

Copyright (c) 2001 PTC Research Foundation of Franklin Pierce  
Law Center  
IDEA: The Journal of Law and Technology

2001

*41 J.L. & TECH. 127*

## **INTERNET DOMAINS AND TRADEMARK CLAIMS: FIRST AMENDMENT CONSIDERATIONS**

DAVID C. NAJARIAN \*

\* B.S., Computer Science, DeSales University; M.B.A., DeSales University; J.D., Widener University. Mr. Najarian is currently a consultant with Devon Consulting, an Information Technology services firm located in Wayne, PA. He lives with his wife and two children on a small farm in rural Pennsylvania.

### **I. Introduction**

Some trademark commentators suggest that the Internet is akin to the Wild West; a kind of lawless frontier, where trademark holders have murky, inconsistent protection against unauthorized parties who use the holder's trademark on the Internet. n1 These commentators suggest that the current protective approach under the Lanham Act n2 is limited. n3

This article rebuts the Wild West analogy by suggesting that the First Amendment should limit trademark protections. Although the scope of this article is primarily limited to trademark claims against unauthorized parties who incorporate the holder's trademark into an Internet domain name, First Amendment analysis may be applicable to trademark claims in other Internet contexts too.

### **II. Trademark Remedies Against Domain Name Registrants**

The law traditionally provides three primary recourses against the unauthorized use of a trademark in a domain name. First, the holder may have a claim of trademark infringement. n4 Second, the holder may have a claim of trademark dilution. n5 Third, the holder may have a claim of unfair competition. n6

Trademark infringement stems from the unauthorized use of a protected mark where such use is likely to cause confusion regarding the origin of the goods or services offered. n7 Similarly, using another's trademark to lure consumers can be infringement even when any resulting confusion regarding the origin of goods is dispelled prior to their actual sale. n8

Trademark dilution stems not from public confusion, but from the diminished quality of a protected mark. n9 Dilution "is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use on noncompeting goods." n10 Dilution often comes by way of tarnishment. n11 Tarnishment occurs where a protected mark is used with a negative or unwholesome association that diminishes the mark. n12

Unfair competition, sometimes called false designation of origin, n13 covers false or misleading descriptions of fact made in connection with commercial advertising or promotion where such descriptions are likely to deceive or cause confusion regarding the origin of goods or services. n14 Confusion can arise either from a literal falsehood used in advertising, or from a literal truth used in advertising that is likely to mislead consumers. n15

Another recourse against the unauthorized use of a trademark in a domain name was created when the Anticybersquatting Consumer Protection Act ("ACPA") was passed and signed into law. n16 The ACPA amended the Trademark Act of 1946 and created a federal remedy for cybersquatting. n17 Cybersquatting involves registering, trafficking in, or using a famous or distinctive mark as a domain name with the bad faith intent to profit from the mark. n18

Additionally, the trademark holder may seek resolution using the Uniform Domain Name Dispute Resolution Policy ("UDRP") that was recently adopted by Internet Corporation for Assigned Names and Numbers ("ICANN"). n19 ICANN requires all registrars of Internet domain names to follow the UDRP. n20 ICANN also accredits dispute resolution service providers. n21

### III. First Amendment Implications of Trademark Protection

Missing from the trademark protections against others using the mark in a domain name is the recognition of a First Amendment defense. n22 Courts have failed to recognize and accept an expressive component in domain names. This failure effectively precludes a First Amendment defense to trademark claims that arise from Internet domain names. Similar criticism can deservedly be made against the newly enacted ACPA and ICANN's UDRP. The result is that trademark law now favors trademark holders, at the expense of domain name registrants.

The First Amendment protects ideological expression. n23 "Ideological expression . . . is integrally related to the exposition of thought. . . and such expression may convey factual information relevant to social and individual decisionmaking." n24 Such expression is protected "whether or not it contains factual representations and even if it includes inaccurate assertions of fact." n25 "'Under the First Amendment there is no such thing as a false idea,' and the only way that ideas can be suppressed is through 'the competition of other ideas.'" n26

The First Amendment also protects commercial speech. n27 Commercial speech has traditionally been defined as speech that does "no more than propose a commercial transaction . . . [and is] removed from any 'exposition of ideas.'" n28 Commercial speech differs slightly from expressive speech in that commercial speech may warrant a different

degree of protection "to insure that the flow of truthful and legitimate commercial information is unimpaired." n29

First Amendment defenses should apply to trademark claims against the unauthorized use of a trademark in a domain name because domain names are expressive. The Lanham Act supports the proposition of a First Amendment defense, albeit narrow in context. n30 Additionally, the Lanham Act excludes remedies for dilution where the use of a famous mark is noncommercial. n31

However, recognition of a First Amendment defense to trademark claims is only a first step. Courts must also resolve issues surrounding use that is simultaneously expressive and commercial. When use is both expressive and commercial, the courts must decipher multi-faceted and/or intrinsic use to determine the appropriate level of protection.

#### IV. Classic First Amendment Application

L.L. Bean, Inc. v. Drake Publishers, Inc. illustrates a First Amendment defense to trademark claims, absent an Internet domain name context. n32 L.L. Bean further demonstrates use that comprises both commercial and expressive components. n33

In L.L. Bean, Drake Publishers, the publisher of High Society magazine, produced an issue containing a two-page article entitled "L.L. Bean's Back-To-School-Sex-Catalog" as a parody of L.L. Bean's clothing catalog. n34 "The article displayed a facsimile of Bean's trademark and featured pictures of nude models in sexually explicit positions using 'products' that were described in a crudely humorous fashion." n35

L.L. Bean alleged trademark infringement, trademark dilution, unfair competition, and other claims. n36 Also, L.L. Bean sought a restraining order to remove the offending issue from circulation. n37 The district court denied L.L. Bean's request for a restraining order. n38 Thereafter, both parties moved for summary judgment. n39 The district court found in favor of L.L. Bean solely on the trademark dilution claim raised under Maine law, n40 and issued an injunction barring further publication of the offending issue. n41

In L.L. Bean, the district court was not sufficiently sensitive to First Amendment concerns. This court typified the common failure of courts to recognize First Amendment defenses to trademark claims. The district court opined that Bean's trademark was in the nature of a property right and need not "yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist." n42

In contrast, the appellate court was sensitive to First Amendment concerns. The appellate court held that the injunction preventing Drake Publishers from publishing the L.L. Bean parody violated First Amendment guarantees and struck down the lower court's injunction. n43 The appellate court also articulated that there are limits to a trademark owner's property right and stated that "trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view." n44

