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## Genericness Doctrine Need Not Apply: Employing Generic Domain Names in Cyberspace.

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## Genericness Doctrine Need Not Apply: Employing Generic Domain Names in Cyberspace.

### Cover Page Footnote

The editors and staff of IPLJ and Professor Stephen W. Feingold

# Genericness Doctrine Need Not Apply: Employing Generic Domain Names in Cyberspace

C. Kim Le\*

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## INTRODUCTION

The domain name <business.com> was auctioned for an unprecedented \$7.5 million;<sup>1</sup> <loans.com> was sold for \$3 million;<sup>2</sup> and <wine.com> fetched \$2.9 million.<sup>3</sup> The domain name <sex.com> is rumored to be worth at least \$250 million.<sup>4</sup> Hotels.com invested close to \$55 million in an advertising campaign launched on broadcast and cable networks.<sup>5</sup> What all of these costly domain names have in common is that they are short, easy to remember, and extremely valuable branding tools for e-businesses.<sup>6</sup> The *Wall Street Journal's* last tally in 2000 revealed

<sup>1</sup> Lee Gomes, *Today, Ventures Pick Names That Are Short and Have Global Ring*, WALL ST. J., Jan. 6, 2003, at A13.

<sup>2</sup> *Loans.com Web Address Auctioned for \$3 Million*, WALL ST. J., Jan. 31, 2000, at B6.

<sup>3</sup> Gail Robinson, *You Paid How Much for That Domain Name?*, Web Developer's Journal, at [http://webdevelopersjournal.com/articles/domain\\_names.html](http://webdevelopersjournal.com/articles/domain_names.html) (Feb. 3, 2000) (providing a list of some of the most expensive domain names). Another example of a high priced domain name is <autos.com>, which was sold to an online car sales company for \$2.2 million. *See id.*; Robert Frank, *How Music.com Found Itself a Hot Address*, WALL ST. J., Feb. 3, 2000, at B1. Additionally, an entertainment company recently bought the domain name <men.com> for \$1.3 million. *See* Associated Press, *Domain Names Once Again Fetch Top Dollar* (Dec. 25, 2003), available at CNN.com, <http://www.cnn.com/2003/TECH/internet/12/25/internet.domains.ap> (last visited Apr. 12, 2004).

<sup>4</sup> *See, e.g.*, Jon Swartz, *Sex.com Ownership Ruling Expected: Domain Name Hotly Disputed*, USA TODAY, Aug. 2, 2000, at 3B (stating that the adult entertainment network built around the <sex.com> domain name is estimated to be worth at least \$250 million by some pornography executives).

<sup>5</sup> *See* Brian Steinberg, *Ads Target Stay-at-Home Travelers*, WALL ST. J., June 6, 2003, at B6.

<sup>6</sup> *See* Jason Black, *What's In a Name?*, INTERNET WORLD, July 15, 2001, at 20 (illustrating that the domain name <salary.com> is a self-branding company name), available at 2001 WL 8972673. The Chief Executive Officer and founder of <salary.com> advises that successful branding should involve selecting domain names that are ““memorable, short to type, and easy to spell.”” *Id.*

that nearly ninety-eight percent of the words in *Webster's English Dictionary* are registered as domain names.<sup>7</sup>

Just when it seemed that all hope was abandoned for businesses that entered into cyberspace, American consumers spent a staggering \$18.5 billion online during the 2003 holiday season.<sup>8</sup> The typical American Internet user visited fifty-five domain names at home and ninety-nine at work on average during the month of December alone.<sup>9</sup> Moreover, analysts predict that online sales may total up to \$65 billion this year and swell by 17 percent over the next 5 years, reaching a whopping \$117 billion by 2008.<sup>10</sup>

What all of these statistics and exorbitant dollar amounts represent are consumers' rapidly growing reliance on the Internet<sup>11</sup> and a surge of opportunities for American businesses in

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<sup>7</sup> Rhea Wessel, *'Dot.coms' Furnish English Language with German-Like Gigantic Names*, WALL ST. J., Apr. 24, 2000, at B17D.

<sup>8</sup> Press Release, Nielsen/NetRatings, Online Consumers Spent \$18.5 Billion During 2003 Holiday Season, According to the Goldman Sachs, Harris Interactive and Nielsen/NetRatings Holiday ESpendings Report (Jan. 5, 2004), available at <http://www.nielsennetratings.com/news.jsp> (last visited Apr. 2, 2004). Online holiday spending jumped thirty-five percent from the 2002 season. *Id.*

<sup>9</sup> Cyberatlas.com, *U.S. Web Usage and Traffic, December 2003*, at [http://cyberatlas-internet.com/big\\_picture/traffic\\_patterns/article/0,,5931\\_3301321,00.ht-ml](http://cyberatlas-internet.com/big_picture/traffic_patterns/article/0,,5931_3301321,00.ht-ml) (last updated Jan. 27, 2004) (citing a Nielsen/NetRating report in 2003).

<sup>10</sup> Matt Hines, *Report: Online Shopping Still A-Hopping*, CNET News.com, at <http://news.com.com/2100-1030-5143637.html> (last modified Jan. 20, 2004) (citing a report by Juniper Research). Over the next five years, the average amount spent by the online consumer may reach \$780 annually. *Id.* Moreover, the number of people making purchases online will reach sixty-seven percent before showing signs of slowing down. *Id.*

<sup>11</sup> In March 2004, it was reported that the number of Americans who have access to the Internet from the home increased to 204.3 million, or nearly 75 percent of the population, up 9 percent from just a year ago. See Press Release, Nielsen/NetRatings, Three Out of Four Americans Have Access to the Internet, According to Nielsen/NetRatings (Mar. 18, 2004), available at <http://www.nielsennetratings.com/news.jsp> (last visited Apr. 6, 2004). Women now also represent a higher proportion of at-home Web surfers. A Nielsen/NetRatings analyst attributes this to the fact that "[w]omen make the majority of purchases and household decisions[, thus,] it's no surprise that they are utilizing the Internet as a tool for daily living." *Id.* (citations omitted). In addition, the worldwide use of the Internet has grown significantly over the last several years. Nua.com, *How Many Online?*, at [http://www.nua.ie/surveys/how\\_many\\_online/index.html](http://www.nua.ie/surveys/how_many_online/index.html) (last visited Apr. 6, 2004). In September 2002, Internet users worldwide totaled 605.6 million. *Id.* This number is more than triple the number of Internet users in the world in September 1999, which was only 201.05 million. Nua.com, *Worldwide*, at [http://www.nua.ie/surveys/-how\\_many\\_online/world.html](http://www.nua.ie/surveys/-how_many_online/world.html) (last visited Apr. 12, 2004).

cyberspace. With thousands or even millions of dollars at stake, e-companies understandably want to protect their online endeavors.<sup>12</sup> And branding may be the key to surviving online.<sup>13</sup> Yet, because generic domain names (“GDNs”)<sup>14</sup> contain generic terms, causes of action premised on federal trademark infringement and unfair competition are likely to be limited, or foreclosed altogether, for e-companies that hold GDNs.<sup>15</sup>

Foreclosing such avenues of protection on the grounds of genericism ignores the unique nature of domain names. Unlike traditional marks, domain names are unique because there can be only one user of any given domain name.<sup>16</sup> This fact alone urges a closer look at GDNs before courts rigidly apply the rules of genericism to bar avenues of protection. Although GDNs contain generic terms, they are not classifiable as generic marks overall.<sup>17</sup>

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<sup>12</sup> See Xuan-Thao N. Nguyen, *Cyberproperty and Judicial Dissonance: The Trouble with Domain Name Classification*, 10 GEORGE MASON L. REV. 183, 186–90 (2001) [hereinafter Nguyen, *Cyberproperty and Judicial Dissonance*] (discussing the rising value of domain names that contain generic terms).

<sup>13</sup> Professor J. Thomas McCarthy explained the importance of the branding:

Both consumer and producer would fare badly in a world without the distinguishing function served by trademarks. If there were no way to tell good products from the poor products, why bother to sell anything but the poorest? When a consumer is faced with competing products and services from which he can choose, there must be some system of trade symbols that identify and distinguish each competitor's wares . . . .

1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 3:5, at 3-4 (4th ed. 2003).

<sup>14</sup> As used in this Note, a domain name that contains a generic term is referred to as a generic domain name (“GDN”). A GDN includes both the second-level domain (“SLD”) and the top-level domain (“TLD”). For further discussion of SLDs and TLDs, see *infra* Part I.B.

<sup>15</sup> See, e.g., Xuan-Thao N. Nguyen, *Shifting the Paradigm in E-Commerce: Move Over Inherently Distinctive Trademarks—The E-Brand, I-Brand and Generic Domain Names Ascending to Power?*, 50 AM. U. L. REV. 937, 962–69 (2001) [hereinafter Nguyen, *Shifting the Paradigm in E-Commerce*] (suggesting that GDNs never will be entitled to trademark protection).

<sup>16</sup> E.g., *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999) (stating that each Web page must have a unique domain name); InterNIC.net, *The Domain Name System: A Non-Technical Explanation – Why Universal Resolvability Is Important*, at <http://www.internic.net/faqs/authoritative-dns.html> (last updated Oct. 5, 2002) [hereinafter InterNIC.net, *A Non-Technical Explanation*] (explaining that identical domain names cannot function within the domain name system).

<sup>17</sup> See discussion *infra* Part I.A.

As cyberspace continues to grow exponentially,<sup>18</sup> so do the possibilities of competitors in the same industry who adopt “parasitic,” or confusingly similar, domain names in order to free ride on the branding and goodwill developed by successful GDN holders.<sup>19</sup> GDN holders, who have invested extensive time, money, and energy in their businesses, deserve protection against such unfair trade practices.<sup>20</sup> In addition, consumers who have come to depend on the services provided by these well-known e-companies should not be subjected to the deception created by the use of parasitic domain names.<sup>21</sup>

This Note will reveal that the scope of trademark and unfair competition law under the Lanham Act<sup>22</sup> is sufficiently broad so as to provide protection to GDNs, notwithstanding the prejudice of the genericness doctrine against generic marks.<sup>23</sup> Specifically, this

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<sup>18</sup> In December 2003, the net total of registered domain names worldwide containing the TLDs, “.com,” “.org,” and “.net,” summed 32,894,380, representing a growth in the millions within just one year. Zooknic Internet Intelligence, *History of gTLD Domain Name Growth*, at <http://www.zooknic.com/domains/counts.html> (last visited Apr. 12, 2004). At that same time, 2,025,045 domain names with the relatively new TLDs, “.biz” and “.info,” were registered worldwide. *Id.*

<sup>19</sup> See, e.g., Nick Wingfield, *Internet Companies See Value in Misaddressed Web Traffic*, WALL ST. J., Sept. 5, 2003, at B1 (illustrating how new e-companies set out to capitalize on Internet users who mistype Web addresses); Ira S. Nathenson, Comment, *Showdown at the Domain Name Corral: Property Rights and Personal Jurisdiction Over Squatters, Poachers and Other Parasites*, 58 U. PITT. L. REV. 911, 927–29 & n.66 (1997) (describing the problem of parasitic registrations of domain names that are confusingly similar to well-known marks and providing some examples of disputes between parasitic domain name registrants and owners of the corresponding well-known marks).

<sup>20</sup> See discussion *infra* Part IV.

<sup>21</sup> See *id.*

<sup>22</sup> 15 U.S.C. §§ 1051–1129 (2000). This Note focuses on the confusion created by competitors that attempt to capitalize on established GDNs within the same industry. For this reason, the potential resolution arising from trademark dilution law, which provides a cause of action regardless of inter-industry competition and likelihood of confusion, is outside the scope of this Note. See 15 U.S.C. § 1127 (defining dilution).

