

# With Liberty and Domain Names for All: Restructuring Domain Name Dispute Resolution Policies\*

## TABLE OF CONTENTS

I.	INTRODUCTION .....	376
II.	AN OVERVIEW: THE INTERNET, DOMAIN NAMES, AND THE VALUE OF MEANINGFUL WORDS AS DOMAINS .....	378
	A. <i>A Star Is Born: The Birth of the Internet as a Military and Educational Resource</i> .....	379
	B. <i>Domain Names Become the Coveted Key to Cyberspace Identity</i> .....	382
	1. <i>Registering Your Very Own Personal Domain Name</i> .....	383
	2. <i>Domain Names as Valuable Personal and Commercial Identifiers</i> .....	385
III.	TAKE YOUR PICK FOR RESOLVING THE DOMAIN NAME OWNERSHIP ISSUE: TRADEMARK LAW, LEGISLATIVE ACTION, OR PRIVATE RESOLUTION .....	387
	A. <i>Trademark Law: Too Narrow to Address Personal Domain Names</i> .....	387
	B. <i>Legislative Regulation: Another Dead-End for Noncommercial Parties</i> .....	394
	C. <i>Private Dispute Resolution: A Flawed but Potential Solution</i> .....	396
IV.	REDESIGNING CYBERLAW TO GIVE POKEY HIS DOMAIN NAME BACK .....	402

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A.	<i>Expanding on Current Policy to Protect Personal Domain Name Registration</i> .....	403
B.	<i>Do Domain Names Really Still Matter? New Issues Raised by Technology and Social Changes</i> .....	413
C.	<i>The Strength of the "Information Society"</i> .....	419
V.	PROPOSALS FOR CHANGE: PROVIDING RIGHTS FOR FUTURE POKEYS .....	422
A.	<i>Solutions in the Works</i> .....	422
B.	<i>Drafting New Dispute Resolution Policies</i> .....	425

## I. INTRODUCTION

The Internet's continued growth as one of the greatest resources of the twenty-first century has led to new disputes and raises questions that the legal system has not seen before. Whose claims to domain names take precedence in the online world? Should individuals be able to register their personal names as domain names without fear that a corporate entity may trump their claims to the registered domains? Consider the following example:

Mr. Van Allen registered the domain name "pokey.org" as a birthday gift for his twelve-year-old son, Chris, nicknamed "Pokey."<sup>1</sup> He registered the domain in good faith:<sup>2</sup> his son had a personal connection to the name, Chris planned to use the site for personal rather than commercial purposes, and Mr. Van Allen made sure to register the name as a noncommercial domain.<sup>3</sup> But Chris unexpectedly received a letter from Prema Toy Co. (Prema), the manufacturer of children's toy figures Gumby and Pokey, demanding that the Van Allens transfer the domain name to Prema.<sup>4</sup>

Prema claimed that its ownership in the trademark<sup>5</sup> "Pokey" precluded the Van Allens from using that mark as a domain name.<sup>6</sup> The domain name registrar notified Chris that his site would be shut down in ninety

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1. David Yan, Note, *Virtual Reality: Can We Ride Trademark Law to Surf Cyberspace?*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 773, 807 (2000) (citing Jeri Clausing, *Gumby Creator Grants Boy Pokey Domain*, N.Y. TIMES ON THE WEB, Apr. 24, 1998, at <http://www.nytimes.com/library/tech/98/04/cyber/articles/24pokey.html>).

2. Good faith refers to undertaking an activity with honesty in one's belief or purpose and absence of intent to defraud or seek unconscionable advantage. BLACK'S LAW DICTIONARY 701 (7th ed. 1999).

3. Yan, *supra* note 1, at 807. Mr. Van Allen registered the domain as a .org rather than a .com. *Id.* For further discussion on the significance of these designations, see *infra* note 59.

4. Yan, *supra* note 1, at 807.

5. A trademark consists of words, phrases, or logos used by a business to distinguish its product(s) from competitors' products. BLACK'S LAW DICTIONARY, *supra* note 2, at 1500.

