Does It Really Suck?: The Impact of Cutting-Edge Marketing Tactics on Internet Trademark Law and Gripe Site Domain Name Disputes

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Does It Really Suck?: The Impact of Cutting-Edge Marketing Tactics on Internet Trademark Law and Gripe Site Domain Name Disputes

Mindy P. Fox

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INTRODUCTION

Imagine that Rachel owns a company, Rachel’s Candy Shop, which sells candy online. She registers the domain name,
www.rachelscandyshop.com. Anyone worldwide can place orders on this website, and Rachel will ship the candy from her warehouse to the purchaser. Let’s further imagine that one customer, Robyn, places an order and receives moldy, contaminated candy weeks after the expected arrival date. To express her dissatisfaction, Robyn registers the domain name, www.rachelscandyshopsucks.com, and creates a website criticizing Rachel’s store and its candy. Other Internet users performing a search for “Rachel’s Candy Shop” are led to both Rachel’s website and Robyn’s corresponding so-called “gripe” site.

In an unrelated business venture, Evan creates a website to promote his bricks-and-mortar chocolate store, Evan’s Divine Chocolates. Evan decides to create a marketing campaign playing off customers’ often-heard sigh, “These chocolates are so delicious but so sinful. I hate you for tempting me.” Evan registers the domain name www.ihateevansdivinechocolates.com and creates a website that ironically and sarcastically bemoans how Evan’s chocolates tempt consumers into indulging their guilty pleasures. People seeing the phrase “I Hate Evan’s Divine Chocolates” and the corresponding website “www.ihateevansdivinechocolates.com” are intrigued and consequently visit the website.¹

Both www.rachelscandyshopsucks.com and www.ihateevansdivinechocolates.com contain the elements of a classic consumer gripe site that uses a trademark in the domain name. Yet the website criticizing Rachel’s company was created by a third party who does not own Rachel’s Candy Shop’s trademark, while the website criticizing Evan’s company was created by Evan himself. Looking exclusively at each domain name, however, it is not possible to determine the owners of each website. Further, the

¹ This sample case is loosely based on a marketing campaign by Steven Singer Jewelers. See infra notes 260–72 and accompanying text.
style and content of each website—attacking the companies—do not help clarify ownership.

It is not far-fetched to imagine organizations promoting their “chick flick” movies, computers, daytime soap operas, romance novels, or tabloids by using consumers’ mixed love/hate relationship with these products. It is not uncommon to hate products we use, and it is creative to spin a marketing campaign around such a theme. On the other hand, consumers devoted to a product, character, or person have been known to create fan sites that promote the trademark even though the website creator does not receive any benefit for doing so. They too are using another’s trademark in their domain name, even if they are endorsing rather than disparaging it.

The federal courts and the World Intellectual Property Organization (“WIPO”) arbitration panels analyze whether a domain name infringes on a trademark owner’s trademark by looking at whether the domain name is likely to confuse Internet consumers about the ownership of the website. The decisions on both gripe sites and fan sites that apply the likelihood of confusion standard are mixed. For example, some decisions explain that people are unlikely to think that a website whose domain name has the word “sucks” or “hate” alongside the trademark was created by the trademark owners, but others argue for a more blanket prohibition on using another’s trademark in a domain name at all. This analysis has been inconsistent and narrow and should be reevaluated and streamlined.

Alternative marketing techniques such as promoting Evan’s Divine Chocolates using the domain name www.ihateevansdivinechocolates.com challenge the traditional likelihood of confusion analysis. Courts tend to maintain that Internet users’ common sense precludes them from believing that

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2 See Donald A. Norman, Emotional Design: Why We Love (or Hate) Everyday Things 7 (2004).
3 See Ben McConnell, Jackie Huba & Guy Kawasaki, Creating Customer Evangelists: How Loyal Customers Become a Volunteer Sales Force 59 (2002).
4 See infra Part I.D.1.
5 See infra Part I.E.
6 See infra Part I.E.
gripe sites are owned by the trademark owner. Yet these alternative marketing techniques demonstrate otherwise. In light of the increase in these techniques, it may no longer be possible to irrefutably hold that no reasonably prudent Internet user would think that, for example, Evan’s Divine Chocolates uses the domain name www.ihateevansdivinechocolates.com.

Part I of this Note discusses trademark law in domain names by providing background on the standards courts and panels use when deciding domain name trademark infringement cases and reviews how these decision-making bodies have ruled on gripe site and fan site trademark infringement cases. Part II of this Note discusses alternative marketing techniques, such as viral marketing and reverse psychology marketing, which effectively promote a product before revealing the sponsoring company’s identity. Part III of this Note considers rulings on the permissibility of using a trademark in the domain name of a website not owned by the trademark owner in light of the increase in alternative marketing techniques. Part IV of this Note argues that both gripe sites and fan sites that use a trademark in their domain name infringe the trademark owner’s rights.

I. TRADEMARKS IN DOMAIN NAMES

A. Domain Name Registration

Since its invention in 1989, the Internet has quickly grown from an exclusive research tool for scientists to the ubiquitous mass medium it is today. Over one billion people worldwide and 79% of adults in the United States use the Internet. Such a vast

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7 See infra Part I.E.
8 See John R. Levine, Margaret Levine Young & Carol Baroudi, The Internet for Dummies 89 (11th ed. 2007).
medium requires an organizational system to help user’s access particular information.

A domain name is the Internet address, which enables Internet users to identify and access websites. It “is a word or series of words followed by ‘.edu’ for education; ‘.org’ for organizations; ‘.gov’ for government entities; ‘.net’ for networks; and ‘.com’ as the catchall for other Internet users.” The “word or series of words”—otherwise known as the “second-level domain name”—often is the website owner’s trademark. According to one study, 67% of online users visited websites using direct navigation, a means whereby consumers type the domain name of a website directly into the Internet browser address box. Clearly, domain names not only allow users to access a website but are also a means to determine which websites can provide the content Internet users seek.

Since November 1998, the Internet Corporation for Assigned Names and Numbers (ICANN), an international organization unaffiliated with any government or government agency, has been managing the domain name system. Internet domain names

11 W. Scott Creasman, Free Speech and “Sucking” — When Is the Use of a Trademark in a Domain Name Fair?, 95 TRADEMARK REP. 1034, 1035 (2005).
13 Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1162 n.1 (C.D. Cal. 1998).
15 Id. at 325.
18 See Memorandum of Understanding Between the U.S. Department of Commerce and Internet Corporation for Assigned Names and Numbers, http://www.ntia.doc.gov/
are registered by ICANN-accredited registrars for less than thirty dollars per domain name per year. A person who submits the proper application and requisite fee is automatically registered as long as no one else has previously registered the requested domain name.

Possessing a trademark does not automatically trigger ownership or use of the same word or phrase in a domain name. A trademark owner must independently register its trademark with ICANN. This “first-come, first-serve” system of domain name registration also allows someone who does not own a trademark to register a website domain name that contains a given trademark. However, reserving a domain name does not give the user any official right to use a trademark in the domain name free from legal claims.
B. Consumer Gripe Sites: [trademark]sucks.com

The Internet has been hailed as “contemporary society’s great equalizer of social, economical, and political power.”27 The cost of producing and disseminating information on the Internet is low, and “the effects of communication immense.”28 Dissatisfied consumers have discovered that the Internet is a vast field over which they can express their discontent. Creating a consumer gripe website is one means of using the Internet to criticize a company. These gripe sites abound with stories of corruption, fraud, and customer mistreatment.29

Many gripe sites’ domain names take the form of “[trademark]sucks.com.”30 In fact, the “sucks” moniker is the most popular denigrating term used in gripe site domain names.31 However, other gripe site formats include “[trademark]stinks.com,”32 “[trademark]bites.com,”33 “boycott[trademark].com,”34 “[trademark]blows.com,”35 and “ihate[trademark].com.”36 Using a company’s trademark in the domain name is strategic because it will attract just the audience the website creator intends to reach.37

28 Id.
29 Id.
33 See Lipton, Commerce Versus Commentary, supra note 32, at 1361.
34 See Fairwinds Partners, LLC, supra note 31 (explaining that approximately 2,000 “domains begin with the term ‘boycott’”).
35 See Johnson, supra note 30, at 478 n.142.
36 See Steel, supra note 32, at B5; see also Johnson, supra note 30, at 478 n.142.
37 See Barrett, supra note 12, at 1013–14 (“Just as a picketer needs to locate herself near the business whose practices she protests, the gripe site operator needs to incorporate the plaintiff’s mark into her domain name. Use of the plaintiff’s mark in the defendant’s
Gripe sites raise important First Amendment questions. On one hand, trademark owners have commercial rights and interests. On the other hand, individuals have free speech interests. Although “there is a social value in allowing people to have easy access to a forum to complain about the activities of a commercial entity[,] . . . the question remains whether these people should be able to utilize a domain name for that forum that somehow corresponds with a trademark associated with the relevant entity.”

C. Consumer Fan Sites: love[trademark].com

“Another type of ‘trademark.com’ case involves the sites of fans and enthusiasts of the mark owner.” The website domain name often contains the full name of the trademark owner, but it could also be in the format “ilove[trademark].com.” Trademark owners seeking to control their famous marks on the Internet have targeted these fan websites with corporate “cease and desist” letters. Unlike gripe sites, fan sites promote the trademark,

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38 See Jacqueline D. Lipton, Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy, 40 WAKE FOREST L. REV. 1361, 1399 (2005) [hereinafter Lipton, Beyond Cybersquatting].
40 Lipton, Beyond Cybersquatting, supra note 38, at 1399.
41 David M. Kelly, “Trademark.com” Domain Names: Must They Communicate the Website’s Protected Content to Avoid Trademark Liability?, 33 AIPLA Q.J. 397, 417 (2005).
42 See, e.g., Lipton, Beyond Cybersquatting, supra note 38, at 1416–18 (discussing the existence of fan sites such as www.brucelsingsteen.com and www.alpacino.com).
which might confuse Internet users trying to establish which entity owns a given website. 45

D. Trademark Law

1. Likelihood of Confusion Standard and Lanham Act

The Lanham Act is a federal statute that protects trademarks. 46 Especially prior to the enactment of the Anti-Cybersquatting Consumer Protection Act (“ACPA”), 47 trademark owners relied on the Lanham Act to resolve trademark disputes. 48 One main type of trademark-based action is trademark infringement. 49 A trademark owner might bring a trademark infringement action under section 32 and section 43(a) of the Lanham Act 50 if someone misappropriated its trademark, such as by using the trademark as part of a domain name. 51 Section 32 of the Lanham Act imposes liability for using a registered trademark without the trademark owner’s consent, 52 and section 43(a) of the Lanham Act imposes liability for using an unregistered common law trademark in a way that is likely to cause confusion as to the owner of the product or service. 53

45 Masnick, supra note 43 (“Perhaps, the only thing is that sucks sites may be protected because no one would confuse a sucks site with the real product site, because the sucks site is obviously trashing the product. With a ‘loves’ site, you could argue that there might be a higher likelihood of confusion.”).

46 Rochat, supra note 44, at 609.

47 See infra notes 66–80 and accompanying text.

48 See Sorgen, supra note 39, at 119.

49 See Lipton, Commerce Versus Commentary, supra note 32, at 1334.


51 See Gilwit, supra note 23, at 276.

52 See 15 U.S.C. § 1114(1)(a) (2006) (“Any person who shall, without the 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 for the remedies hereinafter provided.”).

53 See id. § 1125(a)(1)(A) (“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or
“[T]he ‘likelihood of confusion’ standard ‘is the touchstone of trademark infringement’ claims.”54 However, assessing consumer confusion is “an inherently inexact process.”55 The Second Circuit in *Polaroid Corp. v. Polarad Electronics Corp.*56 attempted to clarify the definition of consumer confusion by propounding a non-exhaustive list of eight factors relevant to determining likelihood of confusion.57 The Ninth Circuit in *AMF, Inc. v. Sleekcraft Boats*,58 enumerated a similar eight-part test for likelihood of consumer confusion.59 Trial and appeals courts systematically and sequentially apply one of these tests or some highly similar alternative.60

The Ninth Circuit in *Interstellar Starship Services, Ltd. v. Epix, Inc.*61 stated that “in the context of the Web, the three most important Sleekcraft factors in evaluating a likelihood of confusion are (1) the similarity of the marks, (2) the relatedness of the goods or services, and (3) the parties’ simultaneous use of the Web as a marketing channel.”62 The court explained that if this “controlling association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”).54


56 287 F.2d 492 (2d Cir. 1961).

