

2009

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

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Mindy P. Fox, *Does It Really Suck?: The Impact of Cutting-Edge Marketing Tactics on Internet Trademark Law and Gripe Site Domain Name Disputes*, 20 *Fordham Intell. Prop. Media & Ent. L.J.* 225 (2009).

Available at: <https://ir.lawnet.fordham.edu/iplj/vol20/iss1/4>

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Cover Page Footnote

Special thanks to my advisor Professor Fabio Arcila for his insights and guidance; to my wonderful husband Evan Fox for his endless love and support; to Susan Sprung and Allie Schafrann for their feedback and suggestions; and to my family and friends for their constant enthusiasm and encouragement. I sincerely appreciate everything that you all have done for me.

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

Mindy P. Fox*

INTRODUCTION	226
I. TRADEMARKS IN DOMAIN NAMES.....	229
A. <i>Domain Name Registration</i>	229
B. <i>Consumer Gripe Sites: [trademark]sucks.com</i>	232
C. <i>Consumer Fan Sites: love[trademark].com</i>	233
D. <i>Trademark Law</i>	234
1. Likelihood of Confusion Standard and Lanham Act	234
2. Anti-Cybersquatting Consumer Protection Act (“ACPA”)	236
3. Uniform Domain Name Dispute Resolution Policy (“UDRP”).....	239
E. <i>Permissibility of Gripe Sites</i>	241
1. Federal Court Litigation	242
a) <i>Bally Total Fitness Holding Corp. v. Faber</i>	242
b) <i>Lucent Technologies, Inc. v. Lucent</i> <i>sucks.com</i>	244
c) <i>Ford Motor Co. v. 2600 Enterprises</i>	245
d) <i>Taubman Co. v. Webfeats</i>	247
2. World Intellectual Property Organization (“WIPO”) Hearings	249
a) <i>Analysis of WIPO Decisions</i>	249
b) <i>Panels Holding for Trademark Owner</i> (Complainant).....	252

226	<i>FORDHAM INTELL. PROP. MEDIA & ENT. L.J.</i> [Vol. 20:225	
	c) Panels Holding for Domain Name Registrant (Respondent)	255
	<i>F. Permissibility of Love Sites</i>	258
II.	MARKETING CAMPAIGNS WITH UNCLEAR SPONSORING COMPANIES	260
	A. <i>Viral Marketing Campaigns</i>	262
	1. Case Study: Burger King’s “Subservient Chicken”	262
	2. Case Study: Smirnoff’s “Tea Partay”	263
	3. Case Study: Court TV’s “That Girl Emily”	265
	4. Case Study: McDonald’s “The Lost Ring”	266
	B. <i>Domain Names Case Studies</i>	267
	1. Steven Singer	268
	2. Loews and Southwest Airlines	270
III.	CONFUSING THE LIKELIHOOD OF CONFUSION STANDARD	271
	A. <i>Permissibility of Trademarks in Gripe Site and Love Site Domain Names Not Owned by Trademark Owner</i>	272
	1. Internet Users and Common Sense	272
	2. Different Intents of Parody	273
	3. Confusion as to Source	274
	B. <i>Impermissibility of Trademarks in Gripe Site and Love Site Domain Names Not Owned by Trademark Owner</i>	276
	1. Association of Trademark Owner and Domain Name Registrant	276
	2. Diversion to the Gripe Site	278
	3. Fan Sites	280
IV.	TOWARDS THE REVERSAL OF GRIPE SITE PERMISSIBILITY PRECEDENT	281
	CONCLUSION	286

INTRODUCTION

Imagine that Rachel owns a company, Rachel’s Candy Shop, which sells candy online. She registers the domain name,

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

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

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

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¹ This sample case is loosely based on a marketing campaign by Steven Singer Jewelers. *See infra* notes 260–72 and accompanying text.

style and content of each website—attacking the companies—do not help clarify ownership.

It is not far-fetched to imagine organizations promoting their “chick flick” movies, computers, daytime soap operas, romance novels, or tabloids by using consumers’ mixed love/hate relationship with these products. It is not uncommon to hate products we use,² and it is creative to spin a marketing campaign around such a theme. On the other hand, consumers devoted to a product, character, or person have been known to create fan sites that promote the trademark even though the website creator does not receive any benefit for doing so.³ They too are using another’s trademark in their domain name, even if they are endorsing rather than disparaging it.

The federal courts and the World Intellectual Property Organization (“WIPO”) arbitration panels analyze whether a domain name infringes on a trademark owner’s trademark by looking at whether the domain name is *likely to confuse* Internet consumers about the ownership of the website.⁴ The decisions on both gripe sites and fan sites that apply the likelihood of confusion standard are mixed.⁵ For example, some decisions explain that people are unlikely to think that a website whose domain name has the word “sucks” or “hate” alongside the trademark was created by the trademark owners, but others argue for a more blanket prohibition on using another’s trademark in a domain name at all.⁶ This analysis has been inconsistent and narrow and should be reevaluated and streamlined.

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

² See DONALD A. NORMAN, EMOTIONAL DESIGN: WHY WE LOVE (OR HATE) EVERYDAY THINGS 7 (2004).

³ See BEN MCCONNELL, JACKIE HUBA & GUY KAWASAKI, CREATING CUSTOMER EVANGELISTS: HOW LOYAL CUSTOMERS BECOME A VOLUNTEER SALES FORCE 59 (2002).

⁴ See *infra* Part I.D.1.

⁵ See *infra* Part I.E.

⁶ See *infra* Part I.E.

gripe sites are owned by the trademark owner.⁷ Yet these alternative marketing techniques demonstrate otherwise. In light of the increase in these techniques, it may no longer be possible to irrefutably hold that no reasonably prudent Internet user would think that, for example, Evan's Divine Chocolates uses the domain name www.ihateevansdivinechocolates.com.

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

I. TRADEMARKS IN DOMAIN NAMES

A. *Domain Name Registration*

Since its invention in 1989,⁸ the Internet has quickly grown from an exclusive research tool for scientists⁹ to the ubiquitous mass medium it is today. Over one billion people worldwide and 79% of adults in the United States use the Internet.¹⁰ Such a vast

⁷ See *infra* Part I.E.

⁸ See JOHN R. LEVINE, MARGARET LEVINE YOUNG & CAROL BAROUDI, *THE INTERNET FOR DUMMIES* 89 (11th ed. 2007).

⁹ See STUART MINOR BENJAMIN, DOUGLAS GARY LICHTMAN, HOWARD SHELANSKI & PHILIP J. WEISER, *TELECOMMUNICATIONS LAW AND POLICY* 912 (2d ed. 2006).

¹⁰ See Press Release, comScore, Global Internet Audience Surpasses 1 Billion Visitors, According to comScore (Jan. 23, 2009), available at <http://www.comscore.com/press/release.asp?press=2698>; see also Solarina Ho, *Poll Finds Nearly 80 Percent of U.S. Adults Go Online*, REUTERS, Nov. 5, 2007, <http://www.reuters.com/article/internetNews/idUSN0559828420071106?feedType=RSS&feedName=internetNews&sp=true>; Internet

medium requires an organizational system to help user's access particular information.

A domain name is the Internet address,¹¹ which enables Internet users to identify and access websites.¹² It "is a word or series of words followed by '.edu' for education; '.org' for organizations; '.gov' for government entities; '.net' for networks; and '.com' as the catchall for other Internet users."¹³ The "word or series of words"—otherwise known as the "second-level domain name"¹⁴—often is the website owner's trademark.¹⁵ According to one study, 67% of online users visited websites using direct navigation, a means whereby consumers type the domain name of a website directly into the Internet browser address box.¹⁶ Clearly, domain names not only allow users to access a website but are also a means to determine which websites can provide the content Internet users seek.

Since November 1998, the Internet Corporation for Assigned Names and Numbers (ICANN), an international organization unaffiliated with any government or government agency,¹⁷ has been managing the domain name system.¹⁸ Internet domain names

World Stats, Internet Usage Statistics: World Internet Users and Population Stats, <http://www.internetworldstats.com/stats.htm> (last visited Sept. 29, 2009) (estimating that over 1.5 billion people worldwide use the Internet).

¹¹ W. Scott Creasman, *Free Speech and "Sucking"—When Is the Use of a Trademark in a Domain Name Fair?*, 95 TRADEMARK REP. 1034, 1035 (2005).

¹² Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 1006 (2007).

¹³ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1162 n.1 (C.D. Cal. 1998).

¹⁴ Colby B. Springer, Comment, *Master of the Domain (Name): A History of Domain Name Litigation and the Emergence of the Anticybersquatting Consumer Protection Act and Uniform Dispute Resolution Policy*, 17 SANTA CLARA COMPUTER & HIGH TECH. L.J. 315, 321 (2001).

¹⁵ *Id.* at 325.

¹⁶ John Cook, *Marchex Solidifies Its Web Presence*, SEATTLE POST-INTELLIGENCER, Nov. 24, 2004, available at http://seattlepi.nwsource.com/business/200885_marchex24.html; see also H.R. REP. NO. 106-412, at 5 (1999) ("In fact, many consumers who do not know the domain name of a company will first try the principal trademark or trade name of that company to locate the company's Web site.").

¹⁷ JEFFREY A. FRANKEL & PETER R. ORSZAG, AMERICAN ECONOMIC POLICY IN THE 1990S, at 383 (2002).

¹⁸ See Memorandum of Understanding Between the U.S. Department of Commerce and Internet Corporation for Assigned Names and Numbers, <http://www.ntia.doc.gov/>

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 231

are registered by ICANN-accredited registrars¹⁹ for less than thirty dollars per domain name per year.²⁰ A person who submits the proper application and requisite fee²¹ is automatically registered as long as no one else has previously registered the requested domain name.²²

Possessing a trademark does not automatically trigger ownership or use of the same word or phrase in a domain name.²³ A trademark owner must independently register its trademark with ICANN.²⁴ This “first-come, first-serve”²⁵ system of domain name registration also allows someone who does not own a trademark to register a website domain name that contains a given trademark. However, reserving a domain name does not give the user any official right to use a trademark in the domain name free from legal claims.²⁶

ntiahome/domainname/icann-memorandum.htm (last visited Jan. 18, 2009); *see also* Press Release, Internet Corp. for Assigned Names & Numbers, ICANN Asks Commerce Department to Begin DNS Transition (Nov. 6, 1998), *available at* <http://www.icann.org/en/announcements/icann-pr06nov98.htm>.

¹⁹ Descriptions and Contact Information for ICANN-Accredited Registrars, <http://www.icann.org/en/registrar/accredited-list.html> (last visited Jan. 18, 2009); *see also* ICANN-Accredited Registrars, <http://www.icann.org/en/registrar/accredited-list.html> (last visited Jan. 18, 2009).

²⁰ *See* ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 759 (rev. 4th ed. 2007).

²¹ Jonathan M. Ward, Comment, *The Rise and Fall of Internet Fences: The Overbroad Protection of the Anticybersquatting Consumer Protection Act*, 5 MARQ. INTEL. PROP. L. REV. 211, 215 (2001) (quoting *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996)).

²² G. Gervaise Davis III, *Internet Domain Names and Trademarks: History and Recent Developments in Domestic and International Disputes: Enabling Electronic Commerce on the Internet*, 670 PLI/Pat 551, 563 (2001).

²³ Dara B. Gilwit, Note, *The Latest Cybersquatting Trend: Typosquatters, Their Changing Tactics, and How to Prevent Public Deception and Trademark Infringement*, 11 WASH. U. J.L. & POL'Y 267, 273 (2003).

²⁴ *Id.*

²⁵ *See* *A.B.C. Carpet Co. v. Naeini*, No. 00-CV-4884-FB, 2002 WL 100604, at *2 (E.D.N.Y. 2002).

²⁶ *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 180 (W.D.N.Y. 2000) (“Of course, registration of a domain name in no way trumps federal trademark law; registration does not itself confer any trademark rights on the registrant.”).