6. See Yan, *supra* note 1, at 807.

days, effective until the question of domain ownership was resolved, and created an alternative site for Chris.<sup>7</sup> Prema demonstrated its power to effectively terminate Chris's use of his own domain name, at least for the duration of the dispute.<sup>8</sup>

But before Prema could issue more threats of site cancellation or a lawsuit, a strong outpouring of community support for young Chris's domain name rights caused Prema to rethink its position.<sup>9</sup> After blaring, "Newsflash . . . pokey.org is mine *and they can't have it!*" on his site,<sup>10</sup> Chris received over 4500 e-mails from around the world, cheering him on.<sup>11</sup> The controversy spawned sympathetic Web sites like the Pokey Protest Page, and hundreds of Internet service providers offered to direct Internet users to his new site.<sup>12</sup> A cyberspace<sup>13</sup> rally against Prema was underway.<sup>14</sup>

Under current domain name policy, if Prema had continued its fight, its ownership of the Pokey trademark would have beat out Chris "Pokey" Van Allen's claim to his own personal name.<sup>15</sup> Current dispute resolution policies and decisions favor trademark owners, awarding domain name rights to parties using the Internet for commercial purposes, at the expense of personal, educational, communication, entertainment, and other noncommercial Internet users' rights.<sup>16</sup> These

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7. *Id.* Domain name registrars oversee the distribution of domain names and maintenance of updated contact information. See *infra* notes 51–52 and accompanying text.

8. See Yan, *supra* note 1, at 807.

9. *Id.*

10. Fred Harper, *The Web: Fightin' Mad*, N.Y. TIMES MAG., May 10, 1998, at 9.

11. Jeri Clausing, *Gumby Creator Grants Boy Pokey Domain*, N.Y. TIMES ON THE WEB, Apr. 24, 1998, at <http://www.nytimes.com/library/tech/98/04/cyber/articles/24pokey.html> (last visited Nov. 9, 2002).

12. Kelly Flaherty, *Domain Name Dispute with a Twist*, THE RECORDER, Mar. 30, 1998, at 1, available at WL 3/30/1998 RECORDER-SF 1.

13. The word "cyber" is often attached to everyday words to indicate a computer, Internet, or electronic connotation. Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/encyclopedia/defineterm?term=cyber> (last visited Feb. 2, 2002). Cyberspace is the collection of resources that comprise the Internet—a region that is "located in no particular geographical location but available to anyone, anywhere in the world, with access to the Internet." *Reno v. ACLU*, 521 U.S. 844, 851 (1997).

14. Yan, *supra* note 1, at 807. Van Allen has a soon-to-be available description of his fight with Prema at his Web site. PokeyWeb, at <http://www.pokey.org> (last visited Sept. 7, 2002).

15. See discussion *infra* Part III.A (providing an overview of current trademark law and explaining the reasons that it is inadequate for solving domain name disputes).

16. See discussion *infra* Part III.C; Jane K. Winn, *Electronic Commerce Law: 2001 Developments*, 57 BUS. LAW. 541, 556 (2001). Of the 2968 domain name disputes heard by

dispute resolution decisions often transfer domains to trademark owners, overlooking common sense ownership rights.<sup>17</sup>

This policy disregards noncommercial cyber users, including individuals, nonprofit organizations, and small mom-and-pop businesses.<sup>18</sup> Large companies are the sharks of cyberspace; their money and power enable them to defeat smaller companies' and individuals' claims to domain names. Dispute resolution policies must place greater emphasis on the Internet as a noncommercial resource, protecting individuals' rights to register their personal names as domains without having those rights unjustly trumped by trademark owners.

This Comment will explore currently available domain name dispute resolution policies and will show why they fail to adequately address the "Pokey" Van Allens of cyberspace, who want to register nontrademarked domains to which they have legitimate claims. Part II of this Comment takes a step-by-step look at the inception of the Internet and the domain name registration system and then explores the value placed on recognizable domain names. Part III outlines the channels currently available for domain name disputes: trademark law, legislation, and private dispute resolution tribunals. Part III also explores the limits of these options for nontrademark owning domain name registrants. Part IV analyzes current trademark and private dispute resolution cases, highlighting analyses that should be applied to good faith registrants asserting personal claims to their first-registered domain names. Part V suggests policy changes that would protect individuals in domain name disputes.