57 *Id.* at 495. Those factors are: (1) “the strength of his [mark],” (2) “the degree of similarity between the two marks,” (3) “the proximity of the products,” (4) “the likelihood that the prior owner will bridge the gap,” (5) “actual confusion,” (6) “the reciprocal of defendant’s good faith in adopting its own mark,” (7) “the quality of defendant’s product,” and (8) “the sophistication of the buyers.” *Id.*

58 599 F.2d 341 (9th Cir. 1979).

59 *Id.* at 348–49. Those factors are: (1) “strength of the mark,” (2) “proximity of the goods,” (3) “similarity of the marks,” (4) “evidence of actual confusion,” (5) “marketing channels used,” (6) “type of goods and the degree of care likely to be exercised by the purchaser,” (7) “defendant’s intent in selecting the mark,” and (8) “likelihood of expansion of the product lines.” *Id.*


61 304 F.3d 936 (9th Cir. 2002).

62 *Id.* at 942 (citing GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1205 (9th Cir. 2000)).
troika” suggests that confusion is likely, the other factors must “weigh strongly” against a likelihood of confusion to avoid the finding of infringement. If it does not suggest that confusion is likely, then a district court must balance all the Sleekcraft factors within the unique context of each case.

Courts deciding domain name trademark infringement actions under the Lanham Act necessarily stretched the existing provisions to fit the unique aspects of the cybersquatting problem, and the results were mixed. In particular, trademark owners relied on the Lanham Act’s provisions governing an infringing party who makes commercial use of the trademark owners’ “famous” marks. However, such governance was inadequate when, for example, the trademark was not so well known that it met the legal definition of “famous” or when the cybersquatter did not actually use the name in commerce. Finally, litigation costs under the Lanham Act were so substantial that some trademark owners chose to pay exorbitant amounts to purchase the domain name from the cybersquatter rather than pursue expensive, slow litigation.

2. Anti-Cybersquatting Consumer Protection Act (“ACPA”)

On November 29, 1999, Congress attempted to address the inadequacies of the Lanham Act by amending section 43 to create the Anti-Cybersquatting Consumer Protection Act (“ACPA”). The House of Representatives Committee on the Judiciary explained in its report that the purpose of the ACPA was to stop the “practice of cybersquatting who register numerous domain names containing American trademarks or tradenames only to hold

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63 GoTo.com, Inc., 202 F.3d at 1205.
64 Interstellar Starship Servs., 304 F.3d at 942 (citing Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp., 174 F.3d 1036, 1058 (9th Cir. 1999)).
65 See id.
66 See Edward T. Dartley, Pulling the Plug on Cybersquatters, 161 N.J. L.J. 270, 270 (2000) (“However, pre-ACPA attempts to curb cybersquatting forced courts to stretch the existing Lanham Act provisions to fit the unique aspects of the cybersquatting problem, sometimes with mixed results.”).
67 Id.
68 Id.
69 Id.
70 Sorgen, supra note 39, at 118.
them ransom in exchange for money.” The report explained that, at the time, “the legal remedies available to trademark owners to prevent cyberpiracy [were] both expensive and uncertain.”

The ACPA disregards the Lanham Act’s requirements of fame and commercial use, includes “distinctive marks,” and replaces the commercial use requirement with the confusingly similar standard. Specifically, the ACPA provides, in pertinent part:

A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of Title 18 or section 220506 of Title 36.

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72 Id. at 6.
To bring a successful action against a cybersquatter under the ACPA, a court must make three determinations. First, the court determines whether the mark was distinct or famous at the time the domain name was registered. Second, the court determines whether the domain name is identical or confusingly similar to the mark. Third, the court determines whether the domain name registrant acted in bad faith, intending to commercially exploit the similarity between the domain name and the mark. The ACPA gives a nonexhaustive list of nine factors for determining whether a person has bad faith intent.

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76 *Id.* at 224–25.
77 *Id.* at 225.
78 See 15 U.S.C. § 1125(d)(1)(B)(i). The list of “bad faith” factors a court may consider includes:

(I) the trademark or other intellectual property rights of the person, if any, in the domain name; (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person; (III) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services; (IV) the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name; (V) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site; (VI) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct; (VII) the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct; (VIII) the person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and (IX) the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous.
The ACPA empowers a court to order the forfeiture or cancellation of a domain name or the transfer of a domain name to the owner of a relevant trademark. In addition, Congress provides for an award of statutory damages up to $100,000 to deter cybersquatting in bad faith and compensate trademark owners.

3. Uniform Domain Name Dispute Resolution Policy (“UDRP”)

As Congress was enacting the ACPA, ICANN developed the Uniform Domain Name Dispute Resolution Policy (“UDRP”), a non-binding arbitration agreement. The UDRP is a private, international, inexpensive, relatively fast, predominantly online dispute resolution procedure for situations where a complainant is disputing the registration of a domain name. The UDRP was adopted on August 26, 1999 and became effective on January 3, 2000. All registrars certified by ICANN must adopt the UDRP.

A UDRP proceeding generally takes about two months, which is more efficient than litigation for trademark owners seeking to repossess a domain name from a cybersquatter. Thus, the UDRP is very attractive for potential complainants that only want to have the domain name transferred. The UDRP has been described as “the administrative alternative to ACPA suits.”

Id.

79 Id. § 1125(d)(1)(C).

80 Id. § 1117(d); see Parchomovsky, supra note 75, at 225 n.70 (“The statutory damages serve two purposes. First, they ensure that the trademark owner receives just compensation for the loss she suffered. Second, they serve a deterrent effect. The threat of losing $100,000 may induce domain-name registrants, especially risk averse ones, to settle cases rather than litigate them until the end.”).


82 See Ward, supra note 21, at 229.

83 Lipton, Beyond Cybersquatting, supra note 38, at 1372.

84 Ward, supra note 21, at 229 n.147.

85 See supra note 19 and accompanying text.

86 Ward, supra note 21, at 229.

87 See Sorgen, supra note 39, at 146.

88 See Schwartz, Consumer Watchdog’s Bark, supra note 27, at 97.

89 Id.

90 Barrett, supra note 12, at 1048 n.290.
The registrars certified by ICANN contractually bind all domain name registrants to submit to a mandatory arbitration under the UDRP if a complaint is made about the registration of one or more relevant domain names.\textsuperscript{91} ICANN uses four separate organizations to adjudicate domain name disputes,\textsuperscript{92} the most significant registrar is the World Intellectual Property Organization ("WIPO").\textsuperscript{93}

To prevail under the UDRP, a complainant must meet a three-prong test.\textsuperscript{94} The complainant must demonstrate that (1) its “domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights,”\textsuperscript{95} (2) the respondent has “no rights or legitimate interests in respect of the domain name,”\textsuperscript{96} and (3) the respondent’s “domain name has been registered and is being used in bad faith.”\textsuperscript{97} All three elements must be present to begin an arbitration proceeding.\textsuperscript{98}

The UDRP provides a nonexhaustive list of factors to consider when determining if there is evidence that the registrant obtained the domain name in bad faith.\textsuperscript{99} Those factors are “strikingly

\begin{itemize}
\item \textsuperscript{91} Lipton, Beyond Cybersquatting, supra note 38, at 1372.
\item \textsuperscript{92} Sorgen, supra note 39, at 124. Those four registrars are the World Intellectual Property Organization ("WIPO"), the National Arbitration Forum ("NAF"), Disputes.org/eResolution Consortium ("eResolution"), and the CPR Institute for Dispute Resolution ("CPR"). \textit{Id}
\item \textsuperscript{93} Lipton, Beyond Cybersquatting, supra note 38, at 1372; see also Milton Mueller, \textit{Rough Justice: An Analysis of ICANN’s Uniform Dispute Resolution Policy} 3, http://dcc.syr.edu/miscarticles/roughjustice.pdf (last visited Sept. 20, 2009) (stating that WIPO attracts 61% of complaints).
\item \textsuperscript{94} Ward, supra note 21, at 230 (“The proof required to prevail under the UDRP is similar to the showing that must be made under the ACPA. The UDRP requires a complainant to meet a three-prong test to win the arbitration and obtain a favorable ruling.”).
\item \textsuperscript{95} ICANN, supra note 81, § 4(a)(i).
\item \textsuperscript{96} \textit{Id}. § 4(a)(ii).
\item \textsuperscript{97} \textit{Id}. § 4(a)(iii); see Ward, supra note 21, at 231 & n.161 (explaining that the domain name must be actually used, not just simply registered).
\item \textsuperscript{98} Sorgen, supra note 39, at 125.
\item \textsuperscript{99} See ICANN, supra note 81, § 4(b). Those factors are:
\begin{itemize}
\item (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess
similar” to the factors in the ACPA. In addition, the UDRP provides a nonexhaustive list of circumstances that, “if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the complainant’s] rights or legitimate interests to the domain name.” However, “[p]anels are currently split in the context of trademark-identical gripe sites, with some encouraging the use of pejorative terms to avoid confusing similarity and others denying that the addition of a pejorative term to a trademark has any impact whatsoever.”

UDRP decisions may be appealed to United States federal courts, which review panel decisions de novo.

E. Permissibility of Gripe Sites

Trademark owners seeking to prevent domain name registrants from using their trademark in a gripe site domain name have

of your documented out-of-pocket costs directly related to the domain name; (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; and (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Id. See Sorgen, supra note 39, at 125.

ICANN, supra note 81, § 4(c). Those circumstances are:
(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Id.


Schwartz, Consumer Watchdog’s Bark, supra note 27, at 109.
sought to enforce their rights through litigation in federal court under the Lanham Act and the ACPA and through arbitration under the UDRP.

1. Federal Court Litigation

The federal courts have reviewed only a limited number of cases involving gripe sites with derogatory terms in the website domain name. The four landmark cases that follow demonstrate the tendency of federal courts to hold in favor of defendant gripe site operators.104

a) Bally Total Fitness Holding Corp. v. Faber

In 1998, the United States District Court for the Central District of California decided the case of *Bally Total Fitness Holding Corp. v. Faber*.105 Bally Total Fitness Holding Corp. (“Bally”) owns the federally registered trademarks and service marks “Bally,” “Bally’s Total Fitness,” and “Bally Total Fitness.”106 Andrew Faber (“Faber”) created a website at www.compupix.com/ballysucks dedicated to complaining about Bally’s health club business.107 An Internet user entering the search term “Bally” would be directed to both Bally’s official website and Faber’s gripe website.108 Internet users who accessed the website would discover Bally’s mark with the word “sucks” printed across it.109 Underneath that image were the words “Bally Total Fitness Complaints! Un-Authorized.”110

Bally brought an action against Faber for trademark infringement, unfair competition, and dilution.111 The court

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104 See infra notes 105–65 and accompanying text.
106 Please note that unlike other gripe site cases, the trademark at issue in *Bally* was not located in the domain name. See generally Creasman, supra note 11, at 1051 (“[T]he registrant’s compupix.com/ballysucks website . . . included the trademark in the Uniform Resource Locator (URL) but not in the domain name portion of the URL.”).
107 *Bally*, 29 F. Supp. 2d at 1162.
108 Johnson, supra note 30, at 478.
109 *Bally*, 29 F. Supp. 2d at 1162.
110 Id.
111 Id.
explained that the *Sleekcraft* factors\textsuperscript{112} for determining likelihood of confusion in a trademark infringement case apply only to related goods and that Bally’s health club and Faber’s website were not related goods.\textsuperscript{113} Further, the court held that because Faber’s website states that it is “unauthorized” and displays the words “Bally sucks,” “[n]o reasonable consumer comparing Bally’s official web site with Faber’s site would assume Faber’s site ‘to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.’”\textsuperscript{114}

Nevertheless, the court still conducted a *Sleekcraft* factors analysis and determined that Bally’s claim failed under that test too.\textsuperscript{115} In particular, the court indicated that Faber’s attachment of “sucks” to Bally’s marks makes Faber’s marks dissimilar from Bally’s marks.\textsuperscript{116} In ruling against Bally on the “similarity of the marks” factor, the court explained that “[s]ucks’ has entered the vernacular as a word loaded with criticism” and that “[i]t is impossible to see Bally’s mark without seeing the word ‘sucks.’”\textsuperscript{117} In addition, the court ruled against Bally on the “evidence of actual confusion” factor.\textsuperscript{118}

In sum, the court in *Bally* recognized that the Internet “affords critics of . . . businesses an . . . efficient means of disseminating

\textsuperscript{112} See supra notes 58–59 and accompanying text.
\textsuperscript{113} See *Bally*, 29 F. Supp. 2d at 1163; see also *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1363 (9th Cir. 1985) (“Related goods are those goods which, though not identical, are related in the minds of consumers.”). The court held that because Bally was involved in the health club industry and Faber was involved in the webpage design industry, their goods were not related. *Bally*, 29 F. Supp. 2d at 1163. The court further explained 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.” *Id.*
\textsuperscript{114} *Bally*, 29 F. Supp. 2d at 1163–64.
\textsuperscript{115} See *id.* at 1164–66.
\textsuperscript{116} See *id.* at 1164 (“Bally argues that the marks are identical. Bally argues that the only difference between the marks is that Faber attached the word ‘sucks’ to Bally’s marks. Bally argues that this is a minor difference.”).
\textsuperscript{117} *Id.*
\textsuperscript{118} *Id.* The court noted that Faber’s site states that it is “unauthorized” and that Faber superimposed the word “sucks” over Bally’s mark; the court concluded that “the reasonably prudent user would not mistake Faber’s site for Bally’s official site.” *Id.*
critical commentary.”  

