

Consumer Gripe Sites, Intellectual Property Law, and the Use of Cease-And-Desist Letters to Chill Protected Speech on the Internet

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But every difference of opinion is not a difference of principle. . . . If there be any among us who [disagree] let them stand undisturbed as monuments of the safety with which error of opinion may be tolerated and where reason is left free to combat it.

—Thomas Jefferson, *First Inaugural Address*, March 4th 1801

INTRODUCTION

In a world of giant multi-national corporations, there is little a single customer can do to make his concerns known to the corporate giant.¹ Oftentimes, consumers write letters to companies in an attempt to communicate their dissatisfaction with goods and services.² However, it is often difficult to locate the proper official

¹ Kurt Kleiner, *A Refund Shall Set You Free!*, *TORONTO STAR*, Aug. 27, 2006, available at <http://jcr.wisc.edu/publicity/press-releases/ward-ostrom-torontostar.doc>.

² *Id.*

at a company to whom a complaint should be sent.³ Furthermore, it is unlikely that a large corporate entity will actually change its behavior in response to a single individual's complaint. Therefore, consumers are increasingly using Internet web pages to voice their complaints about unsatisfactory and unfair corporate conduct.⁴

For example, Brian Zaltsberg launched the KBhomessucks.com website in January of 2003 after he purchased a house from the building company.⁵ The day after he moved into his home, a rainstorm caused water to pour into his garage.⁶ He contacted KB Homes and the company sent out roofers to fix the problem.⁷ The next day brought more rain and consequently water flooded the garage for a second time.⁸ Zaltsberg's frustration peaked when KB Homes refused to replace the sheetrock damaged by the repeated flooding.⁹ In an effort to vent his frustration and share his experience with others, he set up a website to host his complaints.¹⁰ The website, no longer available, hosted all sorts of complaints over the construction of KB Homes.¹¹

This website and others like it are commonly referred to as "gripe sites." "A 'gripe site' is a web site established to criticize an institution such as a corporation."¹² Hundreds of gripe sites have been established in recent years.¹³ In fact, these complaint websites have become the weapon of choice for frustrated

³ Jonathan L. Schwartz, *Making the Consumer Watchdog's Bark as Strong as its Gripe: Complaint Sites and the Changing Dynamic of the Fair Use Defense*, 16 ALB. L.J. SCI. & TECH. 59, 68 (2006) [hereinafter Schwartz, *Consumer Watchdog's Bark*].

⁴ See Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 3, 1 (2005).

⁵ See Charles Wolrich, *The Best Corporate Complaint Sites*, Forbes.com, Aug. 21, 2002, http://www.forbes.com/2002/08/21/0821hatesites_print.html.

⁶ *Id.*

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.*

¹¹ *Id.*

¹² Public Citizen, *Public Citizen "Gripe Site" Representation*, Citizen.org, http://www.citizen.org/print_article.cfm?ID=5799 (last visited Mar. 12, 2007).

¹³ Kleiner, *supra* note 1.

customers and political activists.¹⁴ The nature and prevalence of Internet usage provides a forum that makes it easy for a disgruntled consumer to record and disseminate complaints about corporations in a more efficient manner and to a wider audience.¹⁵ Gripe sites are cheap, effective, accessible by a worldwide audience, and provide an element of anonymity to the site operator, making them an attractive medium for disgruntled consumers to wage war on their target company.

Part I of this Note will discuss the proliferation of consumer gripe sites on the Internet. Specifically, this Note will recognize three types of gripe sites: (1) political commentary and parody sites; (2) sucks.com sites; and (3) trademark.com websites. Part II of this Note will discuss the development of intellectual property jurisprudence in response to lawsuits initiated against gripe site operators on the grounds of trademark infringement, trademark dilution and cybersquatting. Part II of this Note will look at the way the different claims apply to the three types of gripe sites. The Note will seek to determine the limits placed on the Lanham Act by the First Amendment. Part III of this Note analyzes the effect of cease-and-desist letters as an effective tool used by corporations to chill the critical speech of gripe sites operators. Finally, Part IV of this Note attempts to reconcile the law with the reality that cease-and-desist letters remain a powerful tool for corporations despite the expansion of First Amendment protections for speech. Cease-and-desist letters are only effective because the Internet complaint site operators are typically unaware that their actions may be protected under First Amendment law.¹⁶ Therefore, development in the law is largely irrelevant if corporations still have the power to silence the speech of the average gripe site

¹⁴ *Strategies for Blocking Internet "Gripe" Sites and Internet Complaint Sites*, HostingDude.com, http://www.hostingdude.com/internet_complaint_sites/stop_internet_complaint_sites.htm (last visited Mar. 16, 2007) [hereinafter *Strategies*].

¹⁵ Ryan Bigge, *Wearing the Digital Dunce Cap*, MACLEANS.CA, Sept. 27, 2006 http://www.macleans.ca/culture/culture/article.jsp?content=20061002_133913_133913.

¹⁶ See Tricia Beckles & Marjorie Heins, *Commentary: A Preliminary Report on the Chilling Effects of "Cease-and-Desist" Letters*, The Free Expression Policy Project, Oct. 5, 2004, <http://www.fepproject.org/commentaries/ceaseanddesist.html>. See also Sonia Katyal, et. al, *Panel III: Fair Use: Its Application, Limitations and Future*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1017, 1024–31 (2007) (Quilter comments).

operator. Part V of this Note discusses methods to empower gripe site operators to resist threats by the target companies.

I. CONSUMER GRIPE SITES AND THE INTERNET

A. Gripe Sites Generally

In 1998, Scott Harrison noticed a faulty charge on his Chase Manhattan credit card.¹⁷ Despite his request, Chase Manhattan Bank failed to promptly refund the charge.¹⁸ Mr. Harrison was so dissatisfied with the service he received that he established a website at the domain name “chasebanksucks.com.”¹⁹ The site was dedicated to “all those who hate Chase Manhattan Bank”²⁰ The site contained an animated man who walks across the Web page and repeatedly urinates on the Chase logo, and a message board so individuals could “inform others why they should not bank with Chase.”²¹

This site is typical of the various gripe sites found on the Internet. Typically, gripe sites arise from disagreements over only a few hundred dollars worth of goods or services.²² Nevertheless, for some complainers, these Internet gripe sites become the forum for complaints against large companies that continue for years, despite time, expense, threats from companies, and actual lawsuits.²³ John Osborn, operator of the gripe site “U-Hell” states on her site that “this is not about money,” but that “[i]t’s about right and wrong.”²⁴

¹⁷ Robert Trigaux, *Gripe.com*, ST. PETERSBURG TIMES, Jan. 31, 1999, at 1H.

¹⁸ *Id.*

¹⁹ *Id.* Accessing the chasebanksucks.com website now redirects you to www.mercyglobal.com, a website operated by Scott Harrison as a fundraising platform for the humanitarian organization Mercy Ships.

²⁰ *Id.*

²¹ *Id.*

²² *Id.* See Kleiner, *supra* note 1. Sometimes gripe site operators are motivated by reasons other than inferior quality or substandard service. The site “homedepotsucks.com” targets Home Depot for selling lumber cut from old-growth trees.

²³ *Id.*

²⁴ Trigaux, *supra* note 17.

These consumers are motivated because “they feel personally insulted, even humiliated, by their dealings with the offending company”²⁵ They want to get justice, and possibly even revenge.²⁶ Sometimes, these consumer gripe sites morph into “full-fledged public crusades.”²⁷ The most dedicated complainers and successful gripe sites use the “fiery language”²⁸ of civic protest movements and hold themselves out as advocates for social justice.²⁹ “[T]he complainers paint[] themselves as the victim of a grave injustice”³⁰ at the hand of a faceless corporation. They “champion [the interests of] the little guy against a more powerful opponent.”³¹ “They also dramatize[] and even exaggerate[] the harm they had suffered, and stereotype[] their corporate enemies, painting them as not only rude or uncaring, but also as evil.”³²

The Internet has significantly reduced many of the obstacles to collective consumer action.³³ Because the Internet has low barriers to entry, gripe sites are proliferating at a dramatic rate.³⁴ By 1999, more than half of the Fortune 1000 companies have come across a website carping on their business.³⁵ Between 1997 and 1999, the famous gripe site “walmartsucks.com” received 177,000 hits and grew to 2,000 web pages.³⁶ Gripe site “www.myvwlemon.com” has 2,000 members and about 15,000 messages on its message board complaining about Volkswagen automobiles.³⁷ There are so many gripe sites on the Internet today that Yahoo! created a separate directory for these sites.³⁸

Older gripe sites were simple and included little more than a written tirade of the operator’s experiences. Over time, gripe sites

²⁵ Kleiner, *supra* note 1.

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*

³¹ *Id.*

³² *Id.*

³³ See Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 69.

³⁴ See *id.* at 66.

³⁵ Trigaux, *supra* note 17.

³⁶ *Id.*

³⁷ James McNair, *Company Backlash Strikes Gripe Sites*, USA TODAY, Feb. 7, 2005.

³⁸ *Strategies*, *supra* note 14.

grew in sophistication, incorporating audio and video aspects to make the sites more attractive and to better allow them to hold a user's attention.³⁹ For example, the website "microsoft-sucks.com" hosted color photos of company founder Bill Gates being hit by a cream pie.⁴⁰

Companies targeted by gripe sites include credit card companies and banks,⁴¹ telephone companies,⁴² retail stores,⁴³

³⁹ See Trigaux, *supra* note 17.

⁴⁰ *Id.*

⁴¹ See, e.g., The Unofficial American Express Consumer Opinion Web Page, <http://www.amexsux.com/> (targeting American Express) (last visited Mar. 13, 2007); Capital One Sucks!, <http://www.cap1sucks.com/> (targeting Capital One) (last visited Mar. 13, 2007); Compass Bank Sucks!, <http://compass-bank-sucks.com/> (targeting Compass Bank) (last visited Mar. 13, 2007).

⁴² See, e.g., Face AT&T, <http://faceatt.netfirms.com/> (targeting AT&T) (last visited Mar. 13, 2007); Sprint/Nexel Corporation Sucks Website, <http://www.sprintstill.sucks.com/> (targeting Sprint) (last visited Mar. 13, 2007); Welcome to Verizonpathetic.com, <http://www.verizonpathetic.com/> (targeting Verizon) (last visited Mar. 13, 2007).

⁴³ See, e.g., Best Buy Sucks, <http://www.bestbuysux.org/> (targeting Best Buy) (last visited Mar. 13, 2007); Best Buy Receipt Check, <http://www.die.net/musings/bestbuy/> (targeting Best Buy) (last visited Mar. 13, 2007); Save the Redwoods/Boycott the Gap, <http://www.gapsucks.org/> (targeting Gap) (last visited Mar. 13, 2007); Home Depot Sucks, <http://www.homedepotsucks.com/> (targeting Home Depot) (last visited Mar. 13, 2007); You have been Kmarted, <http://kmarted.freesevers.com/> (targeting Kmart) (last visited Mar. 13, 2007); Hel Mart, <http://www.hel-mart.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Welcome to the WALOCAUST, <http://www.walocaust.com/site/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Against the Wal, <http://www.againstthewal.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Sprawl-Busters, <http://www.sprawl-busters.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Wal-mart Blows, <http://www.walmart-blows.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Wal-Mart Watch, <http://walmartwatch.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Wal-Mart Workers Rights, <http://www.walmartworkersrights.org/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Wake Up Wal-Mart, <http://www.wakeupwalmart.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Tell Wal-Mart Enough is Enough, <http://action.americanrightsatwork.org/campaign/walmart2005> (targeting Wal-Mart) (last visited Mar. 13, 2007); Wal-Town, <http://www.wal-town.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); Westbrook Our Home, <http://westbrookourhome.com/> (targeting Wal-Mart) (last visited Mar. 13, 2007); WAM, http://wam_mag.homestead.com/wam.html (targeting Wal-Mart) (last visited Mar. 13, 2007); The Wal-Mart Trash Page, <http://kimsey.stonepics.com/walmart.htm> (targeting Wal-Mart) (last visited Mar. 13, 2007).

product manufacturers,⁴⁴ fast food restaurants,⁴⁵ airlines,⁴⁶ auto manufacturers,⁴⁷ oil companies,⁴⁸ insurance companies,⁴⁹ Internet based companies,⁵⁰ and of course the software giant Microsoft.⁵¹

⁴⁴ See, e.g., Coalition against BAYER, <http://www.cbgnetwork.org/> (targeting Bayer) (last visited Mar. 13, 2007); IAMS Kills!, <http://www.iamskills.com/index.shtml> (targeting Iams) (last visited Mar. 13, 2007); Boycott Nike Home Page, <http://www.saigon.com/~nike/> (targeting Nike) (last visited Mar. 13, 2007).

