

DOMAIN NAMES AT THE INTERSECTION OF FREE SPEECH AND TRADE-MARK LAW ON THE INTERNET

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This article discusses the intersection of trade-mark law and the freedom of speech in the context of Internet domain names. A domain name is a more easily identifiable reference for a long numerical Internet Protocol address (which is used to identify a particular website). The relevance of a domain name in the context of free speech arises where someone chooses a domain name which comprises the trade-mark or trade name of another for a website which criticizes or otherwise comments on the owner of the trade-mark or trade name. The most frequently encountered examples of such activity are cybergripping, the identification of a website by the domain name of the type <trademarksucks.com>, and cybercriticizing, the identification of a website by the domain name <trademarkvariation.com>, where, in each case, the website operator has no permission to use the trade-mark or trade name and criticizes the trade-mark or trade name owner. A more recent development is the use of such a domain name to identify a blog site. The issue is whether one can adopt such a domain name for a website that criticizes the owner of the trade-mark or trade name without violating rights in the trade-mark or trade name comprised within the domain name.

The article considers decisions of United States courts as well as those in Canada. The article also considers relevant decisions under the World Intellectual Property Organization's *Uniform Dispute Resolution Policy* (UDRP) and the approach likely to be adopted under the Canadian Internet Registration Authority's *CIRA Dispute Resolution Policy* (CDRP) for .ca domain names.¹

1. FREEDOM OF EXPRESSION

The constitutions of both Canada and the United States expressly provide for the freedom of expression.

(A) *Canada*

The *Canadian Charter of Rights and Freedoms* provides that everyone has the "freedom of thought, belief, opinion and expression, including freedom of the press

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¹ For further information on these organizations and their policies, see online: <www.wipo.org> and <www.cira.ca> respectively.

and other media of communication”.² The *Charter* only applies to government action and does not apply to private litigation completely divorced from any connection with government.³ Private litigants may only invoke the *Charter* to attack legislation on the basis that the legislation relied on is contrary to the freedom of expression. However, where legislation or the common law creates private commercial rights, these rights must be interpreted consistently with charter values, including the right of freedom of expression.⁴

The Supreme Court of Canada has broadly interpreted the *Charter's* freedom of expression provisions. Freedom of expression protects any activity that conveys a meaning and includes the right to send and receive that information.⁵ The provision extends protection to all types of content and to its many different forms of expression.⁶ Commercial expression is protected and has substantial value and social importance. Freedom of expression protects the right to express dissatisfaction with commercial enterprises, including counter-advertising, provided the expression is not defamatory. Consumers may express frustration or disappointment with goods or services and may share their concerns with other consumers and try to warn them against the practices of a business.⁷

However, the *Charter* recognizes that values conflict and that the government must place some limits on fundamental rights.⁸ The extent to which commercial expression is protected depends on: (i) the purpose of the legislation restricting the expression and whether it is pressing and substantial; (ii) the extent to which it is rationally connected to achieving its objective; (iii) whether it minimally impairs commercial expression; and (iv) whether the deleterious effects of the restriction outweigh the benefits.⁹ It is more difficult to justify infringing expression that is not related to the core values of the *Charter* right, including truth, participation in the political process and individual self-fulfillment.¹⁰

² *Constitution Act, 1982, Part I of the Constitution Act, 1982* being Schedule B to the *Canada Act 1982* (U.K.), 1982, c.11 [*Charter*].

³ *R.W.D.S.U v. Dolphin Delivery Ltd.* [1986] 2 S.C.R. 573.

⁴ Flaherty, Pat and Jana Stettner, “Freedom of Expression: The Growing Implication for Commercial Enterprise”, Intellectual Property Institute of Canada, Annual Meeting, 13 October 2005.

⁵ See *Irwin Toy Ltd. v. Quebec (Attorney General)* [1989] 1 S.C.R. 927 [*Irwin Toy*]; and *Edmonton Journal (The) v. Alberta (Attorney General)* [1989] 2 S.C.R. 1326.

⁶ *Ford v. Quebec (Attorney General)* [1988] 2 S.C.R. 712; *Irwin Toy, ibid*; and *RJR MacDonald Inc. v. Canada (Attorney General)* [1994] 1 S.C.R. 311.

⁷ For further development of the protection of commercial expression, see *R. v. Guignard*, [2002] 1 S.C.R. 472 [*Guignard*].

⁸ *Hill v. Church of Scientology* [1995] 2 S.C.R. 1130.

⁹ *R. v. Oakes* [1986] 1 S.C.R. 103.

¹⁰ For example, *R. v. Butler* [1992] 1 S.C.R. 452.

In the context of trade-mark issues, the *Trade-marks Act*¹¹ and the common law tort of passing off should not be interpreted so as to violate an individual's right to freedom of expression.¹² Passing off is based on a misrepresentation by a person resulting in damage to another person who has goodwill or reputation symbolized by a trade-mark or trade name. However, the *Charter* does not confer the rights to use private property in the service of freedom of expression.¹³ For example, expression in the form of a political spoof or parody is not a defence to an action for depreciation of the value of goodwill in a registered trade-mark.¹⁴

(B) *United States*

In the United States, freedom of speech is guaranteed by the First Amendment to the Constitution and is extended to both individuals and other entities such as corporations.¹⁵ The First Amendment supersedes all federal and state laws and is binding on the courts.¹⁶ Protection is extended to all forms of speech including ideas, expressive conduct, artistic speech, and commercial speech.¹⁷ Commercial speech, however, does not receive the same level of protection.¹⁸ Not surprisingly, there are a significant number of decisions in the United States relating to the relationship between the unauthorized use of trade-marks and the freedom of speech.

Any factual, philosophical, political, ideological or other criticism of a business' practice is constitutionally protected, provided some factual basis underlies the criticism.¹⁹ However, a person has no First Amendment right to make a

¹¹ *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended [TMA].

¹² For example of a passing of decision, see *British Columbia Automobile Association v. Office and Professional Employees Union, Local 378* (2001), 10 C.P.R. (4th) 423 (British Columbia Supreme Court) discussed in section 2(b) below [B.C. Auto. Association].