Such a statement recognizes a First Amendment limitation on the rights of a trademark holder and is a “victory for free speech advocates.” The court found that it was unable to provide a remedy for Bally and granted Faber’s motion for summary judgment.

The holding in *Bally* covers the permissibility of the website www.compupix.com/ballysucks. However, in dicta, the court stated that “even if Faber did use the mark as part of a larger domain name, such as ‘ballysucks.com,’ this would not necessarily be a violation as a matter of law.” The court explained that “no reasonably prudent Internet user would believe that ‘Ballysucks.com’ is the official Bally site or is sponsored by Bally.”

Although the *Bally* decision of 1998 came before the enactment of the ACPA, “the *Bally* court’s analysis directly mirrors [the ACPA’s] identical or confusingly similar standard.”

b) Lucent Technologies, Inc. v. Lucentsucks.com

In 2000, the United States District Court for the Eastern District of Virginia decided the case of *Lucent Technologies, Inc. v. Lucentsucks.com*. *Lucent Technologies, Inc.* (“Lucent”) had owned the federally registered trademarks “Lucent” and “Lucent Technologies” since November 30, 1995. Russell Johnson (“Johnson”) registered the domain name lucentsucks.com, which allegedly contained pornographic photographs and services for

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119 Id. at 1168 (“The explosion of the Internet is not without its growing pains. It is an efficient means for business to disseminate information, but it also affords critics of those businesses an equally efficient means of disseminating critical commentary.”).

120 Id. at 1166 (“Applying Bally’s argument would extend trademark protection to eclipse First Amendment rights. The courts, however, have rejected this approach by holding that trademark rights may be limited by First Amendment concerns.”).

121 Oscar S. Cisneros, Comment, Bally Total Fitness Holding Corp. v. Faber, 15 BERKELEY TECH. L.J. 229, 241 (2000) (“The Bally decision also represents a victory for free speech advocates in their battle against trademark restrictions on the Internet.”).

122 *Bally*, 29 F. Supp. 2d at 1168.

123 Id.

124 Id. at 1165.

125 Id. at 1165 n.2.

126 Sorgen, supra note 39, at 132; see also supra Part I.D.2.


128 Id. at 529.
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sale.129 Lucent brought an action against Johnson for trademark infringement and dilution.130 The court granted Johnson’s motion to dismiss the complaint on the basis of Lucent’s failure to satisfy the jurisdictional requirements of the ACPA.131

Nevertheless, the court discussed the merits of Johnson’s arguments under the then-recently-enacted ACPA.132 Johnson submitted the free speech rights argument that domain names indicative of parody suggest absence of likelihood of confusion and bad faith intent.133 The court maintained that Johnson’s arguments were persuasive, explaining in dicta that “the average consumer would not confuse luentsucks.com with a web site sponsored by [Lucent]”134 and that “[a] successful showing that luentsucks.com is effective parody and/or a cite [sic] for critical commentary would seriously undermine the requisite elements for the causes of action at issue in this case.”135 The “[Lucent] court embraced the [Bally] court’s reasoning regarding the counter-cultural meaning of pejorative terms.”136

c) Ford Motor Co. v. 2600 Enterprises

In 2001, the United States District Court for the Eastern District of Michigan decided the case of Ford Motor Co. v. 2600 Enterprises.137 2600 Enterprises and Eric Corley (“Corley”) registered the domain name fuckgeneralmotors.com.138 An Internet user who types fuckgeneralmotors.com into a web browser is automatically redirected to ford.com.139 Ford Motor Company (“Ford”) brought an action against 2600 Enterprises and Corley for trademark dilution, trademark infringement, and unfair

129 Id.
130 Id.
131 Id.
132 See id. at 529, 534–36 (“Because the ACPA is a new statute, and is still the source of some confusion, we also briefly address some of defendant’s other arguments.”).
133 See id. at 535.
134 Id. at 535.
135 Id. at 535–36.
136 Schwartz, Consumer Watchdog’s Bark, supra note 27, at 92.
138 Id. at 661–62.
139 Id. at 662.
competition. The court denied Ford’s motion for a preliminary injunction.

The court rejected Ford’s argument that the defendants’ use of the Ford mark constitutes “commercial use.” The court explained that the defendants were not using Ford’s mark for commercial gain and thus that their use was not actionable. Further, the court opined that the registered domain name (www.fuckgeneralmotors.com) did not contain Ford’s mark in the domain name itself but rather just in the programming code. Specifically, the programming code redirected users from www.fuckgeneralmotors.com to www.ford.com, but the word Ford was nonetheless not in the actual domain name. Finally, the court held that the unauthorized use did not compete with Ford’s offering of goods or services because the defendants’ use of Ford in their programming code did not prevent Internet users from reaching Ford’s legitimate websites.

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140 Id.
141 Id.
142 Id. at 664.
143 See id. at 663, 665. “In this case, no allegation has been made that Defendants are providing any goods or services for sale under the FORD mark or that they solicit funds . . .” Id. at 663.
144 See id. at 664 (“Here, the domain name registered by Defendants—‘fuckgeneralmotors.com’—does not incorporate any of Ford’s marks. Rather, Defendants only use of the word ‘ford’ is in its programming code, which does no more than create a hyperlink—albeit automatic—to Plaintiff’s ‘ford.com’ site. The court is unpersuaded that this use of the FORD mark in any way hampers Plaintiff’s commercial success in an unlawful manner.”).
145 See id. at 662.
146 This court does not believe that Congress intended the FTDA to be used by trademark holders as a tool for eliminating Internet links that, in the trademark holder’s subjective view, somehow disparage its trademark. Trademark law does not permit Plaintiff to enjoin persons from linking to its homepage simply because it does not like the domain name or other content of the linking webpage.

Id. at 664.
146 Id. at 665.
d) Taubman Co. v. Webfeats

In 2003, the United States Court of Appeals for the Sixth Circuit decided the case of *Taubman Co. v. Webfeats*, on appeal from a judgment in the United States District Court for the Eastern District of Michigan, which had granted the plaintiff two preliminary injunctions. Henry Mishkoff (“Mishkoff”) created the websites theshopsatwillowbend.com and shopwillowbend.com to advertise a new shopping complex being built near his home. Mishkoff was unaffiliated with the mall. When the Taubman Company (“Taubman”) was building the shopping mall, “Taubman discovered that Mishkoff had created this site, [and] . . . demanded he remove it from the internet.”

In response, Mishkoff registered the domain names taubmansucks.com, shopsatwillowbendsucks.com, theshopsatwillowbendsucks.com, willowbendmallsucks.com, and willowbendsucks.com. Each of these domain names linked to a website featuring a running editorial on Mishkoff’s battle with Taubman and its lawyers. The district court granted Taubman’s preliminary injunctions to prevent Mishkoff from using the website shopsatwillowbend.com as well as the five complaint sites. The district court relied on the Lanham Act in granting its injunction.

The circuit court reviewed the district court’s decision for abuse of discretion and dissolved both preliminary injunctions. The court explained that the gripe site taubmansucks.com was an expression of free speech and that “the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a

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147 319 F.3d 770 (6th Cir. 2003).
148 Id. at 771.
149 Id. at 772.
150 Id.
151 Id.
152 Id.
153 Id.
154 See id. at 773.
155 Id. at 773 n.2.
156 Id. at 774.
157 Id. at 780.
business.”158 The court analogized screaming “Taubman Sucks!” from the rooftops—which is permissible under the First Amendment—to writing “taubmansucks” in a domain name.159

Further, the court noted that Mishkoff did not use Taubman’s mark to sell competing goods and that Mishkoff’s use of Taubman’s marks caused no negative impact on the public interest.160 In sum, the court held that a person can

make a lawful noncommercial use of another’s trademark in the domain name of a website, either standing alone or with a pejorative term, such as “sucks,” appended to it, so long as the site includes a disclaimer of affiliation with the trademark holder and does not exist as a conduit for the sales of products.161

Thus, federal courts seem to decide gripe site cases by siding with the domain name owner rather than the trademark owner.162 The courts generally consider the notion that an Internet user is not likely to believe that the trademark owner would create a website disparaging his or her mark.163 In addition, federal courts explain that these gripe sites are noncommercial.164 Consequently, the four key federal court gripe site cases ruled in favor of the domain name owner.165

158 Id. at 778.
159 See id. (“In fact, Taubman concedes that Mishkoff is ‘free to shout ‘Taubman Sucks!’ from the rooftops . . . .’ Essentially, this is what he has done in his domain name. The rooftops of our past have evolved into the internet domain names of our present. We find that the domain name is a type of public expression, no different in scope than a billboard or a pulpit, and Mishkoff has a First Amendment right to express his opinion about Taubman, and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.”).
160 See id. at 778.
162 See id. at 122.
163 See id. at 96–97.
164 See id. at 113.
165 See id. at 113–17.
2. World Intellectual Property Organization (“WIPO”) Hearings

Whereas the federal courts have reviewed only a limited number of cases involving gripe sites with derogatory terms in the website domain name, the WIPO panels have held many hearings involving such websites. Panels are split on their interpretation of the confusingly similar element, and on “whether the addition of a pejorative term . . . to a trademark [in a domain name] shields the respondent from liability.”166

a) Analysis of WIPO Decisions

Between July 20, 2000 and October 31, 2008, WIPO decided thirty-seven (37) cases involving fifty-two (52) domain names containing the word “sucks” or a spelling variation of the word “sucks.”167 WIPO ruled in favor of the complainant trademark owner in twenty-seven (27) cases involving forty-one (41) domain names.168 WIPO ruled in favor of the respondent domain name

166 Schwartz, Consumer Watchdog’s Bark, supra note 27, at 101–02 (“[P]anels are also split on whether the addition of a pejorative term, such as ‘sucks,’ ‘exposed,’ ‘stupidity,’ ‘never,’ and ‘stop,’ to a trademark shields the respondent from liability.”).
167 See WIPO UDRP Domain Name Decisions (gTLD), http://www.wipo.int/amc/en/domains/decisions/index.html (last visited Sept. 20, 2009). To obtain the numbers thirty-seven and fifty-two, it is necessary to search all of the decisions available at this website and count the ones involving domain names with the word “sucks,” “suckz,” “suck,” or “sux.”
registrant in ten (10) cases involving eleven (11) domain names. These numbers indicate that WIPO ruled in favor of the
complainants in almost three times as many cases as they ruled in favor of domain name registrants. As a result of these decisions, WIPO ordered 79% of domain names to be returned to the trademark owner, while just 21% of domain names were allowed to remain in the domain name registrant’s possession.

b) Panels Holding for Trademark Owner (Complainant)

The WIPO panels analyze the legitimacy of domain names according to the tripartite test laid out in paragraph 4(a) of the UDRP. If the panel finds that (1) the domain name is “identical or confusingly similar to a trademark or service mark” in which the complainant has rights, (2) the respondent has “no rights or legitimate interests” in the domain name, and (3) the respondent domain name is being “registered . . . and used in bad faith,” then the panel will transfer the domain name to the complainant. Between July 20, 2000, and October 31, 2008, the WIPO transferred forty-one (41) domain names to the complainant trademark owners.