The appellate court reasoned that:

Famous trademarks offer a particularly powerful means of conjuring up the image of their owners, and thus become an important, perhaps at times indispensable, part of the public vocabulary. Rules restricting the use of well-known trademarks may therefore restrict the communication of ideas. . . . If the defendant's speech is particularly unflattering, it is also possible to argue that the trademark has been tarnished by the defendant's use. The constitutional implications of extending the misappropriation or tarnishment rationales to such cases, however, may often be intolerable. Since a trademark may frequently be the most effective means of focusing attention on the trademark owner or its product, the recognition of exclusive rights encompassing such use would permit the stifling of unwelcome discussion. n45

In striking the injunction, the appellate court stated "any residual effect on first amendment freedoms should be balanced against the need to fulfill the legitimate purpose of the antidilution statute." n46 Thus, anti-dilution statutes can be applied "to prevent a defendant from unauthorizedly merchandising his products with another's trademark." n47

Because the appellate court found the use in L.L. Bean to be solely expressive, such use fell beyond the legitimate purpose of the anti-dilution statute. n48 In its determination, the appellate court distinguished between the magazine as a commercial product and the article as an element of the commercial product. n49 The court supported its rationale noting that, among other things, the article was labeled as "humor" and "parody" and comprised only two pages of the one-hundred-page issue. n50

## V. The Internet: A Brief Technical Overview

Distinguishing between expressive and commercial use of a domain name is difficult because the distinction requires a technical, procedural, and historical understanding of the Internet, Internet protocol ("IP") and domain name services ("DNS"). Significant expositive authority about the Internet, IP and DNS exists. n51 While recognizing expositive treatises, this paper uses summary information. By citing summary information, this paper attempts to provide the necessary relevant background information without overwhelming the reader with complex technical jargon.

An IP address is a numeric identifier for a computer or device on a network. n52 Each identifier is written as four numbers separated by periods. n53 Each number can be zero to 255. n54 For example, the identifier 198.137.240.91 could be an IP address. n55 A portion of the IP address designates the computer, and another portion designates the network to which the computer is attached. n56

A domain name is a lexical identifier of one or more IP addresses. n57 Every domain name includes a suffix. n58 The suffix indicates which top level domain ("TLD") the domain belongs to. n59 There are only a limited number of TLDs now, but others have been proposed. n60

Existing TLDs include:

Gov Government agencies

Edu Educational institutions

Org Non-profit organizations

Mil Military

Com Commercial business

Net Network organizations

XX Code of the corresponding country n61

A Uniform Resource Locator ("URL") is also an address, but it is used to find documents on the World Wide Web ("WWW"). n62 "The first part of the URL address indicates what protocol to use, and the second part specifies either the IP address or the domain name where the resource [or document] is located [on the Web]." n63

Because domain names are used in URLs to identify a web site, (i.e., www.whitehouse.gov) and because both domain names and URLs are addresses, people often assume that websites and domain names are synonymous. However, websites and domain names are not synonymous. A domain name refers to one or more computers, n64 whereas a web site is a collection of one or more common web pages. n65 Another difference between a website and a domain name is that the domain name is translated through the DNS. Domain names also help facilitate non-Internet functions such as e-mail (i.e., the domain name "whitehouse.gov" used in the e-mail address "bill@whitehouse.gov").

DNS is the mechanism used to associate domain names with an IP address. n66 DNS is required because computers communicate with each other using IP addresses, not domain names. n67 DNS simplifies navigation on the Internet by freeing users from the need to remember seemingly arbitrary numbers. n68 DNS was designed "so that users would not have to remember strings of numbers but could use words instead." n69 For example, it is much simpler to remember "whitehouse.gov" than to remember the corresponding IP addresses of "198.137.240.91" and "198.137.240.92." Absent DNS, it is possible to connect to other computers on the Internet directly using the IP address.

The process of matching domain names to an IP address is known as DNS name resolution. n70 "When a user types a domain name such as 'usdcsdny.gov,' his computer must first match that domain name to its associated IP number . . . . The computer attempts to match the domain name to the IP number by sending out . . . an address query." n71 The query is answered "on various Internet-connected computers . . . known as domain name servers." n72 Each domain name server contains a table of information pertaining to known domain names. n73 The domain name server searches its files to see if it can match an IP number to the domain name. n74 Upon receiving an answer containing the associated IP number, the querying computer can establish the connection to the requested location. n75

## VI. Internet Governance

Because IP addresses are numerically limited by a combination of four numbers, and because there are only a limited number of TLDs, governance of the Internet is necessary. n76 Initially, the Internet Assigned Numbers Authority ("IANA"), under U.S. Government contract, was responsible for the global assignment of IP numbers and the registration of domain names. n77 Pursuant to the Federal Cooperative Agreement Act

n78 and the National Science Foundation Act of 1950, n79 as amended, the National Science Foundation ("NSF") solicited proposals to manage domain registration and associated registries. n80 Network Solutions, Inc. ("NSI") became the exclusive registrar for the .com, .org, .net, .edu, and .gov TLDs. n81 IANA remains an overseer of the domain name registration process. n82

In 1998, the authority to administer the agreement governing domain name registration was transferred from the NSF to the Department of Commerce ("DOC"). n83 The DOC subsequently extended and amended NSI's agreement to allow multiple registrars. n84 However, NSI retained responsibility of the registry itself. n85 Additionally, the DOC authorized the Internet Corporation of Assigned Names and Numbers ("ICANN") to take over IANA's responsibilities. n86

Presently ICANN oversees domain name registration and IP address distribution. n87 There are currently more than thirty accredited registrars of domain names, with many ICANN accreditations still pending. n88 IP address distribution is handled through ICANN's appropriate supporting Regional Internet Registry ("RIR"). n89 For example, ARIN is the RIR that administers IP addresses for North America, South America, the Caribbean, and the sub-Saharan Africa. n90

## VII. Putting It Together: Practical Application

Typically, a user wishing to have his or her own domain name, registers that domain name with an accredited registrar. The user must also select a DNS server that will contain the IP address for the user's domain. Unless the user manages his own DNS server, and has independent connections to the Internet, the user must use an Internet Service Provider ("ISP") that performs three functions. The ISP: (1) hosts the user's IP address and domain name on the ISP's own DNS Server; (2) obtains and assigns necessary IP address numbers from the appropriate RIR on behalf of the user; and (3) connects the user to the Internet via a high-speed or telephone modem connection. n91

To accurately assess trademark claims that arise from use on the Internet, it is important to draw correct analogies between Internet components and their real world cousins. One must consider the relationship that Internet components have to each other, as well as to their alleged counterparts. The courts have propounded a number of different, and sometimes confusing, analogies regarding IP addresses and domain names. n92 For example, a domain name is not like a phone number because a domain name can have many IP addresses associated with it, whereas a phone number is simply a phone number. n93 A web page differs from a phone number because a web page designates content. A web page address (also called a "URL") may be like a phone number, but one must use care to differentiate the web page address from the domain name (also called the IP address), or the analogy is confusing. A domain name is not analogous to a vanity phone number such as "1-800-flowers", since "1-800flowers" is a direct representation of the numeric number, whereas a domain name is an indirect conceptual representation.