⁴⁵ See, e.g., Murder King, <http://www.murderking.com/> (targeting Burger King) (last visited Mar. 13, 2007); McSpotlight, <http://www.mcspotlight.org/> (targeting McDonald's) (last visited Mar. 13, 2007); News for McDonald's Franchisees and Franchise owners, <http://www.licenseenews.com/> (targeting McDonald's) (last visited Mar. 13, 2007).

⁴⁶ See, e.g., Boycott Delta, <http://boycottdelta.org/> (targeting Delta) (last visited Mar. 13, 2007); Problems with United Airlines, <http://www.untied.com/> (targeting United Airlines) (last visited Mar. 13, 2007); United Airlines, <http://dir.salon.com/story/business/feature/2000/07/28/united/index.html> (targeting United Airlines) (last visited Mar. 13, 2007).

⁴⁷ See, e.g., The Official Voice of Dissatisfied Ford's Customers, <http://www.fordlemon.com/menu4.html> (targeting Ford Motor Company) (last visited Mar. 13, 2007); Ford Really Sucks, <http://www.fordreallysucks.com/> (targeting Ford Motor Company) (last visited Mar. 13, 2007); Dead Ford Owner's Page, <http://modena.intergate.ca/personal/djk/> (targeting Ford Motor Company) (last visited Mar. 13, 2007); My Ford Aspire Saga, <http://www.angelfire.com/nj/fordaspire/> (targeting Ford Motor Company) (last visited Mar. 13, 2007); Ford Taurus 1993, http://www.geocities.com/assilem_bell/ (targeting Ford Motor Company) (last visited Mar. 13, 2007); Buyer Beware!, <http://home.nycap.rr.com/tritonlemon/> (targeting Ford Motor Company) (last visited Mar. 13, 2007); GM Lemon Complaints Repairs Gripes Fixes and Lawsuits, <http://www.gmlemoncars.com/> (targeting General Motors) (last visited Mar. 13, 2007); General Motors GM Alero Defects and Complaint Website, <http://www.dillows.com/alero.htm> (targeting General Motors) (last visited Mar. 13, 2007); Mercedes Benz Problem Vehicles, <http://www.mercedes-benz-usa.com/> (targeting Mercedes Benz) (last visited Mar. 13, 2007); My VW Jetta GLS VR6 Sucks!, <http://www.myvwlemon.com/> (targeting Volkswagen) (last visited Mar. 13, 2007).

⁴⁸ See, e.g., Stop ExxonMobil, <http://www.stopexxonmobil.org/> (targeting Exxon Mobil) (last visited Mar. 13, 2007); Boycott Shell, <http://www.essentialaction.org/shell/> (targeting Shell) (last visited Mar. 13, 2007).

⁴⁹ See, e.g., Farmers Insurance Group Sucks!, <http://www.farmersinsurancegroup.sucks.com/> (targeting Farmers Insurance Group) (last visited Mar. 13, 2007); Farmer's Really Sucks, http://farmersreallysucks.com/cgi-bin/QAD_CMS.pl (targeting Farmers Insurance Group) (last visited Mar. 13, 2007).

⁵⁰ See, e.g., Google Watch, <http://www.google-watch.org/> (targeting Google) (last visited Mar. 13, 2007); Unofficial Google Trends Blog, <http://blog.outer-court.com/> (targeting Google) (last visited Mar. 13, 2007); Creepy Gmail, <http://www.gmail-is-too-creepy.com/> (targeting Google) (last visited Mar. 13, 2007); Fucked Google, <http://www.fuckedgoogle.com/> (targeting Google) (last visited Mar. 13, 2007); Gmail Users, <http://www.gmailusers.com/> (targeting Google) (last visited Mar. 13, 2007);

The effect of consumer gripe sites on a company's business is particularly devastating to smaller companies and companies that receive a significant portion of their customers online.⁵²

Although companies are primarily concerned that gripe sites will dissuade potential customers from using their services or purchasing their products, loss of potential customers is not the only concern for targets of Internet gripe sites. Companies also seek to protect their names and trademarks on the Internet from these cyber grippers.⁵³ Most gripe sites incorporate the company's name into the domain name of the site, and many incorporate the company's name or logo into the content of the site.⁵⁴ Sometimes, a gripe site operator may pervert a company's logo and doctor it to convey a message reflecting negatively on the corporation.⁵⁵ For example, a gripe site targeting Starbucks⁵⁶ altered the company's logo so that the language in the logo said "Starbucks Sucks" as opposed to "Starbucks Coffee."⁵⁷ More often, the complaint site displays the company's trademark logo with the word "Sucks" or some other derogatory word displayed across the logo.⁵⁸

Welcome to NoPayPal!, <http://paypalsucks.com/> (targeting PayPal) (last visited Mar. 13, 2007).

⁵¹ See, e.g., Microsuck, <http://www.microsuck.com/> (last visited Mar. 13, 2007); Reasons to Avoid Microsoft, <http://www.lugod.org/microsoft/> (last visited Mar. 13, 2007); Just Say NO to Microsoft, <http://microsoft.toddverbeek.com> (last visited Mar. 13, 2007); Don't be Soft on Microsoft!, <http://www.netaction.org/msoft/> (last visited Mar. 13, 2007); Downsize Microsoft, <http://www.namebase.org/boycott.html> (last visited Mar. 13, 2007); The Gneechee's Micro\$oft Boycott Page, <http://members.aol.com/thegneechee/msb.htm> (last visited Mar. 13, 2007); Microsuck, <http://www.fuckmicrosoft.com/> (last visited Mar. 13, 2007); Microsucks Home Page, <http://www.notagoth.com/microsucks/> (last visited Mar. 13, 2007); Youth Against Microsoft, <http://www.angelfire.com/al/YAMS/index2.html> (last visited Mar. 13, 2007); Microslave, <http://www.geocities.com/Athens/Forum/1796/> (last visited Mar. 13, 2007). See also Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 68.

⁵² See *Strategies*, *supra* note 14.

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ See Starbucks Sucks, <http://www.geocities.com/Area51/Station/9248/sucks/> (last visited Mar. 13, 2007).

⁵⁷ *Strategies*, *supra* note 14.

⁵⁸ *Id.*

Generally, consumer gripe sites can be divided into two categories. The first category consists of websites with domain names that are comprised of the trademark of the target company followed by a top-level domain name (TLD).⁵⁹ For example, domain names such as <http://www.tredmakerhomes.com>,⁶⁰ <http://www.theshopsatwillowbend.com>,⁶¹ and <http://www.bosleymedical.com>⁶² all include the trademark of a company followed by a top-level domain name.⁶³ Operators of trademark.com gripe sites specifically select the domain name to make the gripe site more easily found by Internet users who are interested in the target company's products or services.⁶⁴

The second category of gripe sites is commonly known as sucks.com sites. This category consists of websites with domain names that are comprised of the trademark of the target company plus a pejorative term followed by a TLD.⁶⁵ Some common and not so common pejorative terms include the following: sucks,⁶⁶

⁵⁹ Schwartz, *supra* note 3, at 66–67. A top level domain name is the last part of a domain name. For example, for the domain name “trademark.com”, the TLD is “.com.” Domain Name Center.com, <http://www.domain-name-center.com/domain-name-glossary.htm> (last visited Dec. 10, 2006).

⁶⁰ See TMI, Inc. v. Maxwell, 368 F.3d 433, 434 (5th Cir. 2004).

⁶¹ See Taubman Co. v. Webfeats, 319 F.3d 770, 772 (6th Cir. 2003).

⁶² See, e.g., Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 674 (9th Cir. 2005).

⁶³ See also <http://www.aircraft-maintenance.com> (no longer available as of Mar. 15, 2007); <http://www.crownpontiacnissan.com> (no longer available as of Mar. 15, 2007); Nissan Computer Corp, <http://www.nissan.com> (last visited Mar. 15, 2007); <http://www.northlandinsurance.com> (no longer available as of Mar. 15, 2007); Kia Motors, <http://www.kia.com> (actual company website) (last visited Mar. 15, 2007); Mercedes Benz Consumer Warning, <http://www.mercedes-benz-usa.com> (last visited Mar. 15, 2007).

⁶⁴ Northland Ins. Co. v. Blaylock, 115 F. Supp. 2d 1108, 1114 (D. Minn. 2000).

⁶⁵ Schwartz, *supra* note 3, at 66–67.

⁶⁶ See, e.g., <http://www.KBhomesucks.com> (no longer available as of Mar. 15, 2007); NoPayPal!, <http://www.paypalsucks.com> (last visited Mar. 15, 2007); Allstate Insurance Sucks.com, <http://www.allstateinsurancesucks.com> (last visited Mar. 15, 2007); <http://www.airfrancesucks.com> (no longer available as of Mar. 15, 2007); Alitalia Sucks, <http://www.alitaliasucks.com> (last visited Mar. 15, 2007); <http://www.Aasucks.org> (no longer available as of Mar. 15, 2007); <http://www.delta-sucks.com> (no longer available as of Mar. 15, 2007); Northwest Sucks, <http://www.Northwestsucks.com> (last visited Mar. 15, 2007); <http://www.SavageBMWucks.com> (temporarily unavailable as of Mar. 15, 2007); <http://www.suzukiveronasucks.com> (no longer available as of Mar. 15, 2007); Shannon Sylvia's Village Saab Sucks, <http://www.villagesaabsucks.com> (last visited Mar. 15, 2007); American Express Sucks, <http://www.amexsucks.com> (last visited Mar.

sux,⁶⁷ really sucks,⁶⁸ still sucks,⁶⁹ blows,⁷⁰ fuck,⁷¹ pathetic,⁷² boycott,⁷³ rip off,⁷⁴ fraud,⁷⁵ complaints,⁷⁶ litigation,⁷⁷ eats poop,⁷⁸

15, 2007); Capital One Sucks!, <http://www.cap1sucks.com> (last visited Mar. 15, 2007); Compass Bank Sucks, <http://www.compass-bank-sucks.com> (last visited Mar. 15, 2007); <http://www.nextelsucks.com> (no longer available as of Mar. 15, 2007); WalmartSucks.org, <http://www.walmartsucks.org> (last visited Mar. 15, 2007); <http://www.community.livejournal.com/walmartsucks> (no longer available as of Mar. 15, 2007); <http://www.mellonsucks.com> (no longer available as of Mar. 15, 2007); The Home Depot Sucks!, <http://www.homedepotsucks.com> (last visited Mar. 15, 2007); <http://www.radioshacksucks.com> (no longer available as of Mar. 15, 2007); <http://www.statefarmsucks.com> (no longer available as of Mar. 15, 2007); <http://www.earthlinksucks.net> (no longer available as of Mar. 15, 2007); Farmers Insurance Sucks!, <http://www.farmersinsurancegroupsucks.com> (last visited Mar. 15, 2007); Tauban Sucks!, <http://www.taubmansucks.com> (last visited Mar. 15, 2007); <http://www.fordsucks.com> (no longer available as of Mar. 15, 2007); U-Haul Sucks!, <http://www.uhaul-sucks.com> (last visited Mar. 15, 2007); Tauban Sucks!, <http://www.shopsatwillowbendsucks.com> (last visited Mar. 15, 2007); Tauban Sucks!, <http://www.theshopsatwillowbendsucks.com> (last visited Mar. 15, 2007); Tauban Sucks!, <http://www.willowbendmallssucks.com> (last visited Mar. 15, 2007); Tauban Sucks!, <http://www.willowbendsucks.com> (last visited Mar. 15, 2007); DRD Motorsports Sucks, <http://www.drdmotorsportssucks.com> (last visited Mar. 15, 2007); Boycott The Gap, <http://www.gapsucks.org> (last visited Mar. 15, 2007).

⁶⁷ See, e.g., American Express Sucks, <http://www.amexsux.com> (last visited Mar. 15, 2007); <http://www.bestbuysux.com> (no longer available as of Mar. 15, 2007); Yahoo Sucks, <http://www.yahoosuks.com> (last visited Mar. 15, 2007).

⁶⁸ See, e.g., Ford Really Sucks, <http://www.fordreallysucks.com> (last visited Mar. 15, 2007); Farmers Insurance Sucks, <http://www.farmersreallysucks.com> (last visited Mar. 15, 2007).

⁶⁹ See, e.g., Sprint/Nextel Corp. Sucks Website, <http://www.sprintstillsucks.com> (last visited Mar. 15, 2007).

⁷⁰ See, e.g., Wal-Mart Sucks, <http://www.WalMart-Blows.com> (last visited Mar. 15, 2007); <http://www.saturnblows.com> (no longer available as of Mar. 15, 2007).