B. Consumer Gripe Sites: [trademark]sucks.com

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

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

²⁷ Jonathan L. Schwartz, *Making the Consumer Watchdog’s Bark as Strong as Its Gripe: Complaint Sites and the Changing Dynamic of the Fair Use Defense*, 16 ALB. L.J. SCI. & TECH. 59, 69 (2006) [hereinafter Schwartz, *Consumer Watchdog’s Bark*].

²⁸ *Id.*

²⁹ *Id.*

³⁰ Peter Johnson, *Can You Quote Donald Duck?: Intellectual Property in Cyberculture*, 13 YALE J.L. & HUMAN. 451, 478 (2001).

³¹ See Fairwinds Partners, LLC, *The Power of Internet Gripe Sites: Managing the Destructive Potential of “BrandSucks.com,”* PERSPECTIVES, Aug. 13, 2008, available at <http://www.fairwindspartners.com/en/newsroom/perspectives/vol-3-issue-6/background-on-direct-navigation>.

³² *Id.* (“Two thousand domains have ‘stinks.com’ on the right.”); Johnson, *supra* note 30, at 478 n.142; Jacqueline D. Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 WASH. U. L. REV. 1327, 1361 (2006) [hereinafter Lipton, *Commerce Versus Commentary*]; see also Emily Steel, *How to Handle “IHateYourCompany.com,”* WALL ST. J., Sept. 5, 2008, at B5.

³³ See Lipton, *Commerce Versus Commentary*, *supra* note 32, at 1361.

³⁴ See Fairwinds Partners, LLC, *supra* note 31 (explaining that approximately 2,000 “domains begin with the term ‘boycott’”).

³⁵ See Johnson, *supra* note 30, at 478 n.142.

³⁶ See Steel, *supra* note 32, at B5; see also Johnson, *supra* note 30, at 478 n.142.

³⁷ See Barrett, *supra* note 12, at 1013–14 (“Just as a picketer needs to locate herself near the business whose practices she protests, the gripe site operator needs to incorporate the plaintiff’s mark into her domain name. Use of the plaintiff’s mark in the defendant’s

Gripe sites raise important First Amendment questions. On one hand, trademark owners have commercial rights and interests.³⁸ On the other hand, individuals have free speech interests.³⁹ Although “there is a social value in allowing people to have easy access to a forum to complain about the activities of a commercial entity[,] . . . the question remains whether these people should be able to utilize a domain name for that forum that somehow corresponds with a trademark associated with the relevant entity.”⁴⁰

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

“Another type of ‘trademark.com’ case involves the sites of fans and enthusiasts of the mark owner.”⁴¹ The website domain name often contains the full name of the trademark owner,⁴² but it could also be in the format “ilove[trademark].com.”⁴³ Trademark owners seeking to control their famous marks on the Internet have targeted these fan websites with corporate “cease and desist” letters.⁴⁴ Unlike gripe sites, fan sites promote the trademark,

domain name enables the forum site defendant to get the attention of persons seeking the plaintiff—the precise audience he generally will want to reach.”)

³⁸ See Jacqueline D. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 WAKE FOREST L. REV. 1361, 1399 (2005) [hereinafter Lipton, *Beyond Cybersquatting*].

³⁹ See *id.* at 1399; see also Rebecca S. Sorgen, Comment, *Trademark Confronts Free Speech on the Information Superhighway: “Cybergrippers” Face a Constitutional Collision*, 22 LOY. L.A. ENT. L. REV. 115, 130 (2001).

⁴⁰ Lipton, *Beyond Cybersquatting*, *supra* note 38, at 1399.

⁴¹ David M. Kelly, “*Trademark.com*” Domain Names: Must They Communicate the Website’s Protected Content to Avoid Trademark Liability?, 33 AIPLA Q.J. 397, 417 (2005).

⁴² See, e.g., Lipton, *Beyond Cybersquatting*, *supra* note 38, at 1416–18 (discussing the existence of fan sites such as www.brucespringsteen.com and www.alpacino.com).

⁴³ See, e.g., Mike Masnick, *Sucks Sites May Be Legal . . . But What About Loves Sites?*, TECHDIRT, Oct. 23, 2008, <http://www.techdirt.com/articles/20081016/0153122561.shtml>; What Happened to ILoveJackDaniels.com?, <http://www.addedbytes.com/blog/what-happened-to-ilovejackdaniels-dot-com> (last visited Sept. 29, 2009); Dave Wieneke, *Online Brand Protection Gone Wrong: ILoveJackDaniels.com*, USEFULARTS.US, Nov. 5, 2008, <http://usefularts.us/2008/11/05/online-brand-protection-gone-wrong-ilovejackdaniels.com>.

⁴⁴ Leslie C. Roach, “*I See What You’re Saying*”: Trademarked Terms and Symbols as Protected Consumer Commentary in Consumer Opinion Websites, 24 SEATTLE U. L. REV. 599, 601 (2000).

which might confuse Internet users trying to establish which entity owns a given website.⁴⁵

D. Trademark Law

1. Likelihood of Confusion Standard and Lanham Act

The Lanham Act is a federal statute that protects trademarks.⁴⁶ Especially prior to the enactment of the Anti-Cybersquatting Consumer Protection Act (“ACPA”),⁴⁷ trademark owners relied on the Lanham Act to resolve trademark disputes.⁴⁸ One main type of trademark-based action is trademark infringement.⁴⁹ A trademark owner might bring a trademark infringement action under section 32 and section 43(a) of the Lanham Act⁵⁰ if someone misappropriated its trademark, such as by using the trademark as part of a domain name.⁵¹ Section 32 of the Lanham Act imposes liability for using a registered trademark without the trademark owner’s consent,⁵² and section 43(a) of the Lanham Act imposes liability for using an unregistered common law trademark in a way that is likely to cause confusion as to the owner of the product or service.⁵³

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

⁴⁶ Rochat, *supra* note 44, at 609.

⁴⁷ See *infra* notes 66–80 and accompanying text.

⁴⁸ See Sorgen, *supra* note 39, at 119.

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

⁵⁰ See Blossom Lefcourt, *The Prosecution of Cybergrippers Under the Lanham Act*, 3 CARDOZO PUB. L. POL’Y & ETHICS J. 269, 274 (2004).

⁵¹ See Gilwit, *supra* note 23, at 276.

⁵² See 15 U.S.C. § 1114(1)(a) (2006) (“Any person who shall, without the consent of the registrant—(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.”).

⁵³ See *id.* § 1125(a)(1)(A) (“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or

“[T]he ‘likelihood of confusion’ standard ‘is the touchstone of trademark infringement’ claims.”⁵⁴ However, assessing consumer confusion is “an inherently inexact process.”⁵⁵ The Second Circuit in *Polaroid Corp. v. Polarad Electronics Corp.*⁵⁶ attempted to clarify the definition of consumer confusion by propounding a non-exhaustive list of eight factors relevant to determining likelihood of confusion.⁵⁷ The Ninth Circuit in *AMF, Inc. v. Sleekcraft Boats*,⁵⁸ enumerated a similar eight-part test for likelihood of consumer confusion.⁵⁹ Trial and appeals courts systematically and sequentially apply one of these tests or some highly similar alternative.⁶⁰

The Ninth Circuit in *Interstellar Starship Services, Ltd. v. Epix, Inc.*⁶¹ stated that “‘in the context of the Web,’ the three most important *Sleekcraft* factors in evaluating a likelihood of confusion are (1) the similarity of the marks, (2) the relatedness of the goods or services, and (3) the parties’ simultaneous use of the Web as a marketing channel.”⁶² The court explained that if this “controlling

association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”)

⁵⁴ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 27, at 80 (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:1 (4th ed. 2005)).

⁵⁵ GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 424 (2008).

⁵⁶ 287 F.2d 492 (2d Cir. 1961).

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

⁵⁸ 599 F.2d 341 (9th Cir. 1979).

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

⁶⁰ See Miguel C. Danielson, *Confusion, Illusion and the Death of Trademark Law in Domain Name Disputes*, 6 U. FLA. J. TECH. L. & POL’Y 219, 226 (2001).

⁶¹ 304 F.3d 936 (9th Cir. 2002).

⁶² *Id.* at 942 (citing *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000)).

troika”⁶³ suggests that confusion is likely, the other factors must “weigh strongly” against a likelihood of confusion to avoid the finding of infringement.⁶⁴ If it does not suggest that confusion is likely, then a district court must balance all the *Sleekcraft* factors within the unique context of each case.⁶⁵

Courts deciding domain name trademark infringement actions under the Lanham Act necessarily stretched the existing provisions to fit the unique aspects of the cybersquatting problem, and the results were mixed.⁶⁶ In particular, trademark owners relied on the Lanham Act’s provisions governing an infringing party who makes commercial use of the trademark owners’ “famous” marks.⁶⁷ However, such governance was inadequate when, for example, the trademark was not so well known that it met the legal definition of “famous” or when the cybersquatter did not actually use the name in commerce.⁶⁸ Finally, litigation costs under the Lanham Act were so substantial that some trademark owners chose to pay exorbitant amounts to purchase the domain name from the cybersquatter rather than pursue expensive, slow litigation.⁶⁹

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

On November 29, 1999, Congress attempted to address the inadequacies of the Lanham Act by amending section 43 to create the Anti-Cybersquatting Consumer Protection Act (“ACPA”).⁷⁰ The House of Representatives Committee on the Judiciary explained in its report that the purpose of the ACPA was to stop the “practice of cybersquatters who register numerous domain names containing American trademarks or tradenames only to hold

⁶³ *GoTo.com, Inc.*, 202 F.3d at 1205.

⁶⁴ *Interstellar Starship Servs.*, 304 F.3d at 942 (citing *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 (9th Cir. 1999)).

⁶⁵ *See id.*

⁶⁶ *See* Edward T. Dartley, *Pulling the Plug on Cybersquatters*, 161 N.J. L.J. 270, 270 (2000) (“However, pre-ACPA attempts to curb cybersquatting forced courts to stretch the existing Lanham Act provisions to fit the unique aspects of the cybersquatting problem, sometimes with mixed results.”).

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ Sorgen, *supra* note 39, at 118.

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 237

them ransom in exchange for money.”⁷¹ The report explained that, at the time, “the legal remedies available to trademark owners to prevent cyberspiracy [were] both expensive and uncertain.”⁷²

The ACPA disregards the Lanham Act’s requirements of fame and commercial use, includes “distinctive marks,” and replaces the commercial use requirement with the confusingly similar standard.⁷³ Specifically, the ACPA provides, in pertinent part:

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

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

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

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

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

(III) is a trademark, word, or name protected by reason of section 706 of Title 18 or section 220506 of Title 36.⁷⁴

⁷¹ H.R. REP. NO. 106-412, at 5 (1999).

⁷² *Id.* at 6.

⁷³ Sorgen, *supra* note 39, at 120. The ACPA covers famous marks but, unlike the Lanham Act, the ACPA does not only cover famous marks. *See* 15 U.S.C. § 1125(d)(1)(A)(ii) (2006).

⁷⁴ 15 U.S.C. § 1125(d)(1)(A).

To bring a successful action against a cybersquatter under the ACPA, a court must make three determinations. First, the court determines whether the mark was distinct or famous at the time the domain name was registered.⁷⁵ Second, the court determines whether the domain name is identical or confusingly similar to the mark.⁷⁶ Third, the court determines whether the domain name registrant acted in bad faith, intending to commercially exploit the similarity between the domain name and the mark.⁷⁷ The ACPA gives a nonexhaustive list of nine factors for determining whether a person has bad faith intent.⁷⁸

⁷⁵ Gideon Parchomovsky, *On Trademarks, Domain Names, and Internal Auctions*, 2001 U. ILL. L. REV. 211, 224 (2001).

⁷⁶ *Id.* at 224–25.

⁷⁷ *Id.* at 225.