¹³ *Compagnie Générale des Etablissements Michelin-Michelin Cie v. National Automobile, Aerospace, Transportation and General Workers Union of Canada (CAW – (Canada))* (1996), [1997] 71 C.P.R. (3d) 348 (Federal Court, Trial Division) [*Compagnie Générale*].

¹⁴ *Source Perrier (Société Anonyme) v. Fira-Less Marketing Co. Ltd.* (1983), 70 C.P.R. (2d) 61 (Federal Court, Trial Division); and *Natural Footwear Ltd. v. Schwarz* (1986), 12 C.P.R. (3d) 84 (Ontario High Court).

¹⁵ First Amendment to the United States Constitution [First Amendment]. For example, *First National Bank of Boston v. Bellotti* 435 U.S. 765 (1978).

¹⁶ For example, *New York Times Co. v. Sullivan* 376 U.S. 254 (1964).

¹⁷ For an example of ideas as a form of protected speech, see *R.A.V. v. City of St. Paul, Minnesota* 505 U.S. 377 (1992); of expressive conduct, see *Texas v. Johnson* 491 U.S. 397 (1989); of artistic speech, see *ETW Corp. v. Jireh Publishing, Inc.* 332 F. 3d 915 (C.A. 6 2003); and of commercial speech, see *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council Inc.* 425 U.S. 748 (1976) and *Hoffman v. Capital Cities/ABC, Inc.* 255 F. 3d 1180 (C.A. 9 2001).

¹⁸ For example, *City of Cincinnati v. Discovery Network, Inc.* 507 U.S. 410 (1993); *Central Hudson Gas & Electricity Corporation v. Public Service Commission of New York* 447 U.S. 557 (1980) [*Central Hudson*]; *Re R.M.J.* 455 U.S. 191 (1982); and *Hoffman v. Capital Cities/ABC, Inc.*, *supra* note 17.

¹⁹ For example, *Texas Beef Group v. Winfrey* 201 F. 3d 680 (C.A. 5 2000).

misleading use of a trade-mark of another person to criticize the latter.²⁰ While, in trade-mark infringement claims, courts attempt to balance the competing values of freedom of speech and preventing consumer confusion, the First Amendment protects speech critical of a business or its practices from tarnishment claims which arise under dilution law.²¹ Dilution is the tarnishing or blurring of a trade-mark through a use which does not necessarily confuse the public as to source. Therefore, classifying speech as commercial or non-commercial may be crucial in a trade-mark claim since non-commercial speech and mixed commercial/non-commercial speech are expressly exempted from liability for dilution.²² The mere fact that there is a commercial aspect to expression does not mean that the expression is commercial speech.²³ However, there is no broad protection for advertising which links a product to a current public debate.²⁴

Political speech may be protected under the First Amendment. If no likelihood of confusion results, even a prominent appropriation of a trade-mark does not result in trade-mark liability.²⁵ However, if the use of a trade-mark of another gives rise to a substantial likelihood of confusion, trade-mark infringement liability attaches regardless of the political context.²⁶

Parody implicates free speech interests.²⁷ A parody must convey two simultaneous and contradictory messages, that it is the original but that, at the same

²⁰ For example, *Coca-Cola Co. v. Purdy* 72 U.S.P.Q. 2d 1305 (C.A. 8 2004) [*Coca-Cola*].

²¹ For an example of balancing value of freedom of speech and preventing customer confusion, see *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.* 886 F. 2d 490 (C.A. 2 1989) [*Cliffs Notes*]; For examples of the First Amendment protecting speech critical of a business or its practices from tarnish claims, see *Bally Total Fitness Holding Corp. v. Faber* 29 F. Supp 2d 1161 (C.D. Cal. 1998) [*Bally*]; *Northland Insurance Companies v. Blaylock* 115 F. Supp. 2d 1108 (D.C. Minn.) and *Mattel, Inc. v. MCA Records, Inc.* 63 U.S.P.Q. 2d 1715 (C.A. 9 2002) [*Mattel*]; and for an example of a state dilution claim, see *L.L. Bean, Inc. v. Drake Publishers, Inc.* 811 F. 2d 26(C.A. 1 1987) [*L.L. Bean*].

²² For an example of commercial speech classification see *Jews for Jesus v. Brodsky* 159 F. 3d 1351 (C.A. 3 1998) [*Jews for Jesus*], affirming 993 F. Supp. 282 (D.N.J. 1998); and *Planned Parenthood Federation of America, Inc. v. Bucci* 42 U.S.P.Q. 2d 1430 (S.D.N.Y. 1997) [*Planned Parenthood*]. For non-commercial speech statutory exemptions see 15 U.S.C. § 1125(c) and § 1127. For an example of a mixed commercial/non-commercial speech exemption see *Mattel, ibid*.

²³ For example, *Bolger v. Youngs Drug Products Corp.* 463 U.S. 60 (1983); *Bigelow v. Virginia* 421 U.S. 809 (1975); *Ginzburg v. United States* 383 U.S. 463 (1966); and *Thornhill v. Alabama* 310 U.S. 88 (1940).

²⁴ For example, *Central Hudson, supra* note 18.

²⁵ For example, *MasterCard International Inc. v. Nader 2000 Primary Committee, Inc.* 2004 WL 434404 (S.D.N.Y. 2004).

²⁶ For example, *MGM-Pathe Communications Co. v. Pink Panther Patrol* 774 F. Supp. 869 (S.D.N.Y. 1991).

²⁷ For example, *New York Stock Exchange, Inc. v. New York, New York Hotel, LLC* 69 F. Supp. 2d 479 (S.D.N.Y. 1999) [*New York Stock*], reversed on other grounds, 293 F. 3d 550 (C.A. 2 2002).

time, it is not the original and is instead a parody.²⁸ To the extent that it does only the former but not the latter, it is not only a poor parody but is also vulnerable under trade-mark law since the user will be confused.²⁹ Therefore, the courts tend to insist on a strict application of the likelihood of confusion requirement in trade-mark disputes involving parodies. If a person's parody reference to the trade-marks of another creates no more than a moderate likelihood of confusion, trade-mark liability may be avoided.³⁰ However, where a parody of a trade-mark is so similar to the original mark that consumers may easily be confused because they cannot tell it is a parody, liability is found.³¹ A parody that is merely a pretext for commercial exploitation of another's trade-mark is not protected.³² Similarly, if the use of another person's trade-mark is irrelevant to the point of the parody, and the parody could have been made just as effectively without using the mark, the parody is not protected.³³

2. CYBERGRIPING

Cybergripping is the act of registering and using a domain name in the form of <trade-marksucks.com> or <companynamesucks.com> for a website that criticizes the owner of the trade-mark or name or its goods, services or business. While the right to fairly criticize a trade-mark owner is entrenched, an issue arises regarding the right of the registrant to do so by attracting attention to its website by using a domain name which includes the trade-mark or trade name of the owner without permission. There has not yet been any Canadian decision on cybergripping, but there have been a number of United States decisions.