Unlike the phone number 1-800-356-9377, which spells "1-800-flowers" and also spells "1-800-E-JOY-EXX", an IP address such as 198.137.240.91 can only specify a single domain or host. n94 An IP address is similar to an area code. A portion of the IP address refers to the network, which is similar to the area code referring to a calling area. n95

## VIII. Trademark Claims and First Amendment Defenses in an Internet Context

The controversy in *Bally Total Fitness Holding Corp. v. Faber*<sup>n96</sup> arose from the unauthorized derogatory use of Bally's trademark on a web site.<sup>n97</sup> In *Bally*, Faber maintained a website he called "Bally sucks".<sup>n98</sup> The "Bally sucks" web site was not itself a registered domain, but rather a page within the domain name "compupix.com".<sup>n99</sup>

In addition to the "Bally sucks" web site (URL address "www.compupix.com/ballysucks"), Faber's web sites within the compupix domain also included "'Images of Men,' a web site displaying

and selling photographs of nude males (URL address 'www.compupix.com/index.html'); a web site containing information regarding the gay community (URL address 'www.compupix.com/gay'); a web site containing photographs of flowers and landscapes (URL address 'www.compupix.com/fl/index.html'); and a web site advertising 'Drew Faber Web Site Services' (URL address 'www.compupix.com/biz.htm')." n100

In *Bally*, Bally asserted trademark infringement, trademark dilution, and unfair competition stemming from Faber's use of Bally's mark on Faber's website. n101 Faber basically usurped Bally's marks, except that Faber attached the word "sucks" to Bally's marks. n102

Bally's trademark infringement claim fell as a matter of law because the court found little relation between the goods offered on Faber's web site and the goods associated with Bally. n103 The court stated that "a service based on computer literacy and design skills . . . is far removed from the business of managing health clubs." n104 Absent related goods, no reasonable consumer would confuse Faber's site as one "affiliated with, connected with, or sponsored by" Bally. n105

In dicta, the court went on to apply the factors applicable to trademark infringement claims regarding similar goods. n106 These factors included: (1) strength of the mark; (2) similarity of the marks; (3) the competitive proximity of the goods; (4) evidence of actual confusion; (5) marketing channels used; (6) the degree of care likely to be exercised by the consumer; (7) the defendant's intent in selecting the mark; and (8) the likelihood of Plaintiff expanding its product line. n107

In applying the factors applicable to infringement, the court noted that "trademark rights may be limited by First Amendment concerns." n108 In analyzing possible First Amendment ramifications, the court differentiated Faber's use of Bally's trademark within Faber's website from commercial use in his Internet domain name. n109 The court added that "even if Faber did use the mark as part of a larger domain name, such as 'ballysucks.com', this would not necessarily be a violation as a matter of law." n110

The court extended its First Amendment analysis regarding Bally's dilution claim, and rejected Bally's assertion that "using another's mark on the Internet is per se commercial use." n111 The court stated that the dilution statute "will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of a commercial transaction." n112 The court also noted

that "Faber used Bally's marks in connection with a site devoted to a consumer product review of Bally's services." n113

Although largely dicta, the First Amendment analysis in Bally follows the First Amendment analysis in L.L. Bean by recognizing First Amendment limitations to trademark law. Bally also follows L.L. Bean in the court's dissection and segregation of aggregate use into its commercial and expressive components. The court in L.L. Bean implicitly segregated the non-commercial and expressive nature of a single article from the commercial aspects of the whole magazine. n114 Similarly, the court in Bally segregated the non-commercial website contained within a commercial Internet domain from a commercial website contained within a commercial Internet domain. n115

A different outcome from Bally presents itself in *Jews for Jesus v. Brodsky*. n116 In *Jews for Jesus*, the religious organization "Jews for Jesus" taught that "Jesus is the Messiah of Israel and the Savior of the World." n117 In contrast, Brodsky used the domain name "jewsforjesus.org" to sharply criticize the religious organization. n118 Brodsky's web site labeled the organization as a "cult . . . founded upon deceit and distortion of fact." n119

Coincidentally, Brodsky's site did not use the organization's "federally-registered stylized service mark Jews f Starr Jesus." n120 Instead, Brodsky's web site used the organization's common law service mark "Jews for Jesus". n121

"Jews for Jesus" asserted, among other claims, dilution of their federally registered mark and their common law service mark, and infringement of its federally registered mark. n122 "Jews for Jesus" also sought an injunction barring Brodsky's use of the domain name "jewsforjesus.org". n123

One could easily expect the organization's trademark claims to fail because both religion and expression have deeprooted Constitutional protections. One could conclude the First Amendment protects noncommercial criticism of a religion where the trademark holder is both the organized religion and the object of criticism. Presumptively, any trademark protection afforded to the registered mark in this context would be further diminished when applied to the generic use of the mark in its unstylized form. However, under *Jews for Jesus*, these precognitions would be wrong.