⁷⁸ See 15 U.S.C. § 1125(d)(1)(B)(i). The list of “bad faith” factors a court may consider includes:

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

The ACPA empowers a court to order the forfeiture or cancellation of a domain name or the transfer of a domain name to the owner of a relevant trademark.⁷⁹ In addition, Congress provides for an award of statutory damages up to \$100,000 to deter cybersquatting in bad faith and compensate trademark owners.⁸⁰

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

As Congress was enacting the ACPA, ICANN developed the Uniform Domain Name Dispute Resolution Policy (“UDRP”),⁸¹ a non-binding arbitration agreement.⁸² The UDRP is a private, international, inexpensive, relatively fast, predominantly online dispute resolution procedure for situations where a complainant is disputing the registration of a domain name.⁸³ The UDRP was adopted on August 26, 1999 and became effective on January 3, 2000.⁸⁴ All registrars certified by ICANN⁸⁵ must adopt the UDRP.⁸⁶

A UDRP proceeding generally takes about two months,⁸⁷ which is more efficient than litigation for trademark owners seeking to repossess a domain name from a cybersquatter.⁸⁸ Thus, the UDRP is very attractive for potential complainants that only want to have the domain name transferred.⁸⁹ The UDRP has been described as “the administrative alternative to ACPA suits.”⁹⁰

Id.

⁷⁹ *Id.* § 1125(d)(1)(C).

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

⁸¹ ICANN, Uniform Domain Name Dispute Resolution Policy, <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (last visited Sept. 20, 2009).

⁸² See Ward, *supra* note 21, at 229.

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

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

⁸⁵ See *supra* note 19 and accompanying text.

⁸⁶ Ward, *supra* note 21, at 229.

⁸⁷ See Sorgen, *supra* note 39, at 146.

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

⁸⁹ *Id.*

⁹⁰ Barrett, *supra* note 12, at 1048 n.290.

The registrars certified by ICANN contractually bind all domain name registrants to submit to a mandatory arbitration under the UDRP if a complaint is made about the registration of one or more relevant domain names.⁹¹ ICANN uses four separate organizations to adjudicate domain name disputes;⁹² the most significant registrar is the World Intellectual Property Organization (“WIPO”).⁹³

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

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

⁹¹ Lipton, *Beyond Cybersquatting*, *supra* note 38, at 1372.

⁹² Sorgen, *supra* note 39, at 124. Those four registrars are the World Intellectual Property Organization (“WIPO”), the National Arbitration Forum (“NAF”), Disputes.org/eResolution Consortium (“eResolution”), and the CPR Institute for Dispute Resolution (“CPR”). *Id.*

⁹³ Lipton, *Beyond Cybersquatting*, *supra* note 38, at 1372; *see also* Milton Mueller, *Rough Justice: An Analysis of ICANN’s Uniform Dispute Resolution Policy 3*, <http://dcc.syr.edu/miscarticles/roughjustice.pdf> (last visited Sept. 20, 2009) (stating that WIPO attracts 61% of complaints).

⁹⁴ Ward, *supra* note 21, at 230 (“The proof required to prevail under the UDRP is similar to the showing that must be made under the ACPA. The UDRP requires a complainant to meet a three-prong test to win the arbitration and obtain a favorable ruling.”).

⁹⁵ ICANN, *supra* note 81, § 4(a)(i).

⁹⁶ *Id.* § 4(a)(ii).

⁹⁷ *Id.* § 4(a)(iii); *see* Ward, *supra* note 21, at 231 & n.161 (explaining that the domain name must be actually used, not just simply registered).

⁹⁸ Sorgen, *supra* note 39, at 125.

⁹⁹ *See* ICANN, *supra* note 81, § 4(b). Those factors are:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess

similar” to the factors in the ACPA.¹⁰⁰ In addition, the UDRP provides a nonexhaustive list of circumstances that, “if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the complainant’s] rights or legitimate interests to the domain name.”¹⁰¹ However, “[p]anels are currently split in the context of trademark-identical gripe sites, with some encouraging the use of pejorative terms to avoid confusing similarity and others denying that the addition of a pejorative term to a trademark has any impact whatsoever.”¹⁰²

UDRP decisions may be appealed to United States federal courts, which review panel decisions de novo.¹⁰³

E. Permissibility of Gripe Sites

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

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

Id.

¹⁰⁰ See Sorgen, *supra* note 39, at 125.

¹⁰¹ ICANN, *supra* note 81, § 4(c). Those circumstances are:

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

Id.

¹⁰² Jonathan L. Schwartz, *It’s Best to Listen*, 20-APR CBA REC. 42, 44 (2006) [hereinafter Schwartz, *Best to Listen*].

¹⁰³ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 27, at 109.

sought to enforce their rights through litigation in federal court under the Lanham Act and the ACPA and through arbitration under the UDRP.

1. Federal Court Litigation

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

a) Bally Total Fitness Holding Corp. v. Faber

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

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

¹⁰⁴ See *infra* notes 105–65 and accompanying text.

¹⁰⁵ 29 F. Supp. 2d 1161 (C.D. Cal. 1998).

¹⁰⁶ Please note that unlike other gripe site cases, the trademark at issue in *Bally* was not located in the domain name. See generally Creasman, *supra* note 11, at 1051 (“[T]he registrant’s compupix.com/ballysucks website . . . included the trademark in the Uniform Resource Locator (URL) but not in the domain name portion of the URL”).

¹⁰⁷ *Bally*, 29 F. Supp. 2d at 1162.

¹⁰⁸ Johnson, *supra* note 30, at 478.

¹⁰⁹ *Bally*, 29 F. Supp. 2d at 1162.

¹¹⁰ *Id.*

¹¹¹ *Id.*

explained that the *Sleekcraft* factors¹¹² for determining likelihood of confusion in a trademark infringement case apply only to related goods and that Bally's health club and Faber's website were not related goods.¹¹³ Further, the court held that because Faber's website states that it is "unauthorized" and displays the words "Bally sucks," "[n]o reasonable consumer comparing Bally's official web site with Faber's site would assume Faber's site 'to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.'"¹¹⁴

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

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

¹¹² See *supra* notes 58–59 and accompanying text.

¹¹³ See *Bally*, 29 F. Supp. 2d at 1163; see also *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1363 (9th Cir. 1985) ("Related goods are those goods which, though not identical, are related in the minds of consumers."). The court held that because Bally was involved in the health club industry and Faber was involved in the webpage design industry, their goods were not related. *Bally*, 29 F. Supp. 2d at 1163. The court further explained that "[t]he fact that the parties both advertise their respective services on the Internet may be a factor tending to show confusion, but it does not make the goods related." *Id.*

¹¹⁴ *Bally*, 29 F. Supp. 2d at 1163–64.

¹¹⁵ See *id.* at 1164–66.

¹¹⁶ See *id.* at 1164 ("Bally argues that the marks are identical. Bally argues that the only difference between the marks is that Faber attached the word 'sucks' to Bally's marks. Bally argues that this is a minor difference.").

¹¹⁷ *Id.*

¹¹⁸ *Id.* The court noted that Faber's site states that it is "unauthorized" and that Faber superimposed the word "sucks" over Bally's mark; the court concluded that "the reasonably prudent user would not mistake Faber's site for Bally's official site." *Id.*

critical commentary.”¹¹⁹ Such a statement recognizes a First Amendment limitation on the rights of a trademark holder¹²⁰ and is a “victory for free speech advocates.”¹²¹ The court found that it was unable to provide a remedy for Bally¹²² and granted Faber’s motion for summary judgment.¹²³

The holding in *Bally* covers the permissibility of the website www.compupix.com/ballysucks. However, in dicta, the court stated that “even if Faber did use the mark as part of a larger domain name, such as ‘ballysucks.com,’ this would not necessarily be a violation as a matter of law.”¹²⁴ The court explained that “no reasonably prudent Internet user would believe that ‘Ballysucks.com’ is the official Bally site or is sponsored by Bally.”¹²⁵ Although the *Bally* decision of 1998 came before the enactment of the ACPA, “the *Bally* court’s analysis directly mirrors [the ACPA’s] identical or confusingly similar standard.”¹²⁶

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

In 2000, the United States District Court for the Eastern District of Virginia decided the case of *Lucent Technologies, Inc. v. LucentSucks.com*.¹²⁷ Lucent Technologies, Inc. (“Lucent”) had owned the federally registered trademarks “Lucent” and “Lucent Technologies” since November 30, 1995.¹²⁸ Russell Johnson (“Johnson”) registered the domain name lucentSucks.com, which allegedly contained pornographic photographs and services for

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

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

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

¹²² *Bally*, 29 F. Supp. 2d at 1168.

¹²³ *Id.*

¹²⁴ *Id.* at 1165.

¹²⁵ *Id.* at 1165 n.2.

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

¹²⁷ 95 F. Supp. 2d 528 (E.D. Va. 2000).

¹²⁸ *Id.* at 529.

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

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

c) Ford Motor Co. v. 2600 Enterprises

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

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *See id.* at 529, 534–36 ("Because the ACPA is a new statute, and is still the source of some confusion, we also briefly address some of defendant's other arguments.").

¹³³ *See id.* at 535.

¹³⁴ *Id.* at 535.

¹³⁵ *Id.* at 535–36.

¹³⁶ Schwartz, *Consumer Watchdog's Bark*, *supra* note 27, at 92.

¹³⁷ 177 F. Supp. 2d 661 (E.D. Mich. 2001).

¹³⁸ *Id.* at 661–62.

¹³⁹ *Id.* at 662.

competition.¹⁴⁰ The court denied Ford's motion for a preliminary injunction.¹⁴¹

The court rejected Ford's argument that the defendants' use of the Ford mark constitutes "commercial use."¹⁴² The court explained that the defendants were not using Ford's mark for commercial gain and thus that their use was not actionable.¹⁴³ Further, the court opined that the registered domain name (www.fuckgeneralmotors.com) did not contain Ford's mark in the domain name itself but rather just in the programming code.¹⁴⁴ Specifically, the programming code redirected users from www.fuckgeneralmotors.com to www.ford.com, but the word Ford was nonetheless not in the actual domain name.¹⁴⁵ Finally, the court held that the unauthorized use did not compete with Ford's offering of goods or services because the defendants' use of Ford in their programming code did not prevent Internet users from reaching Ford's legitimate websites.¹⁴⁶

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* at 664.

¹⁴³ *See id.* at 663, 665. "In this case, no allegation has been made that Defendants are providing any goods or services for sale under the FORD mark or that they solicit funds . . ." *Id.* at 663.

¹⁴⁴ *See id.* at 664 ("Here, the domain name registered by Defendants—'fuckgeneralmotors.com'—does not incorporate any of Ford's marks. Rather, Defendants only use of the word 'ford' is in its programming code, which does no more than create a hyperlink—albeit automatic—to Plaintiff's 'ford.com' site. The court is unpersuaded that this use of the FORD mark in any way hampers Plaintiff's commercial success in an unlawful manner.").

¹⁴⁵ *See id.* at 662.

This court does not believe that Congress intended the FTDA to be used by trademark holders as a tool for eliminating Internet links that, in the trademark holder's subjective view, somehow disparage its trademark. Trademark law does not permit Plaintiff to enjoin persons from linking to its homepage simply because it does not like the domain name or other content of the linking webpage.

Id. at 664.

¹⁴⁶ *Id.* at 665.

d) Taubman Co. v. Webfeats

In 2003, the United States Court of Appeals for the Sixth Circuit decided the case of *Taubman Co. v. Webfeats*,¹⁴⁷ on appeal from a judgment in the United States District Court for the Eastern District of Michigan, which had granted the plaintiff two preliminary injunctions.¹⁴⁸ Henry Mishkoff (“Mishkoff”) created the websites *theshopsatwillowbend.com* and *shopwillowbend.com* to advertise a new shopping complex being built near his home.¹⁴⁹ Mishkoff was unaffiliated with the mall.¹⁵⁰ When the Taubman Company (“Taubman”) was building the shopping mall, “Taubman discovered that Mishkoff had created this site, [and] . . . demanded he remove it from the internet.”¹⁵¹

In response, Mishkoff registered the domain names *taubmansucks.com*, *shopsatwillowbendsucks.com*, *theshopsatwillowbendsucks.com*, *willowbendmallsucks.com*, and *willowbendsucks.com*.¹⁵² Each of these domain names linked to a website featuring a running editorial on Mishkoff’s battle with Taubman and its lawyers.¹⁵³ The district court granted Taubman’s preliminary injunctions to prevent Mishkoff from using the website *shopsatwillowbend.com* as well as the five complaint sites.¹⁵⁴ The district court relied on the Lanham Act in granting its injunction.¹⁵⁵

The circuit court reviewed the district court’s decision for abuse of discretion¹⁵⁶ and dissolved both preliminary injunctions.¹⁵⁷ The court explained that the gripe site *taubmansucks.com* was an expression of free speech and that “the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a

¹⁴⁷ 319 F.3d 770 (6th Cir. 2003).