⁷¹ See, e.g., <http://www.fuckgeneralmotors.com> (no longer available as of Mar. 15, 2007); FuckedGoogle, <http://www.fuckedgoogle.com> (last visited Mar. 15, 2007); Microsuck, <http://www.fuckmicrosoft.com> (last visited Mar. 15, 2007).

⁷² See, e.g., Verizonpathetic.com, <http://www.verizonpathetic.com> (last visited Mar. 15, 2007).

⁷³ See, e.g., <http://www.boycottdelta.com> (no longer available as of Mar. 15, 2007); Farmers Insurance Group Sucks, <http://www.boycottfarmersinsurance.com> (last visited Mar. 15, 2007); Boycott Fedex!, <http://www.boycottfedex.com> (last visited Mar. 15, 2007).

⁷⁴ See, e.g., <http://www.lexus-ripcoff.com> (no longer available as of Mar. 15, 2007).

⁷⁵ See, e.g., <http://www.fidelitybrokerageinvestmentsfraud.com> (no longer available as of Mar. 15, 2007).

⁷⁶ See, e.g., <http://www.tmobilecomplaints.com> (no longer available as of Mar. 15, 2007).

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stop,⁷⁹ kills,⁸⁰ I hate,⁸¹ and in the case of auto manufactures, lemon.⁸²

Alternatively, some gripe site operators establish their websites at domain names that do not include the trademark of the target company in the domain name. For example, the website located at <http://www.trustmatter.com> targets US Bank, but does not include its trademark in the site's domain name.⁸³ But even when the

⁷⁷ See, e.g., <http://www.pennwarrantylitigation.com> (no longer available as of Mar. 15, 2007).

⁷⁸ See, e.g., <http://www.verizoneatspooop.com> (no longer available as of Mar. 15, 2007).

⁷⁹ See, e.g., Stop Exxpnmobile, <http://www.stopexxonmobil.org> (last visited Mar. 15, 2007).

⁸⁰ See, e.g., IAMS Kills!, <http://www.iamskills.com/index.shtml> (last visited Mar. 15, 2007).

⁸¹ See, e.g., I Hate Starbucks, <http://www.ihatestarbucks.com> (last visited Mar. 15, 2007).

⁸² See, e.g., The Unofficial BMW Lemon Site, <http://www.BMWlemon.com> (last visited Mar. 15, 2007); FordLemon, <http://www.fordlemon.com> (last visited Mar. 15, 2007); <http://www.mysuzukilemon.com> (no longer available as of Mar. 15, 2007); MyVWlemon.com, <http://www.myvwlemon.com> (last visited Mar. 15, 2007); The Ford 5.4 Liter Triton V-8 Engine Is A Lemon!, <http://home.nycap.rr.com/tritonlemon/> (last visited Mar. 15, 2007); GMLemonCars.com, <http://www.gmlemoncars.com> (last visited Mar. 15, 2007).

⁸³ Other consumer gripe sites that do not use the target company's trademark in the domain name include the following: <http://www.badcardeal.org> (no longer available as of Mar. 15, 2007); Ricart Automotive & PayDays Consumer Warning Web Site, <http://www.columbusconsumer.com> (last visited Mar. 15, 2007); Rip-off Report.com, <http://www.ripoffreport.com> (last visited Mar. 15, 2007); Fed Up with Bally Total Fitness, <http://www.mwns.com/BTF/index.htm> (last visited Mar. 15, 2007); Coalition against BAYER Dangers, <http://www.cbgnetwork.org> (last visited Mar. 15, 2007); Salon Media Circus, <http://www.salon.com/may97/media/media970529.html> (last visited Mar. 15, 2007 and targeting Disney); Face AT&T, <http://faceatt.netfirms.com> (last visited Mar. 15, 2007 and targeting AT&T); Dead Ford Owners Page, <http://modena.intergate.ca/personal/djk/> (targeting Ford) (last visited Mar. 15, 2007); Ford Taurus 1993, http://www.geocities.com/assilem_bell/ (last visited Mar. 15, 2007 and targeting Ford); Google Blogscoped, <http://blog.outer-court.com> (targeting Google) (last visited Mar. 15, 2007); News for McDonald's Franchisees, <http://www.licenseenews.com> (targeting McDonald's) (last visited Mar. 15, 2007); International Food Boycott, <http://www.geocities.com/eatnoshit/indexe.html> (targeting multiple companies) (last visited Mar. 15, 2007); Downsize Microsoft, <http://www.namebase.org/boycott.html> (last visited Mar. 15, 2007); The Gneech's Microsoft Boycott Page, <http://members.aol.com/thegneech/msb.htm> (last visited Mar. 15, 2007); Youth Against Microsoft, <http://www.angelfire.com/al/YAMS/index2.html> (last visited Mar. 15, 2007); Microslave, <http://www.geocities.com/Athens/Forum/1796/> (targeting Microsoft) (last visited Mar. 15, 2007); Delocator, <http://www.delocator.net> (targeting Starbucks) (last visited Mar. 15, 2007); WAM Cover,

target company's trademark is not included in the domain name, the trademark may still show up in the URL.⁸⁴ For example, the gripe site located at <http://phanel.com/blockbuster/> displays the target company's trademark as part of the URL because the path to the file to be accessed is titled *blockbuster*.⁸⁵

Finally, some creative gripe site operators register domain names that are puns of the target company's trademark. The most popular of these types of web pages is *starbucked.com*.⁸⁶ In 1995,

http://wam_mag.homestead.com/wam.html (targeting Wal-Mart) (last visited Mar. 15, 2007); Corporate Accountability International, http://www.stopcorporateabuse.org/cms/index.cfm?group_id=1000 (targeting Wal-Mart) (last visited Mar. 15, 2007); Wal-Town, <http://www.waltown.com/> (targeting Wal-Mart) (last visited Mar. 15, 2007).

⁸⁴ URL is the abbreviation for Uniform Resource Locator, the addressing system used in the World Wide Web. The URL contains information about the method of access, the server to be accessed and the path of any file to be accessed. Guide to Network Resource Tools, <http://www.acad.bg/beginner/gnrt/appendix/glossary.html> (last visited Dec. 10, 2006)

⁸⁵ Other examples of these types of gripe sites include the following: Blockbuster Victims.com, <http://phanel.com/blockbuster/> (last visited Mar. 16, 2006); My Ford Aspire Saga, <http://www.angelfire.com/nj/fordaspire/> (last visited Mar. 16, 2006); Welcome General Motors GM Alero Defects and Complaint Website, <http://www.dillows.com/alero.htm> (last visited Mar. 16, 2007); Reasons to Avoid Microsoft, <http://www.lugod.org/microsoft/> (last visited Mar. 16, 2007); Don't Be Soft On Microsoft, <http://www.netaction.org/msoft/> (last visited Mar. 16, 2007); Microsucks, <http://www.notagoth.com/microsucks/> (last visited Mar. 16, 2007); Monsatan, <http://www.seizetheday.org/monsanto/main.htm> (last visited Mar. 16, 2007); Boycott Nike, <http://www.saigon.com/~nike/> (last visited Mar. 16, 2007); Boycott Shell, <http://www.essentialaction.org/shell/> (last visited Mar. 16, 2007); Unfriendly Skies, <http://dir.salon.com/story/business/feature/2000/07/28/united/index.html> (last visited Mar. 16, 2007); The Wal-Mart Trash Page, <http://kimsey.stonepics.com/walmart.htm> (last visited Mar. 16, 2007); Take Action: Tell Wal-Mart Enough is Enough, <http://action.americanrightsatwork.org/campaign/walmart2005?> (last visited Mar. 16, 2007).

⁸⁶ Starbucked.com, <http://www.starbucked.com/> (last visited Mar. 16, 2007). Other examples of these types of gripe sites include the following: GoVeg.com, http://www.goveg.com/corp_murderk.asp (last visited Mar. 16, 2007); Against The Wal, <http://www.againstthewal.com> (last visited Mar. 16, 2007); Sprawl Busters, <http://www.sprawl-busters.com> (last visited Mar. 16, 2007); Microsuck, <http://microsuck.com> (last visited Mar. 16, 2007); You Have Been Kmarted, <http://kmarted.freesevers.com/> (last visited Mar. 16, 2007); McSpotlight, <http://www.mcspotlight.org/> (last visited Mar. 16, 2007); Wear Your Wrath for Wal-Mart, <http://www.hel-mart.com/> (last visited Mar. 16, 2007); Walocaust, <http://www.walocaust.com/site/> (last visited Mar. 16, 2007); Wal-Town, <http://www.waltown.com/> (last visited Mar. 16, 2007).

Jeremy Dorsin purchased an espresso machine from Starbucks that he intended to give to someone as a wedding gift.⁸⁷ Mr. Dorsin was upset to find that the machine did not work properly and that Starbucks failed to provide the complimentary coffee offered with each machine.⁸⁸ Upset with his purchase, Mr. Dorsin complained to Starbucks' corporate office and demanded a top of the line replacement espresso machine.⁸⁹ Starbucks refused to give Mr. Dorsin the \$2,500 espresso machine he demanded, but instead offered to write an apology letter and replace the machine with one of better quality.⁹⁰ Not satisfied, Mr. Dorsin registered the domain name "Starbucked.com" and proceeded to launch an "anti-Starbucks crusade" on the Internet.⁹¹

II. CONSUMER GRIPE SITES AND INTELLECTUAL PROPERTY LAW: A MOVE TOWARDS GRIPE SITE PROTECTION

A. *Introduction to Trademark Law*

By their activity, gripe site operators open themselves up to various causes of intellectual property causes of action. The target companies often assert one or more of the following causes of action: trademark infringement,⁹² trademark dilution,⁹³ and cybersquatting.⁹⁴ Companies may also file a complaint with the Internet domain name registrar and force arbitration under the Uniform Dispute Resolution Policy ("UDRP").⁹⁵

Generally, trademark law initially developed to serve two purposes. The first is to protect competing businesses from those

⁸⁷ Starbucked.com, <http://www.starbucked.com/> (last visited Mar. 16, 2007).

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² 15 U.S.C. § 1114 (2000).

⁹³ *Id.* at § 1125(a)–(c).

⁹⁴ *Id.* at § 1125(d). Plaintiff companies may also raise causes of action under common law defamation, but because the standards for defamation are very high, it is rare that the content of a complaint site would constitute libel. Therefore, this cause of action is outside the scope of this note. *Id.*

⁹⁵ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 78.

who attempt to counterfeit their products.⁹⁶ Second, trademark law sought to reduce transaction costs incurred by consumers when making purchasing decisions.⁹⁷ Trademark infringement law has developed independently from First Amendment law because of its common-law roots in the law of fraud.⁹⁸ Consequently, free speech rights and trademark rights are often in conflict.⁹⁹

1. Trademark Infringement

The infringement clause of the Lanham Act provides:

[a]ny person who shall, without consent of the registrant—
(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant.¹⁰⁰

In order to prevail on a trademark infringement claim, plaintiff must show that (1) it has a valid trademark; (2) defendant used the trademark in interstate commerce in connection with the sale, offering for sale, distribution, or advertising of any goods or services; and (3) the defendants use of such mark is likely to cause confusion.¹⁰¹

2. Trademark Dilution

In addition to creating a cause of action for trademark infringement, the Lanham Act provides the owner of a famous mark the right to an injunction against those whose commercial use of the famous mark causes dilution of the distinctive quality of the

⁹⁶ See *id.* at 79; Travis, *supra* note 4, at 3.

⁹⁷ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 79.

⁹⁸ See Patrick D. Curran, *Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1078 (2004).

⁹⁹ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 109.

¹⁰⁰ 15 U.S.C. § 1114(1) (2005).

¹⁰¹ See *Savannah Coll. of Art & Design, Inc. v. Houeix*, 369 F. Supp. 2d 929, 941 (S.D. Ohio 2004).

mark.¹⁰² In order to support a claim for trademark dilution, the plaintiff markholder must establish the following five elements: (1) plaintiff's mark must be famous; (2) plaintiff's mark must be distinctive; (3) defendant's use must be a commercial use in commerce; (4) the use must have occurred after the mark has become famous; and (5) the use must cause dilution of the distinctive quality of the plaintiff's mark.¹⁰³ Noncommercial use is explicitly excluded under the statute.¹⁰⁴ This exception is designed to prevent courts from silencing constitutionally protected speech.¹⁰⁵

3. Commercial Use

The infringement provision of the Lanham act prohibits a party to “*use in commerce . . . a registered mark in connection with the sale . . . of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive[.]*”¹⁰⁶ Similarly, the dilution provision of the Lanham Act allows for an injunction to stop “*commercial use in commerce of a mark*” if the use causes dilution of the famous mark.¹⁰⁷ Furthermore, the dilution provision prohibits the use of a trademark “*in commerce*” in any way that is “likely to cause confusion.”¹⁰⁸ Specifically, the dilution provision of the Lanham act exempts the “*noncommercial use of the mark.*”¹⁰⁹ Courts generally interpret the “commercial use in commerce” requirement of the dilution statute to be roughly analogous to the “in connection with” the sale of goods and services requirement of the infringement statute.¹¹⁰ Therefore, when both claims are alleged, courts generally address the infringement and dilution causes of

¹⁰² See 15 U.S.C. § 1125(c)(1) (2006).

