



## 801 - Doing Business on the Web: Internet Trademark & Copyright Issues

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## Faculty Biographies

### Ryan Blum

Ryan M. Blum is senior counsel at Scottrade, Inc., a leading online brokerage in Saint Louis, Missouri. He is responsible for legal and regulatory matters relating to operations, real estate, marketing, contracts, insurance, IT, and intellectual property. Mr. Blum is an active participant in guiding the strategic direction of the company.

Mr. Blum formerly served as staff attorney at HOK Group, Inc., a global architecture and design firm.

Mr. Blum is a member of the ACC and the Missouri Bar, the Bar Association of Metropolitan St. Louis.

Mr. Blum is a graduate of Saint Louis University School of Law and has an MBA from the John Cook School of Business at Saint Louis University.

### Teresa Santos

Teresa F. Santos is the associate general counsel for TheStreet.com, Inc. a leading provider of business and investment content through its news and commentary Web site, online video programming, and affiliated programs with co-founder James Cramer including Jim Cramer's Mad Money television show on CNBC. Ms. Santos also serves as a member of the company's executive management team.

Ms. Santos is responsible for all intellectual property matters for the company, including, management of the company's domain name portfolio, copyright and trademark defense, maintenance of the trademark portfolio, and IP matters related to mergers and acquisitions. In addition, Ms. Santos is responsible for corporate governance matters, securities filings, business development contracts, compliance, human resources and litigation matters.

Before joining TheStreet.com, Ms. Santos practiced with the law firm of Reed Smith LLP. Ms. Santos has also been associated with the law firm of Morrison & Foerster, the U.S. Department of Justice and the Harvard Negotiation Project.

Ms. Santos holds a B.A. from Tufts University, a M.A. from Emmanuel College, and a J.D. from Georgetown University.

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## Copyright Violations & Defenses

### ● Copyright Act of 1976

- A federal statute governing copyright protection throughout the United States of America. Under the Copyright Act, copyright protects “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”

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## Copyright Infringement on the Web

- Despite the pervasive idea that the Internet is intended to allow information to be free, legal protection for copyrighted works is thriving, even though the internet may facilitate copying and access to information.
- Republishing without permission articles or other content from Web sites also infringes copyright.
- Common occurrences on web involve copying articles from one website and “pasting” them into a blog or other Web forum
  - *Los Angeles Times v. Free Republic* (C.D.Cal.Nov.9,1999)

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## Copyright Defenses- Fair Use

- “Fair use” may include reproduction of a copyrighted work for purposes such as:
  - Criticism;
  - Comment;
  - News Reporting;
  - Teaching (including multiple copies for classroom use);
  - Scholarship; or
  - Research.
- The doctrine of fair use is a fairly complex area of law. Fair use operates as a defense to a claim of copyright infringement. In deciding whether an alleged copyright infringer has made fair use of a copyrighted work, courts will examine a variety of factors, which include, but are not necessarily limited to:
  - The purpose and character of the use, including whether such use is of commercial nature or is for nonprofit educational purposes;
  - The nature of the copyrighted work;
  - The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
  - The effect of the use upon the potential market for or value of the copyrighted work.

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## Copyright Defenses: First Amendment

- Claim that the First Amendment protects right to post copies of articles on the a Web site. Without the ability to post entire articles, some have asserted asserted that visitors to its site would not be able to express their opinions about media coverage of current events and politics, as well as their views concerning omissions and biases evident in the articles. The court rejected this defense for two reasons.
- First, copyright law promotes free expression by establishing a marketable right to use of one's expression. Copyright thus creates and economic incentive to create and disseminate ideas. Copyright law also promotes the countervailing First Amendment right to refrain from speech by protecting the owner of a copyrighted work from being forced to publish it.
- Second, the court found that Free Republic failed to show that copying entire news articles is essential to allow visitors to its Web site to express their opinions and criticisms.
- **BEST PRACTICE:** Courts have made clear that republication of copyrighted materials, without permission and without a valid defense to infringement, violates copyright law, **even when done in a public discussion forum**. This is important because news articles—and other copyrighted texts—are very frequently republished online in Usenet newsgroups, in online bulletin boards, on Web sites, and in e-mail lists. Always seek permission whenever possible.