<sup>23</sup> The Third Circuit outlined the genericness doctrine in *A.J. Canfield Co. v. Honickman*:

The genericness doctrine prevents trademarks from serving as the substitutes for patents, and protects the public right to copy any non-patented, functional characteristic of a competitor’s product. Trademark law seeks to provide a producer neither with a monopoly over a functional characteristic it has originated nor with a monopoly over a particularly effective marketing phrase [unless] it is necessary to enable consumers to distinguish one producer’s goods from others and even then only if the grant of such a monopoly will not

Note will argue (1) that the unique character of GDNs justifies a reevaluation of the law to protect against the use of confusing similar domain names and (2) that GDNs should be protectable upon a substantial showing of secondary meaning and a likelihood of confusion to Internet consumers. Part I will discuss the current state of protection granted to domain names according to the policies of the U.S. Patent and Trademark Office (“USPTO”). It will focus on GDNs and how the genericness doctrine operates to preclude their protection. Part II will examine the Second Circuit’s deviating treatment of traditional generic marks with respect to unfair competition claims. It also will discuss case law involving vanity phone numbers, which are frequently analogized to domain names. Part III will assemble the established principles of law and apply them in the context of GDNs. Finally, Part IV will propose a federal claim for GDN protection and fashion an appropriate remedy for prevailing GDN holders.

## I. THE CURRENT STATE OF DOMAIN NAMES

Trademarks have moved substantially away from their limited role as indicators of physical origin<sup>24</sup> and are now viewed as necessary (1) to ensure consumers’ rights not to be confused<sup>25</sup> and (2) to protect the expenditures, time, and energy of trademark owners in creating and developing goodwill.<sup>26</sup> The Lanham Act generally provides federal trademark protection for “any word, name, symbol, or device” that is adopted and commercially used

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substantially disadvantage competitors by preventing them from describing the nature of their goods.

808 F.2d 291, 305 (3d Cir. 1986) (citation omitted).

<sup>24</sup> See 1 MCCARTHY, *supra* note 13, § 3:8, at 3-17 to 3-18 (describing the early view of trademarks as indicating a source of physical origin). As trademark law developed, the courts relaxed their rigid view of trademark function and regarded trademarks as indicating a single source. *Id.* § 3:9, at 3-18 to 3-19.

<sup>25</sup> Section 32(a) of the Lanham Act provides, in pertinent part, that “any reproduction, counterfeit, copy, or colorable imitation of a registered mark . . . 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 . . .” 15 U.S.C. § 1114(1)(a)–(b).

<sup>26</sup> See, e.g., 1 MCCARTHY, *supra* note 13, § 2:2, at 2-3 (referring to a company’s right to enjoy the fruits of its investments in the goodwill and reputation of its mark (citing *Nat’l Color Labs., Inc. v. Philip’s Foto Co.*, 273 F. Supp. 1002, 1004 (S.D.N.Y. 1967))).



by a company to distinguish its goods and services from those of others.<sup>27</sup> Under section 32(1) of the Lanham Act (“Section 32(1)”), the infringing use of a “registered mark” that is likely to cause public confusion is liable in civil action.<sup>28</sup> A mark is registrable on the USPTO’s principal register unless it is used in connection with goods that are “merely descriptive.”<sup>29</sup> Therefore, a mark that is deemed merely descriptive is neither eligible for principal register registration nor shielded against presumptively infringing use.<sup>30</sup>

According to section 2(f) of the Lanham Act (“Section 2(f)”), however, a company may register a descriptive mark on the principal register if it later can prove that the mark has become “distinctive.”<sup>31</sup> In the meantime, descriptive marks may be registered on the USPTO’s supplemental register under section 23(a) of the Lanham Act if they are “capable of distinguishing the applicant’s goods or services,” though they are not accorded full-fledged trademark status.<sup>32</sup>

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<sup>27</sup> 15 U.S.C. § 1127.

<sup>28</sup> 15 U.S.C. § 1114(1).

<sup>29</sup> 15 U.S.C. § 1052(e); see *Application of Colonial Stores, Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968) (stating that one test to determine whether a mark is “merely descriptive” involves asking what the mark “would mean to the potential asker when applied to applicant’s goods”). Registration on the principal register is only *prima facie* evidence of the validity of a trademark. See *infra* note 32. An additional showing must be made that the trademark is “use[d] in commerce.” See 15 U.S.C. § 1114.

<sup>30</sup> See 15 U.S.C. §§ 1114, 1052(e). For a discussion of the principal and supplemental registers, see *infra* note 32.

<sup>31</sup> See 15 U.S.C. § 1052(f) (finding that evidence that a mark has become distinctive includes “proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made”); see also 1-3 JEROME GILSON & JEFFREY M. SAMUELS, TRADEMARK PROTECTION AND PRACTICE § 3.04[6][b][i], at 3-130.25 (2003) (explaining that if a descriptive mark has “become so closely associated with a mark owner’s product or service it may be held to be distinctive and, therefore, registerable”).

<sup>32</sup> 15 U.S.C. § 1091(a). The principal register differs from the supplemental register in that it confers certain substantive and procedural advantages that are not afforded to supplemental register registrations. See 1-3 GILSON & SAMUELS, *supra* note 31, § 3.04[3], at 3-100. For example, registration on the principal register “communicates nationwide constructive notice, constitutes *prima facie* or conclusive evidence of the exclusive right to use the mark in interstate commerce, [and] becomes incontestable under certain circumstances . . .” *Id.* § 3.04[3][a], at 3-100. These advantages do not exist for marks registered on the supplemental register. *Id.* Registration on the supplemental register, however, offers other benefits, such as “notice of the registrant’s claim of rights to

The next sections discuss the traditional requirements that domain names must meet to be eligible for Section 32(a) standing. Trademark registration often hinges on the level of the mark's distinctiveness.<sup>33</sup> The classification of GDNs as generic marks, the lowest level of distinctiveness, negatively impacts their chances of making it on either the principal or supplemental register.<sup>34</sup> Because the USPTO chooses to examine GDNs as generic marks, GDNs are almost always doomed.<sup>35</sup>

#### A. Traditional Trademark Analysis of Domain Names

Domain names currently must meet the same two requirements to merit protection as do traditional trademarks and service marks:<sup>36</sup> (1) they must serve as a source identifier; and (2) they must be distinctive.<sup>37</sup> As to the first requirement, "a domain name can become a trademark if it is used as a trademark."<sup>38</sup> The dual nature of domain names—one as business names and the other as locators on the Internet<sup>39</sup>—slightly complicates the matter. As locators, domain names are the easiest method by which Internet

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anyone who searches the Patent and Trademark Office records." *Id.* § 3.04[3][c], at 3-102 to 3-103.

<sup>33</sup> See *infra* Part I.A.

<sup>34</sup> See *infra* Parts I.A–B.

<sup>35</sup> See *infra* Part I.B. Occasionally, GDNs make it on the supplemental register. See *In re Martin Container, Inc.*, No. 75/533,426, 2002 TTAB LEXIS 566, at \*4–\*5 (Trademark Trial & App. Bd. Sept. 4, 2002) (on reconsideration) (pointing out that <books.com> and <officesupplies.com> are registered on the supplemental register, but that the TTAB is not bound by the prior decisions of trademark examining attorneys).

<sup>36</sup> Domain names are generally considered service marks because they represent services available online. See 1 MCCARTHY, *supra* note 13, § 7:17.1, at 7-28 to 7-29. According to the Lanham Act, service marks are treated in the same way as trademarks: "service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks." 15 U.S.C. § 1053 (2000).

<sup>37</sup> See 1 MCCARTHY, *supra* note 13, § 3:1, at 3-2 (explaining that the function of a trademark is to identify the source of the goods and to distinguish the goods from others on the market).

<sup>38</sup> 1 MCCARTHY, *supra* note 13, § 7:17.1, at 7-25.

<sup>39</sup> See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 956 (C.D. Cal. 1997) (observing that domain names "present a special problem . . . because they are used for both a non-trademark technical purpose, to designate a set of computers on the Internet, and for trademark purposes, to identify an Internet user who offers goods or services on the Internet").

users can find Web sites.<sup>40</sup> Rather than memorizing a Web site's Internet protocol address, which consists of a string of numbers, Internet users simply can type in a convenient domain name.<sup>41</sup> According to the district court in *Lockheed Martin Corp. v. Network Solutions, Inc.*, when domain names are "used only to indicate an address on the Internet, [they are] not functioning as a trademark."<sup>42</sup> Domain names must do more than route Internet users to the appropriate Web sites in order to merit protection—the domain name must identify the source of the goods or services.<sup>43</sup> The *Lockheed* court suggests, therefore, that the utilitarian nature of a domain name cannot give rise to trademark status unless the domain name is telling of the particular e-business that is offering the goods or services.<sup>44</sup>

Relevant to the second requirement of traditional trademark analysis is the "spectrum of distinctiveness," which identifies five categories of marks that vary in terms of protection: fanciful, arbitrary, suggestive, descriptive, and generic.<sup>45</sup> The first three categories of marks—fanciful, arbitrary, and suggestive—receive immediate protection upon adoption and use because they are presumed to be inherently distinctive and capable of identifying the source.<sup>46</sup> In cases where the distinctiveness of the domain name turns on the distinctiveness of the corresponding traditional

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<sup>40</sup> See *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999) ("A specific web site is most easily located by using its domain name.").

<sup>41</sup> See *Lockheed*, 985 F. Supp. at 952 (describing the structure of Internet protocol numbers).

<sup>42</sup> *Id.* at 956.

<sup>43</sup> See *id.*; U.S. PAT. & TRADEMARK OFFICE TRADEMARK MANUAL OF EXAMINING PROCEDURE [TMEP] § 1209.03(m) (3d ed., rev. 2, 2003) (stating that "[a] mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services").

<sup>44</sup> See *Lockheed*, 985 F. Supp. at 956.

<sup>45</sup> See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976) (identifying only four main categories of marks by collapsing fanciful and arbitrary into one category). There is a distinction between fanciful and arbitrary terms, and some courts have referred to them as two separate categories. See, e.g., *Butcher Co. v. Bouthout Constr., Inc.*, 124 F. Supp. 2d 750, 754 (D. Me. 2001); *Majestic Drug Co. v. Olla Beauty Supply, Inc.*, No. 97 Civ. 0046, 1997 U.S. Dist. LEXIS 900, \*8 (S.D.N.Y. Jan. 29, 1997).

<sup>46</sup> See *Abercrombie*, 537 F.2d at 10–11; 2 MCCARTHY, *supra* note 13, § 15:1, at 15-5.

trademark from which it was adopted, determining which category the domain name falls under is easy.<sup>47</sup> For instance, because the traditional trademark “MovieBuff” for computer software providing entertainment-related information is suggestive of its product, its matching domain name <moviebuff.com> likewise would be considered inherently distinctive by a court.<sup>48</sup> In this context, however, e-companies that adopt domain names as their primary business names must undergo classification analysis based solely on their domain names.

Descriptive marks do not gain protection unless the mark holder can show secondary meaning.<sup>49</sup> Descriptive marks “forthwith convey[] an immediate idea of the ingredients, qualities or characteristics of the goods.”<sup>50</sup> Secondary meaning is the concept that some marks, although not inherently distinctive, can become “uniquely associated with that person’s goods, service, or business” in the public’s mind.<sup>51</sup> Judge Arthur Carter Denison of the Sixth Circuit best articulated the doctrine of secondary meaning in 1912:

It contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, . . . might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark. So it was

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<sup>47</sup> See, e.g., *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1046–47, 1058–59 (9th Cir. 1999).

<sup>48</sup> See *id.* at 1041, 1058–59. The Ninth Circuit disregarded the “.com” component in <moviebuff.com> and concluded that the “moviebuff” component was identical to the plaintiff’s traditional trademark, “MovieBuff.” *Id.* at 1055.

<sup>49</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000) (citing *Qualitex Co., v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995)); *Abercrombie*, 537 F.2d at 10.

<sup>50</sup> *Abercrombie*, 537 F.2d at 11 (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

<sup>51</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (1995).

said that the word had come to have a secondary meaning

<sup>52</sup>

This exception for descriptive marks that have acquired secondary meaning suggests that public perception plays a significant role in determining whether a mark legitimately functions as a trademark.<sup>53</sup>

In some cases, however, even if the public is aware that there is only one source for a product, the *de facto* secondary meaning doctrine dictates that the term used in the mark must remain free for competitive use if the term is in fact the commonly recognized name of the goods.<sup>54</sup> The public, Internet users especially, are probably aware that each domain name is the only one in existence over the entire Internet and in the entire world. Whether the *de facto* secondary meaning doctrine potentially could invalidate the protection of virtually all descriptive domain names remains a possibility.