First, panels that hold that the format of gripe sites is “confusingly similar” reason that (1) non-English speakers do not necessarily recognize that the addition of the pejorative term dissociates the website from the trademark owner; (2) if the domain name contains the trademark at all, then consumers are likely to associate the website with the trademark owner; (3)
consumers may be diverted from the trademark owner’s website to the respondent’s website when both websites appear in a search engine’s results;177 (4) the term “sucks” or a similar term may be used in its literal descriptive sense, rather than in a “pejorative sense,” such as in an advertising slogan;178 and (5) some companies have established comment sites to obtain feedback on

sites identified by reference to the target’s name, can it be said that the registration would be recognised [sic] as an address plainly dissociated from the Complainant? In the Panel’s opinion, this is by no means necessarily so. The first and immediately striking element in the Domain Name is the Complainant’s name. Adoption of it in the Domain Name is inherently likely to lead some people to believe that the Complainant is connected with it. Some will treat the additional ‘sucks’ as a pejorative exclamation and therefore dissociate it after all from the Complainant; but equally others may be unable to give it any very definite meaning and will be confused about the potential association with the Complainant.”).

177 See TPI Holdings, Inc. v. AFX Commc’ns, Case No. D2000-1472, WIPO Administrative Panel Decision (Feb. 2, 2001), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1472.html (“When an Internet user enters a trademark into search engine and a ‘sucks’-formative domain name is returned as a search result, that user is likely to proceed to the site so identified because of interest or puzzlement created by association of the trademark and the pejorative term. The operator of the website identified by the ‘sucks’-formative domain name will have accomplished the objective of diverting the Internet user seeking the trademark holder’s website. Bad faith adoption of a trademark, including in a ‘sucks’-formative domain name, increases the likelihood of a finding of confusing similarity.”); see also Wal-Mart Stores, Inc. v. Walsucks, Case No. D2000-0477, WIPO Administrative Panel Decision (July 20, 2000), available at http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0477.html (“However, it is likely (given the relative ease by which websites can be entered) that such users will choose to visit the [gripe] sites, if only to satisfy their curiosity. Respondent will have accomplished his objective of diverting potential customers of Complainant to his websites by the use of domain names that are similar to Complainant’s trademark.”).

178 See Vivendi Universal v. Sallen, Case No. D2001-1121, WIPO Administrative Panel Decision (Nov. 7, 2001), available at http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1121.html (“[T]he addition of the word ‘sucks’ to a well-known trademark is not always likely to be taken as ‘language clearly indicating that the domain name is not affiliated with the trademark owner.’ Two examples of the use of the word ‘sucks’ which do not so indicate, even to English speakers, are: (1) the use of the words ‘sucks’ purely descriptively, as in the advertising slogan ‘Nothing sucks like Electrolux’ (If there were a website at <electroluxsucks.com>, it would be unlikely to be taken as unaffiliated with the company Electrolux); and (2) the website of the band Primus, <primussucks.com>, so named after the album Suck on This (1990). (The website of the band’s lead singer, Les Claypool, at <lesclaypool.com>, has a link to the <primussucks.com> website.”).
their products, and thus, consumers may associate the comment site with the gripe site.179

Second, the panel in Chubb Security Australia PTY Ltd. v. Tahmasebi explained that to make a prima facie showing of “no rights or legitimate interests” in the domain name, a complainant must demonstrate that the respondent (1) has not been “commonly known by or associated” with the trademark;180 (2) “has chosen a domain name containing the Complainant’s trademark and which is confusingly similar to the trademark;”181 (3) “has appropriated the Complainant’s name and trademark without permission;”182 and (4) created a website which “does not carry a disclaimer to dispel any initial confusion between the domain name and the Complainant and its trademark.”183

Finally, four examples of evidence of registration and use in bad faith are explicated in the UDRP.184 They are:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark

179 See Koninklijke Philips Elecs. N.V. v. In Seo Kim, Case No. D2001-1195, WIPO Administrative Panel Decision (Nov. 12, 2001), available at http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1195.html (“[I]t is not unknown for companies to establish complaint or comment sites or areas of sites to obtain feedback on their products; accordingly, some people might suppose that a website of this nature at the Domain Name was operated by the Complainant.”).
181 Id.
182 Id.
183 Id.
184 ICANN, supra note 81, § 4(b).
in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.\footnote{Id.}

When a panel finds evidence supporting all three of the abovementioned factors—confusingly similar, no rights or legitimate interests, registration and use in bad faith—it decides to transfer the domain name to the complainant.

c) Panels Holding for Domain Name Registrant (Respondent)

On the other hand, a minority of panels\footnote{See Chubb Sec. Austl. PTY Ltd. v. Tahmasebi, Case No. D2007-0769, WIPO Administrative Panel Decision (Aug. 13, 2007).} have rejected the argument that a gripe site’s use of a mark is impermissible under the UDRP. Those panels found that the complainant failed to satisfy one or more of the prongs of the UDRP tripartite test.\footnote{See supra note 170 and accompanying text.} When determining that a registrant’s domain name is not identical or “confusingly similar” to a trademark, the panels explained that (1) in response to the English language barrier argument,\footnote{See supra note 175 and accompanying text.} Internet users who do not understand the significance of appending “sucks” to a trademark exist in such small numbers as to be insignificant;\footnote{See Asda Group Ltd. v. Kilgour, Case No. D2002-0857, WIPO Administrative Panel Decision (Nov. 11, 2002), available at \url{http://www.wipo.int/ami/en/domains/decisions/html/2002/d2002-0857.html} (“[B]y now the number of Internet users who do not appreciate the significance of the ‘-sucks’ suffix must be so small as to be de minimis and not worthy of consideration.”).} (2) Internet users should realize that “[m]ost

\begin{footnotes}
\item Id.
\item \textit{See supra} note 170 and accompanying text.
\item \textit{See supra} note 175 and accompanying text.
\item \textit{See Asda Group Ltd. v. Kilgour, Case No. D2002-0857, WIPO Administrative Panel Decision (Nov. 11, 2002), available at }\url{http://www.wipo.int/ami/en/domains/decisions/html/2002/d2002-0857.html} (“[B]y now the number of Internet users who do not appreciate the significance of the ‘-sucks’ suffix must be so small as to be de minimis and not worthy of consideration.”).
\end{footnotes}
companies would not publish a website with such a self-denigrating domain name”; 190 (3) common sense and the plain language of the UDRP “[s]upport the view that a domain name combining a trademark with the word ‘sucks’ or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark;” 191 and (4) an Internet user happening upon a gripe site will realize that it is intended to criticize and not to comport with the goals of the trademark. 192

Paragraph 4(c) of the UDRP counsels domain name registrants in demonstrating their rights to and legitimate interests in the domain name. 193 Additionally, the panel in Russo v. Guillaumin 194 elaborated on paragraph 4(c)(iii) by explaining that:

[I]n a proceeding involving parties resident in the United States of America, the free speech guaranty of the First Amendment to the Constitution confers a right or legitimate interest on the use of a domain

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192 See id. (“[O]nce the searcher sees <lockheedsucks.com> and <lockheedmartinsucks.com> listed among the websites for further search, she will be able readily to distinguish the Respondent’s site for criticism from Complainant’s sites for goods from aerospace to t-shirts.”).

193 See ICANN, supra note 81, § 4(c). Three examples of ways to demonstrate “legitimate interest” include:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Id.

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name that itself is an expression of opinion, at least
in the absence of other evidence that the registration
of this domain name was merely a pretext for
cybersquatting.195

The panels in La Quinta Worldwide L.L.C. v. Heartland Times
LLC196 and McLane Co. v. Craig197 similarly held that creating a
website sincerely dedicated to expressing one’s negative opinion
about a company is a legitimate noncommercial fair use.198

Finally, in reference to the “bad faith” requirement, the panel in
La Quinta Worldwide L.L.C. v. Heartland Times LLC stated that
“something more than criticism is required to establish illegitimacy
and bad faith within the meaning of the Policy.”199 Other panels
have determined an absence of bad faith because (1) they do not
consider solicitation of donations commercial use or (2) they
consider sale of merchandise “merely ancillary” to the primary
purpose of criticism.200 Additionally, panels conduct a bad faith
analysis by considering the following factors: (1) if the respondent
has registered multiple domain names containing trademarked
terms; (2) whether the respondent “knew or should have known”
about the registered trademark “prior to registering the domain

195 Id.

196 La Quinta Worldwide L.L.C. v. Heartland Times LLC, Case No. D2007-1660,

197 McLane Co. v. Craig, Case No. D2000-1455, WIPO Administrative Panel Decision
d2000-1455.html.

198 La Quinta Worldwide L.L.C. v. Heartland Times LLC, Case No. D2007-1660,
WIPO Administrative Panel Decision (Jan. 17, 2008) (“The Respondent claims to be
making legitimate noncommercial or fair use of the Domain Name for a ‘cyber-gripe’
opinion website critical of the Complainant and its franchisees . . . . On the face of it, the
website associated with the Domain Name is clearly a ‘protest’ or ‘criticism’ website
concerning the Complainant’s actions and the character and conduct of certain of its
Nebraska franchisees.”); McLane Co. v. Craig, Case No. D2000-1455, WIPO
Administrative Panel Decision (Jan. 11, 2001) (“Respondent is using the domain name
‘mclanenortheast.com’ as a means of protesting against Complainant. Respondent has a
grievance against Complainant and has chosen to publicize this grievance via a web site.
Protest and commentary is the quintessential noncommercial fair use envisioned by the
Policy.”).

199 La Quinta Worldwide L.L.C. v. Heartland Times LLC, Case No. D2007-1660,
WIPO Administrative Panel Decision (Jan. 17, 2008).

200 Schwartz, Consumer Watchdog’s Bark, supra note 27, at 107–08.
name”; and (3) “whether the defendant intentionally chose the name as the address of the gripe site because of the likelihood of diversion.”

F. Permissibility of Love Sites

Between June 4, 2003, and December 19, 2008, WIPO decided six cases involving seven domain names containing the word “love.” WIPO ruled in favor of the complainant trademark owner in all six cases involving all seven domain names. In all six cases involving domain names containing the word “love,” the WIPO panels based their decisions to transfer the domain name to the complainant on a tripartite finding based on paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy. First, the respondents’ domain names were all held to be “identical or confusingly similar to a trademark or service mark” in which the complainant has rights. Second, the respondents were found to

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201 Id. at 108.
202 See WIPO UDRP Domain Name Decisions, supra 167. To find the above-mentioned six cases involving seven domain names, it is necessary to search all of the decisions available at this website and to count the domain names with the word “love.”
204 See supra note 202 and accompanying text.
205 See ICANN, supra note 81, § 4(a).
206 See id. § 4(a)(i). For example, in Harrods Ltd. v. Iorio, the panel explained that “[u]sing the prefix ‘I love’ with the HARRODS trademark does not avoid the disputed domain name being confusingly similar to that trademark.” Harrods Ltd. v. Iorio, Case No. D2008-1684, WIPO Administrative Panel Decision (Dec. 19, 2008). In Serta Inc. v.
have “no rights or legitimate interests” in the domain name.\textsuperscript{207} Third, the panels all found that the respondent domain names were being “registered . . . and used in bad faith.”\textsuperscript{208}

However, it is important to note that the decisions on love sites arbitrated by WIPO have left open the question of whether a domain name containing the word “love” and a trademark owner’s trademark, whose website content exclusively endorsed and promoted the trademark, would be in violation of the UDRP.\textsuperscript{209} In


\textit{Dawson}, the panel explained that “[t]he disputed domain name contains the SERTA mark in its entirety, and the addition of the descriptive phrases [sic] ‘I love my’ is insufficient to change the fact that the domain name is confusingly similar to Complainant’s trademark.” Serta Inc. v. Dawson, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008). Finally, in \textit{GA MODEFINE SA v. pumo}, the panel said that “[g]enerally, the use of the generic term ‘love’ is rather suitable to reinforce the association of the Domain Name with the Complainant’s trademark than to create a clear distinction.” GA MODEFINE SA v. pumo, Case No. D2006-0619, WIPO Administrative Panel Decision (July 18, 2006).