¹⁴⁸ *Id.* at 771.

¹⁴⁹ *Id.* at 772.

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *See id.* at 773.

¹⁵⁵ *Id.* at 773 n.2.

¹⁵⁶ *Id.* at 774.

¹⁵⁷ *Id.* at 780.

business.”¹⁵⁸ The court analogized screaming “Taubman Sucks!” from the rooftops—which is permissible under the First Amendment—to writing “taubmansucks” in a domain name.¹⁵⁹ Further, the court noted that Mishkoff did not use Taubman’s mark to sell competing goods and that Mishkoff’s use of Taubman’s marks caused no negative impact on the public interest.¹⁶⁰ In sum, the court held that a person can

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

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

¹⁵⁸ *Id.* at 778.

¹⁵⁹ *See id.* (“In fact, Taubman concedes that Mishkoff is ‘free to shout ‘Taubman Sucks!’ from the rooftops’ Essentially, this is what he has done in his domain name. The rooftops of our past have evolved into the internet domain names of our present. We find that the domain name is a type of public expression, no different in scope than a billboard or a pulpit, and Mishkoff has a First Amendment right to express his opinion about Taubman, and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.”).

¹⁶⁰ *See id.* at 778.

¹⁶¹ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 27, at 114–15.

¹⁶² *See id.* at 122.

¹⁶³ *See id.* at 96–97.

¹⁶⁴ *See id.* at 113.

¹⁶⁵ *See id.* at 113–17.

2. World Intellectual Property Organization (“WIPO”) Hearings

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

a) Analysis of WIPO Decisions

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

¹⁶⁶ Schwartz, *Consumer Watchdog’s Bark*, *supra* note 27, at 101–02 (“[P]anels are also split on whether the addition of a pejorative term, such as ‘sucks,’ ‘exposed,’ ‘stupidity,’ ‘never,’ and ‘stop,’ to a trademark shields the respondent from liability.”).

¹⁶⁷ See WIPO UDRP Domain Name Decisions (gTLD), <http://www.wipo.int/amc/en/domains/decisionsx/index.html> (last visited Sept. 20, 2009). To obtain the numbers thirty-seven and fifty-two, it is necessary to search all of the decisions available at this website and count the ones involving domain names with the word “sucks,” “suckz,” “suck,” or “sux.”

¹⁶⁸ See Vanguard Trademark Holdings USA, L.L.C. v. European Travel Network, Case No. D2008-1325, WIPO Administrative Panel Decision (Oct. 31, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1325.html> (www.alamo-sucks.com); Wal-Mart Stores, Inc. v. Legal Dep’t, Case No. D2008-1243, WIPO Administrative Panel Decision (Oct. 7, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1243.html> (www.walmartbanksucks.com); Red Bull GmbH v. Gamel, Case No. D2008-0253, WIPO Administrative Panel Decision (Apr. 14, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0253.html> (www.redbullsucks.com); Chubb Sec. Austl. PTY Ltd. v. Tahmasebi, Case No. D2007-0769, WIPO Administrative Panel Decision (Aug. 13, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0769.html> (www.chubbsux.com); Société Air Fr. v. MSA, Inc., Case No. D2007-0143, WIPO Administrative Panel Decision (Apr. 19, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0143.html> (www.airfrancesuck.com); Covanta Energy Corp. v. Mitchell, Case No. D2007-0185, WIPO Administrative Panel Decision (Apr. 3, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0185.html> (www.covantasucks.com);

Deutsche Telekom AG v. AdImagination, Case No. DWS2006-0001, WIPO Administrative Panel Decision (Jan. 4, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2006/dws2006-0001.html> (www.tmobilesucks.ws); Buw Holdings GmbH v. Anon-Web.com, Case No. D2006-0462, WIPO Administrative Panel Decision (June 7, 2006), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0462.html> (www.buwsuckz.com); Soci t  Air Fr. v. Virtual Dates, Inc., Case No. D2005-0168, WIPO Administrative Panel Decision (May 24, 2005), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0168.html> (www.airfrancesucks.com); Wachovia Corp. v. Flanders, Case No. D2003-0596, WIPO Administrative Panel Decision (Sept. 19, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0596.html> (www.wachovia-sucks.com); Berlitz Inv. Corp. v. Tinculescu, Case No. D2003-0465, WIPO Administrative Panel Decision (Aug. 22, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0465.html> (www.berlitzsucks.com); Royal Bank of Scot. Group plc v. Lopez, Case No. D2003-0166, WIPO Administrative Panel Decision (May 9, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0166.html> (www.natwestbanksucks.com); Bayer Aktiengesellschaft v. Dangos & Partners, Case No. D2002-1115, WIPO Administrative Panel Decision (Feb. 3, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1115.html> (www.bayersucks.biz, www.bayersucks.info); Koninklijke Philips Elecs. N.V. v. In Seo Kim, Case No. D2001-1195, WIPO Administrative Panel Decision (Nov. 12, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1195.html> (www.philipssucks.com); Vivendi Universal v. Sallen, Case No. D2001-1121, WIPO Administrative Panel Decision (Nov. 7, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1121.html> (www.vivendiuniversalsucks.com); Salvation Army v. Info-Bahn, Inc., Case No. D2001-0463, WIPO Administrative Panel Decision (May 10, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0463.html> (www.salvationarmsucks.com); ADT Servs. AG v. ADT Sucks.com, Case No. D2001-0213, WIPO Administrative Panel Decision (Apr. 23, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0213.html> (www.adtsucks.com); Soci t  Accor contre Hartmann, Case No. D2001-0007, WIPO Administrative Panel Decision (Mar. 13, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0007.html> (www.accorsucks.com); TPI Holdings, Inc. v. AFX Commc'ns, Case No. D2000-1472, WIPO Administrative Panel Decision (Feb. 2, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1472.html> (www.autotradersucks.com); Diageo plc v. Zuccarini, Case No. D2000-0996, WIPO Administrative Panel Decision (Oct. 22, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0996.html> (www.guinnessbeerreallyreallysucks.com, www.guinness-beer-really-really-sucks.com, www.guinnessbeerreallysucks.com, www.guinness-beer-really-sucks.com, www.guinnessbeersucks.com, www.guinness-beer-sucks.com, www.guinnessreallyreallysucks.com, www.guinness-really-really-sucks.com, www.guinnessreallysucks.com, www.guinness-really-sucks.com, www.guinness-sucks.com); Wal-Mart Stores, Inc. v. MacLeod, Case No. D2000-0662, WIPO Administrative Panel Decision (Sept. 19, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0662.html> (www.wal-martsucks.com); Direct Line Group Ltd., v. Purge I.T., Case No. D2000-0583, WIPO Administrative

registrant in ten (10) cases involving eleven (11) domain names.¹⁶⁹ These numbers indicate that WIPO ruled in favor of the

Panel Decision (Aug. 13, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0583.html> (www.directlinesucks.com); Dixons Group PLC v. Purge I.T., Case No. D2000-0584, WIPO Administrative Panel Decision (Aug. 13, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0584.html> (www.dixonssucks.com); Freeserve PLC v. Purge I.T., Case No. D2000-0585, WIPO Administrative Panel Decision (Aug. 13, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0585.html> (www.freeservesucks.com); Nat'l Westminster Bank PLC v. Purge I.T., Case No. D2000-0636, WIPO Administrative Panel Decision (Aug. 13, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0636.html> (www.natwestsucks.com); Standard Chartered PLC v. Purge I.T., Case No. D2000-0681, WIPO Administrative Panel Decision (Aug. 13, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0681.html> (www.standardcharterededsucks.com); Wal-Mart Stores, Inc. v. Walsucks, Case No. D2000-0477, WIPO Administrative Panel Decision (July 20, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0477.html> (www.walmartcanadasucks.com, www.wal-martcanadasucks.com, www.walmartpuertoricosucks.com, www.walmartuksucks.com).

¹⁶⁹ See *Sermo, Inc. v. CatalystMD, LLC*, Case No. D2008-0647, WIPO Administrative Panel Decision (July 2, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0647.html> (www.seremosucks.com); *S. Cal. Reg'l Rail Auth. v. Arkow*, Case No. D2008-0430, WIPO Administrative Panel Decision (May 12, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0430.html> (www.metrolinksucks.com); *La Quinta Worldwide L.L.C. v. Heartland Times LLC*, Case No. D2007-1660, WIPO Administrative Panel Decision (Jan. 17, 2008), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-1660.html> (www.laquintainnsucks.com); *Russo v. Guillaumin*, Case No. D2006-1627, WIPO Administrative Panel Decision (Apr. 27, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1627.html> (www.dellorussosucks.com); *Xtraplus Corp. v. Flawless Computers*, Case No. D2007-0070, WIPO Administrative Panel Decision (Mar. 9, 2007), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0070.html> (www.zipzoomflysucks.com); *Full Sail, Inc. v. Spevack*, Case No. D2003-0502, WIPO Administrative Panel Decision (Oct. 3, 2003), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0502.html> (www.fullsailsucks.com); *Asda Group Ltd. v. Kilgour*, Case No. D2002-0857, WIPO Administrative Panel Decision (Nov. 11, 2002), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0857.html> (www.asdasucks.net); *Lockheed Martin Corp. v. Parisi*, Case No. D2000-1015, WIPO Administrative Panel Decision (Jan. 31, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1015.html> (www.lockheedmartinsucks.com, www.lockheedsucks.com); *McLane Co. v. Craig*, Case No. D2000-1455, WIPO Administrative Panel Decision (Jan. 11, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1455.html> (www.mclanenortheastsucks.com); *Wal-Mart Stores, Inc. v. Harvey*, Case No. D2000-1104, WIPO Administrative Panel Decision (Nov. 23, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1104.html> (www.wallmartcanadasucks.com).

complainants in almost three times as many cases as they ruled in favor of domain name registrants. As a result of these decisions, WIPO ordered 79% of domain names to be returned to the trademark owner, while just 21% of domain names were allowed to remain in the domain name registrant's possession.

b) Panels Holding for Trademark Owner (Complainant)

The WIPO panels analyze the legitimacy of domain names according to the tripartite test laid out in paragraph 4(a) of the UDRP.¹⁷⁰ If the panel finds that (1) the domain name is "identical or confusingly similar to a trademark or service mark" in which the complainant has rights,¹⁷¹ (2) the respondent has "no rights or legitimate interests" in the domain name,¹⁷² and (3) the respondent domain name is being "registered . . . and used in bad faith,"¹⁷³ then the panel will transfer the domain name to the complainant. Between July 20, 2000, and October 31, 2008, the WIPO transferred forty-one (41) domain names to the complainant trademark owners.¹⁷⁴

First, panels that hold that the format of gripe sites is "confusingly similar" reason that (1) non-English speakers do not necessarily recognize that the addition of the pejorative term dissociates the website from the trademark owner;¹⁷⁵ (2) if the domain name contains the trademark at all, then consumers are likely to associate the website with the trademark owner;¹⁷⁶ (3)

¹⁷⁰ See ICANN, *supra* note 81, § 4(a).

¹⁷¹ *Id.* § 4(a)(i).

¹⁷² *Id.* § 4(a)(ii).

¹⁷³ *Id.* § 4(a)(iii).