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## Copyright Defenses: Waiver, Implied License and Misuse of Copyright

- *Waiver Defense*
- Under copyright law, waiver or abandonment of copyright occurs only if the owner of a copyright intends to surrender his, her, or its rights in the copyrighted work.
- *Implied License Defense*
- However, courts have found implied licenses only in limited circumstances where one party created a work at another party's request and gave it to the other party, intending that the recipient of the work copy and distribute the work.
- *Misuse of Copyright Defense*
- The defense of copyright misuse prohibits a copyright holder from securing an exclusive right or a limited monopoly that the copyright law has not granted.
- Most of the court decisions that recognize affirmative defense of copyright misuse involve unduly restrictive licensing schemes. While unilateral refusal to license a copyrighted work may occasionally give rise to a claim to misuse, the simple desire to exclude others is likely to be a valid business justification for any immediate harm that the exclusion causes to consumers.

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## Copyright and Hyperlinking

- "hyperlinking does not itself involve a violation of the Copyright Act...since no copying is involved." The court noted that a visitor to the Web site is automatically transferred to "the particular genuine web page of the original author." Therefore, no copying occurs as a result of the link.
  - *Ticketmaster Corp., et al. v. Tickets.com, Inc*
- However, hyperlinking isn't always permissible—do not inadvertently become a defendant for contributory infringement for linking to websites that are copyrighting a third party's material
- At this point, copyright law as applied to linking between Web pages is developing but is still quite new. Until a coherent body of law emerges about linking in relation to copyright law, it remains a wise practice to obtain permission from the owners of Web sites to which you wish to link. Finally, *never* link to a webpage that contains material that you know or suspect to have been pirated from its copyright owner and have verified that the person granting the permission is truly the owner of the copyright.
- **BEST PRACTICE** to avoid such situations: ALWAYS EXECUTE LINKING LICENSE AGREEMENTS which contain proper representation, warranties and accompanying indemnities. (A sample Linking Agreement is contained in the supplemental materials)

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## Liability for ISPs and Other "Hosts"

- AOL, Earthlink, Craigslist, Weblogs, YouTube, MySpace, Friendster
- To what extent can these third party hosts who allow the public to post content be held responsible for copyright infringement?
- Internet Service Providers (ISPs) face special problems in the area of copyright law. The ISPs have little control over the activities of any particular subscriber at any given moment. However, despite this lack of control, an ISP or other online service could be held liable for some actions of its subscribers, such as copyright infringement.
- **Statutory Reform: Protection for ISP's**
- In response to lobbying by ISP's, Congress has passed the Online Copyright Infringement Liability Limitation Act (the Act). Many ISP's now include in their subscriber contracts indemnification provisions, whereby their subscribers agree to defend, hold harmless, and indemnify the ISP from any claims of intellectual property infringement, including infringement of copyright.

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### Liability for ISPs and Other “Hosts” The Online Copyright Infringement Liability Limitation Act provides:

● **General Requirements for Protection from Liability**

- As an initial matter, to protect themselves from liability, all service providers must:
- Adopt and reasonably implement a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers of copyrights.
- Inform their subscribers of the copyright infringement policy, and
- Accommodate and not interfere with standard technical measures that copyright owners use to identify or protect copyrighted works.
- The Act defines “standard technical measures” as those technical measures that:
- Have been developed pursuant to broad consensus of copyright owners and service providers in an open, fair, voluntary, multi-industry standards process;
- Are available to any person on reasonable and nondiscriminatory terms; and
- Do not impose substantial costs on service providers or substantial burdens on their systems or networks.