## II. AN OVERVIEW: THE INTERNET, DOMAIN NAMES, AND THE VALUE OF MEANINGFUL WORDS AS DOMAINS

The Internet is a complicated network<sup>19</sup> that operates differently from the

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the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center through November 2001, sixty-four percent have been decided in favor of the complainant, who is usually a trademark owner and is often a group backed by strong financial resources. WIPO Arbitration and Mediation Center for Domain Name Disputes, at <http://arbiter.wipo.int/domains/statistics/results.html> (Nov. 2001); see also Julia Angwin, *Are Domain Panels the Hanging Judges of Cyberspace Court?*, WALL ST. J., Aug. 20, 2001, at B1 (noting a growing bias in favor of trademark holders).

17. Angwin, *supra* note 16.

18. Hereinafter these three types of groups (individuals, nonprofit organizations, and small businesses) will be treated interchangeably because this Comment is meant to address the concern that large corporations with substantial financial resources are given preference regarding domain name rights at the expense of groups that are less likely to have the resources to seek legal recourse to protect such rights. Most at issue is the registration of personal names; thus, Chris "Pokey" Van Allen will be demonstrative of the defendant and respondent class this Comment seeks to protect.

19. A network is defined as a "system that transmits any combination of voice, video and/or data between users." Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/>

physical world. The nature of the Internet, and cyberspace, as quasi-geographical and quasi-conceptual introduces several complications. The emergence of domain names<sup>20</sup> and growing demand for ideally located cyber real estate raise new issues in how conflicts over this property are to be resolved.<sup>21</sup> An understanding of cyberspace development is necessary before one can effectively formulate and evaluate solutions to these new problems.

*A. A Star Is Born: The Birth of the Internet as a Military and Educational Resource*

In 1962 J.C.R. Licklider, head of the computer research program at the Advanced Research Projects Agency (ARPA), formulated a “galactic network” concept where computers would interact globally, and in 1964 ARPA colleague Leonard Kleinrock proposed improvements for the network structure.<sup>22</sup> In 1966, MIT researcher Lawrence G. Roberts accomplished the next step—getting the computers to talk to each other.<sup>23</sup> Roberts connected two computers via a low speed dialup telephone line. By 1969, a government network, called ARPAnet, was in use.<sup>24</sup> Thus, the birth of the Internet.<sup>25</sup>

In the midst of Cold War concerns, the government aimed to create a communications network that would keep information flowing in the event of a large scale disaster, such as nuclear attack.<sup>26</sup> Within this system, each individual computer could connect to the network but still operate independently of any other computer. This global structure where computers interact over multiple independent networks expanded within the government and educational sectors during the 1970s and 1980s.<sup>27</sup> Only

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encyclopedia/defineterm?term=network (last visited Jan. 8, 2002). Networks include the computers that transmit and receive the information as well as supporting hardware. *Id.*

20. See *infra* Part II.B (discussing the development of domain names).

21. See Weston Anson, *The Million Dollar Domain Name*, MANAGING INTELL. PROP., May 1998, at 40–41.

22. Barry M. Leiner et al., *A Brief History of the Internet*, Internet Society, at <http://www.isoc.org/internet/history/brief.shtml> (last revised Aug. 4, 2000).

23. *Id.*

24. *Id.*

25. *Id.*

26. G. BURGESS ALLISON, *THE LAWYER’S GUIDE TO THE INTERNET* 31 (1995); Kris Gautier, *Electronic Commerce: Confronting the Legal Challenge of Building E-Identities in Cyberspace*, 20 MISS. C. L. REV. 117, 120 (1999).

27. Leiner et al., *supra* note 22, at <http://www.isoc.org/internet/history/brief.shtml> (last revised Aug. 4, 2000). In 1990, ARPAnet was transferred to NSFNET and EUnet, systems which linked universities in North America and research facilities in Europe, thus expanding the Internet’s scope to include educational systems. The Living Internet, at [http://livinginternet.com/i/ii\\_summary.htm](http://livinginternet.com/i/ii_summary.htm) (last visited Oct. 19, 2001) (describing the

in the 1990s did the Internet begin its journey as a commercial venture.<sup>28</sup>

At a 1988 Interop trade show in the United States, an early version of the Internet was demonstrated for fifty companies and 5000 engineers,<sup>29</sup> thereby introducing the Internet to the commercial sector.<sup>30</sup> With the advent of user-friendly Internet browsers, such as Mosaic, Netscape Navigator, and Internet Explorer in the mid-1990s,<sup>31</sup> the Internet became

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growth and development of the Internet).