¹⁰³ *Id.* § 1125(c)(1).

¹⁰⁴ *Id.* § 1125(c)(3)(c).

¹⁰⁵ See H.R. Rep. No. 104-374, at 4 (1995); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1122 (D. Minn. 2000) (referencing Michael A. Epstein, *Epstein On Intellectual Property* § 7.06 (4th ed. 1999)).

¹⁰⁶ 15 U.S.C. § 1114(1)(a) (2006) (emphasis added).

¹⁰⁷ *Id.* at §1125(c) (emphasis added).

¹⁰⁸ *Id.* at §1125(a)(1) (emphasis added).

¹⁰⁹ *Id.* at §1125(c)(4)(B) (emphasis added).

¹¹⁰ See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676 (9th Cir. 2005).

action simultaneously by applying a two-part test. First, the court asks if the defendant uses the trademark “in commerce,” and second, if the defendant uses the trademark in a way that is likely to cause confusion.¹¹¹ If the court finds that the trademark is used “in commerce” then the court almost always finds a violation of the Lanham Act under the claim of trademark dilution.¹¹² If the court finds that there is use in commerce *and* a likelihood of confusion, then the court finds a violation for trademark infringement.¹¹³

4. Anticybersquatting Consumer Protection Act

In 1999, Congress passed the Anticybersquatting Consumer Protection Act (“ACPA”)¹¹⁴ in response to the “digital land rush” that occurred after ICANN¹¹⁵ authorized individuals to privately register domain names.¹¹⁶ The statute was designed to create a cause of action against cybersquatters.¹¹⁷ “[C]ybersquatting occurs when a person other than the trademark holder registers the domain name of a well known trademark and then attempts to profit”¹¹⁸ from the registration. The cybersquatter may seek to profit either by attempting to sell the domain name back to the trademark holder at a substantial price, or by using the domain

¹¹¹ See generally *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 1997 WL 133313 (S.D.N.Y. Mar. 24, 1997); *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108 (D. Minn. 2000); *Bosley Med. Inst.*, 403 F.3d 672.

¹¹² See generally *Lamparello*, 420 F.3d 309; *Planned Parenthood*, 997 WL 133313; *People for the Ethical Treatment of Animals*, 263 F.3d 359; *TMI*, 368 F.3d 433; *Northland Ins.*, 115 F. Supp. 3d 1108; *Bosley Med. Inst.*, 403 F.3d 672.

¹¹³ See generally *Lamparello*, 420 F.3d 309; *Planned Parenthood*, 997 WL 133313; *People for the Ethical Treatment of Animals*, 263 F.3d 359; *TMI*, 368 F.3d 433; *Northland Ins.*, 115 F. Supp. 3d 1108; *Bosley Med. Inst.*, 403 F.3d 672.

¹¹⁴ Pub. L. 106-113, 113 Stat. 1536 (codified as amended at 15 U.S.C. § 1125(d) (2000)).

¹¹⁵ ICANN is the abbreviation for the Internet Corporation for Assigned Names and Numbers. ICANN administers the domain name system. Domain names can be registered through one of dozens of different domain name registrars licensed by ICANN.

¹¹⁶ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 75.

¹¹⁷ *Bosley Med. Inst.*, 403 F.3d at 680.

¹¹⁸ *Id.* (citing *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 204 (6th Cir. 2004)).

name to divert business from the trademark holder to the domain name holder.¹¹⁹

The ACPA states that a “person shall be liable in a civil action by the owner of a mark . . . if, without regard to the goods or services of the parties, that person (i) has a bad faith intent to profit from that mark . . .; and (ii) registers, traffics in, or uses a domain name that [is confusingly similar to another’s mark or dilutes another’s famous mark.]”¹²⁰

Unlike the infringement and dilution provisions of the Lanham Act, the ACPA does not contain a commercial use requirement.¹²¹ Instead, the plaintiff must show, among other factors, that the defendant registered the domain name with a “bad faith intent to profit.”¹²² A court may determine bad faith by considering, among others, the nine factors listed in the ACPA.¹²³ These factors include the following: (1) the defendant’s trademark or intellectual property rights to the domain name; (2) the defendant’s use of his legal name or any name used to refer to him in the domain name; (3) the defendant’s prior use of the domain name in connection with any offering of goods or services; (4) the defendant’s bona fide noncommercial or fair use of the mark; (5) whether the defendant seeks to divert consumers from the mark holder’s online location either in a way that could harm good will or tarnish or disparage the mark by creating a confusion regarding the source of the site; (6) whether defendant has offered to transfer or sell the site for financial gain; (7) whether the defendant provided misleading or no contact information when registering the domain name; (8) the defendant’s registration of multiple domain names

¹¹⁹ *Id.* at 680.

¹²⁰ 15 U.S.C. § 1125(d)(1)(A) (2006).

¹²¹ *See* *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 680 (9th Cir. 2005); *MI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004).

¹²² *Bosley Med. Inst.*, 403 F.3d at 681 (holding that a trademark owner asserting a claim under the ACPA must establish that (1) it has a valid trademark entitled to protection; (2) its mark is distinctive or famous; (3) the defendant’s domain name is identical or confusingly similar to, or in the case of famous marks, dilutive of, the owner’s mark; and (4) the defendant used, registered, or trafficked in the domain name (5) with a bad faith intent to profit.).

¹²³ *See* *Lucas Nursery and Landscaping, Inc. v. Grosse*, 359 F.3d 806, 809 (6th Cir. 2004).

which may be duplicative of the marks of others; and (9) the extent to which the mark used in the domain name is famous.¹²⁴ These factors are given as a guide, and are not intended to substitute for a court's careful analysis about whether the defendant's conduct is motivated by a bad faith intent to profit.¹²⁵

B. Political Commentary and Parody Sites

Before the emergence of consumer gripe sites, there were websites dedicated to conveying political, social, or religious messages antithetical to the position of the target organization, either directly or through parody.¹²⁶ These websites incorporate the target institution's trademark into the content of the webpage and into the web address in an attempt to draw Internet users looking for the markholder's website.¹²⁷

For example, in *Planned Parenthood Federation of America, Inc. v. Bucci*,¹²⁸ the defendant registered the domain name "www.plannedparenthood.com" and used the site to convey his anti-abortion message.¹²⁹ Knowing that Internet users seeking the real Planned Parenthood web page were likely sympathetic to the pro-choice position, the defendant deliberately used the plaintiff's trademark as the domain name to attract to the home page Internet users who sought the plaintiff's homepage.¹³⁰

Although these sites are not consumer gripe sites as discussed below, the operator's actions trigger the same causes of action, namely trademark infringement and dilution.¹³¹ The jurisprudence developed in these cases set the stage for litigation against operators of consumer gripe sites. Three cases which deal with

¹²⁴ 15 U.S.C. § 1125(d)(B)(i) (2006).

¹²⁵ See *Lucas Nursery and Landscaping*, 359 F.3d at 811.

¹²⁶ See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, *1 (S.D.N.Y. Mar. 24, 1997), *aff'd.*, 152 F.3d 920 (2d Cir. 1998).

¹²⁷ See *Planned Parenthood*, 1997 WL 133313 at *2.

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Id.* For more on *Planned Parenthood v. Bucci*, see *infra* notes 147–151, 157–159 and accompanying text.

¹³¹ See *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 306 (D.N.J. 1998); *Planned Parenthood*, 1997 WL 133313 at *2.

political commentary or parody websites are heavily cited in consumer gripe site cases; the aforementioned *Planned Parenthood Federation of America, Inc. v. Bucci*,¹³² *Jews for Jesus v. Brodsky*,¹³³ and *People for the Ethical Treatment of Animals v. Doughney (PETA)*.¹³⁴ These cases hold that the use of plaintiff's trademark as the domain name of the defendant's website constitutes trademark infringement and dilution under the Lanham Act.¹³⁵

1. Broad Definition of Commercial Use

In the early political commentary and parody cases, the courts apply a very broad definition of what constitutes "use in commerce."¹³⁶ Defendants were found to have used plaintiff's trademarks in commerce by merely affecting the plaintiff's ability to offer their services over the Internet.¹³⁷ Courts reasoned that if an Internet user was lured to the defendant's website, while in pursuit of the plaintiff's services, they might become frustrated, give up, and never reach the plaintiff's website.¹³⁸ The effect of the defendant's activities on the plaintiff's commerce would satisfy the "in commerce" requirement of the Lanham Act.¹³⁹

In *Jews for Jesus v. Brodsky*, the Third Circuit enjoined defendant's operation of a website at "jewsforjesus.org."¹⁴⁰ In that case, the defendant created a website that was extremely critical of the plaintiff's religious organization Jews for Jesus.¹⁴¹ The court held that the defendant's conduct constituted trademark infringement and dilution.¹⁴² The court found that the defendant's

¹³² 1997 WL 133313.

¹³³ 993 F. Supp. 282 (D.N.J. 1998).

¹³⁴ 263 F.3d 359, 366–67 (4th Cir. 2001).

¹³⁵ See *Jews for Jesus*, 993 F. Supp. at 306; *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, *2 (S.D.N.Y. Mar. 24, 1997), aff'd., 152 F.3d 920 (2d Cir. 1998).

¹³⁶ See *Planned Parenthood Federation of America, Inc.* 1997 WL 133313 at *3.

¹³⁷ See *id.*

¹³⁸ See *People for the Ethical Treatment of Animals*, 263 F.3d at 365.

¹³⁹ See *Jews for Jesus*, 993 F. Supp. at 307–08; *Planned Parenthood*, 1997 WL 133313 at *3.

¹⁴⁰ *Jews for Jesus*, 993 F. Supp. at 307–08.

¹⁴¹ *Id.*

¹⁴² *Id.*

use of the mark was “in commerce” and “in connection with goods or services” even though the defendant did not offer anything for sale on his site or solicit funding.¹⁴³ Additionally, since the defendant’s site was intended to harm and disparage the plaintiff, and contained a link to another site that did sell merchandise, the court decided that the defendant’s site constituted a commercial use.¹⁴⁴

By applying an even broader definition of “in commerce,” the court in *Planned Parenthood* held the defendant’s use of the plaintiff’s trademark on the Internet to be inherently “in commerce.”¹⁴⁵ The District Court in *Planned Parenthood* reasoned that “Internet users constitute a national, even international, audience, who must use interstate telephone lines to access defendant’s website on the Internet. The nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act’s ‘in commerce’ requirement.”¹⁴⁶ As further evidence of commercial use, courts also looked for hyperlinks to other web pages offering goods or services,¹⁴⁷ promotion of a product on behalf of a third party,¹⁴⁸ or the solicitation of funds for non-profit political activity.¹⁴⁹

The courts in these political commentary and parody cases generally do not recognize a First Amendment limit on the scope of trademark protection when the mark is used as the domain name of the defendant’s site. In both *PETA* and *Jews for Jesus*, the content of defendant’s speech was not at issue because the courts did not look past the domain name itself to the content of the

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ See *Planned Parenthood v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313 at *5 (S.D.N.Y. Mar. 24, 1997).

¹⁴⁶ See *Planned Parenthood* 1997 WL 133313 at *3 (S.D.N.Y. Mar. 24, 1997). See also *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 186 (W.D.N.Y. 2000).

¹⁴⁷ *OBH*, 86 F. Supp. 2d at 185–86; *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001); *Jews for Jesus*, 993 F. Supp. at 307–08.

¹⁴⁸ *Planned Parenthood*, 1997 WL 133313 at *5.

¹⁴⁹ *Id.*

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website.¹⁵⁰ Similarly, in *Planned Parenthood*, the court held that the First Amendment did not protect the term in question because the mark was used as the domain name of the site and served as a source identifier rather than existing as a part of the site's communicative message.¹⁵¹ Therefore, in the three aforementioned cases, the courts held that the speech at issue included only the domain name itself, and did not receive the protection of the First Amendment.