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### Liability for ISPs and Other “Hosts” The Online Copyright Infringement Liability Limitation Act provides:

● **Specific Requirements for Protection from Liability**

- In addition to these general measures, under certain circumstances service providers must take further steps to avoid liability for infringements of copyright that others commit. The Act sets forth specific conditions for avoiding liability associated with the following:
- Transmissions
- Temporary storage
- Storage of materials by subscribers
- Linking to infringing materials; and
- Removing or disabling access to materials that someone claims infringes his, her, or its copyright.
- (iv) Limitations on Liability for Linking to Infringing Materials
- Copyright Office of the Library of Congress to receive notifications of claims of copyright infringement.

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## Liability for ISPs and Other “Hosts” The Online Copyright Infringement Liability Limitation Act provides:

- The Act also protects service providers from liability for copyright infringement that could result from the service providers' linking to infringing materials, by means of "information location tools," of which the Act provides several examples: "directory, index, reference, pointer, or hypertext link." Presumably, the Act would also include under this term the following Web-based entities and services, because each of them is a tool for locating information:
  - Search engines,
  - All in one search engines,
  - Meta-search engines,
  - Meta-directories, and
  - Meta-indices.
- The limitations on liability for linking to infringing material by means of "information location tools" are subject to conditions comparable to the conditions a service provider must meet to avoid liability for its subscribers' storage of copyrighted materials. First, the service provider must not have actual or constructive knowledge that the linked materials infringe someone's copyright. Additionally, if the service provider learns that the linked materials infringed a copyright, it must act expeditiously to remove or disable access to the infringing materials.
- Second, the service provider must not receive any financial benefit directly attributable to the alleged infringement, in cases in which the service provider has the right and the ability to control the activity causing the infringement.
- Third, if the service provider receives proper notice of a claimed copyright infringement (as set forth in Section 512(c)(3) of the act; see the discussion in Section C.2.b(iii) above), it must expeditiously remove or disable access to the allegedly infringing material.
- Fourth, the service provider must designate an agent in the

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## Digital Millennium Copyright Act (DMCA)

- 1998 federal law providing, among other things, safe harbor to ISP's that promptly take down infringing content
- <http://www.copyright.gov/legislation/dmca.pdf>

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Digital Millennium Copyright Act

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# “Safe Harbor” Requirements

## ● Conditions:

- ISP has NO actual knowledge that the material is infringing [§512(c)(1)(A)(1)]
- Upon proper notice, must act swiftly to remove - - or block access to - - the material [§512(c)(1)(A)(2) and §512(c)(1)(C)]
- Does not receive a direct financial benefit
- Adopts and implements a reasonable policy
  - Designated Agent

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## Google Digital Millennium Copyright Act

Home

About Google

Terms of Use

Privacy Policy

Search

Product Specific DMCA

- All Services
- AdSense
- Analytics
- Books
- Blogger
- Book Search
- Checkout
- Code Search
- eBooks
- eBooks & Screenshots
- Finance
- Goggles
- Google
- Image Search
- Maps
- News
- Notebook
- Orkut
- Picasa
- Picasa Web Albums
- Product Search
- Video
- All other products

**Digital Millennium Copyright Act**

It is our policy to respond to clear notices of alleged copyright infringement. This page describes the information that should be present in these notices. It is designed to make submitting notices of alleged infringement to Google as straightforward as possible, while retaining the number of notices that we receive. Full and accurate information is crucial to our ability to respond to notices. The form specified below is consistent with the form suggested by the United States Digital Millennium Copyright Act (the text of which can be found at the U.S. Copyright Office Web Site (<http://www.copyright.gov>)) but we will respond to notices of this form from other jurisdictions as well.

