommodating public interests in private proceedings).

n169 Every nominal address must be matched with a numerical one before communication can occur.

n170 Based on more than thirty years of experience with various kinds of legal processes, I prefer (a normative assessment) those processes that offer clear political oversight and judicial review.

n171 Several such things are now available, even if less widely used than they might be. Two such sites are sponsored by NSI. Besides the WHOIS database, NSI also appears to own the "dot com directory." See dotcom.com, <www.dotcom.com> (visited Mar. 29, 2001); WHOIS Lookup, <www.networksolutions.com/cgi-bin/whois/whois> (visited Nov. 4, 2000).

n172 See AIPLA COMMENTS, supra note 179, Part II.B.3.b.

n173 See WIPO REPORT, supra note 5, at <para> 348 n.228 (regarding new navigational measures). "For instance, the latest releases of Netscape's browser include a feature called 'Internet Keywords.' A user wishing to access, for example, the website of BankAmerica Corporation would no longer be required to enter 'http://www.bofa.com' in a browser, but simply 'bank of america.'" Id.

n174 See *Dorer v. Arel*, 60 F. Supp. 2d 558, 562 (E.D. Va. 1999) (noting that a trademark owner could not compel the defendant to transfer an infringing RDN to the plaintiff in partial satisfaction of a judgment); *Kremen v. Cohen*, 99 F. Supp. 2d 1168, 1173 (N.D. Ca. 2000) ("A domain name is a form of intangible property which can not serve as a basis for a conversion claim.").

n175 See 15 U.S.C. § 1060 (1994) (expressing limitations on trademark assignment that do not apply to RDNs). It is thus difficult to see why many RDN owners seek to register them as trademarks. See Oscar S. Cisneros, Internet Land Rush at TM Office (Sept. 18, 2000) <www.wired.com/news/politics/0,1283,38824,00.html>.

n176 In reality, the number of million dollar domain names is probably very few, particularly given the sheer quantity of domain names that have been registered. At this point, the average domain owner would probably have just as much chance of winning the lottery as of selling a domain name for a million dollars.

n177 See Thomas Barrett, Best Practices for Trademarks on the Web: How E-Commerce Has Changed the Rules, DOMAIN NAMES SUPPLEMENT, Apr. 2000, at 26.