2. Likelihood of Confusion: The Initial Interest Doctrine and the Parody Defense

To prevail on a claim for trademark infringement, the plaintiff needs to demonstrate that the use of the plaintiff's trademark is likely to confuse an ordinary consumer as to the source of the webpage.¹⁵² Most circuits look to a list of factors to determine the likelihood of consumer confusion.¹⁵³ In each of the three cases discussed in this section, *Planned Parenthood*, *Jews for Jesus*, and *PETA*, the courts found that the defendant's use of the plaintiff's trademark was likely to confuse the ordinary consumer. Once again, the courts only looked to the defendant's use of the trademark in the domain name of the site, and not to the use of the mark in connection with the content of the web page.

At first blush, the courts' finding of a likelihood of confusion in these cases is somewhat shocking. In *PETA*, the defendant registered the domain name *peta.org* and created a website called "People Eating Tasty Animals."¹⁵⁴ The plaintiff is an animal rights organization whose mission is to promote and heighten public awareness of animal protection issues.¹⁵⁵ The organization opposes the use of animals for food, clothing, testing, or entertainment.¹⁵⁶ Given the nature of the plaintiff organization, it

¹⁵⁰ See *People for the Ethical Treatment of Animals*, 263 F.3d at 366; *Jews for Jesus*, 993 F. Supp. at 306.

¹⁵¹ *Planned Parenthood*, 1997 WL 133313 at *10.

¹⁵² *People for the Ethical Treatment of Animals*, 263 F.3d at 366; *Jews for Jesus*, 993 F. Supp. at 301.

¹⁵³ *Jews for Jesus*, 993 F. Supp. at 301; *Planned Parenthood*, 1997 WL 133313 at *7.

¹⁵⁴ *People for the Ethical Treatment of Animals*, 263 F.3d at 362.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

appears that no one who accesses a website entitled “People Eating Tasty Animals” would reasonably believe that the website was sponsored by an animal rights organization. Nevertheless, the court found that confusion is likely.

The courts in *PETA* and in *Planned Parenthood* addressed the likelihood of confusion in the context of the parody defense. The defendants argued that the court should consider the defendants’ websites in conjunction with the domain names because, together, they parody the plaintiffs’ organizations and, thus, do not create a likelihood of confusion.¹⁵⁷ In both cases the court held that a “parody” must simultaneously convey the message that it is the original and the contradictory message that it is not the original but rather a parody.¹⁵⁸ An Internet user must either see or type the plaintiff’s mark before accessing the website.¹⁵⁹ The domain name conveys the first message, and the second message is conveyed only when the user reads the content of the website.¹⁶⁰ However, since the website does not convey the two messages simultaneously it does not constitute a parody.¹⁶¹

This approach would later be reframed not as a defense, but as a part of the likelihood of confusion analysis known as the initial interest confusion doctrine.¹⁶² The theory behind the doctrine is that the defendant’s domain name is an external label that, on its face, causes confusion among Internet users.¹⁶³ A defendant uses the plaintiff’s trademark in a manner calculated to capture consumer attention, even though no actual sale is completed as a result of the confusion.¹⁶⁴ Courts that apply the initial interest confusion doctrine hold that the momentary confusion experienced

¹⁵⁷ *Id.* at 366–67.

¹⁵⁸ See *People for the Ethical Treatment of Animals*, 263 F.3d at 366; *Planned Parenthood*, 1997 WL 133313 at *10.

¹⁵⁹ *Planned Parenthood*, 1997 WL 133313 at *10.

¹⁶⁰ *People for the Ethical Treatment of Animals*, 263 F.3d at 366.

¹⁶¹ *Id.* at 367.

¹⁶² See *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 195 (W.D.N.Y. 2000).

¹⁶³ See *Planned Parenthood*, 1997 WL 133313, at *12.

¹⁶⁴ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 84.

by a visitor when he or she arrives at the defendant's website is sufficient to find a likelihood of confusion.¹⁶⁵

To show initial interest confusion, courts look to see

(1) whether an appreciable number of people who undertake searches using the plaintiff's trademark terms are looking for plaintiff's site; (2) whether any initial interest confusion was damaging and wrongful; (3) whether anyone believes or is likely to believe there is a connection between the plaintiff's and defendant's sites; (4) whether the defendant received sale opportunities by confusing web users; and (5) whether the defendant intended to divert the plaintiff's customers.¹⁶⁶

In all three cases, the target institutions successfully shut down the websites, at least at their original domain names.¹⁶⁷ But, corporations targeted by consumer gripe sites have not been as successful. The next part of this section will explore how the application of trademark infringement and dilution law evolved from the jurisprudence laid out in these early parody cases. The next part will also look at a cause of action not available to the parody case plaintiffs, namely cybersquatting.

C. Traditional Consumer Gripe Sites: *Sucks.com*

When a consumer decides to establish a gripe site, they must first register a domain name. Sometimes the individual chooses a domain name that is identical or nearly identical to the trademark of the target organization. The individual uses the trademark in an attempt to deliberately divert Internet users away from the target company's website and to the gripe site.¹⁶⁸ More often, the individual chooses a domain name designed to convey to an Internet user immediately that the site is one critical of the target

¹⁶⁵ See *OBH*, 86 F. Supp. 2d at 186.

¹⁶⁶ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 85.

¹⁶⁷ The People Eating Tasty Animals website is now located at <http://www.mtd.com/tasty/> (last visited Mar. 14, 2007).

¹⁶⁸ See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 363 (4th Cir. 2001); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 287 (D.N.J. 1998); *Planned Parenthood*, 1997 WL 133313 *2.

organization. Generally, these domain names take the form of the name of the company with “sucks.com” or some other language that indicates that the content of the site is of a critical nature.¹⁶⁹ These sites are collectively referred to as “sucks.com” sites.

Eric Gray created exactly such a site when he registered paypalsucks.com.¹⁷⁰ Gray created the site to vent his frustrations over PayPal’s customer service and to provide a forum for other disgruntled users of PayPal to do the same.¹⁷¹ Mr. Gray’s personal experience with PayPal would frustrate any customer.¹⁷² He called the company’s customer service phone number, but the representative was unable to assist him. He requested to speak to a supervisor, only to have the customer service representative hang up on him.¹⁷³ When he called back, a different representative also disconnected his call.¹⁷⁴ The website now hosts his story and a forum for other PayPal users to post complaints, provides descriptions of other services that one may use instead of PayPal, and provides help for resolving issues with the company.¹⁷⁵

There are many similarities between these sucks.com sites and the political and social commentary websites addressed above. The site operator’s motives are generally the same: to communicate to a particular audience complaints, issues, or criticism of a business or organization.¹⁷⁶ The operator hopes to communicate the message to potential customers of the target company and ultimately dissuade them from using the target organization’s goods or services.

¹⁶⁹ For example, see the websites at issue in *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528 (E.D. Va. 2000); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998); and *Penn Warranty Corp. v. DiGiovanni*, 810 N.Y.S.2d 807 (N.Y. Sup. Ct. 2005).

¹⁷⁰ Wolrich, *supra* note 5.

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ See NoPayPal, <http://paypalsucks.com/> (last visited Mar. 16, 2007).

¹⁷⁶ See *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998).

On the other hand, operators of these sucks.com sites do not intend on tricking any potential consumer into believing that their site is actually that of the target organization. When the operator uses a word like “sucks” in the domain name, it is clear to the Internet user that the site is not operated by the markholder.¹⁷⁷ Finally, in the sucks.com cases, more often than not the target organization is a commercial entity as opposed to a religious, social or political organization. These differences significantly alter the application of trademark jurisprudence on the use of trademarks in cyberspace. In fact, courts generally favor the defendant as long as the defendant’s legitimate motive in establishing the gripe site is to exercise his or her right to criticize the target company.¹⁷⁸

1. Narrowing the Definition of Commercial Use

The first notable opportunity for a court to apply infringement and dilution law to the use of a trademark in a sucks.com website came in 1998, when Bally Total Fitness Holding Corporation sued Andrew S. Faber for trademark infringement and dilution.¹⁷⁹ Plaintiff held federally registered trademarks in “Bally,” “Bally’s Total Fitness,” and “Bally Total Fitness.”¹⁸⁰ Defendant registered the domain www.compupix.com. Within that domain, Defendant placed the web page at issue, at the URL “www.compupix.com/ballysucks.”¹⁸¹ At that domain, the defendant operated a website titled “Bally sucks,” and hosted criticism of plaintiff’s health club operations. The site included the image of Plaintiff’s registered trademark “Bally,” superimposed with the word “sucks.”¹⁸²

In sharp contrast to the political commentary and parody cases, the court in *Bally Total Fitness Holding Corp. v. Faber* dismissed claims of trademark infringement and dilution brought by plaintiff.

¹⁷⁷ See *id.* at 1165 n.2; *Penn Warranty Corp. v. DiGiovanni*, 810 N.Y.S.2d 807, 817–18 (N.Y. Sup. Ct. 2005).

¹⁷⁸ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 95.

¹⁷⁹ *Bally Total Fitness*, 29 F. Supp. 2d 1161.

¹⁸⁰ *Id.* at 1162.

¹⁸¹ *Id.*

¹⁸² *Id.*

The court held that the mere use of a trademark on the Internet is not per se commercial use; there must be something more.¹⁸³ Unfortunately, the court does not describe what use would rise to the level of commercial use, nor does the court give us clues as to what is not commercial use.¹⁸⁴

In a case involving similar facts, the Supreme Court of New York clarified to some extent what does not qualify as commercial use. In *Penn Warranty Corporation v. DiGiovanni*, the court held that the mere use of a trademark to undermine the trademark holder's business is not commercial use.¹⁸⁵ This is yet another departure of the infringement jurisprudence developed in the context of political commentary and parody sites. Recall that in *Planned Parenthood*, the court held that the effect of the defendant's activities on plaintiff's commercial activities would satisfy the "in commerce" requirement of the Lanham Act.¹⁸⁶

The sucks.com cases do not provide a context for the development of a full definition of commercial use. The websites at issue in these cases were pure consumer gripe sites. There was no indication that any of the operators were also direct competitors of the plaintiff, the websites did not provide ads or links to competitors' websites, nor did the sites offer any commercial products or services whatsoever. Therefore, the court left open the question of whether a consumer gripe site that sold products or provided links to commercial web pages could still use another's trademark without incurring liability for infringement.

¹⁸³ Compare *id.* at 1166, with *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313 (S.D.N.Y. Mar. 24, 1997), *aff'd*, 152 F.3d 920 (2d. Cir. 1998), cert. denied, 525 U.S. 834 (1998). Bally's holding that the use of defendant's trademark in the domain name of the website was not commercial use also departed from the judicial consensus developed in the cybersquatting cases of the 1990s, that all Internet speech is "in commerce." See Travis, *supra* note 4, at 33.

¹⁸⁴ The court in Bally holds that the use of another's trademark in reference to websites designed by the defendant as part of an online resume is not commercial use of the trademark. *Bally Total Fitness*, 29 F. Supp. 2d at 1167.

¹⁸⁵ *Penn Warranty Corp.*, 810 N.Y.S.2d at 817.

¹⁸⁶ See *Planned Parenthood*, 1997 WL 133313 at *3.

2. Likelihood of Confusion: A Step Away From Initial Interest Confusion

It is not surprising that the courts in the context of the sucks.com cases hold that a reasonable consumer would not be confused as to the source of the website.¹⁸⁷ The use of the word “sucks” or a similar word laden with condemnation eliminates any risk of consumer confusion.¹⁸⁸ In other words, a reasonable consumer and Internet user is sophisticated enough to distinguish between subtle differences in domain names, such as the addition of a pejorative term to a trademark.¹⁸⁹ Therefore, even under the strict initial interest confusion test, defendants could easily establish that there was no likelihood of confusion.

For example, both the U.S. District Court for the Central District of California in *Bally Total Fitness*,¹⁹⁰ and the U.S. District Court for the Eastern District of Virginia in *Lucent Technologies, Inc. v. LucentSucks.com* held that in the context of sucks.com gripe sites, a reasonable consumer is unlikely to mistake the gripe site for a website sponsored by the plaintiff.¹⁹¹ The websites in these cases both included the trademark of the defendant followed by the word “sucks.” A closer look at the application of the likelihood of confusion doctrine to the facts of the sucks.com cases reveals a subtle shift in favor of the gripe site operator. Every circuit has a slightly different test to determine the likelihood of confusion, but all essentially look for the likelihood that an ordinary consumer would be confused as to the source or sponsorship of the goods or services.¹⁹²

The court in *Penn Warranty Corporation v. DiGiovanni* implicitly rejected the application of the initial interest confusion doctrine developed in the political commentary and parody cases

¹⁸⁷ *Bally Total Fitness*, 29 F. Supp. 2d at 1163–64. See also Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 90.

¹⁸⁸ See *Lucent*, 95 F. Supp. 2d 528; *Bally Total Fitness*, 29 F. Supp. 2d at 1164; *Penn Warranty Corp.*, 810 N.Y.S.2d 807; Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 96.