Regardless of whether we may be liable for such infringement under local country law or United States law, our response to these notices may include removal or disabling access to material claimed to be the subject of infringing activity and/or terminating subscribers, if we remove or disable access in response to such a notice, we will make a good faith attempt to contact the owner or administrator of the alleged site to inform that they may have a counter-claim. We may also document notices of alleged infringement or other site data. Please note that in addition to being forwarded to the actions who provided the allegedly infringing content, a copy of this legal notice may be sent to a third party auditor for publication and annotation. As such, your letter (with your personal information removed) may be forwarded to United Effects Publications, which publishes it on the Internet. You can see an example of such a publication at <http://www.chillingeffects.org/dmca517/notice.us2/Notice.html>.

**Infringement Notification for Web Search and all other products**

To file a notice of infringement with us, you must provide a written communication (by fax or regular mail -- not by email, except for prior agreements) that sets forth the items specified below. Please note that you will be liable for damages (including costs and attorneys' fees) if you knowingly misrepresent that a product or service is infringing your copyright. Indeed, in a recent case (see below [http://www.copyright.gov/ipod/notice/peterson\\_v\\_dishco/](http://www.copyright.gov/ipod/notice/peterson_v_dishco/)) for more information), a company that sent an infringement notification seeking removal of content material that was protected by the fair use doctrine was ordered to pay such costs and attorneys' fees. The company agreed to pay over \$100,000. Accordingly, if you are not sure whether material available online infringes your copyright, we suggest that you first contact an attorney.

To expedite our ability to process your request, please use the following form (including section numbers):

1. Identify in sufficient detail the copyrighted work that you believe has been infringed upon (for example: "The copyrighted work at issue is the text that appears on [http://www.legal.com/legal\\_page.html](http://www.legal.com/legal_page.html)") or other information

<http://www.google.com/dmca.html>

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## DMCA Notice & Takedown – Section 512 (OCILLA)

- Send written notification of claimed infringement to SP's agent
- Include [§512(c)(3)(A)(i-vi)]:
  - (i) A physical or electronic signature of a person authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.
  - (ii) Identification of the copyrighted work claimed to have been infringed, or, if multiple copyrighted works at a single online site are covered by a single notification, a representative list of such works at that site.
  - (iii) Identification of the material that is claimed to be infringing or to be the subject of infringing activity and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material.
  - (iv) Information reasonably sufficient to permit the service provider to contact the complaining party, such as an address, telephone number, and, if available, an electronic mail address at which the complaining party may be contacted.
  - (v) A statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law.
  - (vi) A statement that the information in the notification is accurate, and under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.

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## Practical Solutions

- Develop procedures to identify and challenge use by others
- Designate a POC at your company
- Engage assistance from a tech vendor
  - Monitor the Web
  - Automate "Cease & Desist" letters

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## Cease & Desist

- Sent to the infringer – ISP or registrar
  - Contract with 3<sup>rd</sup> party to automate
  - “WHOis” search
- Verifiable delivery method
- Send 2<sup>nd</sup> Notice if no response after a few weeks – then escalate
- Start out informal and work up
  - UDRP
  - Equitable Relief – file action in federal or state court

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## Sample Letter

Dear Sir or Madame:

\_\_\_\_\_, an anti-fraud and security company, is under contract to assist [Your Company] in preventing or terminating online activity that targets, or may potentially target [Your Company's] clients as potential fraud victims.

[if to ISP] We have been made aware that you appear to be providing Internet Services to a site which is abusing [Your Company's] brand. This site, [www.xxx.yyy](http://www.xxx.yyy), not only violates [Your Company's] copyright, trade marks and other intellectual property rights, but may also become a host to a phishing attack or other fraudulent scams against [Your Company's] clients.

[if to registrar] We have been made aware that a domain name which abuses [Your Company's] trademark has been registered with you. This domain, [www.xxx.yyy](http://www.xxx.yyy), not only violates [Your Company's] copyright, trade marks and other intellectual property rights, but may also become a host to a phishing attack or other fraudulent scams against [Your Company's] clients.

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## Sample Letter (cont.)