(A) *United States Decisions*

In the United States, cybergripping may be free speech protected by the First Amendment. Cybergripping has been held not to incur liability for a trade-mark cause of action provided that the activity is not commercial.³⁴ For example, an action about a forum for complaints against a business which used a particular trade-mark at a website with the domain name <trademarksucks.com> was dismissed because there was no likelihood of confusion, and there was no dilution because the

²⁸ For example, *Cliffs Notes*, *supra* note 21.

²⁹ For example, *Mutual of Omaha Insurance Co. v. Novak* 775 F. 2d 247 (C.A. 8 1985), *certiorari* dismissed 488 U.S. 933 (1988); and *L.L. Bean*, *supra* note 21.

³⁰ For example, *New York Stock*, *supra* note 27.

³¹ For example, *Anheuser-Busch, Inc. v. Baducci Publications* 28 F. 3d 769 (C.A. 8 1994).

³² For example, *Harley-Davidson, Inc. v. Grotanelli* 164 F. 3d 806 (C.A. 2 1999).

³³ For example, *Elvis Presley Enterprises, Inc. v. Capece* 141 F. 3d (C.A. 5 1998).

³⁴ For example, *The Taubman Company v. Webfeats*, 65 U.S.P.Q. 1834 (C.A. 6 2003) [*Taubman*]; *Bally*, *supra* note 21; and *Sylvia v. Village Saab*, unreported 30 November 2004, Superior Court, Lowell Massachusetts, Chabot, H. "Court Dismisses Slander Charges Against Web Designer", <www.sentinelandenterprise.com> 1 December 2004.

registrant's activity was not commercial. The court said that the word "sucks" has entered the vernacular as a word loaded with criticism.³⁵ If the activity is commercial, a court then assesses whether there is likely to be confusion as to the source of the site.³⁶ In another decision, the use of <trademarksucks.com> for a website offering pornographic services was not restrained, because the court said that a domain name comprising the word "sucks" together with a trade-mark neither attempts to confuse the consumer nor dilute the trade-mark.³⁷ The domain name <fuck[trade-mark].com> was held not confusingly similar to the trade-mark because confusion was said to be inconceivable.³⁸

However, not every "-sucks" domain name is protected.³⁹ Some decisions adopt the view that a "-sucks" domain name is not necessarily privileged as free speech, holding that the use of another person's trade-mark in a domain name is more analogous to a source identifier than to a protected communication, and that the scope of protection for speech depends in part on the intentions of the registrant.⁴⁰

(B) Canadian Decisions

As of the time of writing, there has not been a Canadian court decision that has dealt with a "-sucks" or similar domain name. The issue is likely to turn on whether the domain name would be likely to confuse Internet users as to the source or affiliation of the website or depreciate the value of the goodwill in a registered trade-mark. Since the United States courts analyze these issues on the basis of the right of commercial free speech under the First Amendment, a Canadian court would likely define a trade-mark owner's rights so as not to violate the right to freedom of expression under the *Charter*.⁴¹ Equally, interpretation would not confer the right on the website operator to use the private trade-mark property of the owner in the service of the freedom of expression.⁴² Like the United States courts, a Canadian

³⁵ *Bally*, *supra* note 21.

³⁶ *Taubman*, *supra* note 34.

³⁷ *Lucent Technologies, Inc. v. Johnson* 56 U.S.P.Q. 2d 1637 (C.D. Cal. 2000); see also *Lucent Technologies, Inc. v. LucentSucks.com* 95 F. Supp. 2d 528 (E.D. Va. 2000), dismissed for failure to comply with ACPA procedural requirements.

³⁸ *Ford Motor Company v. 2600 Enterprises* 61 U.S.P.Q. 2d 1757 (E.D. Mich. 2001).

³⁹ *Taubman*, *supra* note 34.

⁴⁰ For an example of a decision holding that the use of another person's trademark in a domain name is more analogous to a source identifier, see *Morrison & Foerster L.L.P. v. Wick* 94 F. Supp. 2d 1125 (D. Colo. 2000) [*Morrison*]; and *Planned Parenthood*, *supra* note 22. For an example of the scope of protection for speech depending in part on the intentions of the registrant, see *Name.space, Inc. v. Network Solutions, Inc.* 202 F. 3d 573 (C.A. 2d Cir. 2000); and *Lucent Technologies, Inc. v. Johnson*, *supra* note 37.

⁴¹ *B.C. Auto. Association*, *supra* note 12.

⁴² *Compagnie Générale*, *supra* note 13.

court is likely to factor into its considerations the intentions of the domain name registrant and whether or not the registrant's website has a commercial purpose.

(C) UDRP Decisions

There have been numerous UDRP decisions in respect of cybergripping. In order for a complainant to succeed in a UDRP proceeding, it must establish that: (i) it has rights in a trade-mark or trade name and the registrant's domain name is identical or confusingly similar to the complainant's mark or name; (ii) the registrant has no right or legitimate interest in the domain name; and (iii) the registrant registered and used the domain name in bad faith.

The approach taken to <-sucks.com> names in proceedings under the UDRP has been mixed. Decisions initially generally favoured complainants and usually ordered transfer of a registration, even where the panel found that a user is unlikely to believe that a <trademarksucks.com> website is sponsored, affiliated or endorsed by the trade-mark owner.⁴³ Decisions have expressed various rationales for finding that a domain name with a "sucks" suffix is confusingly similar to the complainant's mark.⁴⁴

One approach is to start with the anti-cybersquatting intent of the UDRP and to interpret "identical or confusingly similar" to mean that, whenever a domain name incorporates another's trade-mark, or a confusingly similar approximation, this factor is satisfied regardless of the other components of the domain name.⁴⁵ Where a registrant uses a <-sucks.com> site for legitimate protest, the domain name is adequately protected by the legitimate interest and bad faith prongs of the UDRP.