\textsuperscript{207} See ICANN, supra note 81, § 4(a)(ii). In finding that the complainant in \textit{Serta Inc. v. Dawson} “sufficiently pled a prima facie case of illegitimacy,” the panel focused on how the complainant “has shown that Respondent is not associated with any business named ‘I Love My Serta,’ has no present authorization to use the SERTA trademark, and is currently using the disputed domain name illegitimately as a parking page with PPC links to Complainant’s competitors.” Serta Inc. v. Dawson, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008) (emphasis in original).

\textsuperscript{208} See ICANN, supra note 81, § 4(a)(iii). The panel in \textit{Serta Inc. v. Dawson} clarified the bad faith requirement when it stated that “Respondent intentionally attempted to attract internet user [sic] to his website through the fame and goodwill of the SERTA mark.” Serta Inc. v. Dawson, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008). In \textit{Presse v. Shi Cheng}, the panel similarly qualified their determination that respondent had registered the domain name in bad faith, saying that “Respondent had registered and used the disputed domain name . . . to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s ELLE mark as to the source, sponsorship, affiliation and/or endorsement of the Respondent’s website promoting merchandise unrelated to the Complainant.” Presse v. Shi Cheng, Case No. D2005-1240, WIPO Administrative Panel Decision (Feb. 24, 2006).

theory, a love site differs from a gripe site because it promotes, rather than disparages, the trademark. However, while the domain names for these love sites appeared to promote the trademark, the content of these sites actually disparaged the trademark. Because the love site cases arbitrated by the WIPO all dealt with domain names that were registered in bad faith, the panels’ rulings on the “identical or confusingly similar” and “no legitimate interest” factors could not dispose of the case; rather, the “bad faith” factor was dispositive, while the discussion of the “identical or confusingly similar” and “no legitimate interest” factors is dicta.

II. MARKETING CAMPAIGNS WITH UNCLEAR SPONSORING COMPANIES

Much of the domain name trademark law analysis focuses on the “likelihood of confusion” test. When assessing likelihood of confusion, it is critical to consider the ever-changing marketing and media environment. Companies are increasingly employing unique, cutting-edge marketing techniques to cut through the clutter of advertisements and capture consumers’ attention. This section will explore some new alternative marketing techniques that call into question the traditional assumptions underlying the likelihood of confusion test.

By some estimates, approximately five thousand advertisements bombard the average consumer each day. People have access to endless information, but “[w]hat’s in short

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210 See supra Part I.D.1.
211 See infra note 215 and accompanying text.
212 Caitlin A. Johnson, Cutting Through Advertising Clutter, CBS NEWS, Sept. 17, 2006, http://www.cbsnews.com/stories/2006/09/17/sunday/main2015684.shtml (“[W]e’ve gone from being exposed to about 500 ads a day back in the 1970’s to as many as 5,000 a day today.”).
supply is human attention."\(^{213}\) Ad clutter "annoys the audience," "diminishes ad effectiveness," and "negatively impacts brand perception."\(^{214}\) With traditional media and online media competing for consumers’ attention, advertisers have been working increasingly harder to get noticed amid the noisy clutter.\(^{215}\) Information oversaturation requires companies to “up the ante” by constantly being more creative and more outrageous than any of the advertisements that preceded their latest marketing campaign.\(^{216}\)

Four examples of innovative marketing campaigns that broke through the clutter so effectively that viewers proactively shared them with other people are: Burger King’s “Subservient Chicken,”\(^{217}\) Smirnoff’s “Tea Partay,”\(^{218}\) Court TV’s “That Girl Emily,”\(^{219}\) and McDonald’s “The Lost Ring.”\(^{220}\) All four of these campaigns’ creativity stemmed, in part, from a clever strategy whereby viewers did not know the identity of the sponsoring company. In other words, it could be said that all four of these campaigns’ creativity stemmed, in part, from a strategy whereby companies intentionally created a “likelihood of confusion” to send a message to consumers while trying not to promote a commercial agenda that could irritate and alienate those consumers already overwhelmed by society’s ubiquity of advertisements.

These campaigns are relevant to the gripe site and fan site cases because they embody a new marketing trend whereby consumers are effectively targeted precisely because they do not know the identity of the company targeting them. The company thereby remains unobtrusive while sending a memorable message


\(^{216}\) See Johnson, supra note 212.

\(^{217}\) See infra notes 223–33 and accompanying text.

\(^{218}\) See infra notes 234–42 and accompanying text.

\(^{219}\) See infra notes 243–50 and accompanying text.

\(^{220}\) See infra notes 251–59 and accompanying text.
that consumers not only internalize but also desire to share with others. Thus, a company enhances its brand and the value of its trademark through indirect, secretive means.

A. Viral Marketing Campaigns

1. Case Study: Burger King’s “Subservient Chicken”

Starting in March 2005, visitors logged onto www.subservientchicken.com, amounting to almost 400 million hits, to issue commands to a man in a chicken suit wearing lingerie. Website visitors asked the chicken to perform desired actions, such as “jump,” “watch tv,” “take a nap,” “take off your pants,” “wave,” “lay an egg,” “eat,” “sit,” “run around,” and “fart.” The chicken performed one of four hundred different prerecorded functions in a seedy basement reminiscent of a 1980s pornography set “as if he were the voyeuristic visitor’s personal slave.” “Fascinated folks” forwarded the website to their friends, who in turn forwarded it to their friends, and bloggers posted entries speculating on various commands that would instruct the chicken to act “down and dirty.”

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221 See generally SUSAN SWEENEY, 101 WAYS TO PROMOTE YOUR WEB SITE: FILLED WITH PROVEN INTERNET MARKETING TIPS, TOOLS, TECHNIQUES, AND RESOURCES TO INCREASE YOUR WEB SITE TRAFFIC 47 (6th ed. 2006) (discussing the concept and benefits of viral marketing).

222 See BRAD VANAUKEN, BRAND AID: AN EASY REFERENCE GUIDE TO SOLVING YOUR TOUGHEST BRANDING PROBLEMS AND STRENGTHENING YOUR MARKET POSITION 250 (2003) (stating that “trademark law protects a brand’s identity”).


228 See Hein, supra note 226, at 27.

229 Id.
What surprised users most, however, was that Burger King was “behind this strange Web phenomenon.”\textsuperscript{230} The unique, interesting website implicitly promoted Burger King’s brand promise, “Have it your way.”\textsuperscript{231} The website did not overtly state that it was a Burger King website.\textsuperscript{232} When some people found out that the website was an advertisement for Burger King, they became resentful,\textsuperscript{233} demonstrating that they used and promoted the website without any knowledge of its sponsorship.

Just as a company can promote a product without the consumer knowing the company’s identity, a person can disparage or promote a trademark, through a “sucks” site or “love” site, respectively, without Internet users knowing whether the company or a third party created the website. Examples of unique marketing techniques such as Burger King’s “Subservient Chicken” viral campaign highlight how a person or company can influence consumers discreetly yet effectively.

2. Case Study: Smirnoff’s “Tea Partay”

In August 2006, Bartle Bogle Hegarty created a music video starring the “Prep Unit,” a group of upscale private-school types

\begin{itemize}
  \item \textsuperscript{230} Mae Anderson, \textit{CP+B’s “Subservient Chicken” Got People Talking About Burger King, But Did Sales Match the Hype?}, \textit{ADWEEK}, Mar. 7, 2005, at 24.
  \item \textsuperscript{231} \textit{Id.}; see also Mullman, \textit{supra} note 225, at 14. Crispin Porter + Bogusky, the advertising agency behind this campaign, describes its creative intent on their website by saying, “[t]o show how customers really can have it their way with chicken, we created a large subservient chicken that does almost anything anyone asks.” Crispin Porter + Bogusky, Subservient Chicken, http://www.cpbgroup.com/awards/subservientchicken.html (last visited Mar. 27, 2009).
  \item \textsuperscript{232} The only mention of Burger King was a link to the TenderCrisp website (via an icon that said “BK Tendercrisp”) and a BKC copyright at the bottom of the page. \textit{Andrew Schieller \& John Marshall, Social Media and the Burger King Brand} 7 (2007), http://mba.tuck.dartmouth.edu/digital/Research/CaseStudies/6-0025.pdf. People thus wondered whether Burger King sponsored the website or if an Internet prankster inserted the Burger King logo onto his website. \textit{See Snopes Urban Legend References Page, Subservient Chicken}, http://www.snopes.com/business/viral/chicken.asp (last visited Mar. 28, 2009).
  \item \textsuperscript{233} \textit{See Seth Stevenson, Masked: Is Burger King Trying to Put One Over on Me?}, \textit{SLATE}, Oct. 24, 2005, http://www.slate.com/id/2128569 (“Later, when they realized that he was promoting a Burger King sandwich, these same people became bitter and resentful. No one enjoys being duped into forwarding an advertisement to all her friends. Some people even felt they had to apologize.”).
\end{itemize}
who rap about the proper way to throw a tea party.\textsuperscript{234} During the first week after its debut, it ranked seventh for the week in total YouTube viewings and twelfth in viewer comments.\textsuperscript{235} While the video focuses on the Prep Unit’s lifestyle, it also “make[s] a soft pitch for Smirnoff Raw Tea.”\textsuperscript{236} Smirnoff is mentioned only in passing in four out of the fifty-six lines in the rap.\textsuperscript{237}

The Internet video was a viral marketing sensation, garnering more than four million hits on YouTube during its first year.\textsuperscript{238} However, the video has been described as “high on entertainment and low on hard sell.”\textsuperscript{239} Some viewers did not realize that Smirnoff sponsored Tea Partay to promote its new malt beverage product, Raw Tea.\textsuperscript{240} Viral marketers walk a fine line between pushing a brand so hard that users reject it as overly commercial and hiding the brand so carefully that the company is accused of deception.\textsuperscript{241} Such a balancing game proved difficult for Smirnoff. Smirnoff obscured its connection with the video so well that viewers did not translate the hilarity of the video into a desire to try Smirnoff Raw Tea.\textsuperscript{242}

\textsuperscript{235} \textit{Id.}
\textsuperscript{237} \textit{See generally} Posting of Duncan to The Inspiration Room, http://theinspirationroom.com/daily/2007/smirnoff-raw-tea-partay (Jan. 3, 2007, 9:00). For example, one stanza reads, “Straight out of Cape Cod / We’re keeping it real / We’re going to have a party makes the ladies squeal / We’re going to turn it on / with our parents’ riches / We’ll serve Smirnoff raw tea and finger sandwiches.” \textit{Id.}
\textsuperscript{239} David, \textit{supra} note 236.
\textsuperscript{241} \textit{See} David, \textit{supra} note 236.
\textsuperscript{242} \textit{See generally} Paul Bennett, 2006 \textit{Ads: The Ones We Remembered}, \textit{BUS. WK. ONLINE}, Dec. 22, 2006, \textit{http://www.businessweek.com/innovate/content/dec2006/id20061222_238626_page_2.htm} (“Next, in the \textit{Bless Them for Trying} category, Smirnoff, for their white viral gangsta rappers that we all circulated for a few days back in the summer. Making fun of the clichés of rap videos—the bling, the grilles and the girls—all from the perspective of a bunch of Martha’s Vineyard preppies was a very funny idea. Unfortunately, I’m not quite sure if anyone actually held a ‘Tea Partay’ in response, or
CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES

The case of Smirnoff’s “Tea Partay” viral marketing video presents yet another example where a company promoted its product without identifying its association with the product to consumers. Such a situation is pertinent to the gripe site and love site analysis because it shows how consumer opinion can be influenced without a company being completely forward about its association with the brand.