¹⁷⁴ See *supra* notes 168–69 and accompanying text.

¹⁷⁵ See ADT Servs. AG v. ADT Sucks.com, Case No. D2001-0213, WIPO Administrative Panel Decision (Apr. 23, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0213.html> ("The addition of the suffix 'sucks' is a crude attempt to tarnish the mark. Although 'sucks' could make an English speaker consider that the name does not promote the Complainant or its products, not every user of the Internet is well-versed in the English language. Consequently, a user could be led to believe that any name using the world-famous mark is associated with the Complainant.").

¹⁷⁶ See Dixons Group PLC v. Purge I.T., Case No. D2000-0584, WIPO Administrative Panel Decision (Aug. 13, 2000), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0584.html> ("Given the apparent mushrooming of complaints

consumers may be diverted from the trademark owner's website to the respondent's website when both websites appear in a search engine's results;¹⁷⁷ (4) the term "sucks" or a similar term may be used in its literal descriptive sense, rather than in a "pejorative sense," such as in an advertising slogan;¹⁷⁸ and (5) some companies have established comment sites to obtain feedback on

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

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

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

their products, and thus, consumers may associate the comment site with the gripe site.¹⁷⁹

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

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

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

¹⁷⁹ See *Koninklijke Philips Elecs. N.V. v. In Seo Kim*, Case No. D2001-1195, WIPO Administrative Panel Decision (Nov. 12, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1195.html> (“[I]t is not unknown for companies to establish complaint or comment sites or areas of sites to obtain feedback on their products; accordingly, some people might suppose that a website of this nature at the Domain Name was operated by the Complainant.”).

¹⁸⁰ *Chubb Sec. Austl. PTY Ltd. v. Tahmasebi*, Case No. D2007-0769, WIPO Administrative Panel Decision (Aug. 13, 2007), available at <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0769.html>.

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ *Id.*

¹⁸⁴ ICANN, *supra* note 81, § 4(b).

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 255

in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.¹⁸⁵

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

c) Panels Holding for Domain Name Registrant
(Respondent)

On the other hand, a minority of panels¹⁸⁶ have rejected the argument that a gripe site's use of a mark is impermissible under the UDRP. Those panels found that the complainant failed to satisfy one or more of the prongs of the UDRP tripartite test.¹⁸⁷ When determining that a registrant's domain name is not identical or "confusingly similar" to a trademark, the panels explained that (1) in response to the English language barrier argument,¹⁸⁸ Internet users who do not understand the significance of appending "sucks" to a trademark exist in such small numbers as to be insignificant;¹⁸⁹ (2) Internet users should realize that "[m]ost

¹⁸⁵ *Id.*

¹⁸⁶ *See* Chubb Sec. Austl. PTY Ltd. v. Tahmasebi, Case No. D2007-0769, WIPO Administrative Panel Decision (Aug. 13, 2007).

¹⁸⁷ *See supra* note 170 and accompanying text.

¹⁸⁸ *See supra* note 175 and accompanying text.

¹⁸⁹ *See* Asda Group Ltd. v. Kilgour, Case No. D2002-0857, WIPO Administrative Panel Decision (Nov. 11, 2002), available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0857.html> ("[B]y now the number of Internet users who do not appreciate the significance of the '-sucks' suffix must be so small as to be de minimis and not worthy of consideration.").

companies would not publish a website with such a self-denigrating domain name”;¹⁹⁰ (3) common sense and the plain language of the UDRP “[s]upport the view that a domain name combining a trademark with the word ‘sucks’ or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark;”¹⁹¹ and (4) an Internet user happening upon a gripe site will realize that it is intended to criticize and not to comport with the goals of the trademark.¹⁹²

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

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

¹⁹⁰ *La Quinta Worldwide L.L.C. v. Heartland Times LLC*, Case No. D2007-1660, WIPO Administrative Panel Decision (Jan. 17, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-1660.html>.

¹⁹¹ *Lockheed Martin Corp. v. Parisi*, Case No. D2000-1015, WIPO Administrative Panel Decision (Jan. 31, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1015.html>.

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

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

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

Id.

¹⁹⁴ *Russo v. Guillaumin*, Case No. D2006-1627, WIPO Administrative Panel Decision (Apr. 27, 2007), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1627.html>.

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

The panels in *La Quinta Worldwide L.L.C. v. Heartland Times LLC*¹⁹⁶ and *McLane Co. v. Craig*¹⁹⁷ similarly held that creating a website sincerely dedicated to expressing one's negative opinion about a company is a legitimate noncommercial fair use.¹⁹⁸

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

¹⁹⁵ *Id.*

¹⁹⁶ *La Quinta Worldwide L.L.C. v. Heartland Times LLC*, Case No. D2007-1660, WIPO Administrative Panel Decision (Jan. 17, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-1660.html>.

¹⁹⁷ *McLane Co. v. Craig*, Case No. D2000-1455, WIPO Administrative Panel Decision (Jan. 11, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1455.html>.

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

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

²⁰⁰ Schwartz, *Consumer Watchdog's Bark*, *supra* note 27, at 107-08.

name”]; and (3) “whether the defendant intentionally chose the name as the address of the gripe site because of the likelihood of diversion.”²⁰¹

F. Permissibility of Love Sites

Between June 4, 2003, and December 19, 2008, WIPO decided six cases involving seven domain names containing the word “love.”²⁰² WIPO ruled in favor of the complainant trademark owner in all six cases involving all seven domain names.²⁰³ In all six cases involving domain names containing the word “love,”²⁰⁴ the WIPO panels based their decisions to transfer the domain name to the complainant on a tripartite finding based on paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy.²⁰⁵ First, the respondents’ domain names were all held to be “identical or confusingly similar to a trademark or service mark” in which the complainant has rights.²⁰⁶ Second, the respondents were found to

²⁰¹ *Id.* at 108.

²⁰² See WIPO UDRP Domain Name Decisions, *supra* 167. To find the above-mentioned six cases involving seven domain names, it is necessary to search all of the decisions available at this website and to count the domain names with the word “love.”

²⁰³ See *Harrods Ltd. v. Iorio*, Case No. D2008-1684, WIPO Administrative Panel Decision (Dec. 19, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1684.html> (www.iloveharrods.com); *Serta Inc. v. Dawson*, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1474.html> (www.ilovemyserta.com); *Ferrero S.p.A. v. Ferrarini*, Case No. D2006-1163, WIPO Administrative Panel Decision (Nov. 23, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1163.html> (www.ilovenutella.com); *GA MODEFINE SA v. pumo*, Case No. D2006-0619, WIPO Administrative Panel Decision (July 18, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0619.html> (www.armani-love.com); *Presse v. Shi Cheng*, Case No. D2005-1240, WIPO Administrative Panel Decision (Feb. 24, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-1240.html>; see also *Revlon Consumer Prods. Corp. v. Farris*, Case No. D2003-0291, WIPO Administrative Panel Decision (June 4, 2003), available at <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0291.html> (www.iloverevlon.com, www.love-revlon.com).

²⁰⁴ See *supra* note 202 and accompanying text.

²⁰⁵ See ICANN, *supra* note 81, § 4(a).

²⁰⁶ See *id.* § 4(a)(i). For example, in *Harrods Ltd. v. Iorio*, the panel explained that “[u]sing the prefix ‘I love’ with the HARRODS trademark does not avoid the disputed domain name being confusingly similar to that trademark.” *Harrods Ltd. v. Iorio*, Case No. D2008-1684, WIPO Administrative Panel Decision (Dec. 19, 2008). In *Serta Inc. v.*

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 259

have “no rights or legitimate interests” in the domain name.²⁰⁷ Third, the panels all found that the respondent domain names were being “registered . . . and used in bad faith.”²⁰⁸

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

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

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

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

²⁰⁹ The website in *Ferrero S.p.A. v. Ferrarini* presented sponsored links. *Ferrero S.p.A. v. Ferrarini*, Case No. D2006-1163, WIPO Administrative Panel Decision (Nov. 23, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1163.html>. The website in *GA MODEFINE SA v. pumo* resolved to a website in Chinese with pornographic content. *GA MODEFINE SA v. pumo*, Case No. D2006-0619, WIPO Administrative Panel Decision (July 18, 2006). The website in *Harrods Ltd. v. Iorio* offered links to third party gaming or gambling websites. *Harrods Ltd. v. Iorio*, Case No. D2008-1684, WIPO Administrative Panel Decision (Dec. 19, 2008). The website in *Presse v. Shi Cheng* attracted Internet users to the respondent’s site. *Presse v. Shi Cheng*,

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

II. MARKETING CAMPAIGNS WITH UNCLEAR SPONSORING COMPANIES

Much of the domain name trademark law analysis focuses on the "likelihood of confusion" test.²¹⁰ When assessing likelihood of confusion, it is critical to consider the ever-changing marketing and media environment. Companies are increasingly employing unique, cutting-edge marketing techniques to cut through the clutter of advertisements and capture consumers' attention.²¹¹ This section will explore some new alternative marketing techniques that call into question the traditional assumptions underlying the likelihood of confusion test.

By some estimates, approximately five thousand advertisements bombard the average consumer each day.²¹² People have access to endless information, but "[w]hat's in short

Case No. D2005-1240, WIPO Administrative Panel Decision (Feb. 24, 2006). The website in *Revlon Consumer Products Corp. v. Farris* both diverted consumers to the respondent's own website and was used to request monetary compensation from the complainant. *Revlon Consumer Prods. Corp. v. Farris*, Case No. D2003-0291, WIPO Administrative Panel Decision (June 4, 2003), available at <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0291.html>. The website in *Serta Inc. v. Dawson* attracted visitors to a competitor's website. *Serta Inc. v. Dawson*, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008).

²¹⁰ See *supra* Part I.D.1.

²¹¹ See *infra* note 215 and accompanying text.

²¹² Caitlin A. Johnson, *Cutting Through Advertising Clutter*, CBS NEWS, Sept. 17, 2006, <http://www.cbsnews.com/stories/2006/09/17/sunday/main2015684.shtml> ("[W]e've gone from being exposed to about 500 ads a day back in the 1970's to as many as 5,000 a day today.").

supply is human attention.”²¹³ Ad clutter “annoys the audience,” “diminishes ad effectiveness,” and “negatively impacts brand perception.”²¹⁴ With traditional media and online media competing for consumers’ attention, advertisers have been working increasingly harder to get noticed amid the noisy clutter.²¹⁵ Information oversaturation requires companies to “up the ante” by constantly being more creative and more outrageous than any of the advertisements that preceded their latest marketing campaign.²¹⁶

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

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

²¹³ THOMAS H. DAVENPORT & JOHN C. BECK, THE ATTENTION ECONOMY: UNDERSTANDING THE NEW CURRENCY OF BUSINESS 2 (Harvard Bus. Sch. 2002).

²¹⁴ BURSTMEDIA, THE PERILS OF AD CLUTTER 1 (2008), http://www.burstmedia.com/assets/newsletter/items/2008_12_01.pdf.

²¹⁵ See generally WARREN J. KEEGAN, HUGH DAVIDSON & ELYSE ARNO BRILL, OFFENSIVE MARKETING: AN ACTION GUIDE TO GAINING COMPETITIVE ADVANTAGE 305 (2004).

²¹⁶ See Johnson, *supra* note 212.

²¹⁷ See *infra* notes 223–33 and accompanying text.

²¹⁸ See *infra* notes 234–42 and accompanying text.

²¹⁹ See *infra* notes 243–50 and accompanying text.