Generic marks, on the far end of the spectrum, are almost never protected even upon a showing of secondary meaning.<sup>55</sup> Generic

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<sup>52</sup> G.&C. Merriam Co. v. Saalfield, 198 F. 369, 373 (6th Cir. 1912). This court concluded that the plaintiff publisher's title, *Webster's Dictionary* and variations thereof, had acquired secondary meaning and could not be used by the defendant unless accompanied by a disclaimer. *See id.* at 378–79.

<sup>53</sup> *See, e.g.,* Dart Drug Corp. v. Schering Corp., 320 F.2d 745, 748 n.10 (D.C. Cir. 1963) (asserting that “confusion to the public is the essence of both trademark infringement and unfair competition” (citation omitted)).

<sup>54</sup> *See* Am. Online, Inc. v. AT&T Corp., 243 F.3d 812, 822 (4th Cir. 2001) (asserting that “the repeated use of ordinary words functioning within the heartland of their ordinary meaning, and not distinctively, cannot give AOL a proprietary right over those words, even if an association develops between the words and AOL”); A.J. Canfield Co. v. Honickman, 808 F.2d 291, 304 (3d Cir. 1986) (opining that “some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if the terms have or might become identified with a source and so acquire ‘de facto’ secondary meaning”).

<sup>55</sup> *See Abercrombie*, 537 F.2d at 9 (stating that “even proof of secondary meaning . . . cannot transform a generic term into a subject for trademark”); *see also* Miller Brewing Co. v. G. Heileman Brewing Co., 561 F.2d 75, 79 (7th Cir. 1977) (concluding that generic terms may not become a trademark under any circumstances); *In re* Med. Disposables Co., 25 U.S.P.Q.2d (BNA) 1801, 1805 (Trademark Trial & App. Bd. 1992) (holding that because the board “found the term MEDICAL DISPOSABLES to be generic, the question of whether or not it [had] acquired secondary meaning [was] irrelevant”).

marks are “common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold” and “by definition [are] incapable of indicating a particular source of the goods or services.”<sup>56</sup> Known as the genericness doctrine, courts are principally concerned with the monopolization over the generic terms that are necessary for subsequent competitors to do business, which results from the grant of trademark protection.<sup>57</sup> The Lanham Act authorizes courts to grant injunctions in accordance with the principles of equity,<sup>58</sup> and enjoining the use of generic terms is aimed to preserve competition within an industry.<sup>59</sup> This genericness doctrine represents a significant public policy choice in trademark law and lays down a barrier against the protection of generic marks.<sup>60</sup> As Professor J. Thomas McCarthy explained, “To grant an exclusive right to one [company] of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish.”<sup>61</sup>

Section 2(f), however, suggests that marks may earn a place on the USPTO’s principal register if they have become distinctive, or have acquired secondary meaning.<sup>62</sup> Generic marks never fall within the Section 2(f) exception, though, because courts have

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<sup>56</sup> *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001); *see In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (emphasizing that generic marks are “incapable of indicating source” and are “the antithesis of trademarks” (citing *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014 (C.C.P.A. 1979))).

<sup>57</sup> *See Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 116–17 (1938) (declaring that when competitors have the right to make a product, they also have the right to use the term by which the public knows it); *see also Abercrombie*, 537 F.2d at 9 (stating that protection of generic marks with secondary meaning would “deprive competing manufacturers of the product of the right to call an article by its name”); *supra* note 23.

<sup>58</sup> *See* 15 U.S.C. § 1116(a) (2000) (“The several courts vested with jurisdiction of civil actions arising under this chapter shall have the power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable . . .”).

<sup>59</sup> *See supra* note 57.

<sup>60</sup> *See* 2 MCCARTHY, *supra* note 13, § 12:2, at 12-7 to 12-9.

<sup>61</sup> *Id.* at 12-7 (footnote omitted).

<sup>62</sup> *See supra* note 31 and accompanying text.

reasoned that generic marks are fundamentally incapable of becoming distinctive.<sup>63</sup>

### *B. Administrative Treatment of GDNs*

While the law relating to the protectability of GDNs is not developed in the courts, according to the trademark examining attorneys at the USPTO and the appellate agency that reviews their decisions, the Trademark Trial and Appeal Board (“TTAB”), it is readily apparent that GDNs are not eligible for registration on either the principal or supplemental register.<sup>64</sup> The underlying reason for this is that the USPTO’s guidelines for examining attorneys, as set forth in the Trademark Manual of Examining Procedure (“TMEP”), are averse to treating domain names as a unique form of trademark.<sup>65</sup>

The main impediment to trademark registration is the USPTO’s policy with respect to top-level domains (“TLDs”).<sup>66</sup> A domain name is composed of two main components: a second-level domain (“SLD”) and a TLD.<sup>67</sup> Using the domain name <coffee.com> as an example, the term “coffee” is the SLD, followed by the TLD “.com.” According to the TMEP, TLDs are not accorded any trademark significance,<sup>68</sup> and the TTAB and reviewing courts agree.<sup>69</sup> The TMEP states that TLDs “function to indicate an address on the World Wide Web, and therefore

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<sup>63</sup> See cases cited *supra* note 56.

<sup>64</sup> See generally U.S. Pat. & Trademark Office, *Trademark Trial and Appeal Board*, at <http://www.uspto.gov/web/offices/dcom/ttab> (last modified Mar. 10, 2004) (describing the policies of the Trademark Trial and Appeal Board (“TTAB”) and the types of proceedings over which it presides).

<sup>65</sup> See TMEP, *supra* note 43, § 1209.03(m).

<sup>66</sup> See *id.*

<sup>67</sup> See, e.g., *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999); see also *supra* note 14.

<sup>68</sup> See TMEP, *supra* note 43, § 1209.03(m) (“Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable.”).

<sup>69</sup> See, e.g., *Brookfield*, 174 F.3d at 1055 (finding that “‘MovieBuff’ and ‘moviebuff.com’ are, for all intents and purposes, identical in terms of sight, sound, and meaning” and citing four other cases that found marks to be essentially identical when the TLD “.com” was the only difference); *In re Martin Container, Inc.*, 65 U.S.P.Q.2d (BNA) 1058, 1060–61 (Trademark Trial & App. Bd. June 11, 2002).

generally serve no source-indicating function.”<sup>70</sup> Thus, “if a mark is composed of a generic term(s) for applicant’s goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic.”<sup>71</sup> The TMEP cites <bank.com> for an online banking service and <turkey.com> for an online frozen turkey retailer as examples of unregistrable marks.<sup>72</sup>

In *In re Martin Container*, the TTAB affirmed the decision of a trademark examining attorney in refusing to register <container.com> on the supplemental register on the grounds that the component terms were incapable of distinguishing the applicant’s services.<sup>73</sup> The TTAB, relying on the test set forth in *In re Gould Paper Corp.*,<sup>74</sup> found that the generic term “container” combined with “.com” to form <container.com> did not create an amalgamation that “somehow acquired the capability of identifying and distinguishing applicant’s services.”<sup>75</sup> Specifically, the *Gould* test provides that the examining attorney may establish genericness by showing that “separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound.”<sup>76</sup> The TTAB in *Martin Container* analogized the function of TLDs to that of other generic indicators placed after company names such as “Inc.,” “Co.,” and “LTD,” which merely identify the type of company or corporation.<sup>77</sup> Accordingly, the TLD “.com” only identified the company as being an online entity.<sup>78</sup> Consistent with the analyses in prior decisions that refused the registrations of the marks “Paint Products Co.” and “Office Movers, Inc.,” the TTAB concluded

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<sup>70</sup> TMEP, *supra* note 43, § 1209.03(m).

<sup>71</sup> *Id.*

<sup>72</sup> *Id.* § 1215.05.

<sup>73</sup> See *Martin Container*, 65 U.S.P.Q.2d (BNA) at 1060 (affirming the refusal of registration under section 23 of the Lanham Act); see also TMEP, *supra* note 43, § 1215.05.

<sup>74</sup> 834 F.2d 1017, 1018 (Fed. Cir. 1987) (holding that the mark “Screenwipe” for pre-moistened antistatic cloths used to clean computer and television screens was generic).

<sup>75</sup> *Martin Container*, 65 U.S.P.Q.2d (BNA) at 1061.

<sup>76</sup> *Gould*, 834 F.2d at 1018.

<sup>77</sup> *Martin Container*, 65 U.S.P.Q.2d (BNA) at 1060.

<sup>78</sup> *Id.*



that <container.com> was “no more registrable than the generic terms would be by themselves.”<sup>79</sup>

The TTAB in *In re CyberFinancial.Net, Inc.* likewise affirmed a trademark examining attorney’s rejection of <bonds.com> on the principal register.<sup>80</sup> The TTAB, in this proceeding, made its determination based on the standard two-part test for genericness offered by the Federal Circuit for traditional marks: (1) what is the category of goods or services at issue; and (2) whether the term sought to be registered is understood by the relevant public primarily to refer to such category.<sup>81</sup> The TTAB found that the category at issue was the “electronic commerce services regarding financial products . . . via the Internet” and that the public somehow understood <bonds.com> to refer to that category.<sup>82</sup> Drawing from the Ninth Circuit’s reasoning in *Brookfield Communications, Inc. v. West Coast Entertainment*,<sup>83</sup> the TTAB concluded that “.com” only signified the Web site’s commercial nature and carried no trademark significance.<sup>84</sup> It found that the compound term—formed by combining “bonds” with “.com”—was generic and stated that “the public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined.”<sup>85</sup>

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<sup>79</sup> *Id.* (citing *In re Paint Products Co.*, 8 U.S.P.Q.2d (BNA) 1863 (Trademark Trial & App. Bd. July 8, 1988), and *In re E.I. Kane, Inc.*, 221 U.S.P.Q. (BNA) 1203 (Trademark Trial & App. Bd. Feb. 16, 1984), as examples of cases where generic company names combined with generic indicators were not adequately distinctive).

<sup>80</sup> 65 U.S.P.Q.2d 1789 (Trademark Trial & App. Bd. Aug. 28, 2002).

<sup>81</sup> *See H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 991 (Fed. Cir. 1986) (holding that the mark “Fire Chief” for a magazine on the topic of firefighting was descriptive and, therefore, valid after applying a two-part test to determine genericism); *see also Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (establishing the primary significance test for genericism, in which a plaintiff must show that the “primary significance of the term in the minds of the consuming public is not the product, but the producer”).

<sup>82</sup> *CyberFinancial.Net*, 65 U.S.P.Q.2d at 1790.

<sup>83</sup> 174 F.3d 1036 (9th Cir. 1999).

<sup>84</sup> *CyberFinancial.Net*, 65 U.S.P.Q.2d at 1792 (stating that “second-level domain names communicate information as to source” (quoting *Brookfield*, 174 F.3d at 1055)).

<sup>85</sup> *Id.* at 1792.

The TTAB also addressed its interest in preserving competition.<sup>86</sup> Applying the Supreme Court's reasoning from an 1888 case,<sup>87</sup> the TTAB stated that it was necessary for <bonds.com> to remain available for other competitors in the same industry, such as <acmebonds.com> or <unitedbonds.com>, so that they could identify and distinguish their own goods and services.<sup>88</sup>

## II. UNFAIR COMPETITION LAW AND GENERIC TERMS

The flexible doctrine of unfair competition “encompass[es] a broader range of unfair practices [than does trademark law,] which may be generally described as misappropriation of the skill, expenditures, and labor of another.”<sup>89</sup> Marks that have not been registered on the USPTO's principal or supplemental register nevertheless may gain protection under section 43(a) of the Lanham Act (“Section 43(a)”) <sup>90</sup> in cases where “the term name is so associated with [the owner's] goods that use of the same or similar term by another company constitutes a representation that its good from the same source.”<sup>91</sup> Section 43(a)(1)(A) allows recovery for the use of “any word, term, symbol, or device” that is likely to cause confusion as to the origin or association of one's goods or services with those of another.<sup>92</sup>

The following sections turn to the favorable, albeit rare, treatment of generic marks within this area of the Lanham Act. In

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<sup>86</sup> *Id.* at 1793 (stating that “competitors should be allowed to freely use [generic] marks . . . to identify and distinguish their services”).

<sup>87</sup> *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word ‘Company’ only indicates that parties have formed an association . . .”).

<sup>88</sup> *See CyberFinancial.Net*, 65 U.S.P.Q.2d at 1793.