¹⁸⁹ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 90–91.

¹⁹⁰ *Bally Total Fitness*, 29 F. Supp. 2d at 1163–64.

¹⁹¹ See *Lucent*, 95 F. Supp. 2d at 535.

¹⁹² See *Planned Parenthood*, 1997 WL 133313.

to cases involving consumer gripe sites.¹⁹³ The court held that even if an Internet user might initially believe that he or she had reached the markholder's website, the content of the website would immediately dispel the mistaken belief.¹⁹⁴ The "[d]efendant's web site clearly and unmistakably indicates an unfavorable view of plaintiff and its business practices."¹⁹⁵

There also may be a difference in how the courts define "goods or services." In the political commentary and parody cases, it appears that the court defines the goods or services at issue as the content of the webpage, or the webpage itself.¹⁹⁶ Nonetheless, other courts have held that under Lanham Act jurisprudence, it is irrelevant whether customers would be confused as to the origin of the websites, unless there is confusion as to the origin of the respective products.¹⁹⁷ For example, in *Bally Total Fitness* the court held that the goods offered by the parties were not related.¹⁹⁸ Defendant was in the business of designing computer web pages.¹⁹⁹ Plaintiff was in the business of managing health clubs. The court ultimately holds that "[t]he fact that the parties both advertise their respective services on the Internet may be a factor tending to show confusion, but it does not make the goods related."²⁰⁰

3. The First Amendment Emerges as a Limit on the Rights of Markholders

The court's holding in *Bally Total Fitness* is particularly significant because it explicitly acknowledges a First Amendment

¹⁹³ *Penn Warranty Corp.*, 810 N.Y.S.2d at 818.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ See *Planned Parenthood*, 1997 WL 133313 at *4 (noting that both parties provide informational service to the same market).

¹⁹⁷ *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003).

¹⁹⁸ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1164 (C.D. Cal 1998).

¹⁹⁹ *Id.* at 1167.

²⁰⁰ *Id.* at 1163. This analysis is somewhat odd because the content of Defendant's website was designed to criticize the business operations of Bally Health Club, and not to promote the defendant's web design business.

limit on the rights of a trademark holder.²⁰¹ The defendant in *Bally Total Fitness* used Bally's trademark in the domain name of his web page as well as in the content of the webpage itself. Therefore, Bally's trademark became a part of defendant's criticism of plaintiff's business practices. The court held that granting an injunction to the plaintiff is improper because the defendant is exercising his First Amendment right to publish critical commentary about the plaintiff.²⁰² The court acknowledged that defendant's use of the trademark is an essential component of the speech and holds that an "individual who wishes to engage in consumer commentary must have the full range of marks that the trademark owner has to identify the trademark owner as the object of criticism."²⁰³

Nonetheless, the First Amendment is not a broad shield when it comes to trademark infringement. If a defendant's speech incorporates a trademark in a way that is commercial and confusing, then it is misleading commercial speech, and therefore outside the protections of the First Amendment.²⁰⁴ Because the language of the Lanham Act demands both commercial use of the mark and the likelihood that it would cause confusion, the court in *Taubman v. WebFeats* reasoned that there is no need to analyze a constitutional defense independent of the Lanham Act analysis.²⁰⁵ Nevertheless, the court went on to comment that the defendant's use of the plaintiff's mark in his "sucks.com" domain name is "purely an exhibition of Free Speech."²⁰⁶ The First Amendment protects critical commentary when there is no confusion as to source, even when the use of the trademark may result in economic damage to the target organization.²⁰⁷

²⁰¹ *Id.* at 1165–66.

²⁰² *Id.* at 1165.

²⁰³ *Id.* at 1166 n.4.

²⁰⁴ *Taubman Co. v. Webfeats*, 319 F.3d 770, 774–75 (6th Cir. 2003).

²⁰⁵ *Id.* at 775.

²⁰⁶ *Id.* at 778.

²⁰⁷ *Id.*

4. The Anticybersquatting Consumer Protection Act

In 1999, Congress passed the Anticybersquatting Consumer Protection Act (“ACPA”)²⁰⁸ which amended the Trademark Act. The ACPA created a cause of action to prevent the phenomenon of “cyberpiracy” or “cybersquatting.” In the late 1990s and early 2000s, individuals registered domain names using trademarks of existing companies with the intent of later selling the domain name to the corporation at a hefty price.²⁰⁹ The explosion of cybersquatters was problematic in many ways. First, and most obvious, a cybersquatter’s use of a trademark as a domain name prevents the actual mark owner from using the mark as its domain name.²¹⁰ Second, cybersquatters’ use of a trademark diverts potential customers of the mark owner’s goods or services elsewhere, potentially causing a loss of business opportunities for the mark holder.²¹¹ Third, oftentimes these cybersquatters would use the underlying website as an opportunity to display pornography,²¹² thus tarnishing the mark.²¹³ Finally, it was often difficult for trademark owners to enforce their trademark rights because many cybersquatters registered the domain names under aliases in order to avoid identification and service of process by the mark owner.²¹⁴

A defendant was liable under the ACPA if he or she registered, trafficked in, or used domain names that are “identical or confusingly similar to trademarks with the bad-faith intent to profit from the goodwill of the trademarks.”²¹⁵ Notice that liability under

²⁰⁸ Pub.L. No. 106-113, 113 Stat. 1501 (codified as amended at 14 U.S.C. §§ 1114, 1116, 1117, 1125, 1127, 1129 (1999)).

²⁰⁹ Sally M. Abel, *Trademark Issues in Cyberspace: The Brave New Frontier*, 5 MICH. TELECOMM. & TECH. L. REV. 91, 93–97 (1999).

²¹⁰ *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 530 n.1 (E.D. Va. 2000).

²¹¹ *Id.*

²¹² *Id.* at 529.

²¹³ *Id.* at 530 n.1.

²¹⁴ *Id.* at 530. This last problem was addressed by the *in rem* provision of the ACPA which allowed a mark owner to file an action against the domain name itself, if, upon due diligence, the plaintiff was unable to locate the owner of the domain name. *Id.*

²¹⁵ H.R. Rep. No. 106-412, at 8 (1999). For an example of a case where a court finds defendant to have registered the domain name in bad faith, see *E. & J. Gallow Winery v.*

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the ACPA does not require defendant to use the trademark “in commerce,” but instead requires defendant to have a “bad faith intent to profit.”²¹⁶

Rarely does a plaintiff assert a cause of action for cybersquatting against owners of a sucks.com style gripe site. It is unlikely that the actual markholder would ever use such a domain name to promote their own products.²¹⁷ Moreover, a “person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name”²¹⁸ significantly undermines the likelihood that a bad faith intent exists.²¹⁹ The House Judiciary Committee noted that the ACPA intended to protect fair uses of another’s mark online such as in comment, criticism, or parody.²²⁰ Because the word “sucks” is a word “loaded with criticism[,]”²²¹ it is unlikely that the owner of a sucks.com site would display a badfaith intent to profit by registering the domain name.²²²

D. Trademark.com: A Close Call for the Consumer Gripe Site

Although their content may be similar, trademark.com gripe sites differ from sucks.com gripe sites in one crucial way. Operators of trademark.com gripe sites specifically select the domain name to make the gripe site more easily found by Internet users who are interested in the target company’s products or services.²²³ This fundamental difference increases the likelihood

Spider Webs Ltd., 286 F.3d 270 (5th Cir. 2002), where the defendant had previously offered other domain names for sale and the website was turned into a gripe site after litigation began.

²¹⁶ H.R. Rep. No. 106-412 (1999), at 2.

²¹⁷ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 97. *But see* Trigaux, *supra* note 17 (observing that New Jersey lawyer Dan Parisi who owns the rights to dozens of companysucks.com sites targeting Fortune 500 companies may be a speculator who buys the rights to these sites and tries to resell them at a profit to the targeted companies interested in preventing such sites from appearing online).

²¹⁸ 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (2006).

²¹⁹ *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000).

²²⁰ *Id.* at 535 (citing H.R. Rep. No. 106-412).

²²¹ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1164 (C.D. Cal. 1998).

²²² *Lucent*, 95 F. Supp. 2d at 535–36; *See also* *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672 (9th Cir. 2005).

²²³ *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1114 (D. Minn. 2000).

that an Internet user would be confused as to the source or sponsorship of a website. Furthermore, the difference in the domain name strengthens the target company's argument for cybersquatting. Nevertheless, the law still provides a great deal of protection for gripe site operators.

E. Commercial Use: Mixed Use and First Amendment Limits to the Rights of Markholders

Whether or not a trademark is used in commerce does not depend on how the trademark is used in the domain name. Therefore, from an analytical standpoint the commercial use analysis is no different in the trademark.com cases than it is in the sucks.com cases. But in practice, the commercial use requirement gets a lot more attention in the trademark.com cases. Because a defendant is more likely to lose on the likelihood of confusion analysis, defendants put a lot more weight into arguing that the use of the trademark is not in commerce. Therefore, the decisions in the trademark.com cases provide a deeper insight into what is and what is not commercial use.

The Sixth Circuit holds that the Lanham Act prohibits the use of another's mark in connection with even the most minimal commercial activity.²²⁴ In *Taubman v. Webfeats*, the plaintiff "The Shops at Willow Bend" was a shopping mall owner who maintained its own website at "theshopsatwillowbend.com."²²⁵ The defendants registered the domain name at "shopsatwillowbend.com" and created a consumer gripe site.²²⁶ The defendants claimed to have no commercial purpose behind establishing the website.²²⁷ Nevertheless, the Sixth Circuit found that the defendants' use of the plaintiff's domain name was prohibited under the Lanham Act because the website contained a link to a site owned by the defendant's girlfriend in which custom-made shirts were sold, and a link to the defendant's website for his

²²⁴ *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003).

²²⁵ *Id.* at 772.

²²⁶ *Id.*

²²⁷ *Id.*

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web design company.²²⁸ The court noted that although the advertisements were extremely minimal, they nevertheless constituted use “in connection with the advertising” of the good sold by the advertisers.²²⁹

Links to other websites alone are not sufficient to satisfy the commercial use requirement of the Lanham Act.²³⁰ The purpose behind trademark infringement law is to prevent a person from unfairly profiting on a markholder’s goodwill and established reputation through the unauthorized use of the markholder’s trademark.²³¹ Therefore, links to other web pages such as discussion groups that may contain advertising or attorney web pages are insufficient to render a website commercial.²³²

Courts in the trademark.com context also narrowed the scope of the commercial use requirement by focusing on the “in connection with a sale of goods or services” clause of the Lanham Act.²³³ Other courts have merely looked at the “use in commerce” language of the statute, but the Ninth Circuit noted that this requirement is merely a jurisdictional predicate to any law passed by Congress under the Commerce Clause, and that infringement should be found only when the use was “in connection with a sale of goods or services[,]” rather than a “use in commerce.”²³⁴

Furthermore, courts in the trademark.com cases extended greater protection to gripe site operators by explicitly rejecting the holding in *PETA*.²³⁵ Recall that in *PETA*, the court held that the Lanham Act’s commercial use requirement was satisfied because the defendants used the plaintiff’s mark as the domain name.²³⁶ There, the court reasoned that use of the mark in this manner might

²²⁸ *Id.* at 772, 775.

²²⁹ *Id.* at 775.

²³⁰ *Savannah Coll. of Art & Design, Inc. v. Houeix*, 369 F. Supp. 2d 929, 946 (S.D. Ohio 2004).

²³¹ *Id.* at 945 (citing *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987)).

²³² *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 678 (9th Cir. 2005).

²³³ *Id.* at 677.

²³⁴ *Id.*

²³⁵ *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 365–66 (4th Cir. 2001).

²³⁶ *Id.*

deter customers from reaching the plaintiff's site, thus preventing users from obtaining the plaintiff's goods and services.²³⁷ Courts in the trademark.com cases rejected this holding as over-expansive because of the threat such reasoning posed to consumer commentary protected by the First Amendment.²³⁸

1. The Abandonment of the Initial Interest Confusion Doctrine

Unlike the sucks.com websites, there is a high risk of initial confusion in the context of the trademark.com gripe sites.²³⁹ Like the site developers in the political commentary websites discussed above, operators of the trademark.com sites deliberately chose the plaintiff's trademark as the domain name to attract Internet users to the gripe site page.