With regard to Brodsky's use of the registered mark in its unstylized form, the court stated "exact similarities are not required between the allegedly confusing marks." n124 The court opined that trademark rights "include the right to prevent the subsequent use by another person of the same or similar . . . mark, when the business or service for which the . . . mark is subsequently used, is likely to cause confusion as to the origin of the business or the services." n125

The court opined further that the plain term "Jews for Jesus" was not generic, but had acquired a secondary meaning attributed to the plaintiff's organization. n126 Thus, the mark "Jews for Jesus" was protectable both as a federally registered service mark, and under common law. n127

The court found probable trademark infringement under both *15 U.S.C. section 1114* and common law because Brodsky's domain name was nearly identical to the plaintiff's protected mark, and this was likely to create confusion in the minds of consumers. n128

The court also found probable trademark dilution under *15 U.S.C. section 1125(c)* since Brodsky's use of the mark was commercial. n129 While noting that the exception for the noncommercial use of a famous mark was intended to "prevent courts from enjoining constitutionally protected speech," n130 the court in *Jews for Jesus* extended the definition of commercial use to include a situation where the defendant was neither selling goods nor soliciting funds. n131

The court found commercial activity because Brodsky intercepted and targeted the plaintiff's audience. n132 The court further proffered that Brodsky's conduct constituted commercial activity since Brodsky's conduct was "designed to harm the Plaintiff Organization commercially by disparaging it." n133

In supporting its finding of commercial use, the court noted that Brodsky's site contained a hyperlink to a complimentary, yet independent, commercial site. n134 However, Brodsky's site was not affiliated with the complimentary commercial site. n135 Moreover, Brodsky's site publicly disclaimed affiliation with the commercial site. n136

Through its analysis, the court in *Jews for Jesus* precluded a First Amendment defense. With regard to infringement, any First Amendment issues were simply bypassed. With respect to dilution, the court stretched the meaning of commercial use to include simply the targeting of consumers. By equating the interception of an intended audience to commercial activity, the court negated the non-commercial exception to dilution. The court's analysis failed to distinguish between the marketplace of ideas and the commercial marketplace. Under the court's equation, false designation itself can comprise commercial activity, in sharp contrast to section 43(a) of the Lanham Act that requires commercial activity as an element of false designation. n137

Unfortunately, the court's analogy equating interception of an intended audience to commercial activity was strengthened in *Panavision Int'l v. Toeppen*. n138 Yet, *Panavision* differs from *Jews for Jesus* because the defendant in *Panavision* was in the business of, among other things, registering and selling domain names, n139 whereas the defendant in *Jews for Jesus* was engaged in dialogue. n140 Unlike *Jews for Jesus*, the commercial activity in *Panavision* was cybersquatting, n141 which is now explicitly covered by the ACPA. n142

#### IX. A Court Steps in the Right Direction

Although this line of cases could stand for the proposition that courts loathe to apply First Amendment limitations to trademark claims which arise from Internet and domain name contexts, perhaps courts do not wish to open the complex issues surrounding use that is both expressive and commercial. Such loathing may not be aimed solely at trademark law.

Although pertaining to antitrust issues, *PGMedia* suggests that domain names can implicate the First Amendment. n143 Ancillary to antitrust allegations, *PGMedia* asserted that NSI's refusal to recognize *PGMedia*'s proposed new TLD names was in violation of *PGMedia*'s First Amendment guarantees. n144 *PGMedia* proposed 530 new TLDs including ".forpresident", ".formayor" and ".microsoft.free.zone". n145 The district court held that the top level portion of an Internet domain name was not expressive speech, but was simply "a routing instruction that helps computers find each other." n146

The appellate court recognized that First Amendment implications were present and noted that domain names have a "mix of functionality and expression." n147 The appellate court inquired as to whether the mix was "sufficiently imbued with the elements of communication" to trigger First Amendment protection. n148 Such determination "depends on the domain name in question, the intentions of the registrant, the contents of the website, and the technical protocols that govern the DNS." n149

The court held that existing top level domains "do not constitute protected speech under the First Amendment, [however,] we do not preclude the possibility that certain domain names and new . . . [generic top level domain names] could indeed amount to protected speech." n150 Top level domains may someday be used for "'an expressive purpose such as commentary, parody, news reporting or criticism,' comprising communicative messages by the author and/or operator of the website in order to influence the public's decision to visit that website, or even to disseminate a particular point of view." n151 Although the court's recognition was in regard to future TLDs, such analysis could easily be applied to existing full domain names.

The circuit court's recognition that expressive commentary to influence the public's decision to visit a website or to disseminate a particular point of view constitutes protected speech runs contrary to the interception analysis used by the court in *Jews for Jesus*. The court in *PGMedia* properly recognized the possible First Amendment ramifications of domain name regulation and determined when such use is mixed. Unfortunately, the ACPA recognizes no such possibility.

#### X. Congress Takes Two Steps Backward

Under the ACPA, a person can be liable for registering or using a domain name that is identical or confusingly similar to a distinctive mark. n152 In the case of a famous mark, a person can also be liable for diluting the mark. n153 Under the ACPA, the plaintiff can recover punitive damages of \$ 1000 to \$ 100,000 per domain name. n154 In the case of willful conduct, treble damages and attorney's fees may be imposed. n155 Remarkably, liability is triggered by the mere registration of a domain name, regardless of whether the domain name is actually used. n156 In all cyberpiracy cases, a person must have acted with "bad faith". n157

The ACPA extended a trademark holder's traditional protections. Cyberpiracy is neither dilution nor infringement. In cyberpiracy cases, the trademark holder need not show a diminished quality of the mark. n158 The holder need not show consumer confusion in the origin of the goods or services either. n159 Cyberpiracy also is not akin to unfair competition.

Unfair competition focuses on the harm created by deception of consumers. n160 In cyberpiracy cases, the trademark holder need not show actual interception of consumers, harm to consumers, nor actual harm to the trademark holder. n161 Thus, cyberpiracy is a new right.

Unlike traditional trademark protection, cyberpiracy focuses on the bad faith conduct of the actor without regard to actual harm caused to the holder. n162 Similarly, the award of treble damages turns on the bad faith conduct of the actor without regard to actual harm caused to the trademark holder. n163 In the case where liability is imposed on the

mere registration of a domain name, and absent use of the domain name, cyberpiracy becomes a type of inchoate offense because any such actual harm or use is speculation.

The ACPA lists nine factors that aid in finding bad faith.<sup>n164</sup> These factors include, but are not limited to:

(I) the trademark or other intellectual property rights . . . in the domain name;

(II) the extent to which the domain name consists of the legal name of the person . . .