<sup>89</sup> *Am. Footwear Corp. v. Gen. Footwear Co.*, 609 F.2d 655, 662 (2d Cir. 1979).

<sup>90</sup> *See* 15 U.S.C. § 1125(a)(1)(A) (2000).

<sup>91</sup> *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 149–50 (2d Cir. 1997).

<sup>92</sup> 15 U.S.C. § 1125(a) (providing a cause of action against any person who “uses in commerce any word, term, name, symbol, or device . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association . . . or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person”).

particular, two Second Circuit decisions provide a remedial platform to owners of traditional generic marks.<sup>93</sup> Holders of less traditional generic marks—vanity phone numbers—also sought relief successfully in the Second Circuit as well as the Federal Circuit.<sup>94</sup> While holders of vanity phone numbers are not uniformly entitled to an unfair competition claim,<sup>95</sup> vanity phone number cases may offer insight into the types of issues that arise with respect to other less traditional generic marks, namely GDNs.

*A. Hope in the Second Circuit for Generic Marks*

The Second Circuit has provided some accommodation to holders of generic marks by suggesting that a competitor's deceptive use of a generic term may support a claim for unfair competition.<sup>96</sup> In *Murphy Door Bed Co. v. Interior Sleep Systems*, the Second Circuit held that the "Murphy bed" mark was generic and not entitled to trademark protection, but subsequently concluded that its ruling did not preclude the Murphy Door Bed Company from bringing an unfair competition claim based on "passing off products."<sup>97</sup> The court opined that the defendant did not violate the principles of unfair competition merely by selling and advertising its products as Murphy beds; rather, the violation arose when it intentionally misrepresented its beds as being those manufactured by the company holding the "Murphy beds" mark.<sup>98</sup>

Similarly, the Second Circuit in *Genesee Brewing Co. v. Stroh Brewing Co.* suggested that the use of plaintiff beer company's generic mark, "Honey Brown"—if closely associated with

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<sup>93</sup> See discussion *infra* Part II.A.

<sup>94</sup> See discussion *infra* Part II.B.

<sup>95</sup> See *infra* notes 128–31 and accompanying text.

<sup>96</sup> See *Forschner Group v. Arrow Trading Co.*, 30 F.3d 348, 358 (2d Cir. 1994) (holding that "[i]f there is a sufficient factual predicate for this allegation [of confusion as to source], injunctive relief is warranted irrespective of whether the phrase Swiss Army knife is generic"); *Murphy Door Bed Co. v. Interior Sleep Sys.*, 874 F.2d 95 (2d Cir. 1989); *accord* *Blinded Veterans Ass'n v. Blinded Ams. Veterans Found.*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) (concluding that "if an organization's own name is generic, a competitor's subsequent use of that name may give rise to an unfair competition claim if competitor's failure adequately to identify itself as distinct from the first organization causes confusion or a likelihood of confusion").

<sup>97</sup> *Murphy Door Bed Co.*, 874 F.2d at 102.

<sup>98</sup> *Id.*

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plaintiff's beverage—would be impermissible when such use would engender a likelihood of confusion as to the source.<sup>99</sup> The *Genesee* court articulated the two elements of an unfair competition claim: “(1) an association of origin by the consumer between the mark and the first user, and (2) a likelihood of consumer confusion when the mark is applied to the second user's good.”<sup>100</sup> Association of origin is synonymous with secondary meaning and arises when consumers primarily associate a mark with the producer of the goods or services, and not merely the goods or services themselves.<sup>101</sup> Therefore, a claim for unfair competition based upon the use of a generic mark ultimately requires that the claimant demonstrate “(1) something valuable to lose (consumer good will), and (2) a likelihood that it will be unfairly taken (consumer confusion),” at least in the Second Circuit.<sup>102</sup> Although the *Genesee* court acknowledged that consumers and bartenders alike referred to the plaintiff's beer simply as “Honey Brown” and that the defendant company did not take steps to eliminate public confusion in using the term, the court held that preliminary injunction was an inappropriate remedy for an unfair competition claim.<sup>103</sup>

### *B. The Vanity Phone Number Paradigm*

With few judicial decisions surrounding GDNs,<sup>104</sup> the law involving vanity phone numbers that contain generic terms may

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<sup>99</sup> *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 150 (2d Cir. 1997).

<sup>100</sup> *Id.* (citing *Forschner*, 904 F. Supp. at 1417).

<sup>101</sup> *Forschner*, 904 F. Supp. at 1417; see also 2-7 GILSON & SAMUELS, *supra* note 31, § 7.02[5][a], at 7-23 (“[The] implied requirement of Section 43(a) was variously called a form of unique association, a ‘quality similar to secondary meaning,’ or ‘secondary meaning.’” (footnotes omitted)).

<sup>102</sup> *Forschner*, 904 F. Supp. at 1418.

<sup>103</sup> *Genesee*, 124 F.3d at 151.

<sup>104</sup> In one rare decision, *E-cards v. King*, No. 99-CV-3726 (N.D. Cal. May 10, 2000), a jury awarded an online greeting card company, who held the GDN <e-cards.com>, \$4 million on its unfair competition claim against a competitor, who operated under the name <ecards.com>. See Peter Brown, *Protection of Trademarks and Trade Secrets in E-Commerce*, in SOLVING THE LEGAL ISSUES AFFECTING B2B TRANSACTIONS, at 127, 142 (PLI Pats., Copyrights, Trademarks, & Literary Prop. Course, Handbook Series No. 650, 2001). The verdict in the *E-cards* decision is viewed by scholars and some practitioners as effectively granting the online card company a monopoly over a generic term. *Id.*

provide guidance because GDNs and vanity phone numbers have several characteristics in common.<sup>105</sup> Like GDNs, phone numbers are unique because there can be only one holder of any given phone number.<sup>106</sup> Vanity phone numbers, such as 1-800-LAWYERS and 1-800-FLOWERS, are dualistic; they serve as both an identifier of a business and a locator by connecting would-be dialers.<sup>107</sup> The USPTO's policy with respect to dialing prefixes, such as 800, 888, and 877, is the same with TLDs, in that dialing prefixes are not accorded any trademark significance.<sup>108</sup> Moreover, a generic term combined with a dialing prefix is not eligible for registration on the principal or supplemental register.<sup>109</sup>

Domain names are also subject to a similar "parasitic" problem that plagues vanity phone numbers.<sup>110</sup> This parasitic problem arises when competitors anticipate and take advantage of the public's misdialing, mistyping, or misspelling to create vanity phone numbers or domain names that are confusingly similar to existing ones.<sup>111</sup>

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<sup>105</sup> See, e.g., *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999) (observing that "[e]ach web page has a corresponding domain address, which is an identifier somewhat analogous to a telephone number or street address"); cf. 1 MCCARTHY, *supra* note 13, § 7:17.1, at 7-26 (listing other legal metaphors to domain names such as radio station call letters). Compare Ann K. Linnehan, *Need Trademark Protection for a Generic Domain Name? Help May Be Just a Phone Call Away*, 38 GONZ. L. REV. 503, 528-34 (2002/2003) (comparing the structure of domain names to vanity phone numbers and urging that similar protection is justified), with Christie L. Branson, Comment, *Was \$7.5 Million a Good Deal for Business.com? The Difficulties of Obtaining Trademark Protection and Registration for Generic and Descriptive Domain Names*, 17 SANTA CLARA COMPUTER & HIGH TECH. L.J. 285, 310 (2001) (arguing that the analogy of vanity phone numbers to domain names would result in monopolistic practices whereby competitors would be prohibited from using generic terms to describe their products).

<sup>106</sup> See InterNIC.net, *A Non-Technical Explanation*, *supra* note 16 ("Think of the phone system . . . when you dial a number, it rings at a particular location because there is a central numbering plan that ensures that each telephone number is unique. The [domain name system] works in a similar way.").

<sup>107</sup> See Branson, *supra* note 105, at 307.

<sup>108</sup> TMEP, *supra* note 43, § 1209.01(b)(12).

<sup>109</sup> *Id.*

<sup>110</sup> See Nathenson, *supra* note 19, at 927, 968 (comparing parasitic domain names to commonly-misdialed numbers that correspond to well-known vanity phone numbers).

<sup>111</sup> See, e.g., *id.*

A notable dissimilarity between domain names and vanity phone numbers, however, is that phone numbers can contain only ten digits whereas GDNs can contain up to sixty-three characters.<sup>112</sup> Thus, the range of available alternatives and word arrangements is more limited with phone numbers than with domain names.<sup>113</sup>

Four key cases illustrate the differing approaches to trademark and unfair competition claims involving vanity phone numbers. In *Dial-A-Mattress Franchise Corp. v. Page*,<sup>114</sup> a mattress retailer, primarily doing business in the New York metropolitan area under the phone number MATTRES (628-8737), sued a competitor for adopting the confusingly similar phone number 1-800-MATTRESS (628-8737).<sup>115</sup> The Second Circuit declined to decide the case solely upon traditional principles applicable to generic terms and instead asserted that the mattress retailer “[did] not lose the right to protection against [the competitor’s] use of a confusingly similar number and a confusingly similar set of letters that correlate with that number . . . just because the letters spell a generic term.”<sup>116</sup> The court opined that a competitor should not remain free to confuse the public by using a deceptively similar phone number.<sup>117</sup> The Second Circuit further asserted that phone

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<sup>112</sup> See *In re CyberFinancial.Net*, 65 U.S.P.Q.2d 1789, 1793 (Trademark Trial & App. Bd. Aug. 28, 2002). Although sixty-three characters is feasible, the average number of characters in a domain name is only eleven. See Zooknic Internet Intelligence, *Average Length of Domain Names*, at [http://www.zooknic.com/Domains/dn\\_length.html](http://www.zooknic.com/Domains/dn_length.html) (last visited Apr. 6, 2004).

<sup>113</sup> See *infra* text accompanying notes 132–31. For a detailed discussion comparing vanity phone numbers and domain names, see Nathenson, *supra* note 19, at 966–69. Ira S. Nathenson observes that with telephone numbers,

the letters “Q” and “Z” are unavailable. Further, since the numbers two (2) through nine (9) on a phone each correspond to three letters, one mnemonic word may preclude other words: 1-800-BEER-R-US is the same number as 1-800-BEEP-R-UP, and 1-800-4-DOLE-96 is the same as 1-800-I-FOLD-96. . . . Domain names, however, . . . may comprise almost any alphanumeric character.

*Id.*

<sup>114</sup> 880 F.2d 675, 676 (2d Cir. 1989).

<sup>115</sup> The Second Circuit noted that the mattress retailer was “not seeking protection against a competitor’s use of the word ‘mattress’ solely to identify the competitor’s name or product.” *Id.* at 678.

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

numbers may be entitled to trademark protection and that confusingly similar numbers may be enjoined.<sup>118</sup>

The same mattress retailer appealed the TTAB's refusal to register 1-888-MATRESS (628-7377) as a service mark in *In re Dial-A-Mattress Operating Corp.*<sup>119</sup> The Federal Circuit held that the vanity phone number was registrable on the principal register on the grounds that it was descriptive and had acquired distinctiveness.<sup>120</sup> It did not analyze the dialing prefix "888" and the term "mattress" as a combination of two generic terms, as traditionally had been done under the *Gould* test.<sup>121</sup> Instead, it limited *Gould* as being "applicable only to 'compound words formed by the union of words' where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends 'no additional meaning to the term.'"<sup>122</sup> The court concluded that the *Gould* test was the wrong test to apply in this context.<sup>123</sup> The Federal Circuit likened 1-888-MATRESS to a "phrase" rather than a compound word and adopted the commercial-impression-as-a-whole test, in which a vanity phone number is considered as a whole and not as separate components.<sup>124</sup> Viewing 1-888-MATRESS as a whole, the Federal Circuit concluded that the mark was not generic because the relevant public did not refer to "the class of shop-at-home telephone mattress retailers" as 1-888-MATRESS.<sup>125</sup> Given the ten-digit make-up of phone numbers, the Federal Circuit observed that holding a phone number containing the term "mattress" already has precluded competitors from using that number "for all practical purposes," and that further

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<sup>118</sup> *Id.*

<sup>119</sup> 240 F.3d 1341, 1343–44 (Fed. Cir. 2001).