28. Leiner et al., *supra* note 22, at <http://www.isoc.org/internet/history/brief.shtml>.

29. *Id.* By 2000, the same Interop trade show had grown to include an audience of 250,000 attending conferences in seven locations around the world. *Id.* Interop presents trade shows and conferences about Internet, network, and telecommunications technology. See Network World Interop, at <http://www.interop.com> (last visited Feb. 18, 2002).

30. Distinctions must be drawn between commercial layers supporting noncommercial Internet use and actual commercial use of the Internet. David R. Kolzow & Ed Pinero, *EDRI White Paper: The Internet Economy and Its Impact on Local Economic Development*, 17 *ECON. DEV. REV.* 82, 83 (2001). Both of these concepts involve e-Commerce, which is defined as the “process of two or more parties making business transactions via computer and some type of network” including direct connection to the Internet. *Id.* E-Commerce can be broken into four layers. The first layer, which consists of the companies with products and services that create the infrastructure that supports the Internet, includes telecommunications companies, Internet service providers (ISPs), and manufacturers of end-user networking equipment. ISPs are organizations that provide access to the Internet via modem, ISDN, or private line hookups. Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/encyclopedia/defineterm?term=internet+service+provider> (last visited Feb. 2, 2002). The second layer builds on the first-layer infrastructure and provides technology to make online business activities possible. This layer includes software products, Web sites, designers and consultants, and multimedia applications that allow transmission of radio and video clips on the Internet. Companies that actually generate revenue through advertising and membership subscription fees via the Internet comprise the third layer. The fourth layer includes those companies that conduct Web based business transactions, such as business-to-business transactions, online ticket sales, online entertainment, and online professional services. Kolzow & Pinero, *supra* note 30, at 83. This Comment is concerned only with commercial use of the Internet and therefore considers only the fourth layer.

31. Most Internet communication is done via the World Wide Web (www), which consists of multimedia pages or Web sites. Each Web page is simply a file stored in a computer that could be located anywhere around the world, but is connected to the Internet network. *Reno v. ACLU*, 521 U.S. 844, 852 (1997). Web pages can be viewed through “browsers.” Mosaic was a Web browser created by the University of Illinois National Center for Supercomputing Applications (NCSA), released for use in early 1993. This browser was the hot ticket application that caused the public’s interest in the World Wide Web to explode. Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/encyclopedia/defineterm?term=mosaic> (last visited March 1, 2002). Netscape Navigator was created in 1994 by Netscape Communications Corporation and released for free as a commercially useable Internet browser. The Living Internet, at <http://livinginternet.com/wi.htm> (last visited Oct. 19, 2001); Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/encyclopedia/defineterm?term=netscape+navigator> (last visited March 17, 2002). Microsoft began distributing Internet Explorer 1.0 with Windows 95 in 1995, although Mosaic, Netscape, Lynx, and Opera were more popular Web browsers at the time. Scott Schnoll, *The History of the Internet*, at <http://www.nwnetworks.com/ie/history.htm> (last visited Jan. 8, 2002).

accessible to the public.<sup>32</sup> In 1995 the government turned Internet management over to commercial Internet providers, creating market incentive to improve Internet ease of use.<sup>33</sup> Internet use then exploded, but formal, centralized structure remains to be developed to control this growing entity.<sup>34</sup>

Large scale regulation is especially difficult because cyberspace lacks physical borders.<sup>35</sup> Lawmakers and administrative bodies therefore have great difficulty determining how to create manageable laws for the rapidly growing number of Internet disputes.<sup>36</sup> Furthermore, legislators and legal experts are hesitant to draft laws for the Internet that could lead to an inefficient or inconsistent system.<sup>37</sup> However, lest cyberspace remain anarchical like the “wild wild West,”<sup>38</sup> some structure and guidelines are inevitable. The development of the domain name system, described below, demonstrates the move toward regulation and governance of cyberspace.

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32. See Tech Web: The Business Technology Network, at <http://www.techweb.com/encyclopedia/defineterm?term=world+wide+web> (last visited Oct. 19, 2001).

33. *Id.*

34. See Angela Proffitt, *Drop the Government, Keep the Law: New International Body for Domain Name Assignment Can Learn from United States Trademark Experience*, 19 LOY. L.A. ENT. L.J. 601, 606 (1999); see also ED KROL, *THE WHOLE INTERNET: USER'S GUIDE AND CATALOG* 13 (2d ed. 1994). “A comprehensive formal structure for preventing and resolving domain names/trademark disputes has yet to be developed.” Proffitt, *supra*, at 606.