;

(III) the person's prior use, if any, of the domain name . . . ;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark

. . . by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name . . . ;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive . . . .<sup>n165</sup>

Congress, while considering the First Amendment ramifications of the anticyberpiracy provision, determined that these ramifications were adequately addressed.<sup>n166</sup> Congress also failed to explicitly exclude liability for domain registrants who register an otherwise offending domain name that has a legitimate expressive purpose, such as criticizing the trademark holder.<sup>n167</sup> An organization that registers "boycottcompanyX.com" or "companyX-kills-trees.com" could potentially be liable for cybersquatting. Additionally, if the organization's website solicits donations, the solicitation may be evidence of bad faith intent to profit from the mark.<sup>n168</sup>

Although the factor concerning noncommercial or fair use of a mark seems to contemplate non-commercial criticism of the holder, a domain name holder could be

liable because the domain name intercepts consumers. Following the logic that the court applied in *Jews for Jesus*, such interception could be deemed commercial use. n169 Thus, an organization that registers "boycottcompanyX.com" could remain liable for cyberpiracy absent a solicitation or transaction in commercial goods or services.

The factor concerning the lack of intellectual property rights in the domain name may not be a result of bad faith. The lack of intellectual property rights in a domain name could be as benign as in the case of a defendant who failed to begin operation prior to registering the domain name. Similarly, the failure of the domain name to include the registrant or entity's legal name may also be benign. Each failure is quite plausible in the case of a startup entity or developing business concept.

#### XI. ICANN Remains Insensitive

Fulfilling its role as, among other things, the overseer of domain name registrations, ICANN promulgated and adopted the UDRP. n170 The UDRP provides a "procedure for challenging 'cybersquatting,' or bad faith, abusive registrations of domain names." n171 Additionally, "all ICANN-approved registrars must agree to use the dispute resolution policy as part of their accreditation." n172

The UDRP covers domain names that are confusingly similar to existing trademarks, as well as domain names that are identical to existing trademarks. n173 However, the UDRP is limited to "instances of bad faith, abusive registrations, in which the [domain name] registrant has no legitimate rights to the character string used in the domain name." n174

The UDRP differs from the prior practice of NSI, who used to be the exclusive registrar of domain names. n175 NSI's policy covered only domain names that were identical to existing trademarks, and could be invoked in "cases of competing rights to a trademark." n176

Under the UDRP, dispute resolution must be performed by an ICANN-accredited dispute resolution service provider. n177 WIPO was the first such dispute resolution service provider to be accredited by ICANN. n178 Already, WIPO has decided many cases. n179 Other accredited dispute resolution service providers include the National Arbitration Forum and Dispute.org. n180

The UDRP anticipates "legitimate noncommercial or fair use" of a domain name "without intent . . . to tarnish the trademark or service mark at issue." n181 However, because the mere intent to tarnish without actual tarnishment is sufficient to establish liability under the UDRP, the UDRP could be used to deny protection to legitimate criticism sites. n182 For example, if a site is designed to attack a company's labor practices by noting its poor environmental record, that may be enough to show an intent to tarnish the company's mark. n183 Although the UDRP provides redress against domain name registrants for trademark violations, no such explicit protections exist for legitimate criticism of trademark holders. n184 Accordingly, the resolution of cases that implicate free speech under the UDRP has been inconsistent. n185 Thus, the policy is suspect.

#### XII. Conclusion

Courts have largely failed to apply First Amendment protections against trademark claims arising from the Internet. Recent developments by Congress and Internet governing organizations further protect trademark holders at the expense of the First Amendment. Such preclusions against purely ideological and quasi-commercial expression bode against the First Amendment and stifle communication on the developing Internet medium. After recognizing the First Amendment implications of trademark use within Internet domain names and on the Internet, courts must also correctly assess new technology and developing methods of expression.

#### FOOTNOTES:

n1 See Xuan-Thao N. Nguyen, *The New Wild West: Measuring and Proving Fame and Dilution Under the Federal Trademark Dilution Act*, 63 *Alb. L. Rev.* 201, 202-203 (1999). See also Jeffrey J. Look, *The Virtual Wild, Wild West (WWW): Intellectual Property Issues in Cyberspace-Trademarks, Service Marks, Copyrights, and Domain Names*, 22 *U. Ark. Little Rock* 49, 49 (1999).

n2 See generally Trademark (Lanham) Act of 1946, ch. 540, § § 1-50, 60 Stat. 427, 427-46 (codified as amended at 15 *U.S.C.* § § 1051-1127 (1994 & Supp. V 1999)).

n3 See generally Nguyen, *supra* note 1, at 201-39; Look, *supra* note 1, at 49-89.

n4 See 15 *U.S.C.* § 1114 (1994 & Supp. V 1999)

n5 See 15 *U.S.C.* § 1125(c) (Supp. V 1999).

n6 See 15 *U.S.C.* § 1125(a) (1994 & Supp. V 1999).

n7 See 15 *U.S.C.* § 1114(1)(a) (1994 & Supp. V 1999). There is a long line of trademark infringement cases that arose from the unauthorized use of a trademark in a domain name. See, e.g., *Washington Speakers Bureau, Inc. v. Leading Auth., Inc.*, 49 *F. Supp. 2d* 496, 498, 51 *U.S.P.Q.2d* (BNA) 1478, 1479 (*E.D. Va.* 1999)

(holding that the Internet domain names "www.washington-speakers.com", "www.washingtonspeakers.com", "www.washingtonspeakers.net", and "www.washingtonspeakers.net" infringed the mark "Washington Speakers Bureau"); *Hasbro, Inc. v. Clue Computing, Inc.*, 66 *F. Supp. 2d* 117, 119, 126, 52 *U.S.P.Q.2d* (BNA) 1402, 1403, 1409 (*D. Mass.* 1999) (using the domain name "clue.com" to sell computer products and services did not infringe Hasbro's mark for the game "Clue" because there was little likelihood of confusion between computer products and Hasbro toys).

n8 See *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 *F.2d* 254, 259, 2 *U.S.P.Q.2d* (BNA) 1677, 1682 (2d *Cir.* 1987) (holding that initial confusion works a sufficient trademark injury).

n9 See 15 *U.S.C.* § 1125(c)(1) (Supp. V 1999). There are many trademark dilution cases involving Internet domain names. See, e.g., *Toys "R" Us Inc. v. Akkaoui*, 40 *U.S.P.Q.2d* (BNA) 1836, 1838 (*N.D. Cal.* 1996) (diluting the mark "Toys 'R' Us" by selling sexual devices under the domain name "adultsrus.com"); *Panavision Int'l v. Toeppen*, 141 *F.3d* 1316, 1318, 46 *U.S.P.Q.2d* (BNA) 1511, 1513 (9th *Cir.* 1998)