<sup>120</sup> *Id.* at 1347–48 (finding that 1-888-MATRESS was the "legal equivalent" of the prior registered mark 212-MATTRES and, therefore, entitled to *prima facie* evidence of acquired distinctiveness).

<sup>121</sup> See *supra* notes 74–76 and accompanying text.

<sup>122</sup> *Dial-A-Mattress*, 240 F.3d at 1345 (emphasis added) (citing *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1348–49 (Fed. Cir. 1999)).

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 1345–46.

<sup>125</sup> *Id.* at 1346.

precluding registration “merely shifts the race from the [USPTO] to the telephone company.”<sup>126</sup>

In stark contrast to the Second Circuit, the Third Circuit in *Dranoff-Perlstein Associates v. Sklar*<sup>127</sup> refused to grant any protection to a vanity phone number containing a generic term.<sup>128</sup> A personal injury firm with INJURY-1 (465-8791) as its phone number sued a competitor for doing business with INJURY-9 (465-8799).<sup>129</sup> The Third Circuit adhered to traditional trademark principles, which grant protection only to marks that are arbitrary, suggestive, or descriptive with a showing of secondary meaning.<sup>130</sup> It reasoned that protection for vanity phone numbers containing generic terms would allow the first company to obtain such a phone number to gain an unfair advantage over its competitors “merely by winning the race to the telephone company.”<sup>131</sup> The Third Circuit observed that the ten-digit make-up of phone numbers severely limited “the range of commonly used alternatives which effectively communicate the same functional information as the word ‘injury.’”<sup>132</sup> It concluded that if the personal injury firm were permitted to preclude competitors from using “injury” in their phone numbers, “it would achieve the kind of unfair competitive advantage the genericness doctrine is supposed to prevent.”<sup>133</sup>

Rather than addressing the issue of mark classification or the implications of the genericness doctrine, the Sixth Circuit in *Holiday Inns, Inc. v. 800 Reservation, Inc.*<sup>134</sup> focused on the public confusion that potentially arises from the use of parasitic phone numbers.<sup>135</sup> The hotel chain Holiday Inns, which used 1-800-

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<sup>126</sup> *Id.*

<sup>127</sup> 967 F.2d 852 (3d Cir. 1992).

<sup>128</sup> *Id.* at 857.

<sup>129</sup> *Id.* at 853–54.

<sup>130</sup> *Id.* at 855 (discussing the categories of marks under the Lanham Act and their respective levels of protection).

<sup>131</sup> *Id.*

<sup>132</sup> *Id.* at 859.

<sup>133</sup> *Id.* at 859–60. Ultimately, the Third Circuit remanded for a determination as to whether there was a likelihood of confusion with respect to the mark as a whole. *Id.* at 863.

<sup>134</sup> *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996).

<sup>135</sup> *See id.*



HOLIDAY (1-800-465-4329) to book reservations, sued an independent booking service for employing 1-800-HOLIDAY (1-800-465-0329).<sup>136</sup> Dialers reaching the latter number immediately received a recorded message notifying dialers of their misdial and disclaiming affiliation to Holiday Inns.<sup>137</sup> The Sixth Circuit distinguished *Dial-A-Mattress Franchise Corp. v. Page* by pointing out that the competitor in that case had promoted its vanity phone number so as to deliberately cause public confusion.<sup>138</sup> The Sixth Circuit opined that the independent booking service merely took advantage of a “preexisting confusion” on the part of the dialers—namely, the confusion between the number zero and the letter O on the dial pad—but did not itself “create” that confusion.<sup>139</sup> The Sixth Circuit held that the booking service did not use the Holiday Inns trademark nor engage in misleading representation.<sup>140</sup> The booking service, therefore, did not violate the “plain language” of the Lanham Act.<sup>141</sup>

### III. THE APPLICATION OF TRADEMARK AND UNFAIR COMPETITION PRINCIPLES TO GDNS

Mechanically labeling GDNS as generic marks, as trademark examining attorneys and the TTAB do, necessarily evokes the genericness doctrine.<sup>142</sup> Contrary to traditional marks, however,

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<sup>136</sup> *Id.* at 621.

<sup>137</sup> *Id.* The recorded message stated: “Hello. You have misdialed and have not reached Holiday Inns or any of its affiliates. You’ve called 800 Reservations, America’s fastest growing independent computerized hotel reservation service.” *Id.*

<sup>138</sup> *Id.* at 624.

<sup>139</sup> *See id.* at 625 (observing that the defendant in *Dial-A-Mattress Franchise Corp.* had promoted “1-800-MATTRESS” as its phone number in the same geographic regions as the plaintiff was promoting its number, thereby causing confusion).

<sup>140</sup> *Id.* at 626.

<sup>141</sup> *Id.* The district court noted that the booking service was in clear violation of the “spirit,” but not the “letter,” of the Lanham Act. *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 838 F. Supp. 1247, 1255 (E.D. Tenn. 1993), *rev’d in part*, 86 F.3d 619 (6th Cir. 1996).

<sup>142</sup> *See, e.g., In re Allwall Techs., Inc.*, No. 75/879,693, 2003 TTAB LEXIS 395 (Trademark Trial & App. Bd. Aug. 19, 2003) (refusing registration of <art.com> as generic); *In re Mark Deitch & Assocs., Inc.*, No. 75/857,971, 2003 TTAB LEXIS 219 (Trademark Trial & App. Bd. May 13, 2003) (refusing registration of <websitedesigns.com> as generic); *In re Oppedahl & Larson LLP*, No. 78/061,755, 2003

domain names are one of a kind. For example, only one <coffee.com> can exist in cyberspace whereas an infinite number of companies named Coffee Co. can co-exist in the offline world.<sup>143</sup> Hence, the main concern that the genericness doctrine was meant to address—the free use of common words—is not encountered with GDNs.<sup>144</sup> In other words, permitting multiple e-companies to freely compete with <coffee.com> is impossible.<sup>145</sup>

The touchstone of trademark and unfair competition claims—ensuring consumers’ rights not to be confused<sup>146</sup>—is rendered nearly inoperative in the GDN context. Due to the unique nature of GDNs, there is no need to shelter consumers from confusion arising from multiple competitors using the GDN <coffee.com>. Legitimate concerns over restrained competition or likelihood of confusion may arise when e-businesses adopt parasitic domain names such as <coffeee.com>, <coffee.net>, or <coffee-online.com>. Moreover, offline companies taking on deceptively similar names to GDNs, or even identical names, may present trademark infringement and unfair competition issues as well.

The following sections evaluate how traditional principles and policies that have guided generic marks operate within the realm of GDNs when their unique nature are accorded a more prominent role in the analysis. Respecting their uniqueness presents novel considerations in mark classification, while exposing the flaws in the anticompetition argument underlying the genericness doctrine.<sup>147</sup>

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TTAB LEXIS 194 (Trademark Trial & App. Bd. Apr. 16, 2003) (refusing registration of <patents.com> as merely descriptive).

<sup>143</sup> See *supra* note 16.

<sup>144</sup> Regarding concurrent use on the Internet, Professor Michael B. Landau observed: “On the Internet, the domain name form ‘trademark.com’ does not give any indication of territory or of goods and/or services. Traditional concurrent use of a trademark by itself, without alphanumeric modifiers specifying geographic market or goods and services in the domain name, is unworkable.” Michael B. Landau, *Problems Arising Out of the Use of “www.Trademark.com”*: *The Application of Principles of Trademark Law to Internet Domain Name Disputes*, 13 GA. ST. U. L. REV. 455, 472 (1997).

<sup>145</sup> See *supra* note 16.

<sup>146</sup> See *supra* note 53.

<sup>147</sup> See *infra* Part III.A; see also text accompanying *supra* notes 57–61.

*A. Breaking Down and Sizing Up GDNs*

Placing GDNs within the spectrum of distinctiveness, which can be determinative of whether a protectable mark exists in the first place,<sup>148</sup> is not a simple task. One method used to classify these marks is what the TMEP instructs in section 1209.03(m) for the purposes of registration, and another possibility is derived from the Federal Circuit's approach to vanity phone numbers.<sup>149</sup> The diverging approaches of the USPTO, as conveyed through the TMEP, and the Federal Circuit are revealing of the crucial role that TLDs play in determining how GDNs should be appropriately analyzed.<sup>150</sup>

*1. Approaches to How GDNs Can Be Analyzed*

Dissecting GDNs into their component parts and viewing them only as a combination of generic terms almost always will render GDNs generic marks and ultimately unregistrable.<sup>151</sup> The TMEP appears to handle GDNs as if they are compound words, by subjecting them to *Gould*-like treatment<sup>152</sup> and automatically disregarding the TLDs.<sup>153</sup> A TLD, by itself, does not have a source-identifying function<sup>154</sup> and rightly should not be given trademark significance. But the TMEP's instructions under section 1209.03(m) are problematic because they further assume that the union of a TLD with a SLD produces no additional source identification.<sup>155</sup> Average Internet consumers arguably do not break down a domain name into its TLD and SLD components, nor do they attribute trademark significance solely to the SLD.<sup>156</sup> <Coffee.com> would be recited in full as "coffee dot com," and

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<sup>148</sup> See *supra* Part I.A.

<sup>149</sup> See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1343 (Fed. Cir. 2001) (finding that "1-888-MATTRESS" was registrable as a service mark because it had acquired distinctiveness); *supra* Part I.B.

<sup>150</sup> See *infra* Part III.A.1.

<sup>151</sup> But see text accompanying *supra* note 65.

<sup>152</sup> See text accompanying *supra* notes 74–79.

<sup>153</sup> See TMEP, *supra* note 43, § 1209.03(m).

<sup>154</sup> See *supra* Part I.B.

<sup>155</sup> See TMEP, *supra* note 43, § 1209.03(m); *supra* Part I.B.

<sup>156</sup> But see Branson, *supra* note 105, at 303 (suggesting that the public accords "little significance" to the "www" and ".com" components).

only then would it give off the impression of a coffee retailer who does business on the Internet. The SLD alone, “coffee,” signifies little without attaching a TLD.

In effect, the TMEP’s approach in section 1209.03(m) forecloses any chance of registration to companies that operate exclusively on the Internet, regardless of the possibility of deceptive trade practices by competitors.<sup>157</sup> The TTAB, in *Martin Container*, chose to compare the function of TLDs to that of generic indicators such as “Inc.” and “Ltd.,” and in doing so, made a significant oversight: while it is true that “Inc.” identifies extremely little about a company’s source, “.com” speaks to the only possible source.<sup>158</sup> The most that “Inc.” or “Ltd.” adds to a term is the type of business entity, many of which can co-exist with the same name and generic indicator.<sup>159</sup> The TLD “.com” can indicate the type of entity<sup>160</sup> as well as the only entity when attached to a SLD.<sup>161</sup> Analyzing domain names as mere generic components under the *Gould* test, therefore, underestimates the “brand new” meaning formed by the union of a SLD and a TLD.

The Federal Circuit’s approach to vanity phone numbers (commercial-impression-as-a-whole test)<sup>162</sup> arguably makes more sense as applied to domain names because it captures how the

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<sup>157</sup> *But see* text accompanying note 65.

<sup>158</sup> *See supra* note 16.

<sup>159</sup> *See* Sarah E. Akhtar & Robert C. Cumbow, *Why Domain Names Are Not Generic: An Analysis of Why Domain Names Incorporating Generic Terms Are Entitled to Trademark Protection*, 1 J. INTELL. PROP. 226, 234 (1999) (pointing out that several companies can co-exist with the same name, even within the same industry).

<sup>160</sup> *See In re CyberFinancial.Net*, 65 U.S.P.Q.2d 1789, 1792 (Trademark Trial & App. Bd. Aug. 28, 2002) (finding that “.com” only indicated a Web site’s commercial nature); *In re Martin Container*, 65 U.S.P.Q.2d 1058, 1060 (Trademark Trial & App. Bd. June 11, 2002) (defining “.com” as “the code used to identify an Internet user as one operating (or belonging to) a commercial organization (business)”) (citations omitted). Other TLDs can identify types of entities as well. For example, the “.biz” registry is reserved for the promotion of small and large businesses. Neulevel, *at* <http://www.neulevel.biz> (last visited Apr. 5, 2004). Networking providers employ the “.net” registries, and non-profit organizations commonly apply to “.org” registries. *See* Brookfield Communications, Inc. v. W. Coast Entm’t Corp., 174 F.3d 1036, 1044 (9th Cir. 1999). The “.pro” registry was established for self-certified professionals, such as doctors, accountants, and lawyers. RegistryPro, *at* <http://www.registrypro.com> (last visited Apr. 5, 2004).