A second rationale is that a <trademarksucks.com> domain name leads to a diversion of customers because it is pulled up by search engine queries for the trade-mark.⁴⁶ While Internet users are unlikely to believe that the trade-mark owner

⁴³ For example, *Wal-mart Stores, Inc. v. Walsucks* WIPO D2000-0477; and *Wal-mart Stores, Inc. v. MacLeod* WIPO 2000-0662; but see *contra*: *Wal-mart Stores, Inc. v. Wallmartcanadasucks.com* D2000-0104.

⁴⁴ For example, *Full Sail, Inc. v. Spevack* WIPO D2003-0502.

⁴⁵ For example, *Wal-Mart Stores, Inc. v. MacLeod*, *supra* note 43; *Kendall/Hunt Publishing Co. v. headhunterbob*, NAF FA102247; *Soci t  Air France v. Virtual Dates Inc.* WIPO D2005-0168 [*Air France*]; and *Diners Club International Ltd. v. SPS* NAF FA149414.

⁴⁶ For example, *The Salvation Army v. Info-Bahn, Inc.* WIPO D2001-0463; *ADT Services AG v. ADT Sucks.com*, WIPO D2001-0213 [*ADT Services*]; *Soci t  Accor v. Hartmann*, WIPO D2001-0007; *TPI Holdings, Inc. v. AFX Communications* WIPO D2000-1472; *Standard Chartered PLC v. Purge I.T.* WIPO D2000-0681; *Direct Line Group Ltd. v. Purge I.T.* WIPO D2000-0583 [*Direct Line*]; *Dixons Group PLC v. Purge IT* WIPO D2000-0584; *Freeserve PLC v. Purge IT* WIPO D2000-0585; *National Westminster Bank PLC v. Purge IT* WIPO D2000-0636 [*Westminster Bank*]; *Wal-mart Stores, Inc. v. Walsucks*, *supra* note 43; *Vivendi Universal v. Sallen* D2001-1121 (with dissent) [*Vivendi*]; *Koninklijke Philips Electronics N.V. v. Kim* D2001-1195 [*Koninklijke*]; *Bloomberg L.P. v. Secaucus Group*, NAF FA97077; *Cabela's Inc. v. Cupcake Patrol* NAF FA95080; *Bayer Aktiengesellschaft v. Dangos & Partners* WIPO D2002-1019 [*Aktiengesellschaft*]; *The Royal Bank of Scotland Group plc v.*

actually sponsors the site, it is likely that potential customers would visit the site, if only to satisfy their curiosity. This would allow a registrant to divert potential customers of a complainant to a website by the use of a domain name that is similar to the complainant's trade-mark.

A third common theory for a finding of confusing similarity is that a <trademarksucks.com> site may be mistaken for a trade-mark owner's official complaint site.⁴⁷ Panels have noted that the most striking element of these domain names is the complainant's mark, which could lead people to believe that the complainant sponsors the site.

A fourth basis is that non-English speakers may not be familiar with the pejorative nature of the word "sucks", so that they may be confused about the potential association with the complainants. Thus, such users may believe that any name using the trade-mark is associated with the complaint.⁴⁸ However, in certain situations the word "sucks" may not be used in the pejorative sense, and can only be used in a purely descriptive manner.⁴⁹

More recently, panels are increasingly holding that there is no confusing similarity between the mark TRADEMARK and the domain name <trademarksucks.com> because there is no real possibility of confusion.⁵⁰ Those decisions conclude that there is no confusing similarity between the trade-mark and the domain name because both common sense and the plain language of the UDRP support the view that a domain name combining the trade-mark with the word "sucks" or other such language clearly indicates that the domain name is not affiliated with the trade-mark owner.⁵¹ Some panels even see it as a *per se* rule that <trademarksucks.com> websites cannot be confusingly similar to a trade-mark.⁵²

Website operators have adopted other similar terms in combination with the target's trade-mark. A domain name with "truthabout-" before a trade-mark in a domain name was distinguished from "-sucks" names on the basis that the word

Lopez WIPO D2003-0166; *Wachovia Corporation v. Flanders* WIPO D2003-0596; *Clear Channel Communications v. RadioAid.com LLC* NAF FA273224; and *Bell Inc. v. Innervision Web Solutions* NAF FA445601.

⁴⁷ For example, *Direct Line*, *ibid*, and *Koninklijke*, *ibid*; and *National Westminster*, *ibid*.

⁴⁸ For example, *ADT Services*, *supra* note 46; *Aktiengesellschaft*, *supra* note 46; and *Air France*, *supra* note 45.

⁴⁹ For example, *Vivendi*, *supra* note 46.

⁵⁰ For example, *Lockheed Martin Corp. v. Parisi* WIPO D2000-1015 [*Lockheed*]; *McLare Company Inc. v. Craig* WIPO D2000-1455 [*McLare*]; *Walmart Stores, Inc. v. Wallmartcanadasucks.com*, *supra* note 43; *Cryptologic Inc. v. Internet Billions Domains Inc.* NAF FA317825; *KB Home v. RegisterFly.com* NAF FA506771; and *Homer TLC, Inc. v. GreenPeople* NAF FA550345.

⁵¹ For example, *Lockheed*, *supra* note 50; and *Air France*, *supra* note 45 (dissent).

⁵² For example, *Walmart Stores, Inc. v. Walsucks*, *supra* note 43; *Asda Group Limited v. Kilgour* WIPO D2002-0857; and *McLare*, *supra* note 50.