3. Case Study: Court TV’s “That Girl Emily”

In the summer of 2007, a large billboard looming over Times Square read: “Hi Steven, / Do I have your attention now? I know all about her, you dirty, sneaky, immoral, unfaithful, poorly endowed slimeball. Everything’s caught on tape. Your (soon-to-be-ex) Wife, Emily / p.s. I paid for this billboard from OUR joint bank account.” The billboard generated interest among everyone from a booking agent for “Good Morning America” to British Glamour to bloggers. While the booking agent and magazine wanted to feature Emily’s story, bloggers began to wonder whether this billboard was a hoax and, if so, which company was behind the hoax.

Soon, viewers uncovered that Court TV was behind the sign and one of the blogs. Court TV used the viral technique to

244 See id.
245 See id.
246 See, e.g., Posting of Kevin Aylward to Wizband Blog, http://wizbangblog.com/content/2006/07/19/the-curious-case-of-that-girl.php (July 19, 2006, 15:22). Aylward explains that “[e]ven before doing some background research we were skeptical. The last funny billboard tip we got turned out to be a scam and this one felt ‘scamish’ from the word go.” Id. He later reveals that it is a hoax but that “no one really knows who is behind the hoax.” Id. He even goes as far as suggesting that readers write a letter to Google saying that the blog corresponding to the billboard is in violation of the Terms of Service for Google’s blogging system. Id. He ends the post by saying, “[o]nce enough e-mail about Emily and her hoax site make it into Google headquarters someone at Google pull the plug on That Girl Emily.” Id.
247 See Bosman, supra note 243.
promote its reality show, Parco P.I.\textsuperscript{248} Court TV and its advertising agency, Gem Group, designed the campaign “to get consumers talking about whether Emily, whose cheating husband Steven was exposed by a private detective, actually existed.”\textsuperscript{249} Although Emily was fictitious, Court TV’s goal of generating interest—as measured by the number of visitors to the blog—was achieved.\textsuperscript{250}

The story of “That Girl Emily” is yet another example of the impact a company can make without revealing its identity. “That Girl Emily” illuminates the gripe site and love site analysis because it shows that people do not necessarily know the source of the information that they consume.

4. Case Study: McDonald’s “The Lost Ring”

The final example of a marketing technique whereby consumer interest is stimulated without revealing the sponsoring company is McDonald’s “The Lost Ring.” According to the official website, “The Lost Ring was a global, multi-lingual alternate reality game that united players in a quest to recover ancient Olympic secrets. It centered around Ariadne, a lost Olympic athlete from a parallel universe.”\textsuperscript{251} Fifty bloggers received packages in March 2008 with a poster and a clue that took them to the game’s website.\textsuperscript{252} Over time, the virtual reality game drew in millions of players in one hundred countries.\textsuperscript{253}

\textsuperscript{248} Id.
\textsuperscript{250} See Bosman, supra note 243. By one estimate, six hundred blogs picked up the story and followed the mystery. See Parco P.I. New York Stunt Campaign, supra note 249.
At first, no one knew who created the game.254 Within one or two days, players searching for clues found the terms of service on the website, which revealed that McDonald’s sponsored the game.255 People were shocked because “[n]othing about the game was branded McDonald’s, and the game’s Web sites—mysterious and hip, like ‘Lost’ mixed with ‘The Blair Witch Project’—were a far cry from the golden arches.”256 In fact, some players even liked the game, despite not liking McDonald’s.257 Later, some aspects of the brand, such as the double arches, appeared.258 McDonald’s was very careful not to make its branding too overt.259

McDonald’s “The Lost Ring” demonstrates that a company, through its website, can achieve pervasiveness without necessarily revealing its identity upfront. Likewise, the owner of a sucks site or “love” site can impact public opinion about a brand, whether or not consumers believe that the owner is affiliated with the trademark.

B. Domain Names Case Studies

Another discreet, creative way for a company to promote its brand while attracting and vigorously spreading attention is by creating a domain name that captivates potential consumers. Some companies have capitalized on the intrigue generated by gripe sites and the presumption that gripe sites disparage, rather than promote, a company by creating effective, ironic domain names that promote, rather than disparage, their companies.

254 Terdiman, supra note 251 (“No one knows who created this game, but you can be sure that it wasn’t the International Olympic Committee.”).
256 Id.
257 See id. (noting that Geoff May, a player in Ontario who founded a website on The Lost Ring, said, in reference to McDonald’s, that “Not everyone likes them”).
258 See Richard Brunelli, McDonald’s Brave New World, ADWEEKMEDIA, Dec. 1, 2008, http://www.adweekmedia.com/aw/content_display/custom-reports/buzzawards/e3i9417c5a4a703467d97b51be9e35149f8.
259 See Garcia, supra note 252.
1. Steven Singer

Large billboards along Interstate 95 in Philadelphia screamed, “I Hate Steven Singer!” in scrawled capital letters and featured a website address—www.ihatestevensinger.com—below the exclamation. Viewers speculated that a jilted girlfriend purchased the billboard and created the website. However, the billboard and accompanying website ironically belonged to Steven Singer, a Philadelphia jeweler. When a customer who purchased a ring from Steven Singer jokingly “blamed” Singer, nine months later, for the birth of his daughter, Singer took the backhanded compliment and made it the focus of a reverse psychology advertising campaign.

The website address www.ihatestevensinger.com features an elegant advertisement for a jewelry store. However, if users click anywhere on the website or wait about fifteen seconds, a brown box with “I Hate Steven Singer” scrawled across it appears on the screen. Website users are then redirected to http://ihatestevensinger.com/default1.asp, which is set up like a consumer gripe site. The website premise can be encapsulated in the line, “So why do men HATE Steven Singer? Because women LOVE him . . . and his diamonds.” The website bashes Steven Singer from the perspective of a contented bachelor whose life could be redirected from endless partying as a young single man to monotonous stability as a married man (if Steven Singer successfully sells this man an engagement ring). The website

261 Id.
265 See id. After clicking on the website, the brown box appears in about fifteen seconds.
266 Steven Singer Jewelers, supra note 263.
also bashes Steven Singer from the perspective of a married man whose wife wants Steven Singer and Singer’s jewelry more than she wants her husband.\textsuperscript{268} The website lists “Top 10 Reasons I Hate Steven Singer.”\textsuperscript{269}

This anti-marketing campaign generated a lot of buzz.\textsuperscript{270} People were intrigued enough by the “hate” message to go to the website to learn more about the slogan.\textsuperscript{271} Such reverse psychology marketing tactics apparently resonated with consumers because Steven Singer Jewelers’ profits in 2005 and 2006 were up 15–20\% over each of the previous year’s profits.\textsuperscript{272}

Temple University marketing professor Indrajit Sinha and University of Graz (Austria) marketing professor Thomas Foscht state that:

\begin{quote}
It is perhaps easy to disparage and dismiss these developments as passing fads, but in our view they represent a real change in business. What these anti-marketers are working from is the deep-seated consumer resentment against the prevalent norms and practices of traditional marketing. . . . Many people are simply tired of all the spin and the
\end{quote}

\begin{footnotes}
\item[268] See id.
\item[269] Id. Those ten reasons are:

(10) My wife spends more time with Steven Singer than she does with me. (9) My Friday nights used to be Happy Hours with the guys, now it’s chick flicks and cosmos. (8) The phone number for Steven Singer Jewelers is on our speed dial ahead of my work and cell phone numbers! (7) My wife re-set the GPS system so it always leads us back to Steven Singer Jewelers. (6) Flowers and chocolates don’t work anymore. (5) My daughter’s first word was “carat” and I don’t think she was talking about salad. (4) There’s an 8 x 10 of him on our mantel. (3) Now that my wife knows I have a romantic side—we talk about my feelings! (2) My wife’s new idea of a quickie is getting a tennis bracelet over lunch. (1) He actually makes buying a diamond fun. That son of a bitch.

\item[270] See SINHA & FOSCHT, supra note 262, at 147.
\item[271] Id.
\item[272] See Covel, supra note 260.
\end{footnotes}
pretense that is commonly on view in ads and slogans.  

2. Loews and Southwest Airlines

While 35% of “brandsucks” domain names surveyed by FairWinds Partners, LLC are owned by the brand found within the domain, it appears that only Loews (movie theater chain) and Southwest Airlines have utilized their trademark’s corresponding “sucks” domain name strategically. Loews registered loewssucks.com and placed a “Guest Satisfaction Survey” on that page. Customers visiting the website by accident may be impressed with Loews’ dedication to customer service, and Loews will also have at least tried to resolve the problems that angered consumers looking for a gripe site. Also, Southwest Airlines features the following statement on southwestsucks.com:

Southwest Airlines strives to maintain a high level of Customer Service and is proud of its corporate reputation and responsiveness to its Customers. As part of that effort, Southwest wants to control the release of inaccurate and irresponsible information about the Company via the Internet. If you would like more information on Southwest, please go to www.southwest.com.

Eighty-three percent of the “brandsucks” domain names surveyed by FairWinds Partners, LLC resolve to the brand’s actual website. Some critics have argued that such a technique damages the brand because “companies that do this are associating their brand with a memorable and negative domain name.”

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274 See Fairwinds Partners, LLC, supra note 31, at 4–5.

275 See id.; accord Steel, supra note 32.

276 See Fairwinds Partners, LLC, supra note 31, at 4.


278 Fairwinds Partners, LLC, supra note 31, at 5.

279 Id.
Nevertheless, Internet consultants say that companies should utilize their corresponding “sucks” sites as a unique marketing opportunity “to reach out to the Internet community or to prevent a potential public relations nightmare.”280 For example, companies could use them as a vehicle to solicit customer feedback and tackle customer grievances.281

III. CONFUSING THE LIKELIHOOD OF CONFUSION STANDARD

The increasing prevalence of a marketing trend whereby companies compete for consumers’ limited mindshare with creative techniques that obscure the sponsoring company’s identity complicates the gripe site and fan site legal analysis by unraveling and changing the foundational elements behind the courts’ and panels’ reasoning. A website can be very popular, quite influential, and heavily trafficked without Internet users knowing who owns it. Yet gripe site case law and panel decisions are based upon an analysis of whether website visitors would be confused about who owns a website. If Internet users can be influenced by a website to the point that they forward it on to their friends without knowing the source of its content, the fundamental unresolved question of the permissibility of using another person or company’s trademark in a domain name becomes even more complicated.

The federal court and WIPO cases on both “sucks” and “love” sites do not settle the overarching issue of whether it is permissible to use another person or company’s trademark plus a provocative modifier in a website domain name without infringing on the trademark owner’s rights because their rulings are inconsistent.282 This section will focus on why the federal courts and WIPO panels have argued for and against the conclusion that a domain name containing a trademark not owned by the domain name registrant is likely to confuse Internet users into believing that the trademark owner created the website. This section will then consider how

280 Id. at 4.
281 Steel, supra note 32.
282 While the intent of gripe sites differs markedly from the intent of a pure fan site, the central concept of appropriating—or misappropriating—a trademark remains the same.
such analyses are affected by new marketing trends that obscure the sponsoring company’s identity.

A. Permissibility of Trademarks in Gripe Site and Love Site Domain Names Not Owned by Trademark Owner

All four federal court cases decided under federal statutes (Lanham Act and ACPA)—Bally Total Fitness Holding Corp. v. Faber, Lucent Technologies, Inc. v. Luentsucks.com, Ford Motor Co. v. 2600 Enterprises, and Taubman Co. v. Webfeats—and ten out of thirty-seven (27%) WIPO panel decisions decided under the UDRP between July 20, 2000, and October 31, 2008, held that a person may create a gripe site whose domain name contains a trademark plus a derogatory modifier without infringing on the trademark owner’s rights. In addition, none of the six WIPO panel decisions decided under the UDRP between June 4, 2003, and December 19, 2008, held that a person may create a love site whose domain name contains a trademark plus the word “love” without infringing on the trademark owner’s rights. Not only do these numbers demonstrate that there is inconsistency in the law of domain names and trademarks, but they also show that the court decisions differ markedly—pun intended—from the decisions of the arbitration panels.