<sup>161</sup> *See supra* note 16.

<sup>162</sup> *See* text accompanying *supra* note 124.

public realistically views domain names. <Coffee.com> is akin to a phrase, or a sequence of words that are regarded as a meaningful unit.<sup>163</sup> Attaching “.com” to the end of “coffee” lends additional meaning on the whole by indicating that the company’s services are online, are represented by a commercial entity bearing some relation to coffee, and, most importantly, originate from the only e-company in existence with the domain name <coffee.com>.

## 2. GDNs as Generic Marks Overall?

A GDN, when properly analyzed as a phrase, does not fit the traditional conception of a generic mark. Put another way, GDNs do not pass as generic marks under the standard two-part test to determine genericism.<sup>164</sup> First, <coffee.com> is not the common name that the relevant public understands to refer to coffee retailers who do business on the Internet.<sup>165</sup> <Coffee.com> is not literally the genus of online coffee retailers.<sup>166</sup> Second, as discussed above, <coffee.com> is capable of indicating the source of the services because the public recognizes that <coffee.com> is the only source there is.

A complementary definition of a generic mark, which is tied to free competition principles, depends on the competitors’ need to use it: “if no commonly used alternative effectively communicates the same functional information, the term that denotes the product [or service] is generic.”<sup>167</sup> While competitors engaged in the online coffee business may need the word “coffee” to adequately

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<sup>163</sup> E.g., WEBSTER’S II NEW COLLEGE DICTIONARY 829 (1995); cf. Linnehan, *supra* note 105, at 528–29 (“[A] top-level domain such as ‘.com’ is not a word and is not generic for the services of the domain name. It is a code of reference used to signify the type of organization identified by the domain name. Each of these codes—‘888’ and ‘.com’—when combined with a word element like ‘mattress’ or ‘container,’ create a brief expression. In other words, a phrase is created.”).

<sup>164</sup> See *supra* note 81 and accompanying text (discussing the two-part test offered by the Federal Circuit to determine whether a mark is generic).

<sup>165</sup> But see Nguyen, *Shifting the Paradigm in E-Commerce*, *supra* note 15, at 956–66 (implying that the public immediately understands <www.wireless.com> to refer to wireless services).

<sup>166</sup> See text accompanying *supra* note 56.

<sup>167</sup> A.J. Canfield Co. v. Honickman, 808 F.2d 291, 305–06 (3d Cir. 1986); see also Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 145 (2d Cir. 1987) (noting that the test articulated in *A.J. Canfield* is a useful complement to the test for genericism).

describe their services, <coffee.com>, as such, is not a term that competitors can use to compete because of the technical limitations of the Internet. Thus, the need of several competitors to use <coffee.com> concurrently would be impossible to satisfy.<sup>168</sup>

Even if GDNs escape from being labeled as generic marks, the *de facto* secondary meaning doctrine<sup>169</sup> might operate to prevent any rights from being acquired in the GDNs. At first glance, the *de facto* secondary meaning doctrine appears to apply to GDNs because it refers to the situation in which the public is aware that a single source for a particular service exists over a period of time.<sup>170</sup> This doctrine, like the genericness doctrine, “reflects the legal conclusion that . . . the term must be held free for competitive use if it is in fact the commonly recognized name of the goods.”<sup>171</sup> Because the rationale of the *de facto* secondary meaning doctrine also anticipates the need for free competitive use, it also fails to concede the non-duplicable nature of domain names.

GDNs fit tenuously within the definition of a generic mark. The result of approaching GDNs as phrases, under the commercial-impression-as-a-whole test, is that GDNs seldom would be considered generic marks. Although <coffee.com> is a service mark that contains a generic term, it is not necessarily a generic mark overall.

### 3. GDNs as Descriptive Marks

The category of descriptive marks is a better classification for GDNs.<sup>172</sup> For example, <pets.com> conveys the impression that some service related to pets is available by visiting the Web site—whether it be the online service of a pet seller, a pet supply retailer, a pet care service, or a newsletter on the topic of pet care. The Federal Circuit in *Dial-A-Mattress* stated that “the mark need not recite *each* feature of the relevant goods or services in detail to be

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<sup>168</sup> See *supra* note 16.

<sup>169</sup> See *supra* note 54 and accompanying text.

<sup>170</sup> See *supra* text accompanying note 54.

<sup>171</sup> JANE C. GINSBURG, JESSICA LITMAN & MARY L. KEVLIN, TRADEMARK AND UNFAIR COMPETITION LAW: CASES AND MATERIALS 336 (3d ed. 2001).

<sup>172</sup> The Second Circuit acknowledged that “[t]he lines of demarcation . . . are not always bright.” *Abercrombie & Fitch v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

descriptive.”<sup>173</sup> <Pets.com> would be sufficiently descriptive, although not exact as to which type of pet-related services is being offered.

Here, TLDs again introduce a novel consideration in the classification of marks. TLDs are an indispensable component to every domain name because a Web site cannot operate without one.<sup>174</sup> While TLDs lend meaning to GDNs on the whole, they primarily serve a functional role.<sup>175</sup> Yet, the very component that transforms the GDNs into descriptive marks—the TLD—is mandatory for all GDNs.<sup>176</sup> Every company doing business through a Web site must employ a TLD in its domain name, and the types of TLDs available to select from are limited.<sup>177</sup> The necessity of TLDs, therefore, automatically forces descriptive names upon e-companies. Nevertheless, <pets.com> more closely resembles a descriptive mark rather than a generic mark overall. That TLDs are required components of all domain names does not mean that a domain name is less capable of functioning as a valid trademark.

#### 4. Arbitrary or Suggestive GDNs

The main focus of this Note is on e-companies that adopt GDNs and provide online services having to do with the generic terms involved—such as an online espresso machine retailer that employs <coffee.com>—and whether those GDNs are truly generic marks. An e-company might adopt a GDN for services *unrelated* to the generic term and, thus, may encounter less of a classification obstacle in the trademark examining attorney’s office.<sup>178</sup> Section 12.09.03(d) of the TMEP states that a “mark

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<sup>173</sup> *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (emphasis added).

<sup>174</sup> See InterNIC.net, *A Non-Technical Explanation*, *supra* note 16.

<sup>175</sup> See *id.*

<sup>176</sup> See *id.*

<sup>177</sup> In addition to “.com,” “.net,” and “.edu,” newly offered TLDs include “.aero,” “.biz,” “.coop,” “.info,” “.museum,” and “.name.” InterNIC.net, *InterNIC FAQs on New Top-Level Domains*, at <http://www.internic.net/faqs/new-tlds.html> (last updated Sept. 25, 2002). The registry agreement for “.pro” is under negotiation. *Id.*

<sup>178</sup> See TMEP, *supra* note 43, § 12.09.03(d); see, e.g., *In re Colonial Stores, Inc.*, 394 F.2d 549, 552 (C.C.P.A. 1968) (holding that the mark “SUGAR & SPICE” for bakery

comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods.”<sup>179</sup> Accordingly, <coffee.com> would be considered an arbitrary mark when it is used to sell assorted candies online whereas <sugar.com> would be a suggestive mark to sell the same. Both of these GDNs arguably would be entitled to trademark registration and protection, regardless of whether they are viewed as a combination of generic terms or as a phrase, because they fall within the inherently distinctive end of the spectrum of distinctiveness.<sup>180</sup> A GDN that is used in an arbitrary or suggestive manner may be easier to recognize and may pose less of a problem for registration at the USPTO.<sup>181</sup>

### B. GDNs Behaving Anticompetitively

As technology stands today, nothing can be done about the *de facto* monopoly conferred to the holder of any given domain name.<sup>182</sup> <Coffee.com>, as such, is untouchable by online competitors that desire the same domain name.<sup>183</sup> Valid anticompetitive concerns, however, may arise with respect to the use of similar domain names, especially because GDNs incorporate generic terms. By obtaining a court-issued injunction,<sup>184</sup> the company holding <coffee.com> potentially could enjoin competitors, such as <coffee.net> or <coffee-online.com>, from using the term “coffee” in their domain names.

Analogizing GDNs to vanity phone numbers (as analyzed by the courts in the *Dial-A-Mattress* decisions) may exacerbate these

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products was entitled to trademark registration because the combined terms could “function as an indication of more than a mere description of the ingredients of the goods on which the mark is used”).

<sup>179</sup> TMEP, *supra* note 43, § 12.09.03(d); *see also supra* note 178.

<sup>180</sup> *See* text accompanying *supra* notes 45–46.

<sup>181</sup> *See supra* note 178.

<sup>182</sup> *See supra* Part III.A.2.

<sup>183</sup> *See id.*

<sup>184</sup> *See* 15 U.S.C. § 1116 (2001) (establishing that courts with jurisdiction over civil actions concerning trademarks may grant injunctions to prevent the violation of a trademark holder’s rights).



anticompetitive concerns. Although domain names resemble vanity phone numbers in several ways, one dissimilarity remains significant: many more variations of domain names are possible using the same generic term because the SLD of a domain name can contain up to sixty-three characters and can include alphabetic letters, numerals, and hyphens, whereas vanity phone numbers are limited to exactly ten digits.<sup>185</sup> A GDN holder who successfully brings a cause of action in the Federal or Second Circuits, by way of analogy to vanity phone numbers, potentially could enjoin competitors from using all of those variations over the entire Internet.<sup>186</sup> As a result, a system would be created whereby trademark priority would be established according to the first to scoop up a GDN by applying to a domain name registrar,<sup>187</sup> which screens domain names against multiple registrations.<sup>188</sup> The first to register a GDN with Network Solutions, Inc.,<sup>189</sup> for example, would be the first and only one able to commercially put it to use and then get it onto the USPTO's register.<sup>190</sup>

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<sup>185</sup> See *In re CyberFinancial.Net, Inc.*, 65 U.S.P.Q. 1789, 1793 (Trademark Trial & App. Bd. Aug. 28, 2002); text accompanying *supra* notes 112–13.

<sup>186</sup> See Nathenson, *supra* note 19, at 968 (arguing that more possibilities exist with similar domain names than in the case of telephone numbers).

<sup>187</sup> See Nguyen, *Shifting the Paradigm in E-Commerce*, *supra* note 15, at 976–78; Branson, *supra* note 105, at 310.

<sup>188</sup> Domain name registrars administer domains names to prevent multiple entities from registering the same domain name. See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 953 (C.D. Cal. 1997) (explaining the role of the registrar, National Science Foundation, in screening domain name applications); InterNIC.net, *A Non-Technical Explanation*, *supra* note 16 (discussing the function of registrars). As one registrar explains, “Registrars process name registrations for Internet end users and then send the necessary [domain name system] information to a registry for entry into the centralized registry database. The [domain name system] information is then propagated over the Internet.” VeriSign, Naming and Directory Services, *Frequently Asked Questions*, at <http://www.verisign.com/nds/naming/faq.html> (last visited Apr. 2, 2004). To maintain a Web site, an applicant must first register the domain name with a domain name registrar. See InterNIC.net, *InterNIC FAQs on the Domain Names, Registrars, and Registration*, at <http://www.internic.net/faqs/domain-names.html> (last updated Sept. 25, 2003).

<sup>189</sup> Network Solutions, Inc. is the largest domain name registrar. See Network Solutions, Inc., *About Network Solutions*, at [http://www.networksolutions.com/en\\_US/about-us.jhtml;jsessionid=FXEASTS15K1OGCWLEALCFEQ](http://www.networksolutions.com/en_US/about-us.jhtml;jsessionid=FXEASTS15K1OGCWLEALCFEQ) (last visited Apr. 2, 2004).

<sup>190</sup> See 15 U.S.C. § 1114 (2001) (requiring “use in commerce”); *supra* note 29.