Please take all necessary steps to immediately shut down the fraudulent website, terminate its availability to the Internet and discontinue the transmission of any e-mails associated with this website.

We understand that you may not be aware of this improper use of your services and we appreciate your cooperation.

We specifically would ask that you also take the following actions (if relevant or possible):

- Please provide us with a tar/zip file of the source code for this site, so that we may analyze it to help prevent further attacks.
- If any customer data has been captured that is stored on your systems or equipment, please send us that data so that the customers to whom that data relates can be notified and take steps to protect their credit.
- Please provide a copy of any records you maintain that indicate the name, contact information, method of payment or similar information that may be useful in helping learn the identity and location of the customer for whom the website has been operated.

Thank you for your cooperation to prevent and terminate this fraudulent activity.

Sincerely,

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## Establishing Enforcement

- Necessary due to internet presence of your business, from marketing to customer activity
- Relatively inexpensive
- Be proactive
  - Set up internal program – admins. in Legal and/or IT
  - Consult with anti-fraud vendors

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## Brand Protection Services

- Scan the Web for your URL's (24x7)
- Monitor internally via a dashboard
- Take action against brand abuse
  - Contact relevant ISP's or email provider to shut down fraudulent sites, email accounts, and initiate cease & desist procedures
  - Monitor suspicious sites – “spoofing”

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## Domain Names, URLs and Search

- How to Buy and Sell Domain Names
  - use Domain Name Transfer Agreements when buying and selling
  - use an escrow agent to assist in the transfer
  - use a reputable registrar and try to use the same one for all your company's URLs- it will create ease in additional purchases and transfers as well as maintaining your company's URL portfolio
- Trademark Impact on URLs
  - URLS are intellectual property
  - trademark dilution can result from trademarked word being used in a URL
  - entities with registered trademarks will have additional weight in attaining corresponding URLs because they have been otherwise using the trademarks in commerce.

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## Search Engines- Buying Keywords

- Currently courts are split on the issue
- Generally, these “adword” services allow persons to purchase words, usually trademarks or tradenames, that will trigger the placement of advertisements or website links on search page results when those terms are searched
- Often competitors will purchase words associated with the trademarks or tradenames of other companies naturally leading to some diversion of web traffic to the sites of the companies who purchased the words rather than those companies with the trademark
- Case law in the United States to date has not fully reconciled whether this practice constitutes “use in commerce” such that it qualifies as impermissible trademark use and infringement
  - *Government Employees Insurance Company v. Google, Inc.* (E.D. Va. 2004): court held that simply purchasing the words without display of the underlying trademark did not rise to the level of use in commerce necessary for liability under the Lanham Act. See also *Merck & Co v. Mediplan Health Consulting* (S.D.N.Y. 2006)
  - *Edina Realty, Inc. v. TheMLSonline.com* (D. Minn 2006): court held that there was the requisite use in commerce by the mere transaction of purchasing the keyword because the intent was to commercially benefit.
- **BEST PRACTICE:** Continue to send cease and desist letters when competitors purchase your trademarks as keywords emphasizing the commercial benefit of these adwords and the intent behind purchasing the words. Avoid purchasing keywords that are known trademarks of others.

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## Cybersquatting - definition

- Registration of a domain name that is identical (or very similar) to a known trademark or a famous name owned by another...
- With the intent to:
  - Sell the name to the owner
  - Redirect traffic to a competitor or a cause
  - Use for commercial purposes (possible First Amendment defense if non-commercial use)

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## Cybersquatting - defenses

- Anticybersquatting Consumer Protection Act (ACPA) - 2000
- Uniform Domain Name Dispute Resolution Policy (UDRP) - earliest cases in 1999

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## Purpose of ACPA & UDRP

- Stop misappropriation and misuse of internet domain names
- Curb “rampant cybersquatting”
- Provide internet reliability - reduce consumer’s confusion about the source and sponsorship of web pages.
- Protect trademark owners from loss of goodwill.