1. Internet Users and Common Sense

The court in Bally stated that “no reasonably prudent Internet user would believe that ‘Ballysucks.com’ is the official Bally site or is sponsored by Bally.” The court in Lucent stated that “the average consumer would not confuse lucentsucks.com with a web site sponsored by plaintiff.” The panel in Asda Group Ltd. v. Kilgour stated that “by now the number of Internet users who do not appreciate the significance of the ‘-sucks’ suffix must be so

283 See supra notes 168–69 and accompanying text.
284 See supra note 203 and accompanying text.
285 Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1165 n.2 (C.D. Cal. 1998); accord supra note 125 and accompanying text.
286 Lucent Techs., Inc. v. Luentsucks.com, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000); accord supra note 134 and accompanying text.
small as to be de minimis and not worthy of consideration.” 287
Finally, the panel in Lockheed Martin Corp. v. Parisi stated that “once the searcher sees <lockheedsucks.com> and <lockheedmartinsucks.com> listed among the websites for further search, she will be able readily to distinguish the Respondent’s site for criticism from Complainant’s sites for goods from aerospace to t-shirts.” 288 However, if these four quotations were indisputable, then it would naturally follow that one could say, “no reasonably prudent Internet user would believe that ‘ihatestevensinger.com’ is the official Steven Singer [Jewelers] site or is sponsored by Steven Singer.” 289 Yet Steven Singer purposefully manipulated this conception—or misconception—to advance his marketing campaign. 290

Therefore, the example of Steven Singer seriously undermines the contention that Internet users’ common sense precludes them from believing that gripe sites are owned by the trademark owner. Because it is wrong to conclude that Steven Singer does not own ihatestevensinger.com, it may no longer be possible to irrefutably hold that no reasonably prudent Internet user would think that, for example, Bally owns “ballysucks.com.”

2. Different Intents of Parody

The court in Lucent indicated that domain names indicative of parody suggest absence of likelihood of confusion, 291 but it is very difficult to determine what constitutes parody in this context. The court in Lucent referred to “luentsucks.com” as being a parody of Lucent’s legitimate website. 292 Yet, the court does not clarify

289 But see Bally, 29 F. Supp. 2d at 1165 n.2; see also supra notes 125, 285 and accompanying text.
290 See supra Part II.B.1.
291 See Lucent Techs., Inc. v. Luentsucks.com, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000); see also supra text accompanying note 133.
292 See Lucent, 95 F. Supp. 2d at 535.
whether the sucks site was a parody of the legitimate website because (1) it was mocking the original website and its content in an effort to dissociate itself or (2) it was imitating the original website in a way to creatively promote its message.\textsuperscript{293} The first is the concept of a gripe site, and the second is the concept of reverse psychology marketing. The first dissociates the domain name registrant from the trademark owner, and the second identifies the domain name registrant with the trademark owner. The first intends to hurt the trademark, and the second intends to bolster the trademark. Thus, each type of parody has a different agenda, and a blanket statement that parody is permissible is incomplete if it does not distinguish between the two ways parody can be used in domain names.

Savvy website owners can use parody to draw attention to their website in an effort to promote it. Generally an Internet user first encounters a website through its domain name, and that Internet user is more likely to access a particularly memorable domain name.\textsuperscript{294} A domain name based on reverse psychology is particularly memorable because it shocks and intrigues the viewer. Parody can comment with both praise and scorn, and therefore it cannot be used as a heuristic for determining website ownership from a domain name.

3. Confusion as to Source

The court in \textit{Taubman} stated that “the First Amendment protects critical commentary when there is no confusion as to source.”\textsuperscript{295} However, as more companies become inconspicuous in

\textsuperscript{293} \textit{See generally} Linda Hutcheon, A Theory of Parody: The Teachings of Twentieth-Century Art Forms 6 (2000) (stating that parody is “a form of imitation, but imitation characterized by ironic inversion, not always at the expense of the parodied text”).


\textsuperscript{295} Taubman Co. v. Webfeats, 319 F.3d 770, 778 (6th Cir. 2003); \textit{see also} text accompanying note 158.
their marketing campaigns, the current standard for what constitutes “confusion as to source” shifts. Viewers were shocked to discover that Burger King created Subservient Chicken, Smirnoff created Tea Partay, Court TV created That Girl Emily, and McDonald’s created The Lost Ring. Such shock stems from the company’s creative way of generating interest by distributing its advertisement and marketing campaign message before revealing its corporate sponsorship and identity. However, the popularity of such techniques may cause one of two results. First, consumers may become more defensive and consequently analyze the relationship between media messages and sponsorship. Specifically, consumers may learn to analyze the source of media content more deeply or challenge the connection between an advertisement, its sources, and its intention. Alternatively, the popularity of such techniques may require the courts to be more vigilant in protecting consumers from the confusion that such marketing techniques necessarily engender.

In addition, companies are focusing on customer relationship management because the connection between consumer satisfaction and profits is undeniable. According to one study, 93% of companies solicit customer feedback. In addition, “[o]ne of the most common pieces of user-generated content on the web is the customer review.” Southwest Airlines strategically references its commitment to consumer satisfaction by soliciting feedback on southwestsucks.com. Other companies may decide

296 See, e.g., supra notes 230, 240, 256 and accompanying text.
297 See Gerhard Raab, Riad A. Ajami, G. Jason Goddard & Vidyaranya B. Gargeya, Customer Relationship Management: A Global Perspective 8–9 (2008) (“Many considerations justify investment in the setting up and realizing of CRM [customer relationship management]. . . . Every satisfied customer brings in at least three more customers. An unhappy customer communicates his negative experience to ten more potential customers. The rate of repeat sales climbs with increased reliance and satisfaction with the performance of their suppliers. . . . It is becoming clear what an immense increase in effectiveness the implementation of CRM can provide.”).
300 See supra note 277 and accompanying text.
to dedicate the “sucks” site domain names that they own to such productive, customer-driven purposes. This strategy benefits the company yet further complicates the gripe site legal analysis. The company benefits because it turns a potentially disastrous consumer relationship into an opportunity to make amends by learning about and then hopefully addressing the cause of the consumer’s complaint. Yet such a strategy complicates the gripe site legal analysis because it is no longer easy to determine if a domain name in the gripe site format is owned by the company for legitimate marketing or public relations purposes or if it is owned by an angry third party.

B. Impermissibility of Trademarks in Gripe Site and Love Site Domain Names Not Owned by Trademark Owner

Twenty-seven out of thirty-seven (73%) WIPO panel decisions decided under the UDRP between July 20, 2000, and October 31, 2008, held that a person who creates a gripe site whose domain name contains a trademark plus a derogatory modifier infringes on the trademark owner’s rights.301 All six WIPO panel decisions decided under the UDRP between June 4, 2003, and December 19, 2008, held that a person who creates a love site whose domain name contains a trademark plus the word “love” infringes on the trademark owner’s rights.302 These numbers highlight a tension between trademark law and free speech rights in domain names and, when compared to the federal courts’ analysis, demonstrate an inconsistency in the law of domain names and trademarks.

1. Association of Trademark Owner and Domain Name Registrant

The panel in ADT Services AG v. ADT Sucks.com stated that “a user could be led to believe that any name using the world-famous mark is associated with the Complainant.”303 The panel in Dixons Group PLC v. Purge I.T. explained:

301 See supra notes 168–69 and accompanying text.
302 See supra note 203 and accompanying text.
The first and immediately striking element in the Domain Name is the Complainant’s name. Adoption of it in the Domain Name is inherently likely to lead some people to believe that the Complainant is connected with it. Some . . . may be unable to give it any very definite meaning and will be confused about the potential association with the Complainant.\(^{304}\)

An increase in reverse psychology marketing techniques such as those used by Steven Singer would reinforce the idea that a company’s name in a domain name associates the website with the company. Marketing professors Indrajit Sinha and Thomas Foscht believe that these techniques are indicative of a trend that will become increasingly pervasive.\(^{305}\) Thus, the courts deciding these cases in the future will have to consider the impact of this new advertising environment on the way consumers interpret company trademarks.

Additionally, sometimes an organization puts the word “sucks” in its domain name as part of its brand image. For example, the panel in *Vivendi Universal v. Sallen* mentioned that the vacuum cleaner Electrolux, whose slogan refers to Electrolux’s suctioning power as “Nothing sucks like an Electrolux” might want the domain name electroluxsucks.com and that the band Primus, whose slogan is “Primus sucks” could use the domain name primussucks.com.\(^{306}\) Both of these examples demonstrate ways a company can use its “sucks” website to directly promote its product. The double entendre in Electrolux’s slogan\(^{307}\) and the

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\(^{305}\) See *Sinha & Foscht*, supra note 262, at 147–48 and accompanying text.


irony of Primus’s band identity\textsuperscript{308} demonstrate that the word “sucks” can have other meanings besides serving to denigrate a product. The notion that the word “sucks” has the power to intrigue consumers and attract attention, coupled with the consequent applicability to marketing campaigns, suggests that the word “sucks” in gripe sites may need to be analyzed from a broader perspective.

Because the meaning of the word “sucks” varies from situation to situation, consumers may be unclear about its intent in a particular situation and thus not know how to interpret how the website content relates to the trademark. Consequently, consumers first looking at the domain name may be confused between whether the website is owned by the company who has rights to the trademark or whether it is owned by a third party who has misappropriated the trademark. Because adding the word “sucks” to a trademark does not automatically indicate that a third party owns the website, the assertion that Internet users are unlikely to be confused by “sucks” site ownership is weakened.

2. Diversion to the Gripe Site

Part of the reason these alternative marketing techniques are so effective is because they intrigue consumers to find out more about their source. For example, the “hate” message in Steven Singer’s campaign captivates people into going to the website and ascertaining the story behind the slogan.\textsuperscript{309} Likewise,

When an Internet user enters a trademark into a search engine and a “sucks”-formative domain name is returned as a search result, that user is likely to proceed to the site so identified because of interest or puzzlement created by association of the

\textsuperscript{308} See Urban Dictionary, Primus Sucks, http://www.urbandictionary.com/define.php?term=Primus%20sucks (last visited Feb. 20, 2009) (“Primus sucks . . . is the band Primus’ slogan, meaning that you would say it if you really like primus. . . . [I]f you see someone post a comment on a youtube video of primus and they say primus sucks give them an E-high five.”).

\textsuperscript{309} See supra text accompanying note 271.
trademark and the pejorative term. The operator of the website identified by the “sucks”-formative domain name will have accomplished the objective of diverting the Internet user seeking the trademark holder’s website.\textsuperscript{310}

Alternative marketing techniques succeed because they are fascinating enough to stimulate consumers’ attention. Advertisements that obscure the company’s identity can capture and divert consumer attention. Thus, the success of reverse psychology marketing techniques may lend credence to panels which base their holdings on gripe sites’ intrigue and ability to divert consumers from the trademark owner’s legitimate site to the “sucks” site.

It is possible that Internet users seeking the legitimate company website who are diverted to the complaint site will notice the discrepancy and redirect their search immediately. Yet, if these gripe sites are intriguing enough, then they do have the power to effectively divert consumers to them and maintain consumer attention. By posting enough hateful information about a company, the gripe site can succeed in permanently redirecting the Internet user from the legitimate website to its own website.\textsuperscript{311} Consequently, because gripe sites successfully intrigue Internet users in a similar manner to alternative marketing techniques, it may be naïve to declare that alternative marketing techniques effectively intrigue, divert, and subtly promote their agenda while gripe sites do not. An admission that gripe sites are so intriguing and diverting as to promote their messages undermines the assertion that an Internet user seeking the company’s website is unlikely to be confused by visiting the gripe site.


\textsuperscript{311} \textit{See, e.g.}, Barrett, \textit{supra} note 12, at 1024 n.192; Lipton, \textit{Beyond Cybersquatting}, \textit{supra} note 38, at 1430.
3. Fan Sites

The WIPO panel decisions on fan sites are consistent yet not comprehensive. All six cases between June 4, 2003, and December 19, 2008, held that the addition of the words “I love” or the word “love” to a trademark does not prevent the domain name from being confusingly similar to the trademark.\(^{312}\) In fact, the word “love” reinforces the association between the domain name and the trademark rather than distinguishing between their respective owners.\(^{313}\) However, none of these panels evaluated a case in which the domain name with the word “love” plus the trademark resolved to a website that endorsed the trademark.\(^{314}\) Thus, the “love” site analysis is critically incomplete because no case has addressed a website in which both the domain name and website content promoted the trademark. Nevertheless, it is possible to look at the trends underlying the panels’ decisions to further clarify the “sucks” site analysis and suggest the impact of a possible increase in reverse psychology marketing.