These anticompetition concerns would pose less difficulty if the USPTO and the courts chose to grant only qualified GDNs—i.e., those marks that are successful and widely recognized by the public—protection. Any advantage that may result from first-come-first-serve registration with Network Solutions is innate to the domain name system; someone will always be the first to register a GDN with a domain name registrar and become its sole holder.<sup>191</sup> This “priority system” would not necessarily grant a monopoly to the first entity to dream up <coffee.com> and register it with Network Solutions, as some argue.<sup>192</sup> According to the proposal below, it simply would allow the company holding <coffee.com> the opportunity to earn and exercise the statutory rights owed to it in accordance to Section 43(a) the Lanham Act.<sup>193</sup>

#### IV. FAIR PLAY IN CYBERSPACE: A PROPOSAL FOR GDN PROTECTION

A competitor should not remain free to use a domain name that is deceptively similar to a GDN that has achieved success and recognition in the e-marketplace. Because “coffee” is generic, <coffee.com> should not be able to enjoin e-competitors in the same industry that merely use <coffeee.com>, <coffee.net>, or <coffee-now.com>, but it should be able to sustain a claim against competitors who deceptively use those domain names to pass off their services as those belonging to <coffee.com>.<sup>194</sup> Therefore, a competitor does not engage in trademark infringement merely by

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<sup>191</sup> See *supra* note 187.

<sup>192</sup> See, e.g., Nguyen, *Shifting the Paradigm in E-Commerce*, *supra* note 15, at 976–77 (arguing that a company that merely registers a GDN first gains an unfair advantage over its competitors); *supra* note 187 and accompanying text.

<sup>193</sup> But see Nguyen, *Shifting the Paradigm in E-Commerce*, *supra* note 15, at 976–77 (“Extending unfair competition law with respect to generic domain names will hinder the growth of e-commerce.”). Specifically, Professor Xuan-Thao N. Nguyen opposes injunctive relief in this context. *Id.* at 978.

<sup>194</sup> Cf. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15, cmt. d (1995) (“Use of a generic term in a manner likely to deceive or mislead a significant number of prospective purchasers as to the source of the goods or service, however, may subject the user to liability under the general rule proscribing misrepresentations of source. . . . Subsequent users, although protected in their right to use a generic term, may thus be required to take reasonable precautions to avoid a likelihood of confusion.”).

selling and advertising its services under the domain name <coffeee.com>; it might, however, end up confusing the public in doing so.<sup>195</sup>

The rules of genericism should not be rigidly applied to domain names because they do not fit the mold of traditional marks. The best way to approach GDNs is to revisit the two fundamental goals of trademark and unfair competition law—protecting consumers’ ability to distinguish among services provided by competitors and guarding the goodwill of mark owners<sup>196</sup>—and assemble a system of protection that effectively serves those goals.

GDNs can be protected in such a way that remains faithful to the spirit of the Lanham Act, without going beyond the letter of the law. The law of unfair competition is sufficiently flexible to provide protection to GDNs. Unlike Section 32(1), the broad language of Section 43(a) does not require that the mark be registered, which suggests that the insurmountable hurdle that generic marks face in trademark law is not present in unfair competition law.<sup>197</sup> With no reference to the requirement of a “registered mark,” Section 43(a) appears to extend trademark-like protection to marks that are not registered or registrable.<sup>198</sup> This may mean that the search for the perfect classification of GDNs has little bearing on the application of Section 43(a). As one treatise explained, “Congress recognized that [Section 43(a)] fills an important gap in federal unfair competition law and . . . it expects the courts to continue to interpret the section accordingly.”<sup>199</sup> The Second Circuit’s refusal in *Dial-A-Mattress*, therefore, to foreclose an unfair competition claim based on a

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<sup>195</sup> See discussion *supra* Part II.A.

<sup>196</sup> See discussion *supra* Part I.

<sup>197</sup> *E.g.*, *Forschner Group, Inc. v. Arrow Trading Co.*, 904 F. Supp. 1409, 1416 (S.D.N.Y. 1995) (“Although genericness prevents a word or phrase from attaining trademark protection, it does not prevent a court from determining whether a competitor’s later use of that word or phrase is unfair.”).

<sup>198</sup> See 15 U.S.C. § 1125 (2001) (establishing that any person who uses any word in a manner likely to cause confusion, or misrepresents goods or services shall be liable).

<sup>199</sup> 2-7 GILSON & SAMUELS, *supra* note 31, § 7.02[4], at 7-18.

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service mark containing a generic term was not an anomaly in the law and was within the bounds of the Lanham Act.<sup>200</sup>

The spirit of the Lanham Act calls for the government to safeguard businesses' goodwill, and e-companies that adopt GDNs should not be excluded.<sup>201</sup> Categorically excluding GDNs from protection would be accepting a tenuous classification of genericism and ignoring the uniqueness that GDNs possess apart from the familiar, yet outmoded, spectrum of distinctiveness. The following sections propose a system of protection against unfair trade practices for e-companies that hold qualified GDNs. The proposed cause of action is crafted within the boundaries of the Lanham Act and takes into consideration the backdrop of potential anticompetition concerns.

#### *A. Cause of Action for GDN Holders*

A claim for the protection of a GDN should satisfy two intertwined requirements: (1) the GDN has acquired substantial secondary meaning; and (2) there is a likelihood of confusion among the relevant public. The unique nature of GDNs goes to the first requirement, but more than inherent uniqueness should be shown. A showing of substantial secondary meaning additionally ensures that the most deserving GDNs are protected.

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<sup>200</sup> *But see* Nguyen, *Shifting the Paradigm in E-Commerce*, *supra* note 15, at 976–77 (stating that “expanding [section 43(a)] to include competitor’s use of generic terms fails to reconcile with other provisions in the Lanham Act that grant no trademark protection to generic trademarks”).

<sup>201</sup> In recognizing the importance of goodwill, the Supreme Court stated:  
The protection of trade-marks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants.

*Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

### 1. Establishing Substantial Secondary Meaning

While the majority of the public probably is aware that only one given domain name can exist on the Internet,<sup>202</sup> the public also should be able to mentally associate an actual online service with a particular GDN before secondary meaning is properly established. Simply put, the GDN should be well known. Traditional factors helpful in measuring the secondary meaning of GDNs may include sales success, significant advertising expenditures, and favorable evidence on brand recognition by consumers.<sup>203</sup> An additional consideration should be the efforts exerted to make the GDN visible to the public, both online and offline, as is any other traditional trademark. This may include the frequency of promotion on various media, such as on other Web sites, radio, television, magazines, newspapers, or billboards.<sup>204</sup> Other useful factors involve the public's affirmative actions to seek out the e-company, as evidenced by the number of "hits" that the Web site receives and the amount of unsolicited e-mails or letters that the e-company receives from consumers.<sup>205</sup>

### 2. Finding Signs of Confusion

Under the proposed claim, secondary meaning is evaluated in tandem with likelihood of confusion. While all of the above factors establishing secondary meaning may demonstrate that consumers are extremely familiar with <pets.com>, it does not necessarily follow that consumers who nevertheless purchase from

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<sup>202</sup> See *supra* note 16; see also Akhtar & Cumbow, *supra* note 159, at 228 (suggesting that the public appreciates that ".com" indicates an e-company and, therefore, a single source).

<sup>203</sup> Traditional factors of secondary meaning include (1) sales success, (2) advertising expenditures, (3) studies on consumer recognition, (4) unsolicited media coverage, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark's use. See, e.g., Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1222 (2d Cir. 1987).

<sup>204</sup> See 2 MCCARTHY, *supra* note 13, § 15:50, at 15-79 (suggesting that advertisements may create a mental association in the public's mind, including the minds of individuals who never have purchased the goods).

<sup>205</sup> See *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 141 (2d Cir. 1987) (referring to unsolicited letters that demonstrate that a large number of consumers identify plaintiff's beer as "Honey Brown").

<pets.net> mistakenly believe that they are purchasing from <pets.com>. The factors pertinent to determining a likelihood of confusion, as discussed below,<sup>206</sup> should be simultaneously considered to ascertain whether a GDN has secondary meaning. In other words, a GDN that has secondary meaning is one in which the adoption of a similar domain name by an e-competitor would “constitute[] a representation that its goods come from the same source.”<sup>207</sup> The requirements of the proposed cause of action are satisfied when a GDN is associated with its service in such a way that Internet consumers are likely to be confused by a competitor’s use of a similar domain name.

a) Limitations on GDN Protection

Before discussing the factors evincing a likelihood of confusion, it should be first pointed out that a showing of actual public confusion should not be overestimated, particularly when the confusion is nominal.<sup>208</sup> So-called initial interest confusion should be insufficient to satisfy the second part of the proposed cause of action. The concept of initial interest confusion has gained popularity in cases dealing with the Internet.<sup>209</sup> This is the situation in which the adoption of a similar mark diverts consumers’ attention from the original source that they were seeking although by the time of purchase they are no longer confused.<sup>210</sup> The *Brookfield* court asserted that the “diversion of consumers’ initial interest is a form of confusion against which the Lanham Act protects.”<sup>211</sup> Using this reasoning, another court found that a “[d]efendant’s domain name and home page address are external labels that, on their face, cause confusion among

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<sup>206</sup> See *infra* notes 219–17 and accompanying text.

<sup>207</sup> *Genesee*, 124 F.3d at 149–50.

<sup>208</sup> See *infra* note 219 (listing evidence of actual public confusion as a factor in analyzing unfair competition claims).

<sup>209</sup> See *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (stating that by using <moviebuff.com> to divert people looking for “MovieBuff” products, the defendant “improperly benefits from the goodwill that [plaintiff] developed in its mark”).

<sup>210</sup> See *id.*

<sup>211</sup> *Id.* at 1063 (citing *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1043–46 (9th Cir. 1997)).

Internet users and may cause Internet users who seek plaintiff's web site to expend time and energy accessing defendant's web site."<sup>212</sup> Accordingly, the adoption of a similar domain name that operates to attract potential consumers' interest may be actionable even though the consumers thereafter rectify any initial confusion.

Liability for initial interest confusion alone is inappropriate because the experience of the Internet has trained millions of users to expect that they will not reach the Web sites that they want every time. While an online consumer may land on the wrong Web site, often only a few seconds may pass before he or she realizes the mistake. A consumer looking to purchase dog collars on <pets.com> may inadvertently land on the pet care newsletter Web site called <pets.org>, yet will not be confused in a way that should result in protection for <pets.com>. Consumers have come to expect that locating a particular online pet supplier's Web site may require some trial and error.<sup>213</sup> Another example is where a consumer mistakenly types in or clicks on a link for <potatoe.com> to reach <potato.com>. Recalling the concept of "pre-existing confusion" from the *Holiday Inns* case,<sup>214</sup> the holder of <potatoe.com> may have intentionally adopted that GDN to catch poor spellers or oblivious consumers, but did not itself create that grammatical confusion. With well over thirty-five million domain names in cyberspace,<sup>215</sup> some imprecision in the process of locating desired Web sites is inherent in the experience of the Internet, regardless of the affirmative acts of the competing GDN holder.<sup>216</sup> Although the Lanham Act seeks to protect consumers' ability to distinguish among the services provided by competitors,

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<sup>212</sup> *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1441 (S.D.N.Y. 1997) (issuing an injunction in favor of the plaintiff, Planned Parenthood, against the defendant, the host of Catholic Radio, in order to dispel confusion induced by defendant's domain name <www.plannedparenthood.com>).

<sup>213</sup> See generally *Brookfield*, 174 F.3d at 1062.

<sup>214</sup> See *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 621 (6th Cir. 1996); *supra* notes 135–41 and accompanying text.

<sup>215</sup> This amount includes ".com," ".org," ".net," ".biz," and ".info" domain names only. See *supra* note 18.

<sup>216</sup> Compare how the *Brookfield* court distinguished the *Holiday Inns* case: "[Defendant here] acted affirmatively in placing [plaintiff's] trademark in the metatags of its web site, thereby creating the initial interest confusion." *Brookfield*, 174 F.3d at 1065 (emphasis in original).

fleeting initial interest confusion on the Internet is of little concern and should not be actionable.

The Sixth Circuit's reasoning in *Holiday Inns* is helpful in that it speaks to the overall Internet experience—no one *creates* the imprecision in surfing the Internet for a particular Web site.<sup>217</sup> But, at the same time, this inherent imprecision should not excuse competitors from using deceptive trade practices or confusing the public. The type of confusion that does raise the specter of concern is a long-term confusion as to source, particularly when the offending competitor provides similar services.<sup>218</sup> For example, consumers are confused as to source when they fully believe that they are purchasing dog supplies from <pets.com>, but in actuality the services are rendered by <petz.com>.