“sucks” suggests critical commentary, whereas the phrase “truth about” has no such connotation and confuses Internet users by including the complainant’s mark in its domain name.⁵³ However, domain names with the words “stop-” before the trade-mark and “-fraud” or “-theft” after the trade-mark were held not to be confusingly similar.⁵⁴ A domain name of the type <trademarkcarcass.com> was held not to be confusingly similar with the trade-mark.⁵⁵

Domain names comprising famous trade-marks combined with the word “nude” or “sex” are subject to an analysis similar to the “sucks” names, but UDRP panels are more likely than courts to find possible confusion, because words like “sex” are not as obviously dissociated from the trade-mark owner as “sucks”.⁵⁶ The domain name <fuck[trademark].com> was held not confusingly similar to the trade-mark because confusion was said to be inconceivable.⁵⁷

(D) CDRP Decisions

At the time of writing, there has not yet been a CDRP decision that has dealt with a “-sucks” or similar domain name. However, a decision dealing with a criticism site said in *obiter* comments that a domain name such as <trademarksucks.ca>, which identifies that the domain name and related website are used for criticism, would be a legitimate use.⁵⁸

3. CYBERCRITICIZING

Cybercriticizing is the identification of a website by the domain name <trademarkvariation.com> where the website operator has no permission to use the trade-mark or trade name and criticizes the trade-mark or trade name owner. The operator does not rely on a “sucks” or similar component of a domain name to attract visitors. A criticism site differs from a gripe site in that it is not immediately apparent from the domain name that the website is critical of, or at least not affiliated with, the trade-mark owner. Criticism sites also raise the issue as to whether a registrant can legitimately use another person’s trade-mark or name in a domain name.

⁵³ For example, *Nestlé Waters North America Inc. v. JAT* NAF FA220027.

⁵⁴ See *ECG European City Guide v. Woodell* NAF 183897 regarding “stop-[trademark].com”; and *FMR Corp. v. Native American Warrior Society*, online: WIPO D2004-0978 regarding “[trademark]fraud/theft.com” [FMR].

⁵⁵ For example, *The Neiman Marcus Group, Inc. v. CTSG* NAF FA243503.

⁵⁶ For an example of a domain name combined with “nude”, see *Kidman v. Zuccarini* WIPO D2000-1415. For an example of a domain name combined with “sex”, see *Ebay Inc. v. Ebay4sex.com* WIPO D2000-1632; and *Yahoo! Inc. v. Dough* NAF FA245971.

⁵⁷ *America Online Inc. v. Johuathan Investments Inc.* WIPO D2001-0918.

⁵⁸ *Diners Club International Ltd. v. Planet Explorer Inc.* CIRA-00016 (B.C.I.C.A.C.), (2004), 32 C.P.R. (4th) 377 [Diners Club].

(A) United States Decisions

A number of United States decisions relating to cybercriticizing have been decided in actions pursuant to the *Anti-Cybersquatting Consumer Protection Act*.⁵⁹ The *ACPA* protects owners of distinctive or famous trade-marks by providing a cause of action against a person who, in bad faith, registers, uses or trafficks in a domain name that is identical or similar to a distinctive trade-mark, or that dilutes a famous mark.⁶⁰

As in the case of gripe sites, United States courts analyze these issues on the basis of the right of commercial free speech accorded under the First Amendment.⁶¹ The adoption of a domain name may be, but is not necessarily, privileged as free speech.⁶² The scope of protection for speech depends in part on the intention of the registrant.⁶³ The use by a customer of a domain name including the trade-mark of a business for a website describing a customer's negative experience with the trade-mark owner is a non-commercial purpose and does not suggest a bad faith intent to profit under the *ACPA*.⁶⁴ This sort of comment does not represent the type of harm that the *ACPA* was designed to eradicate.⁶⁵ A site on which users submit comments on their experiences with businesses and reference third party trade-marks in postings probably avoids liability.⁶⁶ A link to a newsgroup website that featured advertising was too attenuated a path to render the criticism site commercial.⁶⁷ However, after a complaint is filed that a domain name comprises the trademark of

⁵⁹ 15 U.S.C. § 1129 [*ACPA*]

⁶⁰ 15 U.S.C. § 1125

⁶¹ For example, *CPC International, Inc. v. Skippy Inc.* 33 U.S.P.Q. 2d 1907 (C.A. 4 2000); see also *Lamparello v. Falwell* 76 U.S.P.Q. 2d 1024 (C.A. 4 2005), reversing 360 F. Supp. 2d 773 (E.D. Va. 2004) [*Lamparello*].

⁶² For an example of an adoption of a domain name privileged as free speech, see *Lamparello, ibid.*; and *Penn Warranty Corp. v. DiGiovanni* 2005 WL 2741947 (N.Y. Sup. 2005) [*Penn*]. For an example of a domain name not privileged as free speech, see *Morrison, supra* note 40.

⁶³ For example, *Planned Parenthood, supra* note 22.

⁶⁴ For example, *Lucas Nursery and Landscaping Inc. v. Grosse* 70 U.S.P.Q. 2d 1149 (C.A.6 2004); *Mayflower Transit v. Prince* 70 U.S.P.Q. 2d 1814 (D.N.J. 2004); *TMI Inc. v Maxwell* 70 U.S. P.Q. 2d 1630 (C.A. 5 2004); *Knight-McConnell v. Cummins* 2004 WL 1713824 (S.D.N.Y.); *MCW, Inc. v. Badbusinessbureau.com, L.L.C.* 2004 WL 833595 (N.D. Tex. 2004)[*MCW*]; *Nissan Motor Co. v. Nissan Computer Corp.*, unreported, no. 04-869 (U.S.S.C. 2005), affirming 72 U.S.P.Q. 2d 1078 (C.A. 9 2004), reversing in part 65 U.S.P.Q. 2d 2008 (C.D. Cal. 2002) and 61 U.S.P.Q. 2d 1839 (C.D. Cal. 2002); *Whitney Information Network, Inc. v. Xcentric Ventures, LLC* 2005 WL 1677256 (M.D. Fla. 2005) [*Whitney*]; and *Penn, supra* note 62; but see *contra: Bosley Medical Institute, Inc. v. Kremer* 74 U.S.P.Q. 2d 1280 (C.A. 9 2005), affirming in part 2004 U.S. Dist. LEXIS 8336 (S.D. Cal. 2004) [*Bosley*].

⁶⁵ See *Bosley, ibid.*

⁶⁶ *MCW, Inc. v. Badbusinessbureau.com, L.L.C.*, *supra* note 64; *Whitney, supra* note 64; and *Hy Cite Corp. v. Badbusinessbureau.com* 2005 U.S. Dist. LEXIS 38082 (D. Ariz. 2005).