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## ACPA – 15 USC §1125

- Signed into law on November 29, 2000
- Provides a civil cause of action under the Lanham Act (§43(d))
- Protects owners of distinctive or famous marks
- Protects personal names
- Must file in US district court
- US has jurisdiction over **.com .org & .net** (top level domain registry is Network Solutions in VA)

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## ACPA Elements

- Defendant Registered, trafficked in **or** used a domain name (registration is actionable),
- Identical or “confusingly similar” to plaintiff’s trademark (or dilutive if famous mark)
- Plaintiff’s mark was “distinctive” at the time of defendant’s registration (or famous or reserved for Red Cross or US Olympics)
- Defendant had a “bad faith” intent to profit from the mark.

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## ACPA “Confusingly similar” factors

- Strength of owner’s mark
- Similarity between owner’s mark & domain name
- Degree to which products compete
- Alleged infringer’s intent to pass goods off as those of trademark owner
- Incidents of actual confusion
- Purchaser care that can eliminate any likelihood of confusion. (Faegre v Purdy)

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## ACPA “distinctive” factors (or how to protect your trademark)

- “The degree of inherent or acquired distinctiveness of the mark”
- The duration and extent of use of the mark
- The duration and extent of advertising & publicity of the mark (advertise your mark)
- The geographical extend of the trading area
- The Channels of trade for goods & services

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## ACPA “distinctive” factors (or how to protect your trademark)

- The degree of recognition of the mark in trading areas and commonality in channels of trade (between trademark and domain)
- The nature & extent of use by same or similar marks by others (police your mark)
- Whether your mark is registered (this also acts as an absolute defense)

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## ACPA's nine “Bad Faith” factors

- Trademark or other IP rights registrant has in the domain name
- The extent domain name matches or consists of registrant's legal name
- Registrant's prior use of the domain name for goods & services

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## ACPA “Bad Faith” factors (cont’d)

- Fair use, or bona fide non-commercial use of the domain name & underlying mark
- Intent to divert customers to harm goodwill, tarnish, infringe or harm trademark owner
- Attempts to sell to the rightful owner or prior conduct indicating a pattern of selling names

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## ACPA “Bad Faith” factors (cont’d)

- Accuracy of information provided in registration
- Registration of multiple domain names that are similar to other marks
- The extent a trademark is distinctive or famous

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## Benefits & Burdens of ACPA

- Benefits
  - Access to Federal court (usually parties settle)
  - Injunction (take domains off the market fast)
  - Choice of damages
- Burdens
  - Federal court (expensive, time consuming)
  - Fairly forgiving of legitimate use

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## Another choice ... UDRP

- Faster
- Cheaper
- Limited to:
  - Transfer domain
  - Close it down

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## Dispute Resolution using UDRP

- Internet Corporation for Assigned Names and Numbers (ICANN) – Marina Del Rey, CA
- World Intellectual Property Organization (WIPO) - Geneva Switzerland
- Uniform Domain Name Dispute Resolution Policy (UDRP) – drafted by ICANN & WIPO
- National Arbitration Forum (NAF)

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## Dispute Resolution Providers

- World Intellectual Property Organization (WIPO)
- National Arbitration Forum (NAF)
- CPR Institute for Dispute Resolution (CPR)
- Asian Domain Name Dispute Resolution Centre (ADNDRC)

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## UDRP dispute statistics

- Number of disputes filed with WIPO increased 25% between 2005 and 2006 (1456 to 1824) and 15% in first half of 2007 (1035 to 1226)
- Disputes filed first seven months of 2007 total *more than the number of disputes filed for the years 2002, 2003, or 2004.* (1226)
- At the current filing rate, the number of disputes filed in 2007 will exceed those filed in any other year since UDRP began. (est. 2100).