(registering domain names for subsequent sale constitutes commercial activity sufficient to uphold a claim of dilution).

n10 *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30, 1 U.S.P.Q.2d (BNA) 1753, 1756 (1st Cir. 1987) (quoting Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 *Harv. L. Rev.* 813, 825 (1927)).

n11 See *L.L. Bean*, 811 F.2d at 31, 1 U.S.P.Q.2d at 1756-57.

n12 See *id.* at 30, 1 U.S.P.Q.2d at 1756.

n13 See *Two Pesos, Inc., v. Taco Cabana, Inc.*, 505 U.S. 763, 780, 23 U.S.P.Q.2d (BNA) 1081, 1088 (1992) (citing *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1201, 202 U.S.P.Q. (BNA) 643, 649 (9th Cir. 1979)).

n14 See 15 U.S.C. § 1125(a)(1)(A & B) (1994). There are many unfair competition cases involving Internet domain names. See, e.g., *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 308-09, 46 U.S.P.Q.2d (BNA) 1652, 1673 (D.N.J. 1998), *aff'd*, 159 F.3d 1351 (3d Cir. 1998) (stating that Plaintiff Organization brought an unfair competition claim against a defendant that maintained an Internet site under a domain name similar to the name of plaintiff's organization); *Planned Parenthood Fed'n of Am. Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1432-34 (S.D.N.Y. 1997) (stating that plaintiff brought an unfair competition claim against a defendant that maintained an Internet site under a domain name similar to the name of plaintiff's organization).

n15 See *Johnson & Johnson v. Smithkline Beecham Corp.*, 960 F.2d 294, 297, 22 U.S.P.Q.2d (BNA) 1362, 1365 (2d Cir. 1992).

n16 See generally Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, § § 3001-10, 113 Stat. 1501A-545, 1501A-545 to 1501A552 (1999) (codified as amended in scattered sections of 15 U.S.C. (1994 & Supp. V 1999)) [hereinafter ACPA].

n17 See *id.* at § 3002 (codified as amended at 15 U.S.C. § 1125(d) (Supp. V 1999)).

n18 See *id.* at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A) (Supp. V 1999)). See also *Sporty's Farm v. Sportsman's Market, Inc.*, 202 F.3d 489, 493, 53 U.S.P.Q.2d (BNA) 1570, 1572-73 (2nd Cir. 2000), *cert. denied*, 120 S.Ct. 2719 (2000).

n19 See ICANN: Uniform Domain Name Dispute Resolution Policy (last modified Jun. 4, 2000) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>.

n20 See *id.* See also ICANN: Uniform Domain-Name DisputeResolution Policy (last modified Jun. 17, 2000) <<http://www.icann.org/udrp/udrp.htm>>.

n21 See ICANN: Uniform Domain Name Dispute Resolution Policy (last modified Jun. 4, 2000) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>. Several disputes between trademark holders and domain name registrants have been decided using ICANN's UDRP. See, e.g., ICANN: Search Index of Proceedings Under the Uniform Domain-Name Dispute-Resolution Policy (visited Nov. 11, 2000) <<http://www.icann.org/cgi-bin/udrp/udrp.cgi>>.

n22 See generally 15 U.S.C. § § 1051-1127 (1994 & Supp. V 1999).

n23 See U.S. Const. amend. I.

n24 *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 780 (1976).

n25 *Id.*

n26 *Id.* (quoting *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 339-40 (1974)).

n27 See *id.* at 771-72.

n28 *Id.* at 762.

n29 *Id.* at 772 & n.24.

n30 See 15 U.S.C. § 1125(c)(4)(B) (Supp. V 1999) (noting that non-commercial use of a mark is not actionable under this section).

n31 See 15 U.S.C. § 1125(c)(4)(B & C) (Supp. V 1999).

n32 811 F.2d 26, 34, 1 U.S.P.Q.2d (BNA) 1753, 1759 (1st Cir. 1987).

n33 *Id.* at 32, 1 U.S.P.Q.2d at 1757.

n34 *Id.* at 27, 1 U.S.P.Q.2d at 1753.

n35 *Id.*

n36 See *id.*

n37 See *id.*

n38 See *id.*

n39 See *id.*

n40 See *id.*

n41 See *id.* at 27, U.S.P.Q.2d at 1753-54.

n42 *L.L. Bean, Inc. v. Drake Publisher, Inc.*, 625 F. Supp. 1531, 1537, 228 U.S.P.Q. (BNA) 733, 738 (quoting *Lloyd Corp., Ltd. v. Tanner*, 407 U.S. 551, 567 (1972)).

n43 See *L.L. Bean, Inc. v. Drake Publisher, Inc.*, 811 F.2d 26, 34, 1 U.S.P.Q.2d (BNA) 1753, 1759 (1st Cir. 1987).

n44 *Id.* at 29, 1 U.S.P.Q.2d at 1755.

n45 *Id.* at 30-31, 1 U.S.P.Q.2d at 1756 (quoting Robert C. Denicola, Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols, 1982 *Wis. L. Rev.* 158, 195-97 (1982)).

n46 See *id.* at 31, 1 U.S.P.Q.2d at 1757.

n47 *Id.* at 32, 1 U.S.P.Q.2d at 1758.

n48 *Id.* at 31, 1 U.S.P.Q.2d at 1757.

n49 *Id.* at 32, 1 U.S.P.Q.2d at 1757.

n50 *Id.*

n51 See generally Paul Albitz & Cricket Liu, DNS and BIND (Mike Loukides ed., 3d ed. 1998) (providing a brief history of the Internet, detailed information on DNS, DNS

configuration, and DNS management); Craig Hunt, TCP/IP Network Administration (Mike Loukides & Gigi Estabrook eds., 2d ed. 1998) (providing details on TCP/IP protocol, server configuration and network management); Preston Gralla, How the Internet Works (Greg Wiegand ed., 1st ed. 1999) (providing illustrative information on the working of the Internet).

n52 See Webopedia Definition and Links, IP Address (last modified Dec. 22, 1997) <<http://webopedia.internet.com/TERM/I/IPaddress.html>>.

n53 See id.

n54 See id.

n55 See id.

n56 See id.

n57 See Webopedia Definition and Links, Domain Name (last modified Apr. 3, 2000) <<http://webopedia.internet.com/TERM/d/domainname.html>>.

n58 See id.

n59 See id.

n60 See id.

n61 See id.