²²⁰ See *infra* notes 251–59 and accompanying text.

that consumers not only internalize but also desire to share with others.²²¹ Thus, a company enhances its brand and the value of its trademark through indirect, secretive means.²²²

A. *Viral Marketing Campaigns*

1. Case Study: Burger King's "Subservient Chicken"

Starting in March 2005, visitors logged onto www.subservientchicken.com,²²³ amounting to almost 400 million hits,²²⁴ to issue commands to a man in a chicken suit wearing lingerie.²²⁵ Website visitors asked the chicken to perform desired actions,²²⁶ such as "jump," "watch tv," "take a nap," "take off your pants," "wave," "lay an egg," "eat," "sit," "run around," and "fart."²²⁷ The chicken performed one of four hundred different prerecorded functions in a seedy basement reminiscent of a 1980s pornography set "as if he were the voyeuristic visitor's personal slave."²²⁸ "Fascinated folks" forwarded the website to their friends, who in turn forwarded it to their friends, and bloggers posted entries speculating on various commands that would instruct the chicken to act "down and dirty."²²⁹

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

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

²²³ Although <http://www.subservientchicken.com/> (last visited Feb. 12, 2009) is still accessible, http://www.subservientchicken.com/pre_bk_skinned.swf (last visited Feb. 12, 2009) shows how the website looked during Burger King's advertising campaign.

²²⁴ Noreen O'Leary, *A New Game: Resurgence of the Internet*, ADWEEK, Jan. 3, 2005, at 4.

²²⁵ Jeremy Mullman, *The 'Ad Age' Tale of the Ape*, ADVERTISING AGE, Oct. 2, 2006, at 14.

²²⁶ Kenneth Hein, *Burger King Tastes Like Chicken, Smells like Guerrilla Marketing*, BRANDWEEK, Nov. 22, 2004, at 27.

²²⁷ *10 Most Popular Commands Issued to the Subservient Chicken*, ADVERTISING AGE, Dec. 20, 2004, at 4.

²²⁸ See Hein, *supra* note 226, at 27.

²²⁹ *Id.*

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

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

2. Case Study: Smirnoff’s “Tea Party”

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

²³⁰ Mae Anderson, *CP+B’s “Subservient Chicken” Got People Talking About Burger King, But Did Sales Match the Hype?*, ADWEEK, Mar. 7, 2005, at 24.

²³¹ *Id.*; see also Mullman, *supra* note 225, at 14. Crispin Porter + Bogusky, the advertising agency behind this campaign, describes its creative intent on their website by saying, “[t]o show how customers really can have it their way with chicken, we created a large subservient chicken that does almost anything anyone asks.” Crispin Porter + Bogusky, *Subservient Chicken*, <http://www.cpbgroup.com/awards/subservientchicken.html> (last visited Mar. 27, 2009).

²³² The only mention of Burger King was a link to the TenderCrisp website (via an icon that said “BK Tendercrisp”) and a BKC copyright at the bottom of the page. ANDREW SCHNELLER & JOHN MARSHALL, *SOCIAL MEDIA AND THE BURGER KING BRAND 7* (2007), <http://mba.tuck.dartmouth.edu/digital/Research/CaseStudies/6-0025.pdf>. People thus wondered whether Burger King sponsored the website or if an Internet prankster inserted the Burger King logo onto his website. See Snopes Urban Legend References Page, *Subservient Chicken*, <http://www.snopes.com/business/viral/chicken.asp> (last visited Mar. 28, 2009).

²³³ See Seth Stevenson, *Masked: Is Burger King Trying to Put One Over on Me?*, SLATE, Oct. 24, 2005, <http://www.slate.com/id/2128569> (“Later, when they realized that he was promoting a Burger King sandwich, these same people became bitter and resentful. No one enjoys being duped into forwarding an advertisement to all her friends. Some people even felt they had to apologize.”).

who rap about the proper way to throw a tea party.²³⁴ During the first week after its debut, it ranked seventh for the week in total YouTube viewings and twelfth in viewer comments.²³⁵ While the video focuses on the Prep Unit's lifestyle, it also "make[s] a soft pitch for Smirnoff Raw Tea."²³⁶ Smirnoff is mentioned only in passing in four out of the fifty-six lines in the rap.²³⁷

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

²³⁴ Eleftheria Parpis, *BBH Gets Viral for Smirnoff Raw Tea*, ADWEEK ONLINE, Aug. 9, 2006, http://www.adweek.com/aw/eseach/article_display.jsp?vnu_content_id=1002984057.

²³⁵ *Id.*

²³⁶ Posting of David to Third Way Blog, <http://www.thirdwayblog.com/smirnoff/smirnoff-tea-partay-preppies-on-youtube.html> (Aug. 16, 2006, 14:18).

²³⁷ See generally Posting of Duncan to The Inspiration Room, <http://theinspirationroom.com/daily/2007/smirnoff-raw-tea-partay> (Jan. 3, 2007, 9:00). For example, one stanza reads, "Straight out of Cape Cod / We're keeping it real / We're going to have a party makes the ladies squeal / We're going to turn it on / with our parents' riches / We'll serve Smirnoff raw tea and finger sandwiches." *Id.*

²³⁸ Press Release, Diageo PLC, Smirnoff "Tea Partay" Goes Green (Aug. 2, 2007), available at <http://www.diageo.com/en-row/NewsAndMedia/PressReleases/2007/Press+Release+2+August+2007+Smirnoff+Tea+partay.htm>.

²³⁹ David, *supra* note 236.

²⁴⁰ See Posting of William I. Lengeman III to Tea Guy Speaks, <http://www.teaguy-speaks.com/2006/08/smirnoff-raw-tea-partay.html#links> (Aug. 12, 2006, 9:41).

²⁴¹ See David, *supra* note 236.

²⁴² See generally Paul Bennett, *2006 Ads: The Ones We Remembered*, BUS. WK. ONLINE, Dec. 22, 2006, http://www.businessweek.com/innovate/content/dec2006/id20061222_238626_page_2.htm ("Next, in the *Bless Them for Trying* category, Smirnoff, for their white viral gangsta rappers that we all circulated for a few days back in the summer. Making fun of the clichés of rap videos—the bling, the grilles and the girls—all from the perspective of a bunch of Martha's Vineyard preppies was a very funny idea. Unfortunately, I'm not quite sure if anyone actually held a 'Tea Partay' in response, or

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

3. Case Study: Court TV's "That Girl Emily"

In the summer of 2007, a large billboard looming over Times Square read: "Hi Steven, / Do I have your attention now? I know all about her, you dirty, sneaky, immoral, unfaithful, poorly endowed slimeball. Everything's caught on tape. Your (soon-to-be-ex) Wife, Emily / p.s. I paid for this billboard from OUR joint bank account."²⁴³ The billboard generated interest among everyone from a booking agent for "Good Morning America" to British *Glamour* to bloggers.²⁴⁴ While the booking agent and magazine wanted to feature Emily's story,²⁴⁵ bloggers began to wonder whether this billboard was a hoax and, if so, which company was behind the hoax.²⁴⁶

Soon, viewers uncovered that Court TV was behind the sign and one of the blogs.²⁴⁷ Court TV used the viral technique to

even drank the stuff, but we all looked slightly askance at Smirnoff the next day, like they had been kinda slutty but in a good way.").

²⁴³ Julie Bosman, *Public Hath No Fury, Even When Deceived*, N.Y. TIMES, July 24, 2006, at C6, available at <http://www.nytimes.com/2006/07/24/business/media/24billboard.html>.

²⁴⁴ See *id.*

²⁴⁵ See *id.*

²⁴⁶ See, e.g., Posting of Kevin Aylward to Wizband Blog, <http://wizbangblog.com/content/2006/07/19/the-curious-case-of-that-girl.php> (July 19, 2006, 15:22). Aylward explains that "[e]ven before doing some background research we were skeptical. The last funny billboard tip we got turned out to be a scam and this one felt 'scamish' from the word go." *Id.* He later reveals that it is a hoax but that "no one really knows who is behind the hoax." *Id.* He even goes as far as suggesting that readers write a letter to Google saying that the blog corresponding to the billboard is in violation of the Terms of Service for Google's blogging system. *Id.* He ends the post by saying, "[o]nce enough e-mail about Emily and her hoax site make it into Google headquarters someone at Google pull the plug on That Girl Emily." *Id.*

²⁴⁷ See Bosman, *supra* note 243.

promote its reality show, *Parco P.I.*²⁴⁸ Court TV and its advertising agency, Gem Group, designed the campaign “to get consumers talking about whether Emily, whose cheating husband Steven was exposed by a private detective, actually existed.”²⁴⁹ Although Emily was fictitious, Court TV’s goal of generating interest—as measured by the number of visitors to the blog—was achieved.²⁵⁰

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

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

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

²⁴⁸ *Id.*

²⁴⁹ See *Parco P.I. New York Stunt Campaign*, BRANDWEEK, Mar. 26, 2007, at R16.

²⁵⁰ See Bosman, *supra* note 243. By one estimate, six hundred blogs picked up the story and followed the mystery. See *Parco P.I. New York Stunt Campaign*, *supra* note 249.

²⁵¹ See *The Lost Ring*, <http://thelostring.com/> (last visited Feb. 13, 2009). Alternative reality games are “mixed-media affairs that task players the world over with solving puzzles, both individually and working with others, online and in the real world, with the goal of reaching some ultimate solution.” Daniel Terdiman, *New Worldwide Multimedia Game Linked to Olympics*, CNET NEWS, Mar. 2, 2008, http://news.cnet.com/8301-13772_3-9884001-52.html.

²⁵² See Tonya Garcia, *McDonald’s Is Behind the Lost Ring ARG*, PRWEEK, Apr. 1, 2008, <http://www.prweekus.com/McDonalds-is-behind-the-Lost-Ring-ARG/article/108501>.

²⁵³ *Power Players 2008*, ADVERTISING AGE, Oct. 13, 2008, at 58, available at http://adage.com/article?article_id=131600.

At first, no one knew who created the game.²⁵⁴ Within one or two days, players searching for clues found the terms of service on the website, which revealed that McDonald's sponsored the game.²⁵⁵ People were shocked because "[n]othing about the game was branded McDonald's, and the game's Web sites—mysterious and hip, like 'Lost' mixed with 'The Blair Witch Project'—were a far cry from the golden arches."²⁵⁶ In fact, some players even liked the game, despite not liking McDonald's.²⁵⁷ Later, some aspects of the brand, such as the double arches, appeared.²⁵⁸ McDonald's was very careful not to make its branding too overt.²⁵⁹

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

B. Domain Names Case Studies

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

²⁵⁴ Terdiman, *supra* note 251 ("No one knows who created this game, but you can be sure that it wasn't the International Olympic Committee.").

²⁵⁵ See Stephanie Clifford, *An Online Game So Mysterious Its Famous Sponsor Is Hidden*, N.Y. TIMES, Apr. 1, 2008, at C5, available at <http://www.nytimes.com/2008/04/01/business/media/01adco.html?scp=1&sq=alternate+reality+game&st=nyt#>.

²⁵⁶ *Id.*

²⁵⁷ See *id.* (noting that Geoff May, a player in Ontario who founded a website on The Lost Ring, said, in reference to McDonald's, that "Not everyone likes them").

²⁵⁸ See Richard Brunelli, *McDonald's Brave New World*, ADWEEKMEDIA, Dec. 1, 2008, http://www.adweekmedia.com/aw/content_display/custom-reports/buzzawards/e3i9417c5a4a703467d97b51be9e35149f8.

²⁵⁹ See Garcia, *supra* note 252.

1. Steven Singer

Large billboards along Interstate 95 in Philadelphia screamed, “I Hate Steven Singer!” in scrawled capital letters and featured a website address—www.ihatestevensinger.com—below the exclamation.²⁶⁰ Viewers speculated that a jilted girlfriend purchased the billboard and created the website.²⁶¹ However, the billboard and accompanying website ironically belonged to Steven Singer, a Philadelphia jeweler.²⁶² When a customer who purchased a ring from Steven Singer jokingly “blamed” Singer, nine months later, for the birth of his daughter, Singer took the backhanded compliment and made it the focus of a reverse psychology advertising campaign.²⁶³

The website address www.ihatestevensinger.com features an elegant advertisement for a jewelry store.²⁶⁴ However, if users click anywhere on the website or wait about fifteen seconds, a brown box with “I Hate Steven Singer” scrawled across it appears on the screen.²⁶⁵ Website users are then redirected to <http://ihatestevensinger.com/default1.asp>, which is set up like a consumer gripe site. The website premise can be encapsulated in the line, “So why do men HATE Steven Singer? Because women LOVE him . . . and his diamonds.”²⁶⁶ The website bashes Steven Singer from the perspective of a contented bachelor whose life could be redirected from endless partying as a young single man to monotonous stability as a married man (if Steven Singer successfully sells this man an engagement ring).²⁶⁷ The website

²⁶⁰ See Simona Covell, *Jeweler Cultivates a Fun Image for the Guys*, WALL ST. J., July 2, 2007, at B4.