35. Christine Lepera, *Litigating in Cyberspace*, WL 662 PLI/PAT 773, 787–88 (2001) (stating that the Internet’s lack of boundaries and “free-for-all atmosphere” have opened a “Pandora’s box of legal issues”).

36. The adoption of the Internet has been “exceptionally quick,” and the policies governing the domain name system “have been in rapid evolution.” THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM, REPORT OF THE SECOND WIPO DOMAIN NAME PROCESS 20 (2001), available at <http://wipo2.wipo.int> [hereinafter SECOND WIPO REPORT]. WIPO heard one domain name dispute case in 1999. The number of cases heard in 2001 jumped to 1420. WIPO Arbitration and Mediation Center, at <http://arbiter.wipo.int/domains/statistics/results.html> (Nov. 2002).

37. “[T]he Internet is one of those areas of commerce that must be marked off as a national preserve to protect users from inconsistent legislation that, taken to its most extreme, could paralyze development of the Internet altogether.” *Am. Library Ass’n v. Pataki*, 969 F. Supp. 160, 169 (S.D.N.Y. 1997). In the context of the Internet’s “rapid growth and change, understandably, there is a certain anxiety about the potentially negative effects that heavy handed regulation might have.” SECOND WIPO REPORT, *supra* note 36, at 20.

38. Jeffrey L. Look, *The Virtual Wild, Wild West (WWW): Intellectual Property Issues in Cyberspace-Trademarks, Service Marks, Copyrights, and Domain Names*, 22 U. ARK. LITTLE ROCK L. REV. 49 (1999).

## B. Domain Names Become the Coveted Key to Cyberspace Identity

Domain names are the aliases that users enter into Web browsers to access host Web sites. They have become surprisingly valuable commodities because of their scarcity.<sup>39</sup> Each computer that connects to the network is assigned an Internet protocol (IP) address consisting of a combination of numbers. The domain name simply labels an IP address. When a user enters a domain name into a Web browser, the computer connects to the corresponding IP address, although the user rarely sees the IP address during the transaction.<sup>40</sup> Domain names help make IP addresses more memorable by consisting of recognizable combinations of words and letters.<sup>41</sup> But because no two IP addresses can be the same, no two domain names can be the same.<sup>42</sup> Domain names must then be unique because if they labeled more than one IP address there would be no way to identify which server was to be contacted.<sup>43</sup>

The scarcity of this resource results from the limited number of domain names that actually have commercial and personal value, not from a physical limitation on the number of domain names that could be used.<sup>44</sup> Conflict arises because domain names must be *absolutely* unique,

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39. Although there are many possible word, letter, and number combinations for domain names, and “the total quantity of the resource is great, each particular instance is as scarce as it is possible to be.” CHRISTOPHER REED, *INTERNET LAW: TEXT AND MATERIALS* 37 (2000). Four key factors lead to scarcity of the domain name resource. The first is technical uniqueness of the name. Only one specific resource can be identified through an IP address or domain name. Second is semantic uniqueness, referring to the limitation on the number of recognizable names. For example, the domain name “smith.com” has meaning to the human mind, while random combinations of letters and numbers, such as q3ewz99m.com, do not. Third is economic uniqueness, which is the value of the name in the market. With trade names and trademarks, the ability to sell goods or services under a brand name, such as Coca Cola, is more valuable than being forced to sell the product under the name “New Brand Cola.” Last is origin uniqueness, addressing the source of the domain and information contained in the corresponding Web site. A legal opinion from Professor Smith is probably more valuable and is *perceived* as more valuable than one from Joe Smith who manages a restaurant. It is important for Web sites to reliably identify their source. *Id.* at 38.

40. *Id.* at 38–39.

41. *Id.* at 39. For example, the domain name “www.sandiego.edu” is more memorable than its IP address—192.55.87.16.