Despite the similarities, courts in the context of trademark.com gripe sites have generally rejected the initial interest confusion doctrine.²⁴⁰ To do so, courts have looked to the purpose behind the Lanham Act. In *Bosley v. Kremer*, the Ninth Circuit held that “the Lanham Act seeks to prevent consumer confusion that enables a seller to pass off his goods as the goods of another . . . [T]rademark infringement protects only against mistaken *purchasing decisions* and not against confusion generally.”²⁴¹ “[I]t is irrelevant whether [Internet users] would be confused as to the origin of the website, unless there is confusion as to the origin of the respective products.”²⁴² In *Northland Insurance v. Blaylock*, the court held that likelihood of confusion does not exist in the context of

²³⁷ *Id.*

²³⁸ *Bosley Med. Inst.*, 403 F.3d at 679.

²³⁹ This argument is partially premised on the notion that individuals reach websites by typing into their browser the name of a product or company as the secondary level domain, followed by the TLD such as “.com” This is an extremely inefficient practice of searching the Internet, and it is unlikely that a significant number of Internet users still rely on this method. See Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 74–75.

²⁴⁰ See *Lamparello v. Falwell*, 420 F.3d 309, 316 (4th Cir. 2005), cert. denied, 126 S. Ct. 1772 (2006).

²⁴¹ *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005) (citing *Lang v. Ret. Living Publ'g Co., Inc.*, 949 F.2d 576, 582–83 (2d. Cir. 1991) (internal quotation marks and citation omitted)).

²⁴² *Taubman v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003).

trademark.com gripe sites where defendant created the website “www.northlandinsurance.com” to criticize plaintiff’s business after a legal dispute over insurance coverage for his yacht.²⁴³ Plaintiff had previously registered the trademark “Northland Insurance.”²⁴⁴ The court held that due to the content of the website there was no likelihood of confusion because “any reasonable Internet user would readily ascertain that defendant’s site is not affiliated with or sponsored by plaintiff.”²⁴⁵

Alternatively, courts have abandoned the initial interest confusion doctrine by looking back to the purpose behind the doctrine itself. In *Northland Insurance*, the court noted that the initial interest confusion doctrine was designed to prevent the “bait and switch by infringing producers to impact the buying decisions of consumers in the market for the goods, effectively allowing the competitor to get its foot in the door by confusing consumers.”²⁴⁶ This analysis links the initial interest confusion doctrine directly to the “use in connection with . . . goods or services” clause of the Lanham Act. “In other words, while defendant may arguably be trying to ‘bait’ Internet users, there is no discernable “switch.”²⁴⁷

Finally, courts have reasoned against the initial interest confusion doctrine because the doctrine presumes that Internet users are not sophisticated enough to distinguish between the trademark owner’s website and a gripe site.²⁴⁸ In actuality, a reasonable consumer is more likely to resume their search for the mark owner’s website after a momentary delay and find the intended site.²⁴⁹

This retreat from the initial interest confusion doctrine occurs alongside the expansion of First Amendment protection of speech by those who use another’s trademark without authorization to communicate ideas or express points of view.²⁵⁰ If courts applied

²⁴³ *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1114, 1121–22 (D. Minn. 2000).

²⁴⁴ *Id.* at 1114.

²⁴⁵ *Id.* at 1122.

²⁴⁶ *Id.* at 1119.

²⁴⁷ *Id.* at 1120.

²⁴⁸ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 86.

²⁴⁹ *Id.* at 87.

²⁵⁰ *BosleyMed. Inst.*, 403 F.3d at 677.

the initial interest confusion doctrine in its strictest sense, they would eliminate the fair use defense and consequently chill the right to free speech on the Internet.²⁵¹ Therefore, courts generally rejected the initial interest confusion doctrine and returned to using the more traditional trademark infringement analysis.

2. ACPA

Unlike the infringement and dilution provisions of the Lanham Act,²⁵² the ACPA looks specifically at the intent of the gripe site operator when he or she registers the domain name and creates the gripe site.²⁵³ Theoretically, consumer gripe sites fall outside of the scope of the ACPA because the gripe site operator registers the domain name with the intent to complain about the mark holder's products or services.²⁵⁴ When the website contains commentary critical of the mark holder's company, it is difficult for a court to find evidence that the gripe site operator's intent was to mislead consumers with regard to the sites sponsorship.²⁵⁵

In the trademark.com scenario, the content of a website will not overcome other evidence of a bad faith intent to profit. Even if a defendant uses the website to set up a gripe site, he may nevertheless also have a bad faith intent to profit from the registration. A central factor to the finding of bad faith is the registration of multiple websites.²⁵⁶ Courts look to see if the defendant has registered other variants of the plaintiff's trademark or previously has registered marks of other companies as domain names.²⁵⁷ This multiple registration is evidence of the defendant's intent to sell the domain name to the legitimate markholder.

In *Toronto-Dominion Bank v. Karpachev*, the District Court for the District of Massachusetts applied the nine factors and

²⁵¹ See Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 87–88.

²⁵² *Taubman v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003) (holding that the inquiry for trademark infringement is not one of intent and in that sense the Lanham Act is a strict liability statute).

²⁵³ *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 810 (6th Cir. 2004).

²⁵⁴ *Id.*; see also Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 95.

²⁵⁵ *Lucas Nursery*, 359 F.3d at 810.

²⁵⁶ *Id.* at 811.

²⁵⁷ *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1125 (D. Minn. 2000).

concluded that there was sufficient evidence to show that the defendant had acted in bad faith under the ACPA.²⁵⁸ The defendant registered sixteen domain names composed of various misspellings of the target company's trademark TD Waterhouse.²⁵⁹ On the websites associated with these names, the defendant attacked the plaintiff and alleges that Toronto-Dominion Bank was involved in white collar crime.²⁶⁰ The defendant compared the plaintiff's business methods to what "Nazi or Soviet Totalitarians [sic] did to their victims."²⁶¹ The court concluded that the defendant had acted in bad faith, relying on the fact that defendant registered sixteen domain names.²⁶² In other words, a domain name registrar cannot avoid liability for cybersquatting simply by using the registered domain names as gripe sites.

Courts have allowed some leeway for the defendant to register a few different domain names. In *TMI v. Maxwell*, defendant Maxwell registered two domain names related to TrendMaker Homes.²⁶³ He registered www.trendmakerhomes.com and www.trendmakerhome.info.²⁶⁴ However, the court held that the registration of the second site related to TrendMaker Homes did not indicate a bad faith intent to profit.²⁶⁵ Maxwell registered the second domain name for the same purposes as the first, and only after the registration of the first name expired.²⁶⁶

Although the ACPA contains no commercial use requirement, the defendant's noncommercial use of the plaintiff's trademark does play a part in the ACPA analysis. Non-commercial use of the plaintiff's trademark weighs strongly in favor of the defendant as evidence of his lack of a bad faith intent to profit.²⁶⁷ Furthermore, if there is no evidence of an attempt by the defendant to sell the website to the plaintiff or a third party, it is unlikely that a court

²⁵⁸ *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 114 (D. Mass. 2002).

²⁵⁹ *Id.* at 111 & n.2.

²⁶⁰ *Id.* at 112.

²⁶¹ *Id.*

²⁶² *Id.* at 114.

²⁶³ *TMI, Inc. v. Maxwell*, 368 F.3d 433, 434-35 (5th Cir. 2004).

²⁶⁴ *Id.*

²⁶⁵ *Id.* at 440.

²⁶⁶ *Id.*

²⁶⁷ *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1124 (D. Minn. 2000).

will find the requisite bad faith intent to profit to justify liability under the ACPA.²⁶⁸

F. UDRP

As an alternative to litigation, companies may file complaints with the Internet domain name registrar and force arbitration under the terms of the Uniform Domain-Name Dispute Resolution Policy (UDRP).²⁶⁹ The ICANN requires that all domain name registrants submit to a mandatory UDRP arbitration proceeding when a markholder alleges that: (1) the registrant's domain name is identical or confusingly similar to the trademark of the complainant; (2) the registrant has no rights in the domain name; and (3) the "domain name has been registered in bad faith."²⁷⁰ The bad faith element can be satisfied by showing that the respondent registered the domain name with the intent to (1) cybersquat;²⁷¹ (2) prevent the mark holder from registering that domain name; (3) disrupt the business of a competitor; or (4) attract internet users to the website for commercial gain by creating a likelihood of confusion as to the source of the products or services found on the website.²⁷²

Unfortunately, UDRP analysis of the three aforementioned factors tends to reach inconsistent conclusions for "nearly identical facts because of the lack of binding precedent and uniform guidelines in the system."²⁷³ "This institution's unpredictability defeats its efficiency and legitimacy, as well as kills legitimate criticism in cyberspace."²⁷⁴

²⁶⁸ *Id.*

²⁶⁹ Jonathan L. Schwartz, *It's Best to Listen*, 20-APR CBA REC. 42, 44 [hereinafter Schwartz, *Listen*].

²⁷⁰ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 98.

²⁷¹ As defined above, cybersquatting occurs when the registrant of the domain name holds the domain name ransom with the intent to sell the domain name to the markholder at a significant price.

²⁷² Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 98.

²⁷³ Schwartz, *Listen*, *supra* note 269, at 44.

²⁷⁴ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 108-09.

Fortunately for gripe site operators, UDRP decisions are not binding and may be appealed to U.S. federal courts.²⁷⁵ Furthermore, UDRP panelists generally apply U.S. trademark and First Amendment law.²⁷⁶ Therefore, as the law regarding gripe sites continues to develop towards creating clear bright-line rules, UDRP decisions will become more and more consistent with U.S. trademark law.²⁷⁷

G. Summary

United States courts have been generally consistent in their application of laws and precedent in gripe site cases. This consistency has succeeded in creating bright-line rules for gripe site operators seeking to avoid liability for trademark infringement, dilution and cybersquatting.²⁷⁸ Generally, as long as a gripe site operator does not profit from the website and does not include advertisements or links to commercial websites, the defendant's use of the trademark will fall outside the scope of the Lanham Act. Moreover, as long as the gripe site operator does not attempt to sell the domain name to the trademark owner or to a third party, or register multiple domain names, it is unlikely that the plaintiff will be able to sustain a claim for cybersquatting.²⁷⁹

III. INFORMAL USE OF INTELLECTUAL PROPERTY LAW: THE CHILLING EFFECT OF CEASE-AND-DESIST LETTERS

Corporations expend significant resources to create and maintain a brand image and develop goodwill in their trademark.²⁸⁰ Because of this great investment, corporations are extremely intolerant of those who attempt to criticize and, in effect, reduce the value of their mark.²⁸¹ Trademark owners are particularly

²⁷⁵ *Id.* at 109.

²⁷⁶ *Id.* at 109 & n.282.

²⁷⁷ *Id.* at 109.

²⁷⁸ *See id.* at 90.

²⁷⁹ *See, e.g.,* Northland Ins. Cos. v. Blaylock, 115 F. Supp. 2d 1108, 1124–25 (D. Minn. 2000).

²⁸⁰ *See* Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 121; Travis, *supra* note 4, ¶ 3.

²⁸¹ *See* Travis, *supra* note 4, ¶ 3.

intolerant of Internet gripe sites. Gripe sites pose a significant threat to companies because they can spread truthful as well as untruthful information about the company with great speed and to a wide audience, which could devastate the value of a company's trademark and damage a company's reputation.²⁸² Therefore, the proliferation of gripe sites on the Internet has spawned a counter-movement of corporate quashing.²⁸³ Targeted companies have been extremely aggressive in attempting to shut down gripe sites, notwithstanding that the probability of success in a legal battle is slight.²⁸⁴

Retail and service companies are particularly concerned because consumers often search the Web for the opinions and experiences of others with regard to products and services the consumer is considering.²⁸⁵ If this search for information leads the potential consumer to a complaint website, there is a strong chance that the company will lose the potential customer.²⁸⁶ In 1996, a disgruntled customer of EPS Technologies established a website criticizing the company for its poor customer service.²⁸⁷ The web page was designed with metatags²⁸⁸ that caused it to appear ahead of the real EPS Technologies website on search engines.²⁸⁹ The company received phone calls from customers canceling their orders after discovering the gripe site.²⁹⁰ At the end of the day, EPS purported to have lost hundreds of orders as a result of the gripe site.²⁹¹

²⁸² Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 78; Martin H. Samson, *Pruning the Gripe Vine*, http://www.phillipsnizer.com/publications/articles/Article-GripeSiteSamson1-05_art.cfm (last visited Mar. 2, 2007).

²⁸³ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 71.

²⁸⁴ K. J. Greene, *Abusive Trademark Litigation and the Incredible Shrinking Confusion Doctrine—Trademark Abuse in the Context of Entertainment Media and Cyberspace*, 27 HARV. J.L. & PUB. POL'Y 609, 636–37 (2004).

²⁸⁵ See *Strategies*, *supra* note 14.