²⁶¹ *Id.*

²⁶² See INDRAJIT SINHA & THOMAS FOSCHT, REVERSE PSYCHOLOGY MARKETING: THE DEATH OF TRADITIONAL MARKETING AND THE RISE OF THE NEW “PULL” GAME 147 (2007).

²⁶³ See Steven Singer Jewelers, <http://www.stevensingerjewelers.com/about/historyofIHSS.asp> (last visited Feb. 14, 2009); see also Sammy Mack, *I Wanna Know*, PHILA. WKLY., Mar. 31, 2004, <http://www.philadelphiaweekly.com/view.php?id=7047>.

²⁶⁴ See Steven Singer Jewelers, <http://www.ihatestevensinger.com/> (last visited Feb. 14, 2009).

²⁶⁵ See *id.* After clicking on the website, the brown box appears in about fifteen seconds.

²⁶⁶ Steven Singer Jewelers, *supra* note 263.

²⁶⁷ See Steven Singer Jewelers, <http://www.stevensingerjewelers.com/default1.asp> (last visited Feb. 14, 2009).

also bashes Steven Singer from the perspective of a married man whose wife wants Steven Singer and Singer's jewelry more than she wants her husband.²⁶⁸ The website lists "Top 10 Reasons I Hate Steven Singer."²⁶⁹

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

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

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

²⁶⁸ *See id.*

²⁶⁹ *Id.* Those ten reasons are:

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

Id.

²⁷⁰ *See SINHA & FOSCHT, supra note 262, at 147.*

²⁷¹ *Id.*

²⁷² *See Covell, supra note 260.*

pretense that is commonly on view in ads and slogans.²⁷³

2. Loews and Southwest Airlines

While 35% of “brandsucks” domain names surveyed by FairWinds Partners, LLC are owned by the brand found within the domain, it appears that only Loews (movie theater chain) and Southwest Airlines have utilized their trademark’s corresponding “sucks” domain name strategically.²⁷⁴ Loews registered loewssucks.com and placed a “Guest Satisfaction Survey” on that page.²⁷⁵ Customers visiting the website by accident may be impressed with Loews’ dedication to customer service, and Loews will also have at least tried to resolve the problems that angered consumers looking for a gripe site.²⁷⁶ Also, Southwest Airlines features the following statement on southwestsucks.com:

Southwest Airlines strives to maintain a high level of Customer Service and is proud of its corporate reputation and responsiveness to its Customers. As part of that effort, Southwest wants to control the release of inaccurate and irresponsible information about the Company via the Internet. If you would like more information on Southwest, please go to www.southwest.com.²⁷⁷

Eighty-three percent of the “brandsucks” domain names surveyed by FairWinds Partners, LLC resolve to the brand’s actual website.²⁷⁸ Some critics have argued that such a technique damages the brand because “companies that do this are associating their brand with a memorable and negative domain name.”²⁷⁹

²⁷³ See SINHA & FOSCHT, *supra* note 262, at 147–48; see also MikeMcGuff.com, <http://mikemcguff.blogspot.com/2008/07/i-hate-steven-singer.html> (last visited July 23, 2008) (suggesting that the same concept will “start[] creeping into other cities across the United States”).

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

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

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

²⁷⁷ Southwest.com, http://www.southwest.com/new_message.html (last visited Feb. 14, 2009).

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

²⁷⁹ *Id.*

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

III. CONFUSING THE LIKELIHOOD OF CONFUSION STANDARD

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

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

²⁸⁰ *Id.* at 4.

²⁸¹ Steel, *supra* note 32.

²⁸² While the intent of gripe sites differs markedly from the intent of a pure fan site, the central concept of appropriating—or misappropriating—a trademark remains the same.

such analyses are affected by new marketing trends that obscure the sponsoring company's identity.

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

All four federal court cases decided under federal statutes (Lanham Act and ACPA)—*Bally Total Fitness Holding Corp. v. Faber*, *Lucent Technologies, Inc. v. LucentSucks.com*, *Ford Motor Co. v. 2600 Enterprises*, and *Taubman Co. v. Webfeats*—and ten out of thirty-seven (27%) WIPO panel decisions decided under the UDRP between July 20, 2000, and October 31, 2008,²⁸³ held that a person may create a gripe site whose domain name contains a trademark plus a derogatory modifier without infringing on the trademark owner's rights. In addition, none of the six WIPO panel decisions decided under the UDRP between June 4, 2003, and December 19, 2008, held that a person may create a love site whose domain name contains a trademark plus the word "love" without infringing on the trademark owner's rights.²⁸⁴ Not only do these numbers demonstrate that there is inconsistency in the law of domain names and trademarks, but they also show that the court decisions differ markedly—pun intended—from the decisions of the arbitration panels.

1. Internet Users and Common Sense

The court in *Bally* stated that "no reasonably prudent Internet user would believe that 'Ballysucks.com' is the official Bally site or is sponsored by Bally."²⁸⁵ The court in *Lucent* stated that "the average consumer would not confuse lucentSucks.com with a web site sponsored by plaintiff."²⁸⁶ The panel in *Asda Group Ltd. v. Kilgour* stated that "by now the number of Internet users who do not appreciate the significance of the '-sucks' suffix must be so

²⁸³ See *supra* notes 168–69 and accompanying text.

²⁸⁴ See *supra* note 203 and accompanying text.

²⁸⁵ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 n.2 (C.D. Cal. 1998); accord *supra* note 125 and accompanying text.

²⁸⁶ *Lucent Techs., Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000); accord *supra* note 134 and accompanying text.

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 273

small as to be *de minimis* and not worthy of consideration.”²⁸⁷ Finally, the panel in *Lockheed Martin Corp. v. Parisi* stated that “once the searcher sees <lockheedsucks.com> and <lockheedmartinsucks.com> listed among the websites for further search, she will be able readily to distinguish the Respondent’s site for criticism from Complainant’s sites for goods from aerospace to t-shirts.”²⁸⁸ However, if these four quotations were indisputable, then it would naturally follow that one could say, “no reasonably prudent Internet user would believe that ‘ihatestevensinger.com’ is the official Steven Singer [Jewelers] site or is sponsored by Steven Singer.”²⁸⁹ Yet Steven Singer purposefully manipulated this conception—or misconception—to advance his marketing campaign.²⁹⁰

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

2. Different Intents of Parody

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

²⁸⁷ *Asda Group Ltd. v. Kilgour*, Case No. D2002-0857, WIPO Administrative Panel Decision (Nov. 11, 2002), available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0857.html>; see also *supra* note 189 and accompanying text.

²⁸⁸ *Lockheed Martin Corp. v. Parisi*, Case No. D2000-1015, WIPO Administrative Panel Decision (Jan 31, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1015.html>; see also *supra* note 192 and accompanying text.

²⁸⁹ *But see Bally*, 29 F. Supp. 2d at 1165 n.2; see also *supra* notes 125, 285 and accompanying text.

²⁹⁰ See *supra* Part II.B.1.

²⁹¹ See *Lucent Techs., Inc. v. Luentsucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000); see also *supra* text accompanying note 133.

²⁹² See *Lucent*, 95 F. Supp. 2d at 535..

whether the sucks site was a parody of the legitimate website because (1) it was mocking the original website and its content in an effort to dissociate itself or (2) it was imitating the original website in a way to creatively promote its message.²⁹³ The first is the concept of a gripe site, and the second is the concept of reverse psychology marketing. The first dissociates the domain name registrant from the trademark owner, and the second identifies the domain name registrant with the trademark owner. The first intends to hurt the trademark, and the second intends to bolster the trademark. Thus, each type of parody has a different agenda, and a blanket statement that parody is permissible is incomplete if it does not distinguish between the two ways parody can be used in domain names.

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

3. Confusion as to Source

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

²⁹³ See generally LINDA HUTCHEON, A THEORY OF PARODY: THE TEACHINGS OF TWENTIETH-CENTURY ART FORMS 6 (2000) (stating that parody is “a form of imitation, but imitation characterized by ironic inversion, not always at the expense of the parodied text”).

²⁹⁴ See, e.g., TypedHype.com, How to Create a Memorable Website (Mar. 4, 2009), <http://www.typedhype.com/2009/03/how-to-create-memorable-domain-name/>; see also Amazing Traffic Tips—Memorable Domain Name (Sept. 3, 2008), <http://blog.eukhost.com/webhosting/amazing-traffic-tips-7-%E2%80%93-memorable-domain-name/>; Dirk Krischenowski, Study Shows German Internet Users Prefer Memorable Domain Names for Cities and Regions (Nov. 2, 2007), http://www.circleid.com/posts/711212_german_internet_domain_names/.

²⁹⁵ *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003); see also text accompanying note 158.

their marketing campaigns, the current standard for what constitutes “confusion as to source” shifts. Viewers were shocked to discover that Burger King created Subservient Chicken, Smirnoff created Tea Partay, Court TV created That Girl Emily, and McDonald’s created The Lost Ring.²⁹⁶ Such shock stems from the company’s creative way of generating interest by distributing its advertisement and marketing campaign message before revealing its corporate sponsorship and identity. However, the popularity of such techniques may cause one of two results. First, consumers may become more defensive and consequently analyze the relationship between media messages and sponsorship. Specifically, consumers may learn to analyze the source of media content more deeply or challenge the connection between an advertisement, its sources, and its intention. Alternatively, the popularity of such techniques may require the courts to be more vigilant in protecting consumers from the confusion that such marketing techniques necessarily engender.

In addition, companies are focusing on customer relationship management because the connection between consumer satisfaction and profits is undeniable.²⁹⁷ According to one study, 93% of companies solicit customer feedback.²⁹⁸ In addition, “[o]ne of the most common pieces of user-generated content on the web is the customer review.”²⁹⁹ Southwest Airlines strategically references its commitment to consumer satisfaction by soliciting feedback on southwestsucks.com.³⁰⁰ Other companies may decide

²⁹⁶ See, e.g., *supra* notes 230, 240, 256 and accompanying text.

²⁹⁷ See GERHARD RAAB, RIAD A. AJAMI, G. JASON GODDARD & VIDYARANYA B. GARGEYA, CUSTOMER RELATIONSHIP MANAGEMENT: A GLOBAL PERSPECTIVE 8–9 (2008) (“Many considerations justify investment in the setting up and realizing of CRM [customer relationship management]. . . . Every satisfied customer brings in at least three more customers. An unhappy customer communicates his negative experience to ten more potential customers. The rate of repeat sales climbs with increased reliance and satisfaction with the performance of their suppliers. . . . It is becoming clear what an immense increase in effectiveness the implementation of CRM can provide.”).

²⁹⁸ See *Trust the Voice of the Customer*, BUS. TRENDS Q., <http://www.btquarterly.com/?mc=trust-voice&page=crm-viewwebevents> (last visited Sept. 29, 2009); *accord* Benchmark Portal, Caller Satisfaction Measurement, <http://www.benchmarkportal.com/knowledgebase/caller-satisfaction-measurement> (last visited Sept. 29, 2009).

²⁹⁹ Neal Creighton, *Don’t Leave Customer Feedback to Chance*, IMEDIA CONNECTION, Oct. 23, 2007, <http://www.imediainconnection.com/content/17033.asp>.