42. *Id.* at 37. When an Internet user enters the domain name into a software application (such as a Web browser), the software sends that name to one of its domain name server (DNS) computers. The DNS searches its database for the IP address that matches the domain name and returns the IP address to the requesting software application. Once the software has received the IP address, it can be used to communicate with the server to which the domain name refers. *Id.*

43. *Id.*

44. See Leah Phillips Falzone, *Playing the Hollywood Name Game in Cybercourt: The Battle over Domain Names in the Age of Celebrity-Squatting*, 21 *LOY. L.A. ENT. L.J.* 289, 293 (2001). Memorable, easy-to-spell domain names are “more valuable than diamonds.” Steven Levy, *We’re Running Out of Dot.coms*, *NEWSWEEK*, Oct. 11, 1999, at 79.



while names in the physical world need only be *relatively* unique.<sup>45</sup> Recognizable domain names can potentially convey information about the identity of a Web page's source and the content contained therein.<sup>46</sup> Both companies and individuals like young Pokey place value on a recognizable domain that, by its title alone, conveys a message about the Web site's content. Resulting from this limited and coveted resource is a set of problems that do not generally exist in the physical world.<sup>47</sup>

Further complications arise because the Internet operates through various computers on a global scale, rather than existing as a geographically oriented network.<sup>48</sup> So unlike the geographical nature of trademark disputes,<sup>49</sup> the registration of the domain name "smith.com" precludes any other potential registrant from using that name anywhere in the world. Even more disputes arise from the registration system's first come, first served basis when the domain name is registered and subsequent users find that the domain name is unavailable.<sup>50</sup>

### *1. Registering Your Very Own Personal Domain Name*

Domain names are registered on a first come, first served basis when the registrant contacts a domain name registrar<sup>51</sup> and pays a fee.<sup>52</sup> Domain names can typically be registered for thirty to forty dollars per year, but can sell for much more than this registration fee.<sup>53</sup> For

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45. REED, *supra* note 39, at 41.

46. Jefferson F. Scher, *Swapping Claims in Cyberspace: Legal/Technical Context and Negotiation Strategies for Domain Name Deals*, 21 HASTINGS COMM. & ENT. L.J. 545, 556 (1999).

47. REED, *supra* note 39, at 38. For example, the physical world can handle duplication of names, such as "John Smith." If John Smith writes a book, the reader can still identify the one-and-only author by contacting the publisher or reading the author's biography. And the library has a system for shelving multiple books by different John Smith's (alphabetical order by title). On the Internet, however, there can only be one Smith.com. And if Joe Smith, rather than John Smith, operates his Web site at Smith.com, John Smith must choose a different domain name.

48. *Id.* at 42.

49. See *infra* note 90 and accompanying text (discussing the geographic nature of trademarks).

50. REED, *supra* note 39, at 42.

51. One such registrar is Verisign (now the parent company for Network Solutions, Inc. (NSI), another popular registrar). VeriSign Inc., at <http://www.netsol.com> (last visited Feb. 1, 2003). NSI was the first company to have exclusive control over domain name registration, but in 1998 its government contract ended and other groups were allowed to register domain names. Proffitt, *supra* note 34, at 604-05.

52. REED, *supra* note 39, at 39.

53. See Verisign, at <http://www.verisign.com> (last visited Mar. 17, 2002).

example, Ty, Inc. offered \$1000 to the registrant of ty.com.<sup>54</sup> A purchaser paid \$20,000 for madonna.com.<sup>55</sup> And business.com sold for \$7.5 million.<sup>56</sup> Upon registration, the domain name registrar checks with a master registry to ensure that the domain is not already registered, but performs no additional checks to ensure that the domain name will not infringe or dilute an existing trademark.<sup>57</sup> Therefore, the registrant must do her own research to lessen the chance of infringement or dilution liability for using the domain name.

The registrant's rights in the domain name derive from the registry contract; mere registration of a domain name does not create any intellectual property rights, including copyright or trademark rights.<sup>58</sup> When new top-level domains (TLD)<sup>59</sup> are created, registration in an existing TLD does not guarantee ownership of the same domain name in the new TLD.<sup>60</sup> The registrant must register the domain in the new TLD separately. Thus, the registration process is a largely self-guided, first come, first served system that potentially exposes the uninformed or ill-prepared registrant to legal liability.

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54. Adrian Wolff, *Pursuing Domain Name Pirates into Uncharted Waters: Internet Domain Names that Conflict with Corporate Trademarks*, 34 SAN DIEGO L. REV. 1463, 1484–85 (1997).