²⁸⁶ *Id.*

²⁸⁷ *Id.*

²⁸⁸ Metatags are special Web-search markers that inform a search engine as to the content of the webpage. *Id.*

²⁸⁹ *Id.*

²⁹⁰ *Id.*

²⁹¹ *Id.*

With increasing frequency, corporate trademark owners are using the language of trademark law as a weapon to chill Internet speech.²⁹² These trademark owners send threatening cease-and-desist letters to gripe site operators asserting trademark infringement, dilution, or cybersquatting.²⁹³ Naturally, the letters do not inform the gripe site operator that their use of the mark may fall under a fair use exception.²⁹⁴ The letters threaten costly litigation and massive liability based on these various intellectual property causes of action. These cease-and-desist letters serve as an extremely effective tool as they often intimidate their recipients into giving up their rights without judicial intervention.²⁹⁵ In many instances gripe site operators are coerced to shut down their Website in response to the cease-and-desist letter.²⁹⁶

Some commentators argue that it is the uncertainty in the law that permits cease-and-desist letters to be so effective when used to threaten Web publishers with costly litigation and substantial liability.²⁹⁷ But in fact, as mentioned before, courts have been consistent in their application of laws and precedent in gripe site cases.²⁹⁸ Generally, as long as a gripe site operator does not profit from the website and does not include advertisements or links to commercial websites, then the defendant's use of the trademark will fall outside the scope of the Lanham Act.²⁹⁹ Moreover, as long as the gripe site operator does not attempt to sell the domain name to the trademark owner or to a third party, or register multiple domain names, it is unlikely that the plaintiff will be able

²⁹² See Travis, *supra* note 4, at ¶ 2; Beckles & Heins, *supra* note 16.

²⁹³ See Travis, *supra* note 4, at ¶ 2.

²⁹⁴ See Beckles & Heins, *supra* note 16.

²⁹⁵ Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1200 (2006).

²⁹⁶ Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 72. See Travis, *supra* note 4, at 5–6; *Strategies*, *supra* note 14. In addition to using cease-and-desist letters, corporations often register the sucks.com version of their name in order to prevent somebody else from posting a gripe site at that domain name. See also Trigaux, *supra* note 17, at 4; Grossman, *Gripe sites raise some interesting legal issues*, Tech: Gripe Sites, <http://thetechmag.com/intex.php/news/main/931/event=view>; *Strategies*, *supra* note 14.

²⁹⁷ See, e.g., Travis, *supra* note 4, at 72.

²⁹⁸ See Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 90.

²⁹⁹ *Id.* at 96.

to sustain a claim for cybersquatting.³⁰⁰ However, this Note argues that the power of the cease-and-desist letter does not come from any uncertainty in the law, but instead results from a combination of three factors.

First, recipients of cease-and-desist letters are generally ignorant of their legal rights under trademark and First Amendment Law.³⁰¹ Because many gripe site owners are lay citizens that do not understand trademark and intellectual property law, a cease-and-desist letter often has the intended effect of coercing an individual to shut down the gripe site.³⁰² Second, recipients of these letters lack experience with the legal system.³⁰³ Third, there is often a great resource disparity between the two parties.³⁰⁴

The corporate targets of gripe sites are aware of their strategically advantageous position and use cease-and-desist letters to coerce gripe site operators into taking down their sites, even though the company is aware that their likelihood of success in court is remote.³⁰⁵ The practice has a chilling effect on the First Amendment free speech rights of gripe site operators.³⁰⁶ This result is concerning because “the potential for corporate hegemony over ideas threatens the very foundation of our free society.”³⁰⁷

IV. BRINGING THE REAL WORLD UP TO SPEED

Despite an apparent shift toward protection of consumer commentary on the Internet, cease-and-desist letters remain an effective tool for companies to silence their critics.³⁰⁸ “They know that they’re not going to win, but do it hoping that they’re going to intimidate people,” said Public Citizen Litigation Group

³⁰⁰ *Id.* at 107–08.

³⁰¹ See Beckles & Heins, *supra* note 16, at 3.

³⁰² Greene, *supra* note 284, at 637.

³⁰³ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 71.

³⁰⁴ *Id.*

³⁰⁵ *Id.*

³⁰⁶ See Beckles & Heins, *supra* note 16, at 3.

³⁰⁷ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 3, at 72 (citations omitted).

³⁰⁸ Samson, *supra* note 282.

attorney David Arkush.³⁰⁹ This practice must end because the commentary contained on consumer gripe sites is exactly the type of speech the First Amendment is designed to protect.³¹⁰ Consumer gripe sites serve as industry watchdogs.³¹¹ By acting as a soapbox to host consumer complaints, gripe sites pressure companies to improve their goods and services and provide responses to consumer complaints.³¹² Furthermore, gripe sites help the dissemination of consumer opinions and facilitate informed decisions of potential consumers.³¹³ Thus, consumers can make purchasing decisions based on a wide range of information and are not necessarily limited to a company's advertising.³¹⁴ Something must be done to address the use of cease-and-desist letters to chill the protected speech found on internet gripe sites. The balance between protection of corporate interests and allowing consumers to sound-off lies must be established—and it's possible that it may be best established beyond the shadow of the law.

How effective the cease-and-desist letter is as a tool to chill speech that is likely protected under the First Amendment as consumer commentary depends on a variety of factors, including awareness that the law may protect such speech, support from the community, financial resources, familiarity with the legal system, and the personality of the gripe site operator.³¹⁵ Generally, all courts and commentators agree that trademark law should not be used to chill speech that would otherwise be protected under the First Amendment. However, if the effectiveness of cease-and-desist letters is based on factors not addressed by trademark jurisprudence or legislation, then the solution to the chilling problem must come from elsewhere.

Cease-and-desist letters are designed to take advantage of the gripe site operators' unawareness of their legal rights under

³⁰⁹ Tresa Baldas, *Trademark Lawsuits: The Price of Online Gripping*, LEGAL INTELLIGENCER, Dec. 3, 2004, at 4.

³¹⁰ See Schwartz, *Consumer Watchdog's Bark*, *supra* note 3, at 111–12.

³¹¹ *Id.* at 76.

³¹² *Id.* at 76–77.

³¹³ *Id.* at 77.

³¹⁴ *Id.*

³¹⁵ See Tricia Beckles & Heins, *supra* note 16.

trademark and First Amendment law.³¹⁶ Therefore, educating the gripe site operators of their legal rights may empower them to resist pressure from the corporation to shut down their web page. The Fair Use Network, part of the Free Expression Policy Project, a program of the Brennan Center for Justice at NYU School of Law, has established a website specifically for this purpose.³¹⁷ The website, located at www.fairusenetwork.org, is dedicated to helping individuals, such as gripe site operators, understand and defend their rights to fair use and free expression.³¹⁸ The Network looks to create informational material and resources that are comprehensible to those who are not experts in the field of trademark law, including overviews of fair use and expressive rights. The website was launched on June 15, 2006 and its effect on the activist community has yet to be seen.³¹⁹ If this network is successful in educating gripe site operators of their legal rights under trademark and First Amendment law, it may significantly decrease the power of the cease-and-desist letter.

Furthermore, educating gripe site operators of the nature of cease-and-desist letters and their propensity to overstate the rights of the sender may also encourage recipients to ignore idle threats. It is not a stretch to assume that the best way to communicate with website operators is through the Internet. Therefore, websites such as that of Chilling Effects website may have a profound effect on the education of the typical gripe site operator.

Chilling Effects, a joint project of the Electronic Frontier Foundation and several U.S. law schools, seeks to expose copyright holders who suppress the fair use of otherwise protected material or who use the law to intimidate secondary users.³²⁰ Chilling Effects analyzes and posts hundreds of cease-and-desist

³¹⁶ *Id.*

³¹⁷ The Fair Use Network, <http://www.fairusenetwork.org> (last visited Mar. 17, 2007); The Free Expression Policy Project, *FEPP Launches The Fair Use Network*, <http://www.fepproject.org/fepp/FUEI.html> (last visited April 10, 2007).

³¹⁸ Free Expression Policy Project, *supra* note 317.

³¹⁹ *Id.*

³²⁰ Victoria Smith Ekstrand, *Protecting the Public Policy Rationale of Copyright: Reconsidering Copyright Misuse*, 11 COMM. L. & POL'Y 565, 565 (2006).

letters on its website, www.chillingeffects.org.³²¹ Chilling Effects found that out of more than 850 cease-and-desist letters it has analyzed, many of the copyright holders' claims are flawed. About thirty percent allege a weak claim for copyright infringement.³²² The Chilling Effects study "legitimizes the concern about the ever-growing population of 'copyright bullies'—content owners who create a chilling effect on the reuse of their work in the marketplace."³²³ If the same can be done with cease-and-desist letters alleging trademark infringement, dilution, and cybersquatting, then recipients may be more inclined to ignore or respond to the letter in a way other than shutting down the website.

Cease-and-desist letters are also designed to take advantage of the corporation's legal and financial assets.³²⁴ Frequently, the targets of gripe sites are large multi-national corporations with an in-house staff of attorneys paid to protect the legal interests of the corporation.³²⁵ Gripe site operators, on the other hand, are far less likely to have ready access to legal advice. Because gripe site operators are often naive to the protections provided by trademark law and the First Amendment, they are more likely to shut down their sites in response to a cease-and-desist letter than to expend the resources to retain a lawyer.

This is where *pro bono* attorneys step in. Public Citizen is the most famous organization that has stepped up to assist gripe site owners in defending their First Amendment right to maintain a gripe site.³²⁶ In the last four years, the Public Citizen Litigation Group has handled multiple lawsuits initiated against gripe site operators.³²⁷ Public Citizen has assisted the operators of gripe sites including the defendants in *Bosley v. Kremer*³²⁸ and *Taubman v.*

³²¹ *Id.*

³²² *Id.*

³²³ *Id.*

³²⁴ See Tricia Beckles & Heins, *supra* note 16. The companies do not necessarily have the same leverage in the courtroom. "The courts aren't just going to roll over because [the plaintiff] is the bigger party," said attorney Jeremy D. Bisdorf of Raymond & Prokop. Baldas, *supra* note 309.

³²⁵ See Samson, *supra* note 282.

³²⁶ Public Citizen, *supra* note 12.

³²⁷ Baldas, *supra* note 309.

³²⁸ 403 F.3d 672 (2005).

Webfeats.³²⁹ Furthermore, the aforementioned Fair Use Network intends to expand existing *pro bono* legal resources to individuals such as gripe site operators.³³⁰ Such resources may include legal services provided by law student clinical programs. Organizations such as Public Citizen are crucial to addressing the problem of cease-and-desist letters that proffer claims of trademark infringement, dilution, and cybersquatting. They empower the gripe site operator to resist the pressures from the target company to give up the website and enable the operator to mount a legal defense in support of his or her First Amendment rights.

Occasionally, when a gripe site operator receives a cease-and-desist letter from the target company, the operator will scan and post the letter on the gripe site.³³¹ More often than not, the company comes off as a bully and the letter perpetuates the image of the corporation as a heartless corporate entity.³³² This can result in a “public relations nightmare”³³³ for the targeted company and draw even more attention to the gripe site.³³⁴ If gripe site operators continue to post the cease-and-desist letters on their webpage, then the risk to the company of fanning the disgruntled consumers’ flame may outweigh the benefit of shutting down the website. For example, attorney Mark Grossman does not advise his clients to issue cease-and-desist letters to gripe site operators because of the risk that the letter will be scanned and posted on the gripe site.³³⁵ Furthermore, Virginia Richard of Winston & Strawn’s intellectual property department in New York warns that “[t]he impact [of

³²⁹ 391 F.3d 770 (2003).

³³⁰ Free Expression Policy Project, *supra* note 317.

³³¹ See *Taubman Co. v. Webfeats*, 319 F.3d 770, 772 (6th Cir. 2003); Trigaux, *supra* note 17. For example, www.amexsux.com posts all the communications between lawyers for American Express and the gripe site.

³³² See Mark Grossman, *Gripe Sites Raise Some Interesting Legal Issues*, THE TECHMAG.COM, available at <http://thetechmag.com/intex.php/news/main/931/event=view> (last visited Mar. 2, 2007).

³³³ Baldas, *supra* note 309.

³³⁴ *Id.*

³³⁵ Mark Grossman, *Gripe Sites*, http://www.ecomputerlaw.com/articles/show_article.php?article=2006_gripe_sites.

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gripe sites] overall is minimal, whereas the publicity that may arise from a lawsuit could do more damage than the site itself[.]”³³⁶

CONCLUSION

The freedom to speak critically of political institutions and private corporations is the backbone of the First Amendment right to free speech. This freedom must be protected. As the law continues to develop, and knowledge of trademark law is disseminated to the consumer activist public, the chilling effect of cease-and-desist letters will continue to decline, thus fostering a robust discourse on the quality and value of corporations and their products.

³³⁶ Baldas, *supra* note 309.