The traditional test for a likelihood of confusion typically involves several factors,<sup>219</sup> three of which are the most probative to determining a likelihood of confusion in this context: (1) the similarity between the GDN and the competitor's mark, (2) the proximity of the type of services, and (3) the competitor's intention in adopting a similar domain name.<sup>220</sup> First, because identical GDNs are not an issue,<sup>221</sup> the similarity between respective domain names should be the focus. For instance, <pets.net> is similar to <pets.com> in that the same SLD is used; and <petz.com> is similar to <pets.com> in that the alternate spelling does not change the way which Internet consumers would pronounce the domain

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<sup>217</sup> See Nathenson, *supra* note 19, at 959–61 (describing the expectation of a typical Web surfer as “an educated guess, rather than an absolute expectation”).

<sup>218</sup> See 2-5 GILSON & SAMUELS, *supra* note 31, § 5.01[3][c][iv], at 5-22 (defining confusion as to source as the situation in which the public mistakenly believes that it is purchasing goods manufactured by the original mark owner).

<sup>219</sup> See *Polaroid Corp. v. Polarad Elecs. Corp.*, 286 F.2d 492, 495 (2d Cir. 1961). The *Polaroid* factors are (1) similarity of marks, (2) strength of plaintiff's mark, (3) quality of the defendant's goods or services, (4) proximity of the goods or services, (5) likelihood that plaintiff will bridge the gap, (6) evidence of actual confusion, (7) defendant's good faith, and (8) consumer sophistication. See *id.*

<sup>220</sup> As the *Brookfield* court noted, the similarity of the marks and the proximity of the goods or services are “always important” in a likelihood of confusion analysis. *Brookfield*, 174 F.3d at 1054.

<sup>221</sup> See *supra* note 16.



name phonetically.<sup>222</sup> Identical or similar phonetic pronunciation may cause public confusion particularly when the Web sites are verbally advertised, such as on the radio or television.<sup>223</sup>

Second, where a domain name such as <pets.biz> is a direct competitor of <pets.com>, confusion is more likely.<sup>224</sup> As the *Brookfield* court opined, “The use of similar marks to offer similar products accordingly weighs heavily in favor of likelihood of confusion.”<sup>225</sup> On the other hand, if <pets.biz> is an online newsletter about pet care whereas <pets.com> is an online pet supply retailer, the adoption of <pets.biz> is less likely to confuse consumers who are looking to purchase particular pet supplies.<sup>226</sup> Even further, if <pets.biz> provides banking services, then a finding of confusion is much less likely.<sup>227</sup>

Third, inquiring into <pets.biz>’s justification for adopting its domain name may lead to a presumption of a likelihood of confusion.<sup>228</sup> If <pets.com> offers proof that <pets.biz> was intentionally trying to deceive the public, courts may presume that such deception resulted.<sup>229</sup> Comparing elements of the respective domain names’ Web sites for similar colors, fonts, layouts, sound files, or login and checkout procedures also may be relevant in

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<sup>222</sup> Cf. *Nathenson*, *supra* note 19, at 960 (explaining that a dispute arising over a domain name readily suggests that the domain names at issue are highly similar).

<sup>223</sup> Cf. *Krim-Ko Corp. v. Coca-Cola Bottling Co. of N.Y.*, 390 F.2d 728, 731–32 (C.C.P.A. 1968) (stressing the importance of phonetic similarity when the goods are of the type frequently purchased by verbal order).

<sup>224</sup> See *Brookfield*, 174 F.3d at 1056.

<sup>225</sup> *Id.*; accord *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 188 (W.D.N.Y. 2000) (finding that where two e-companies “compete for the same audience—namely, Internet users who are searching for a web site that uses [a] plaintiff[s]’s mark as its address”—such a “high degree of competitive proximity increases the likelihood of confusion among Internet users”).

<sup>226</sup> See *supra* notes 224–22.

<sup>227</sup> See *id.*

<sup>228</sup> See 3 MCCARTHY, *supra* note 13, § 23:110, at 23-273 to 23-275. Other courts suggest that a defendant’s bad faith creates only an inference of confusion rather than a presumption. See, e.g., *Res. Developers, Inc. v. Statue of Liberty-Ellis Island Found., Inc.*, 926 F.2d 134, 140 (2d Cir. 1991) (holding that when bad faith is shown, “a powerful inference may be drawn that the defendant has succeeded in confusing the public”).

<sup>229</sup> See 3 MCCARTHY, *supra* note 13, § 23:110, at 23-273 (explaining that proof of intended confusion tends to show confusion in fact).

determining whether <pets.biz> acted in good faith.<sup>230</sup> For instance, if <pets.biz> displays its name on its Web site by emphasizing the “.biz”—i.e., the dissimilar portion of the mark—in large, bold, blinking font, then such efforts to distinguish its domain name would weigh in its favor.<sup>231</sup> In addition, the presence of an obvious and effective disclaimer may be indicative of good faith or an effort to distinguish services.<sup>232</sup>

#### b) Confusion by Offline Competitors

Another type of confusion, confusion as to association, may arise when offline competitors adopt names that are similar or identical to online GDNs.<sup>233</sup> If <pets.com> has acquired secondary meaning, then the public is likely to be confused as to association when a store called “Pets.com” or even “Pets.com Offline” opens down the street.<sup>234</sup> In addition to the similarity of the marks, one of the factors that should weigh most heavily in determining likelihood of confusion in this scenario should be whether the GDN holder will “bridge the gap” in services.<sup>235</sup> As one court explained, “This factor contemplates ‘the senior user’s interest in preserving avenues of expansion and entering into related fields.’”<sup>236</sup> Pets.com Offline may argue that it is providing pet supplies in a different market than <pets.com>, namely the offline

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<sup>230</sup> See 3 *id.* § 23:52 (stating that the use of the same lettering, colors, and format weighs in favor of finding a likelihood of confusion).

<sup>231</sup> See 3 *id.* § 23:42 (“Although it is not proper to dissect a mark, one feature of a mark may be more significant and it is proper to give greater force and effect to that dominant feature. Thus, as a preliminary to comparing marks in their entireties, it is not improper to downplay the similarity of very descriptive parts of conflicting marks.”).

<sup>232</sup> Compare *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1325, 1330 (2d Cir. 1987) (suggesting that the use of disclaimers can cure confusion effectively in markets comprised of sophisticated consumers), with *Home Box Office, Inc. v. Showtime/Movie Channel, Inc.*, 832 F.2d 1311, 1316 (2d Cir. 1987) (holding that the burden to prove that a disclaimer is effective is placed on the defendant).

<sup>233</sup> See 2-5 GILSON & SAMUELS, *supra* note 31, § 5.01[3][c][iv], at 5-22 (describing confusion as to source as the situation in which the public believes that the offending mark is associated or connected with the original mark).

<sup>234</sup> See *id.*

<sup>235</sup> See *Lexington Mgmt. Corp. v. Lexington Capital Partners*, 10 F. Supp. 2d 271, 286–87 (S.D.N.Y. 1998); *supra* note 219.

<sup>236</sup> *Lexington Mgmt. Corp.*, 10 F. Supp. at 287 (quoting *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 504 (2d Cir. 1996)).

market. But if <pets.com> has demonstrated that it is likely to expand its online services and offer the same services in a physical location in Manhattan, then a finding of a likelihood of confusion may ensue.

Furthermore, the intention of Pets.com Offline in adopting its name would be questionable and may trigger a presumption of confusion.<sup>237</sup> Even if it had a credible justification for adopting a similar name, however, the well-known *Dawn Donut* rule establishes that if “expansion were probable, then the concurrent use of the marks would give rise to the conclusion that there was a likelihood of confusion.”<sup>238</sup> An e-company holding a GDN with secondary meaning, therefore, may be protected from unfair competition by its brick-and-mortar competitors if it intends to cross over to the offline world.

### B. Fashioning an Equitable Remedy

When a competitor is likely to cause consumer confusion, it should be required “‘to use every reasonable means to prevent confusion’ as to the source of the products.”<sup>239</sup> As discussed, issuing injunctions raises fears that the holder of <coffee.com> effectively would gain a monopoly over the generic term “coffee” in other domain names.<sup>240</sup> The *Genesee* court acknowledged that a competitor’s use of a generic term may not be enjoined altogether.<sup>241</sup> Rather, the holder of a GDN should be entitled to an equitable remedy that is “no broader than necessary to cure the effects of the harm caused.”<sup>242</sup> The sensible remedy is to require the offending competitor to distinguish its services and explicitly notify consumers that its services do not come from or are not associated with those of the prevailing GDN holder.<sup>243</sup>

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<sup>237</sup> See text accompanying *supra* notes 228–29.

<sup>238</sup> *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 364 (2d Cir. 1959).

<sup>239</sup> *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 150 (2d Cir. 1997) (quoting *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 121 (1938)).

<sup>240</sup> See *supra* Part III.B.

<sup>241</sup> See *Genesee*, 124 F.3d at 151.

<sup>242</sup> *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1325, 1329 (2d Cir. 1987) (citing *Swann v. Charlotte–Mecklenburg Bd. of Educ.*, 402 U.S. 1, 16 (1971)).

<sup>243</sup> See *Genesee*, 124 F.3d at 151 (quoting *Forschner Group v. Arrow Trading Co.*, 30 F.3d 348, 359 (2d Cir. 1994)).

The offending competitor could distinguish its services by differentiating the appearance of its Web site, which may include calling attention to the dissimilar portion of the GDN everywhere it appears on the Web site—by using large fonts, bolding, or underlining, for example.<sup>244</sup> An explicit notification also should be required in the form of a full disclaimer, as opposed to a hyperlink to the disclaimer, placed at the top of each page of the Web site so that it is quickly noticeable while the page is loading.<sup>245</sup> Although disclaimers may not be effective in some traditional contexts,<sup>246</sup> their utility may be greater online because Internet consumers are already sensitized to the fact that they will not always land on the right Web sites. A disclaimer on <pets.biz> may dispel any confusion quickly and aid consumers along in their search for <pets.com>. A hyperlink to the prevailing GDN holder's Web site additionally should be provided alongside the disclaimer to direct lost Internet consumers.<sup>247</sup>

As for offline competitors that are found to have caused a likelihood of confusion as to association,<sup>248</sup> courts should grant an injunction in favor of prevailing GDN holders. Still, <coffee.com> should not be able to prevent "Coffee Co." or "Coffee Offline" from opening on Fifth Avenue. But if an offline competitor takes on "Coffee.com" or "Coffee.com Offline" as its name, which later results in confusion to the public because <coffee.com> is taken in its entirety, then injunction may serve as a reasonable remedy.

## CONCLUSION

The present scheme of intellectual property protection under Section 43(a) of the Lanham Act can provide the proper analytic framework for addressing GDNs. A policy change removing the

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<sup>244</sup> See *supra* Part IV.A.2.a.

<sup>245</sup> *But see* Home Box Office, Inc. v. Showtime/Movie Channel, Inc., 832 F.2d 1311, 1315–16 (2d Cir. 1987) (reviewing academic literature that concludes that disclaimers, which utilize negating words such as "no" or "not," are frequently ineffective).

<sup>246</sup> See *id.* (referring to scientific research demonstrating the lack of effectiveness of disclaimers placed on football jerseys).

<sup>247</sup> See Nathenson, *supra* note 19, at 961 (suggesting that hyperlinks that forward Internet users to their desired Web sites may alleviate confusion).

<sup>248</sup> See *supra* notes 233–35 and accompanying text.

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stigma of GDNs as generic marks is first needed, however, in order to deal effectively with the reality of the Internet and the ability of GDNs to function as true trademarks. The uniqueness of GDNs has been a dominant theme in this Note's analysis and ultimately urges the conclusion that GDNs should be protectable upon a showing of secondary meaning and likelihood of confusion of Internet consumers. The application of the genericness doctrine is wholly inappropriate in the context of these novel, yet source-identifying marks.

The proposed remedy preserves fair competition and helps to allay concerns over monopoly, while also alleviating confusion within the Internet community. Safeguarding the substantial efforts of GDN holders in creating and developing goodwill, under this proposal, comports with language of the Lanham Act while faithfully upholding its fundamental goals.