³⁰⁰ See *supra* note 277 and accompanying text.

to dedicate the “sucks” site domain names that they own to such productive, customer-driven purposes. This strategy benefits the company yet further complicates the gripe site legal analysis. The company benefits because it turns a potentially disastrous consumer relationship into an opportunity to make amends by learning about and then hopefully addressing the cause of the consumer’s complaint. Yet such a strategy complicates the gripe site legal analysis because it is no longer easy to determine if a domain name in the gripe site format is owned by the company for legitimate marketing or public relations purposes or if it is owned by an angry third party.

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

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

1. Association of Trademark Owner and Domain Name Registrant

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

³⁰¹ See *supra* notes 168–69 and accompanying text.

³⁰² See *supra* note 203 and accompanying text.

³⁰³ *ADT Services AG v. ADT Sucks.com*, Case No. D2001-0213, WIPO Administrative Panel Decision (Apr. 23, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0213.html>.

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 277

The first and immediately striking element in the Domain Name is the Complainant's name. Adoption of it in the Domain Name is inherently likely to lead some people to believe that the Complainant is connected with it. Some . . . may be unable to give it any very definite meaning and will be confused about the potential association with the Complainant.³⁰⁴

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

Additionally, sometimes an organization puts the word "sucks" in its domain name as part of its brand image. For example, the panel in *Vivendi Universal v. Sallen* mentioned that the vacuum cleaner Electrolux, whose slogan refers to Electrolux's suctioning power as "Nothing sucks like an Electrolux" might want the domain name *electroluxsucks.com* and that the band Primus, whose slogan is "Primus sucks" could use the domain name *primussucks.com*.³⁰⁶ Both of these examples demonstrate ways a company can use its "sucks" website to directly promote its product. The double entendre in Electrolux's slogan³⁰⁷ and the

³⁰⁴ *Dixons Group PLC v. Purge I.T.*, Case No. D2000-0584, WIPO Administrative Decision (Aug. 13, 2000), available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0584.html>.

³⁰⁵ See SINHA & FOSCHT, *supra* note 262, at 147–48 and accompanying text.

³⁰⁶ *Vivendi Universal v. Sallen*, Case No. D2001-1121, WIPO Administrative Panel Decision (Nov. 7, 2001), available at <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1121.html>.

³⁰⁷ See Ross Thomson, *Lost in Translation*, MED. MARKETING & MEDIA, Mar. 2005, at 82; *True Tales From the Workplace*, TRAINING & DEV., June 2000, at 96. *But see* Webster's Online Dictionary, Vax, <http://www.websters-online-dictionary.org/VA/VAX.html> (last visited Feb. 20, 2009) ("But in 1996, the press manager of Electrolux AB, while confirming that the company used this slogan in the late

irony of Primus's band identity³⁰⁸ demonstrate that the word "sucks" can have other meanings besides serving to denigrate a product. The notion that the word "sucks" has the power to intrigue consumers and attract attention, coupled with the consequent applicability to marketing campaigns, suggests that the word "sucks" in gripe sites may need to be analyzed from a broader perspective.

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

2. Diversion to the Gripe Site

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

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

1960s, also tells us that their marketing people were fully aware of the possible double entendre and intended it to gain attention.").

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

³⁰⁹ See *supra* text accompanying note 271.

trademark and the pejorative term. The operator of the website identified by the “sucks”-formative domain name will have accomplished the objective of diverting the Internet user seeking the trademark holder’s website.³¹⁰

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

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

³¹⁰ TPI Holdings, Inc. v. AFX Commc’ns, Case No. D2000-1472, WIPO Administrative Panel Decision (Feb. 2, 2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1472.html>; *see also* Wal-Mart Stores, Inc. v. Walsucks, Case No. D2000-0477, WIPO Administrative Panel Decision (July 20, 2000), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0477.html> (“[U]sers will choose to visit the [gripe] sites, if only to satisfy their curiosity.”).

³¹¹ *See, e.g.,* Barrett, *supra* note 12, at 1024 n.192; Lipton, *Beyond Cybersquatting*, *supra* note 38, at 1430.

3. Fan Sites

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

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

³¹² See, e.g., *Harrods Ltd. v. Iorio*, Case No. D2008-1684, WIPO Administrative Panel Decision (Dec. 19, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1684.html>; *Serta Inc. v. Dawson*, Case No. D2008-1474, WIPO Administrative Panel Decision (Nov. 20, 2008), available at <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1474.html>.

³¹³ See *GA MODEFINE SA v. pumo*, Case No. D2006-0619, WIPO Administrative Panel Decision (July 18, 2006), available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0619.html>.

³¹⁴ See *supra* note 209.

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

IV. TOWARDS THE REVERSAL OF GRIPE SITE PERMISSIBILITY PRECEDENT

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

³¹⁵ See generally *Brown v. Bd. of Educ.*, 347 U.S. 483, 492–93 (1954) (“In approaching this problem, we cannot turn the clock back to 1868 when the Amendment was adopted, or even to 1896 when *Plessy v. Ferguson* was written. We must consider public education in the light of its full development and its present place in American life throughout the Nation.”).

command.”³¹⁶ Today’s advertising environment is replete with ad clutter,³¹⁷ and consequently, companies endlessly compete for consumers’ attention by making their marketing campaigns increasingly creative, unique, and outrageous.³¹⁸ Studies have empirically shown that Internet advertisements that pique consumers’ curiosity yet obscure critical information about the product entice consumers to learn more about the product and to focus on more efficient processing and comprehension of that information.³¹⁹ Anecdotal evidence demonstrates how obscuring a company’s identity can capture consumer attention, generate intrigue and interest, and position marketers to capitalize on these consumers’ attention.³²⁰ Consumers resent traditional marketing, and advertisers, recognizing this aversion, are changing the ways they conduct marketing campaigns.³²¹

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

³¹⁶ See *Lawrence v. Texas*, 539 U.S. 558, 577 (2003) (“The doctrine of *stare decisis* is essential to the respect accorded to the judgments of the Court and to the stability of the law. It is not, however, an inexorable command.”).

³¹⁷ See *supra* note 212 and accompanying text.

³¹⁸ See *supra* note 215 and accompanying text.

³¹⁹ See Satya Menon and Dilip Soman, *Managing the Power of Curiosity for Effective Web Advertising Strategies*, 31 J. ADVERTISING 1, 8, 11 (2002) (demonstrating the “inverted-U-shaped relationship between the level of information provided in the first advertisement and the degree of interest generated in subsequent processing of the ad”).

³²⁰ See *supra* notes 225–72 and accompanying text.

³²¹ See *supra* text accompanying note 273.

³²² See Jenna Wortham, *Separating Real from Fake on the Internet*, N.Y. TIMES, Dec. 24, 2008, <http://bits.blogs.nytimes.com/2008/12/24/separating-real-from-fake-on-the-internet/>.

³²³ See *id.* (“As the Web becomes an important component of brand identity for companies and a digital extension of identity for consumers, determining what is real and what is fake becomes even more crucial.”); see also Leah Graham & Panagiotis Takis

The courts and arbitration panels must necessarily step in by redefining how they examine trademark law in the context of domain name infringement.

First, the courts and panels should recognize that marketers have addressed the rise in ad clutter by tailoring their campaigns to be more ingenious. Specifically, the four examples mentioned above—Burger King’s “Subservient Chicken,” Smirnoff’s “Tea Partay,” Court TV’s “That Girl Emily,” and McDonald’s “The Lost Ring”—show how a company can produce a captivating, wildly popular marketing campaign while at least temporarily obscuring the company’s association with the advertisements.³²⁴ Viewers are intrigued and influenced by the creative websites, videos, and billboards. At the same time, they are unaware of who is promoting this media. Courts and panels considering Internet domain names in conjunction with the likelihood of confusion standard must be aware of those realities.

Second, the courts and panels should recognize that alternative marketing techniques such as viral marketing and reverse psychology marketing tend to be slightly deceptive, capturing consumers’ attention because of their creativity, humor, or mystery rather than because of their clear purpose as an advertisement associated with a product. Plus, these campaigns often use the Internet as a key medium of expression.³²⁵ As a result, when the courts and panels analyze whether a viewer is likely to be confused about whether a trademark owner or third party has created a gripe site or love site, it is necessary that the courts and panels understand that legitimate advertisements have confused consumers. In light of that reality, courts and panels must be careful not to jump to seemingly obvious conclusions about a consumer’s likelihood of being confused or not. Instead, courts and panels analyzing whether something is deceptive must

Metaxas, “*Of Course It’s True; I Saw It on the Internet!*”: *Critical Thinking in the Internet Era*, 46 COMM. ACM 71, 71, 75 (2003) (explaining that Internet users have trouble ascertaining the veracity and trustworthiness of the information they find on the Internet).

³²⁴ See Parts II.A.1, II.A.2, II.A.3, II.A.4.

³²⁵ See Wortham, *supra* note 322 (“The issue of disclosure and authenticity has surfaced a multitude of times across the Internet, especially on popular user-driven sites like YouTube, Facebook and Twitter.”).

remember that both legitimate trademark owners and unaffiliated third parties use deception as a means to their respective ends; the trademark owners use deception to pique interest, while the unaffiliated third parties use deception to divert interest. Thus, deceptive intent is not a completely effective measure of likelihood of confusion.

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

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

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

³²⁶ See *supra* notes 21–26 and accompanying text.

³²⁷ See generally *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992) (explaining that the First Amendment prevents government from banning speech or expressive conduct because it disapproves of the ideas expressed).

the realities of the way the Internet and marketing techniques are used today.

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

³²⁸ Congress, in passing the Lanham Act, believed that "trademarks should receive nationally the greatest protection that can be given them." S. REP. NO. 1333, at 6 (1946), *as reprinted in* 1946 U.S.C.C.S. 1274. Trademark laws, like other statutes, should be interpreted to avoid conflicts with the Constitution. *See* William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1213 (2008). The First Amendment does not restrict trademark owners' traditional rights. *See* Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 WIS. L. REV. 158, 166. In fact, the Supreme Court has recognized that the First Amendment does not interfere with federal trademark law. *See* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 540 (1987) (affirming the appellate court's finding that the United States Olympic Committee's property right in the word "Olympic" and its associated symbols and slogans can be protected without violating the First Amendment).

³²⁹ *See* Kiran Nasir Gore, *Trademark Battles in a Barbie-Cyber World: Trademark Protection of Website Domain Names and the Anticybersquatting Consumer Protection Act*, 31 HASTINGS COMM. & ENT L.J. 193, 206 (2009); *see also* Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 98 TRADEMARK REP. 1086, 1086 (2008) ("[T]he concept of consumer confusion has served as the touchstone for trademark liability.").

³³⁰ *See* Denicola, *supra* note 328, at 165; *see also* 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 31:44 (2006) (explaining that the First Amendment defense does not cover using another's trademark to convey a message).

³³¹ Denicola, *supra* note 328, at 190; *see also* Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 771-72 (1976) ("The First Amendment, as we construe it today does not prohibit the State from insuring that the stream of commercial information flow cleanly as well as freely.").

interpretation is necessary precisely because consumers familiar with alternative marketing techniques are likely to be confused about who owns the content of a website whose domain name contains a trademark qualified by a provocative word. First Amendment concerns are not implicated when, as here, trademark law's goals of preventing consumer confusion are furthered by a finding of infringement.

CONCLUSION

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

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

³³² See *supra* notes 21–26 and accompanying text.

³³³ See *supra* notes 29–36 and accompanying text.

³³⁴ See *supra* notes 41–43 and accompanying text.

2009] *CUTTING-EDGE MARKETING TACTICS AND GRIPE SITES* 287

viral marketing campaigns that intrigue consumers and generate attention before ever revealing the sponsoring company's identity. Most notably, Steven Singer Jewelers created a reverse psychology marketing campaign by appearing to tarnish his brand while actually generating awareness about and interest in it. These techniques, combined with companies like Loews' and Southwest Airlines' efforts to use their gripe site format domain name to solicit customer feedback, emphasize that the "likelihood of confusion" analysis must be understood in a broader context than ever before. In other words, it is not self-evident that a "sucks" site, for example, could not have been created by the trademark owner.

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