n62 See Webopedia Definition and Links, URL (last modified Jun. 24, 1998) <<http://webopedia.internet.com/TERM/U/URL.html>>.

n63 Id.

n64 See Webopedia Definition and Links, Domain Name (last modified Apr. 3, 2000) <<http://webopedia.internet.com/TERM/d/domainname.html>>.

n65 See Webopedia Definition and Links, Web site (last modified Jun. 16, 1997) <<http://webopedia.internet.com/TERM/w/website.html>>.

n66 See Cricket Liu et al., Managing Internet Information Services 13 (Adrian Nye ed., 1st ed. 1994).

n67 See Ed Krol, The Whole Internet: User's Guide & Catalog 24-27 (Mike Loukides ed., 2d ed. 1994).

n68 See Liu, *supra* note 66, at 13.

n69 *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 391 (S.D.N.Y. 1999).

n70 See id.

n71 Id.

n72 Id.

n73 See id.

n74 See id.

n75 See *id.*

n76 The limitation to the number of TLD's is less a technical limitation and more a function of convenient name management.

n77 See *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 391 (S.D.N.Y. 1999).

n78 See generally 31 U.S.C. § 6305 (1994 & Supp. IV 1998).

n79 See generally 42 U.S.C. § § 1861-87 (1994 & Supp. IV 1998).

n80 See *PGMedia*, 51 F. Supp. 2d at 393.

n81 See *id.*

n82 See *id.* at 393-94.

n83 See *id.* at 399.

n84 See *id.*

n85 See *id.*

n86 See Memorandum of Understanding Between the U.S. Dep't of Commerce and Internet Corp. for Assigned Domain Names (visited Apr. 4, 2001) <<http://www.ntia.doc.gov/ntiahome/domainname/icannmemorandum.htm>>. Because ICANN was created largely by administrative agreement, an issue remains as to the extent of ICANN's mandate in its exercise of control over the Internet and the validity of such exercise outside its initial mandate.

n87 See Articles of Incorporation (As Revised) (last modified Nov. 23, 1998) <<http://www.icann.org/articlespr23nov98.html>>.

n88 See ICANN: List of Accredited and Accreditation Qualified Registrars (last modified Sep. 25, 2000) <<http://www.icann.org/registrars/accredited-list.html>>.

n89 See The Address Supporting Organization, RIR Links (last modified Aug. 21, 2000) <<http://www.aso.icann.org/rirs/>>.

n90 See ARIN, About ARIN (visited Oct. 15, 2000) <<http://www.arin.net/arinintro.htm>>.

n91 See Albitz & Liu, *supra* note 51, at 9, 49 and 53. See also Liu, *supra* note 66, at 2.

n92 See, e.g., *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 392 & n.7 (S.D.N.Y. 1999) (comparing the network portion of an IP address to zip codes and area codes); *Watts v. Network Solutions, Inc.*, No. IP 98-1529C H/G, 1999 U.S. Dist. LEXIS 20605, at \*3 (S.D. Ind. May 7, 1999) (comparing domain names to phone numbers); *Reno v. American Civil Liberties Union*, 521 U.S. 844, 852 (1997) (comparing web pages to phone numbers).

n93 For example, the domain name "whitehouse.gov" can be associated with several different IP addresses such as "198.137.240.91" and "198.137.240.92", but, the phone number "1-800-356-9377", even though it spells both "1800-FLOWERS" and "1-800-E-JOY-EXX", is still the same underlying phone number.

n94 See W. Richard Stevens, *Unix Network Programming* 202 (Brendan M. Stewart ed., 1st ed. 1990).

n95 See *PGMedia*, 51 F. Supp. 2d at 408.

n96 29 F. Supp. 2d 1161, 50 U.S.P.Q.2d (BNA) 1840 (C.D. Cal. 1998).

n97 *Id.* at 1162, 50 U.S.P.Q.2d at 1841.

n98 *Id.*

n99 *Id.*

n100 *Id.*

n101 See *id.*

n102 See *id.* at 1164, 50 U.S.P.Q.2d at 1843.

n103 See *id.* at 1163-64, 50 U.S.P.Q.2d at 1842.

n104 *Id.* at 1163, 50 U.S.P.Q.2d at 1842.

n105 *Id.* at 1163-64, 50 U.S.P.Q.2d at 1842.

n106 See *id.* at 1163-66, 50 U.S.P.Q.2d at 1842-44.

n107 See *id.* at 1164-66, 50 U.S.P.Q.2d at 1842-44.

n108 *Id.* at 1166, 50 U.S.P.Q.2d at 1844.

n109 See *id.* at 1165, 50 U.S.P.Q.2d at 1843.

n110 *Id.* at 1165, 50 U.S.P.Q.2d at 1843-44.

n111 *Id.* at 1166, 50 U.S.P.Q.2d at 1845.

n112 *Id.* at 1166-67, 50 U.S.P.Q.2d at 1845 (quoting 141 Cong. Rec. S19,306-10 (daily ed. Dec. 29, 1995) (statement of Sen. Hatch)).

n113 *Id.* at 1166, 50 U.S.P.Q.2d at 1845.

n114 See *L.L. Bean, Inc. v. Drake Publisher, Inc.*, 811 F.2d 26, 32, 1 U.S.P.Q.2d (BNA) 1753, 1757 (1st Cir. 1987) (noting that the article comprised only two pages of a one hundred-page issue).

n115 See *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1164, 50 U.S.P.Q.2d (BNA) 1840, 1843 (C.D. Cal. 1998).

n116 993 F. Supp. 282, 311-12, 46 U.S.P.Q.2d (BNA) 1652, 1676 (D.N.J. 1998), *aff'd*, 159 F.3d 1351 (3d Cir. 1998).

n117 *Id.* at 288, 46 U.S.P.Q.2d at 1656.

n118 See *id.* at 291, 46 U.S.P.Q.2d at 1658.

n119 *Id.* at 291 & n.15, 46 U.S.P.Q.2d at 1658 & n.15.

n120 *Id.* at 290, 46 U.S.P.Q.2d at 1657-58.

n121 See *id.* at 290, 46 U.S.P.Q.2d at 1657.

n122 See *id.* at 287, 46 U.S.P.Q.2d at 1655.

n123 See *id.*

n124 *Id.* at 296, 46 U.S.P.Q.2d at 1662.

n125 *Id.* at 296, 46 U.S.P.Q.2d at 1663 (quoting *Caesars World, Inc. v. Caesar's Palace*, 490 F. Supp. 818, 823, 209 U.S.P.Q. (BNA) 492, 497 (D.N.J. 1980)).