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## WIPO's Major Concerns for the future

- Automatic registration
- Tasting period (five day free registration)
- New registrars
- New generic Top Level Domains

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## UDRP 4(a) Elements

- Domain name is identical or confusingly similar to a trademark, and
- Registrant has no rights or legitimate interests in the domain name, and
- Registrant registered name and is using it in “bad faith”



## UDRP 4(b) Bad Faith

- Circumstances that evidence “registration and use of a domain in bad faith - domain registered:
  1. primarily for the purpose of selling
  2. to prevent mark owner from using it
  3. to disrupt a competitor’s business
  4. to create confusion



## ACPA vs. UDRP

- Results
- Elements
- Benefits & Limitations

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## Result comparison

- ACPA
  - Choice between actual or statutory damages
  - Transfer the name
- UDRP
  - Transfer ownership
  - Delete names

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## Element comparison

- ACPA
  - Identical, confusingly similar or dilutive
  - Used in commerce
  - Bad Faith – nine factors
- UDRP
  - Identical, confusingly similar
  - No legitimate interest
  - Bad Faith – four factors

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## ACPA Benefits & Limitations

- Injunction
- Possible damage awards – plaintiff may elect at any time before final judgment:
  - Actual (court's discretion) –
    - Defendant's profits (defendant need only show revenue, plaintiff must prove expenses)
    - Up to three times actual damages
    - Costs (court may award reasonable fees in exceptional cases)
  - Statutory (court's discretion) – award ranges from \$1,000 - \$100,000 per domain name

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## ACPA Benefits & Limitations (cont'd)

- Most squatters settle early in the lawsuit
- Either party may initiate ACPA action anytime during a UDRP proceeding
- Limitations
  - Slow
  - Expensive

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## UDRP Benefits & Limitations

- Fast (approximately three months)
- Inexpensive (compared to lawsuit)
- Limitations
  - No injunctions
  - No damages
  - No discovery
  - Not binding on courts

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## Conclusion – protect your online IP

- Create unique marks (BOLO trac)
- Register all trademarks with the USPTO
- Use marks consistently and often
- Maintain records and examples of all advertising, press releases, and web sites that use your name, trademark or slogan
- Actively protect marks from infringement.

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## Conclusion – protect your online IP

- Register all domain names
  - Trademarks
  - “-” and “.” variations
  - “sucks” sites
  - Singular & plural
  - Common misspellings
  - Name + product type (bankmortgage.com)

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## Conclusion – protect your online IP

- register important domains prior to:
  - Launch of new product
  - Merger
  - Name changes
- Pay attention to new gTLDs
  - .jobs. – employment related sites
  - .mobi – mobile devices
  - .travel – travel related services
  - .post – postal services
  - .tel – telephone to internet

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## Conclusion – protect your online IP

- Register all relevant Country Code Top Level Domains (ccTLD)
  - .tv (Tuvalu) - used for tv & entertainment
  - .in (India) – used for internet
  - .la (Laos) – used for Los Angeles
  - .ws (Western Samoa) – used for website
  - .fm (Federated States of Micronesia) – used for FM radio stations

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## Conclusion – protect your online IP

- Use long-term, tamper-resistant registration to lock in domain names
- Register dangerous and near-names
- Monitor registrations for improper use of your trademark, brand, and slogans.
- Watch for traffic diversion sites
- Know when ownership changes.

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## Conclusion – protect your online IP

- Detect fraud & investigate immediately
  - Use of company name
  - Plays or profits on consumer trust or lack of technical knowledge.
- Collect evidence (screen captures, logging sites <http://www.archive.org/web/web.php>)
- Create playbook for administrative, legal or technical response.

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## Conclusion – protect your online IP

- Take quick action to deter or shut-down cybersquatting sites.
- Warn or prevent customers from reaching sites.
- Document all costs, damages, lost “hits”, expenses to pursue and revenues (if any) generated by the pirating site.

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## Conclusion – protect your online IP

- Know the benefits & limitations of the ACPA and the UDRP.
- Questions .... ???

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