⁶⁷ For example, *Bosley, supra* note 64.

another, altering the website to include commercial comment, political protest, public service activity or parody does not avoid liability.⁶⁸

Where the use of a trade-mark in association with a critical website results in a likelihood of confusion or a misrepresentation, there may be liability for a violation of trade-mark rights, even if the website has a disclaimer.⁶⁹ Trade-mark owners have succeeded where a defendant intentionally registered and used a domain name comprising a trade-mark to deceive users into accessing the website. The courts have found liability where the critical nature of the website content did not dispel the initial interest confusion caused by the domain name, and where the nature of the domain name may be inappropriate.⁷⁰

Liability has also been found where the domain name includes the trade-mark purely to attract users to a site which bears no relationship to the trade-mark owner's product or where the domain name is used to link to unrelated sites.⁷¹ While metatags are permitted to attract users to a criticism site, pagejacking is not.⁷²

A domain name used for an alleged parody site may be protected if it actually conveys the message that it is a parody.⁷³ While a parody must engender some initial confusion, an effective parody diminishes the risk of confusion by conveying only enough reference to the target to allow appreciation of the parody.⁷⁴ A domain

⁶⁸ For non-commercial comment, see *Audi AG v. D'Amato* 381 F. Supp. 2d 644 (E.D. Mich. 2005). For political protest, see *Shields v. Zuccarini* 59 U.S.P.Q. 2d 1207 (C.A. 3 2001). For public service activity, see *E & J Winery v. Spider Webs Ltd.* 62 U.S.P.Q. 2d 1404 (C.A. 2002). For parody, see *People for the Ethical Treatment of Animals v. Doughney* 60 U.S.P.Q. 2d 1109 (C.A. 4 2001) [*Ethical Treatment*].

⁶⁹ For example, *Jews for Jesus*, *supra* note 22; *Planned Parenthood*, *supra* note 22; and *Board of Directors of Sapphire Bay Condominium West v. Simpson*, no. 04-3690, 2 May 2005 (C.A. 3 2005).

⁷⁰ For examples of intentional registration and use of a domain name comprising a trademark to deceive users into accessing a trademark, see *Morrison*, *supra* note 40; and *Harrison v. Microfinancial, Inc.* 74 U.S.P.Q. 2d 1848 (D. Mass 2005). For examples of the critical nature of the website content not dispelling the initial interest confusion, see *OBH Inc. v. Spotlight Magazine Inc.* 54 U.S.P.Q. 2d 1383 (W.D.N.Y. 2002); *Ethical Treatment*, *supra* note 68; *Morrison*, *supra* note 40; and *Purdy v. Burlington North Santa Fe Corp.* 21 Fed. App. 518 (C.A. 2001). For an example of where the nature of the domain name may be inappropriate, see *Bear Stearns Cos. v. Lavalley* WL 31757771 (N.D. Tex. 2002).

⁷¹ For example, *Faegre & Benson LLP v. Purdy* 129 Fed. Appx. 323 (8 Cir. 2005), contempt [*Faegre*]; and *Coca-Cola*, *supra* note 20.

⁷² For examples of metatags permitted for a criticism site, see *Bally*, *supra* note 21; *Bihari v. Cross* 119 F. Supp. 2d 309 (S.D.N.Y. 2000); *Patmont Motor Works, Inc. v. Gateway Marine Inc.* 1997 WL 81170 (N.D. Cal. 1997); and *J.K. Harris & Co. v. Kassel* 253 F. Supp. 2d 1120 (N.D. Cal. 2003), reversing 62 U.S.P.Q. 2d 1926 (N.D. Cal. 2002). For an example of pagejacking, see *Faegre*, *supra* note 71.

⁷³ For example, *Ethical Treatment*, *supra* note 68; and *New York Stock Exchange, Inc. v. Gahary* 196 F. Supp. 2d 401 (S.D.N.Y. 2002).

⁷⁴ For example, *Ethical Treatment*, *supra* note 68.

name used for an alleged parody site is not protected if the user must access the site to determine that it is a parody.⁷⁵ Sexually offensive parody is not protected.⁷⁶

(B) *Canadian Decisions*

In Canada, consumer counter-advertising, in which a consumer criticizes goods or services supplied by a business, is protected speech under the *Charter*.⁷⁷ In a case relating to a criticism site, the court said that, since the purpose of the defendant's website was to promote criticism, the site could be characterized as an exercise of free speech protected by the *Charter*. In *Bell ExpressVu Limited Partnership v. Tedmonds & Co. Inc.*, the plaintiff, owner of the EXPRESSVU trade-mark and the domain name <expressvu.com>, brought a motion seeking various forms of relief, one of which was summary judgment on the claim that the defendants' website, operating under the domain name <expressvu.org>, was an infringement of the plaintiff's trade-mark.⁷⁸ The plaintiff also sought a transfer of that domain name. The court refused both, concluding that the evidence revealed a genuine issue for trial as to the intention and effect of the defendant's website. The court found that the purpose of the defendant's website was to promote criticism of the plaintiff as a commercial enterprise rather than for the defendant's own commercial use. The function of the website could be characterized as an exercise of free speech and was thus protected under the *Charter*. Further, the disclaimer on the defendant's website meant that success on the claim for passing off was unlikely.

In another case, where any depreciation of the value of a plaintiff's trade-marks resulted from criticism on the defendant's website, as opposed to use of the plaintiff's mark, the defendant was not liable. In *British Columbia Automobile Association v. Office and Professional Employees Union, Local 378*, the plaintiff automobile association, a licensee of the marks BCAA and CAA, registered the domain names <bcaa.com>, <bcaa.bc.ca> and <bcaa.org>.⁷⁹ It brought an action for copyright infringement, passing off and depreciation of goodwill against the defendant union, which established a website at the domain name <bcaastonstrike.com> during a lawful strike. The defendant's website had substantially reproduced the plaintiff's website and had used the plaintiff's trade-marks in its metatags, domain name and website. The plaintiff argued that the defendant's metatags intentionally diverted users to the wrong website, and that, because the defendant's website did not indicate that there was no connection between the two websites, this caused confusion. The court concluded that, in the case of similar metatags, there was no passing off or depreciation of goodwill.

⁷⁵ For example, *Pinehurst Inc. v. Wick* 66 U.S.P.Q. 2d 1610 (M.D.N.C. 2003).