n126 See *id.* at 298, 46 U.S.P.Q.2d at 1664.

n127 See *id.* at 299, 46 U.S.P.Q.2d at 1665.

n128 See *id.* at 305, 46 U.S.P.Q.2d at 1670.

n129 See *id.* at 308, 46 U.S.P.Q.2d at 1673.

n130 *Id.* at 307-308, 46 U.S.P.Q.2d at 1672.

n131 See *id.* at 308, 46 U.S.P.Q.2d at 1672-73.

n132 See *id.*

n133 See *id.*

n134 See *id.* at 308, 46 U.S.P.Q.2d at 1673.

n135 See *id.*

n136 See *id.*

n137 See Trademark (Lanham) Act of 1946, ch. 540, § 43(a), 60 Stat. 427, 441 (codified as amended at 15 U.S.C. § 1125(a) (1994 & Supp. V 1999)).

n138 945 F. Supp. 1296, 40 U.S.P.Q.2d (BNA) 1908 (C.D. Cal. 1996) (holding that frustrating the ability of customers to find the trademark holder's web page diluted the plaintiff's mark).

n139 See *id.* at 1300, 40 U.S.P.Q.2d at 1911.

n140 993 F. Supp. 282, 308, 46 U.S.P.Q.2d (BNA) 1652, 1672-73 (D.N.J. 1998).

n141 *Panavision*, 945 F. Supp. at 1300, 40 U.S.P.Q.2d at 1911.

n142 See ACPA, *supra* note 16.

n143 *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 407 (S.D.N.Y. 1999).

n144 See *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 579-80 (2d Cir. 2000).

n145 See *id.* at 578.

n146 *PGMedia*, 51 F. Supp. 2d at 408.

n147 *Name.Space*, 202 F.3d at 585.

n148 *Id.*

n149 *Id.*

n150 *Id. at 586.*

n151 *Id.*

n152 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A)(ii)(I) (Supp. V. 1999)).

n153 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A)(ii)(II) (Supp. V 1999)).

n154 See ACPA, *supra* note 16, at § 3003 (codified as amended at 15 U.S.C. § 1117(d) (Supp. V 1999)).

n155 See ACPA, *supra* note 16, at § 3003 (codified as amended at 15 U.S.C. § 1117(a) (Supp. V 1999)).

n156 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A)(ii) (Supp. V 1999)).

n157 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A)(i) (Supp. V 1999)).

n158 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(A) (Supp. V 1999)).

n159 See *id.*

n160 See generally 15 U.S.C. § 1125 (1994 & Supp. V 1999).

n161 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d) (Supp. V 1999)).

n162 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d) (Supp. V 1999)).

n163 See *id.*

n164 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(B)(i) (Supp. V 1999)).

n165 *Id.*

n166 See Statement of Senator Orrin G. Hatch before the Committee on the Judiciary (July 29, 1999) <<http://www.senate.gov/hatch/state101.html>> (stating that the S. 1255 bill "does not affect traditional trademark defenses, such as fair use, or a person's first amendment rights").

n167 See ACPA, *supra* note 16, at § 3002 (codified as amended at 15 U.S.C. § 1125(d) (Supp. V 1999)).

n168 See *id.* at § 3002 (codified as amended at 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (Supp. V 1999)).

n169

993 F. Supp. 282, 46 U.S.P.Q.2d (BNA) 1652 (D.N.J. 1998).

n170 See ICANN: Uniform Domain Name Dispute Resolution Policy (last modified Jun. 4, 2000) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>.

n171 Trademarks-Internet Domains: ICANN Accredits WIPO to Provide Cybersquatting Dispute Resolution Services, 68 U.S. L. WK. 2333, 2333 (1999).

n172 Id.

n173 Id.

n174 Id.

n175 See id.

n176 Id.

n177 See ICANN: Uniform Domain Name Dispute Resolution Policy (last modified Jun. 4, 2000) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>.

n178 See ICANN: Approved Providers for Uniform Domain Name Dispute Resolution Policy (last modified May 21, 2000) <<http://icann.org/udrp/approved-providers.htm>>.

n179 See WIPO Arbitration and Mediation Center, Domain Name Dispute Resolution Service (visited Sept. 25, 2000) <<http://arbiter.wipo.int/domains/index.html>>.

n180 See ICANN: Approved Providers for Uniform Domain Name Dispute Resolution Policy (last modified May 21, 2000) <<http://icann.org/udrp/approved-providers.htm>>.

n181 See ICANN: Uniform Domain Name Dispute Resolution Policy, 4(c)(iii) (visited Apr. 9, 2001) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>.

n182 See A Catalog of Critical Process Failures; Progress on Substance; More Work Needed (visited Apr. 9, 2001) <<http://www.icann.org/comments-mail/commentudrp/current/msg00107.html>>.

n183 See id.

n184 See ICANN: Uniform Domain Name Dispute Resolution Policy, 4(c)(iii) (visited Apr. 9, 2001) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>.

n185 See, e.g., WIPO Arb. & Mediation Center, Admin. Panel Dec., Case No. D2000-1072, *New York Times Co. v. New York Internet Serv.*, <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1072.html>> (finding a commercial use in the domain name "newyorktimes.com" where such use was primarily for listing commentary regarding the New York Times because the site also contained a banner ad for the domain registrant's internet service provider); WIPO Arb. & Mediation Center, Admin. Panel Dec., Case No. D2000-0869, *Estee Lauder Inc. v. estelauder.com*, <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0869.html>> (finding the defendant's interest in the domains associated with "complaint sites" regarding Estee Lauder did not rise to a legitimate interest where the domain names were confusingly similar to the plaintiff's mark).

But see, WIPO Arb. & Mediation Center, Admin. Panel Dec., Case No.

D2000-0190, Bridgestone Firestone, Inc. v. Jack Myers, <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0190.html>> (finding "legitimate fair use and free speech rights" in the domain name "Bridgestone-Firestone.net" because the site was not engaged in commercial activity); WIPO Arb. & Mediation Center, Admin. Panel Dec., Case No. D2000-1015, Lockheed Martin Corp. v. Dan Parisi, <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1015.html>> (refusing to order the transfer of lockheedmartinsucks.com and lockheedsucks.com because the domain names were not confusingly similar to the plaintiff's trademark and the disputed names were used in the exercise of free speech).