Specifically, the concept underlying reverse psychology marketing—where a trademark owner creates a website promoting its product by using the trademark plus a pejorative modifier in the domain name—is similar to the concept of “love” sites—where a third person creates a website promoting a trademark and uses the trademark plus a praising modifier in the domain name. Both types of websites promote the project, and both of them do so by using a trademark plus another word in the domain name. Even though fan sites are created by third parties and reverse psychology marketing websites are created by the trademark owner, courts’ opinions on “love” sites can be used as guidance in evaluating a new legal standard in light of the uptick in reverse psychology marketing.


\(^{314}\) See supra note 209.
Whereas domain names containing the word “sucks” plus a trademark may or may not confuse Internet users attempting to determine the source of the website’s content, it appears that domain names containing the word “love” plus a trademark do confuse Internet users attempting to determine the website’s owner. If panels and courts were to hold that the word “love” plus a trademark in a domain name infringes on the trademark’s owner’s rights because it is likely to confuse consumers—regardless of website content—then underlying the “love” site analysis is the proposition that consumers are confused, if not misguided, by websites whose domain names contain trademarks not owned by the website owner. If marketers purposefully developed campaigns intending to confuse, if not mislead, consumers regarding advertising sponsorship, then the bar for “likelihood of confusion” would be even lower. Changing the standard for “likelihood of confusion” to meet the changing requirements of the new marketing environment would complicate the already inconsistent “sucks” site analysis, perhaps encouraging panels to bring their reasoning closer to conforming with the fan site prohibition against using trademarks in “love” site domain names. In other words, if a “love” site is confusing because a company could promote its product by associating its trademark with the word “love,” then a company who associates its trademark with the word “sucks” or “hate” in an effort to promote its product has presented a domain name that may confuse Internet users.

IV. TOWARDS THE REVERSAL OF GRIPE SITE PERMISSIBILITY PRECEDENT

Law should be considered in light of the societal and cultural norms existing at the time a case is decided.315 The doctrine of stare decisis, although entitled to respect, is not an “inexorable

315 See generally Brown v. Bd. of Educ., 347 U.S. 483, 492–93 (1954) (“In approaching this problem, we cannot turn the clock back to 1868 when the Amendment was adopted, or even to 1896 when Plessy v. Ferguson was written. We must consider public education in the light of its full development and its present place in American life throughout the Nation.”).
command.”316 Today’s advertising environment is replete with ad clutter,317 and consequently, companies endlessly compete for consumers’ attention by making their marketing campaigns increasingly creative, unique, and outrageous.318 Studies have empirically shown that Internet advertisements that pique consumers’ curiosity yet obscure critical information about the product entice consumers to learn more about the product and to focus on more efficient processing and comprehension of that information.319 Anecdotal evidence demonstrates how obscuring a company’s identity can capture consumer attention, generate intrigue and interest, and position marketers to capitalize on these consumers’ attention.320 Consumers resent traditional marketing, and advertisers, recognizing this aversion, are changing the ways they conduct marketing campaigns.321

Advertisements are increasingly cryptic; sponsoring companies’ names are evermore obscured.322 Consequently, the notion that consumers are not likely to be confused by the addition of the word “sucks” to a company’s trademark is sadly outdated. The website lucentsucks.com might be Lucent’s consumer complaint site; the website ballysucks.com could be a creative play on this gym’s promise to suck the fat from one’s body; the website shopsatwillowbendsucks.com could be an alternative marketing technique. Consumers are ill-equipped to make these crucial distinctions about what is real and what is fake on the Internet.323

316 See Lawrence v. Texas, 539 U.S. 558, 577 (2003) (“The doctrine of stare decisis is essential to the respect accorded to the judgments of the Court and to the stability of the law. It is not, however, an inexorable command.”).
317 See supra note 212 and accompanying text.
318 See supra note 215 and accompanying text.
319 See Satya Menon and Dilip Soman, Managing the Power of Curiosity for Effective Web Advertising Strategies, 31 J. ADVERTISING 1, 8, 11 (2002) (demonstrating the “inverted-U-shaped relationship between the level of information provided in the first advertisement and the degree of interest generated in subsequent processing of the ad”).
320 See supra notes 225–72 and accompanying text.
321 See supra text accompanying note 273.
323 See id. (“As the Web becomes an important component of brand identity for companies and a digital extension of identity for consumers, determining what is real and what is fake becomes even more crucial.”); see also Leah Graham & Panagiotis Takis
The courts and arbitration panels must necessarily step in by redefining how they examine trademark law in the context of domain name infringement.

First, the courts and panels should recognize that marketers have addressed the rise in ad clutter by tailoring their campaigns to be more ingenious. Specifically, the four examples mentioned above—Burger King’s “Subservient Chicken,” Smirnoff’s “Tea Partay,” Court TV’s “That Girl Emily,” and McDonald’s “The Lost Ring”—show how a company can produce a captivating, wildly popular marketing campaign while at least temporarily obscuring the company’s association with the advertisements. Viewers are intrigued and influenced by the creative websites, videos, and billboards. At the same time, they are unaware of who is promoting this media. Courts and panels considering Internet domain names in conjunction with the likelihood of confusion standard must be aware of those realities.

Second, the courts and panels should recognize that alternative marketing techniques such as viral marketing and reverse psychology marketing tend to be slightly deceptive, capturing consumers’ attention because of their creativity, humor, or mystery rather than because of their clear purpose as an advertisement associated with a product. Plus, these campaigns often use the Internet as a key medium of expression. As a result, when the courts and panels analyze whether a viewer is likely to be confused about whether a trademark owner or third party has created a gripe site or love site, it is necessary that the courts and panels understand that legitimate advertisements have confused consumers. In light of that reality, courts and panels must be careful not to jump to seemingly obvious conclusions about a consumer’s likelihood of being confused or not. Instead, courts and panels analyzing whether something is deceptive must

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324 See Parts II.A.1, II.A.2, II.A.3, II.A.4.
325 See Wortham, supra note 322 (“The issue of disclosure and authenticity has surfaced a multitude of times across the Internet, especially on popular user-driven sites like YouTube, Facebook and Twitter.”).
remember that both legitimate trademark owners and unaffiliated third parties use deception as a means to their respective ends; the trademark owners use deception to pique interest, while the unaffiliated third parties use deception to divert interest. Thus, deceptive intent is not a completely effective measure of likelihood of confusion.

Third, the courts and panels should thus realize that using a company’s trademark in an Internet domain name, whether it is clearly being promoted or being denigrated, cannot be a heuristic for determining ownership of the website or content in which that trademark is used. As explained above, this black-and-white approach to determining whether trademark infringement has occurred cannot be sustained in today’s new marketing environment.

Fourth, when analyzing gripe sites and fan sites, the courts should not assume that Internet users are unlikely to be confused about website ownership because the trademark in the domain name is being modified by a word with a clear evocative meaning. The domain name trademarksucks.com could be owned by the trademark owner to creatively promote its product, or it could be owned by a consumer infuriated with the trademark owner’s product. The domain name ilovetrademark.com could be owned by the trademark owner hoping to reinforce a positive message about its trademark, or it could be owned by a person who loves the product but is unaffiliated with the company. Anyone can register a domain name inclusive of a trademark regardless of his or her association with the trademark owner.326

Thus, using another person or company’s trademark plus a provocative modifier in a website domain name should constitute trademark infringement. So as not to be a content-based restriction on free speech, such a restriction must necessarily apply to both gripe sites and fan sites.327 The federal courts and the WIPO panels should streamline their analyses to be consistent and reflect

326 See supra notes 21–26 and accompanying text.
327 See generally R.A.V. v. City of St. Paul, 505 U.S. 377, 382 (1992) (explaining that the First Amendment prevents government from banning speech or expressive conduct because it disapproves of the ideas expressed).
the realities of the way the Internet and marketing techniques are used today.

This bright-line prohibition on using another person or company’s trademark plus a provocative modifier in a domain name does not violate the First Amendment. In fact, because this prohibition is based on the well-settled trademark law likelihood of confusion standard, it does not even raise First Amendment questions.\(^\text{328}\) Trademark law evolved to focus on preventing consumer confusion.\(^\text{329}\) “Reliance on the confusion rationale as the primary basis of liability has effectively insulated traditional trademark doctrine from constitutional attack.”\(^\text{330}\) In fact, “[w]hen trademark protection is delimited by the confusion rationale, recourse to constitutional principles is unnecessary.”\(^\text{331}\) This Note’s determination that using another person or company’s trademark plus a provocative modifier in a domain name constitutes trademark infringement is based on a careful evaluation of the likelihood of consumer confusion. Stricter trademark law

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\(^{330}\) See Denicola, \textit{supra} note 328, at 165; see also S. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 31:44 (2006) (explaining that the First Amendment defense does not cover using another’s trademark to convey a message).

\(^{331}\) Denicola, \textit{supra} note 328, at 190; see also Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 771–72 (1976) (“The First Amendment, as we construe it today does not prohibit the State from insuring that the stream of commercial information flow cleanly as well as freely.”).
interpretation is necessary precisely because consumers familiar with alternative marketing techniques are likely to be confused about who owns the content of a website whose domain name contains a trademark qualified by a provocative word. First Amendment concerns are not implicated when, as here, trademark law’s goals of preventing consumer confusion are furthered by a finding of infringement.

CONCLUSION

Anyone can register a domain name, even if the domain name contains a trademark that the domain name registrant does not own.\textsuperscript{332} Consumers dissatisfied with products and companies have created consumer gripe sites, which are in formats such as [trademark]sucks.com and ihatetrademark.com.\textsuperscript{333} Consumers enthusiastic about products or companies have created fan sites, which are in formats such as ilovetrademark.com.\textsuperscript{334} Trademark owners such as Bally’s, Lucent Technologies, Ford Motor Company, and the Taubman Company have sued in federal court under the Lanham Act and the ACPA to prevent domain name registrants from using their trademarks. Other companies have used WIPO arbitration under the UDRP to attempt to enforce their trademark rights. Whereas the federal courts have always held that “sucks” sites are permissible, the WIPO panels are split on this issue. In addition, the WIPO panels have held that “love” sites are impermissible, but they have only faced “love” sites presenting content unaffiliated with or unsupported by the trademark. Both the federal court and WIPO decisions on both “sucks” and “love” sites are based on the court’s analysis of whether consumers are likely to be confused about who owns the domain name in question.

Alternative marketing techniques such as viral marketing and reverse psychology marketing threaten the current domain name trademark law analysis. Companies such as Burger King, Smirnoff, Court TV, and McDonald’s have spearheaded innovative

\textsuperscript{332} See supra notes 21–26 and accompanying text.
\textsuperscript{333} See supra notes 29–36 and accompanying text.
\textsuperscript{334} See supra notes 41–43 and accompanying text.
viral marketing campaigns that intrigue consumers and generate attention before ever revealing the sponsoring company’s identity. Most notably, Steven Singer Jewelers created a reverse psychology marketing campaign by appearing to tarnish his brand while actually generating awareness about and interest in it. These techniques, combined with companies like Loews’ and Southwest Airlines’ efforts to use their gripe site format domain name to solicit customer feedback, emphasize that the “likelihood of confusion” analysis must be understood in a broader context than ever before. In other words, it is not self-evident that a “sucks” site, for example, could not have been created by the trademark owner.

Consequently, it is critical that the federal courts and arbitration panels, in an effort to streamline this already conflicting area of the law, consider avant garde marketing techniques when performing their “likelihood of confusion” analyses. In doing so, they will realize that consumers are likely to be confused about the ownership of apparent “sucks” site and “love” site domain names. The precarious balance between free speech rights and trademark law must necessarily weigh in favor of trademark law, and thus it should be impermissible to use another’s trademark in one’s domain name, regardless of how it is qualified.