⁷⁶ For example, *Starbucks v. Dwyer*, unreported, no. C00-1499 (N.D. 2000).

⁷⁷ *Guignard*, *supra* note 7.

⁷⁸ *Bell ExpressVu Limited Partnership v. Tedmonds & Co. Inc.* [2001] O.J. No. 1558 (Sup.Ct. J.).

⁷⁹ *B.C. Auto. Association*, *supra* note 12.

However, where the defendant's metatags were identical to those trade-marks of the plaintiff, the plaintiff's claim for passing off was successful.

However, if the use of a domain name comprising a trade-mark results in a likelihood of confusion or misrepresentation, there may be trade-mark infringement or passing off. There may be a cause of action for depreciation of the value of goodwill if the trade-mark is registered and the defendant's activity in respect of the domain name constitutes trade-mark use. A former employee was restrained by an interlocutory injunction from using deformed versions of his ex-employer's trade-mark and logo on a criticism site. In *Investors Group Inc. v. Hudson*,⁸⁰ the defendant, a former employee of the petitioner, operated a website critical of the petitioner, displayed deformed versions of the petitioner's logo and used misleading links. The respondent had described his ongoing litigation with the petitioner on two websites in a way that was critical and allegedly defamatory of the petitioner. He also incorporated a misleading hyperlink, which purported to lead to the petitioner's website, but which, in fact, led back to the defendant's website. The petitioner brought a motion for slander. The defendant argued that the court had no jurisdiction to hear the motion, as the defendant's server was located outside Canada and, therefore, the allegedly slanderous acts were committed in a jurisdiction outside Canada. The court concluded that it did have jurisdiction to decide the matter and granted an interim injunction restraining the defendant from using the petitioner's trade-marks.

(C) UDRP Decisions

Under the UDRP, depending on the circumstances of the particular case, the use of a domain name for a website that engages in parody, commentary or criticism may be permitted.⁸¹ Decisions on this issue have gone both ways but UDRP decisions generally hold that a criticism site does not have a legitimate interest in a domain name that does not clearly indicate its critical purpose with "sucks" or some similar term.⁸² It is not sufficient that the criticism may be apparent from the content of the site.⁸³ More often, decisions are likely to conclude that a criticism site does not have

⁸⁰ *Investors Group Inc. v. Hudson* [1998] Q.J. 4323, 1998 CarswellQue4282 (Sup. Ct).

⁸¹ For example, *Bridgestone Firestone, Inc. v. Myers* WIPO D2000-0190 [*Bridgestone*]; and *Pensacola Christian College Inc. v. Gage* (2001), NAF FA101314; but see *contra: North American Wilderness Recovery, Inc. v. Citizens With Common Sense* (2001), NAF FA97058; *Estée Lauder Inc. v. estelauder.com* WIPO D2000-0869; and *Falwell v. The Liberty Alliance* (2003), NAF FA 198936.

⁸² For example, *New York Times Co. v. New York Internet Services* WIPO D2000-1072; *Monty and Pat Roberts Inc. v. Keith* WIPO D2000-0299; *Compagnie de Saint Gobain v. Com-Union Corp.* WIPO D2000-0020 [*Saint Gobain*]; *Reg Vardy Plc v. Wilkinson* WIPO D2002-0593; and *The Paxton Herald v. Millard* (2002), NAF FA 114770 [*Paxton Herald*].

⁸³ For example, *Council of American Survey Research Organizations v. The Consumer Information Organization, LLC* WIPO D2002-0377 [*American Survey*]; and *Paxton Herald*, *supra* note 82; but see *contra: Britannia Building Society v. Britannia Fraud Prevention* WIPO 2001-0505 [*Britannia*].

a legitimate interest in a domain name that does not clearly indicate its critical purpose with “sucks” or some similar term.⁸⁴

Under the UDRP, a finding of a good faith non-commercial use, one of the legitimate interest factors, is usually precluded where the registrant chooses a domain name that consists solely of the complainant’s trade-mark.⁸⁵ Further, although a registrant may have a right to refer to a mark in critical content, the wholesale appropriation of a complainant’s mark in a domain name without any distinguishing material creates confusion with the complainant’s business and is not a fair use.⁸⁶ For example, the operation of a website at <tradename.com> or <trademark.com> criticizing the company known as Tradename Inc. or a company selling TRADEMARK brand goods might not be considered a good faith use.⁸⁷ A legitimate interest has not been found where the registrant’s site promotes a competing product.⁸⁸ For example, if a site features third party pop-up advertisements for payment, it is commercial.⁸⁹

Some panels have held that using a domain name for a website that attacks the owner of the trade-mark reflected in the domain name is a bad faith use.⁹⁰ Decisions have indicated that disparagement of a trade-mark owner for any reason, commercial or not, precludes a finding of a legitimate interest.⁹¹ Even patronage of, or enthusiasm for, a company’s products may not be a legitimate interest.⁹²

Yet, some panels have held that critical website content is not a bad faith use.⁹³ Some decisions have found legitimate interests in criticism sites even when the domain name is identical to the complainant’s trade-mark.⁹⁴ The use of a website to post commentary or criticism constitutes a fair or non-commercial use, so long as there is no intent to commercially gain by misleadingly diverting consumers or by

⁸⁴ See note 81.

⁸⁵ For example, *Saint Gobain*, *supra* note 82; and *Fox News Network, LLC v. Solomon* WIPO D2005-0022.

⁸⁶ For example, *American Survey*, *supra* note 83; *Paxton Herald*, *supra* note 82; *The Laurel Pub Co. Ltd. v. Robertson* WIPO D2004-0978; and *Gardere Wynne Sewell LLP v. DefaultData.com* WIPO D2001-1093; but see *contra*: *Britannia*, *supra* note 83.

⁸⁷ For example, *Rectory School v. LeClerc* NAF FA52049; *Eastman Chemical Company v. Patel* NAF FA524752; and *Eastman Chemical Company v. Patel* NAF FA561094.

⁸⁸ For example, *CSA International v. Shannon* WIPO D2000-0071 [*CSA International*].

⁸⁹ *FMR*, *supra* note 54.

⁹⁰ For example, *CSA International*, *supra* note 88; and *DFO Inc. v. Williams* WIPO D2000-0181.

⁹¹ For example, *PG&E Corporation v. Anderson* WIPO D2000-1264.

⁹² For example, *Rollerblade, Inc. v. McGrady* WIPO D2000-0429.

⁹³ For example, *Bridgestone*, *supra* note 81; and *Kendall v. Mayer* WIPO D2000-0868.

⁹⁴ For example, *Bridgestone*, *supra* note 81; *The Francis Estate v. Magidson Fine Art Inc.* WIPO D2000-0673; and *Legal & General Group Plc v. Image Plus* WIPO D2002-1019.

tarnishing a trade-mark.⁹⁵ The solicitation of donations or advertisements for a criticism site does not render it commercial.⁹⁶ In some cases, a disclaimer on the website may make a criticism site a fair use without the use of added material in the domain name.⁹⁷ A parody site whose name reflected the trade-mark of the target was held to be a legitimate interest.⁹⁸

There is a divergence in the cases which involve United States parties or panelists, in which case it is less likely that bad faith is found, and cases which do not involve either a United States party or panelist. This seems to reflect the impact of the First Amendment.⁹⁹ There is an emerging consensus that, when used for a United States based criticism site, a domain name comprising a trade-mark can constitute a legitimate interest when there is no indicium of bad faith.¹⁰⁰ However, where the registrant acts in bad faith, such as where there is a motive of commercial gain, an intention to disrupt the activities of the complainant, or an intention to sell the domain name at a profit, a legitimate interest is not found.¹⁰¹

(D) CDRP Decisions

While the CDRP is not legislation, it is possible that its legitimate interest factor of “criticism, review or news reporting”¹⁰² may be interpreted in accordance with the principles of the *Charter*.¹⁰³ This would be consistent with the UDRP approach to cases with some connection to the United States. Under the CDRP, the use of a domain name or a mark for criticism may be legitimate. The issue is the extent to which the use encroaches on the proprietary rights of the complainant.¹⁰⁴ A CDRP decision acknowledged that domain names which merely use the mark of another have generally been held to be confusingly similar and used in bad faith under the

⁹⁵ For an example of fair use, see *Howard Jarvis Taxpayers Association v. McCauley* WIPO D2004-0014 [*Howard Jarvis*]; for an example of non-commercial use, see *Shell International Petroleum Company Limited v. Donovan* WIPO D2005-0538; for an example of no intent to commercially gain by misleadingly diverting consumers or by tarnishing a trade-mark, see *Britannia*, *supra* note 83.

⁹⁶ For example, *Ladner v. Wetmore* NAF FA 305190.

⁹⁷ For example, *Britannia*, *supra* note 83; and *Bridgestone*, *supra* note 81.

⁹⁸ *A&F Trademark Inc. v. Jorgensen* WIPO D2001-0900.

⁹⁹ For example, *Howard Jarvis*, *supra* note 95; and *National Collegiate Athletic Association v. Brown* 72 U.S.P.Q. 2d 13198 (WIPO 2004) [*National Collegiate*].

¹⁰⁰ For example, *Howard Jarvis*, *supra* note 95; and *National Collegiate*, *supra* note 99.

¹⁰¹ For an example of commercial gain, see *Bridgestone*, *supra* note 81; For an example of an intention to disrupt the activities of the complainant, see *Justice for Children v. Rneetso/O'Steen* WIPO D2004-0175. For an example of an intention to sell the domain name at a profit, see *Kendall v. Mayer* WIPO D2000-0868.

¹⁰² CDRP, Paragraph 3.6(d).

¹⁰³ *Charter*, *supra* note 2.

¹⁰⁴ *Diners Club*, *supra* note 58.

UDRP.¹⁰⁵ This is because the owner of a trade-mark is entitled to decide who may use its mark and how.¹⁰⁶ In a CDRP proceeding, the focus of the inquiry is not on the website; rather the issue is whether the unqualified use of the mark in the domain name is legitimate.¹⁰⁷ Where a person uses the well-known mark of a company as a domain name for a criticism site, without any language identifying the critical nature of the site, the use is not a legitimate interest.¹⁰⁸

4. BLOGS

Blogs, or weblogs, are increasingly used to publish comments on the Internet. A blog is typically directed to subject matter of a particular theme. There have already been numerous lawsuits against bloggers, most of which not surprisingly relate to defamation and related causes of action.¹⁰⁹ Some have been related to comments on trade-mark disputes.¹¹⁰ However, blogs may themselves raise trade-mark and domain name issues. A blog containing the trade-mark of the target of its criticism in its domain name prompted a suit in the United States by the trade-mark owner against Google because the blog is ranked relatively highly in keyword searches for the trade-mark.¹¹¹ The author is not aware of any other trade-mark related decision dealing with blogging in Canada or any other English law jurisdiction. However, a Belgian court restrained the use of a domain name which incorporates a well known trade-mark of another for a blog.¹¹²

5. CONCLUSION

As the foregoing discussion illustrates, there is no clear trend as to whether one may use in a domain name for a website the trade-mark or trade name of the target of criticism on the site. If there is any broad conclusion that can be reached it is that a court is more likely to tolerate the unauthorized use of a domain name with a trade-mark or trade name of another for a website which engages in non-commercial comment than it would be for a website with a commercial purpose. However, there is no consistency in the decisions and they all appear to be fact-specific. Therefore, those who adopt such domain names may be at risk.

¹⁰⁵ *Ibid.*

¹⁰⁶ *Ibid.*

¹⁰⁷ *Ibid.*

¹⁰⁸ *Ibid.*

¹⁰⁹ For an example of a defamation lawsuit against a blogger, see *Holmes v. Ford*, unreported, no. BC 221609 (Cal. Sup. 2000). For an example of related causes of action, see *Software Development and Investment of Nevada v. Wall*, no. 05-1109 (D. Nev. filed 11 August 2005).

¹¹⁰ *Cohen v. Ford*, no. 00-CV-5966 (C.D. Cal. filed 2000).

¹¹¹ *Jews for Jesus v. Google, Inc.*, 05-CV-10684 (filed 21 December 2005).

¹¹² *Belgacom Skynet v. Telefun*, unreported, no. A/05/01426 (Brussels Commercial Court 2006).