55. See *Ciccone v. Parisi*, WIPO Case No. D2000-0847, ¶ 4 (Oct. 12, 2000), available at <http://arbiter.wipo.int/domains/decisions.html/2000/d2000-0847.html>.

56. Drew M. Wintringham & Michael S. Lemley, *Cybersquatting in the Millennium*, THE METROPOLITAN CORP. COUNS., Feb. 2000, at 22.

57. REED, *supra* note 39, at 39. Infringement is a legally sanctionable act that interferes with the exclusive rights of a trademark owner and can be punishable by injunctive relief and damages. BLACK'S LAW DICTIONARY, *supra* note 2, at 785. Dilution is another legal claim whereby a trademark owner asserts that another party has diminished the value of the trademark by using it. *Id.* at 469.

58. REED, *supra* note 39, at 41.

59. Within the domain name, the "www" identifies that the page is part of the World Wide Web. The letters to the right of the last period are the top level domain (TLD), and the letters to the left of the last period are the second level domain (SLD). Proffitt, *supra* note 34, at 603. For example, in the domain name "www.sandiego.edu," edu is the TLD and sandiego is the SLD, or what is most commonly meant by the term "domain name." Generally only SLDs are considered in domain name disputes. *Experience Hendrix, L.L.C. v. Denny Hammerton*, WIPO Case No. D2000-0364, ¶ 7 (Aug. 15, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d0364.html> (respondent unsuccessfully arguing that the word "JimiHendrix.com" is distinctively different from the words "Jimi Hendrix"). Existing TLDs include .com for commercial applications, .org for organizations, .edu for educational institutions, .gov for government groups, and .net for network or computer related sites. The need for additional domain names increases as the Internet grows. Recently, for example, seven new TLDs were established. WIPO Arbitration and Mediation Center, *New gTLDs*, at <http://arbiter.wipo.int/domains/gtld/newgtld.html> (last visited Oct. 19, 2001). These TLDs include .aero (for the air-transport industry), .biz (for businesses), .coop (for cooperatives), .info (for unrestricted uses), .museum (for museums), .name (for personal names and individuals), and .pro (for lawyers, physicians, and accountants). SECOND WIPO REPORT, *supra* note 36, at 8–9.

60. Proffitt, *supra* note 34, at 604. For example, registering smith.com does not guarantee rights to smith.name.

## 2. Domain Names as Valuable Personal and Commercial Identifiers

Individuals and organizations generally choose domain names based on the name's semantic connection with the person's or group's name. Companies use three primary means of domain name selection. First, they often register the organization's name. For example, aba.org is easy for users to remember. The connection between the source (the American Bar Association, or ABA) and the Web site's content is easy for users to recognize. Second, organizations might register domain names that describes their activities. For example, Martindale-Hubble, a well-known resource for attorneys, registered the domain name "lawyers.com." Third, a domain name may be similar to a company's registered trademark or unregistered trade name. For example, IBM and Microsoft are registered trademarks in many jurisdictions, making their domain names, "ibm.com" and "microsoft.com," easily recognizable.<sup>61</sup>

Domain names have grown to be both personal and business identifiers.<sup>62</sup> As commercial activity on the Internet began increasing, businesses started using domain names as one of the standard modes of communication to identify themselves, their products, and their activities.<sup>63</sup> Newspaper, radio, and television advertisements often include the company's domain name along with other means of identification.<sup>64</sup> The domain name has become a standard part of a company's contact information.<sup>65</sup>

Possession of a domain name incorporating or capitalizing on a trademark or brand leads to increased sales, trades, and other

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61. REED, *supra* note 39, at 39. The value of domain names incorporating a company's mark has increasingly significant effects across several industries. Weston Anson, *The Million Dollar Domain Name*, MANAGING INTELL. PROP., May 1998, at 40 (The "concept of valuing domain names . . . , particularly ones linked to an established trade mark or brand, is increasingly a major issue, not only on the Internet but also on Wall Street and in other financial and legal circles.").

62. THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO DOMAIN NAME PROCESS ¶ 10 (1999), <http://www.icann.org> [hereinafter FINAL REPORT].

63. *Id.*

64. *Id.*

65. Note that while other types of contact information, such as a telephone or fax number, usually consist of anonymous strings of numbers that have no other significance, the domain name can be used to easily identify the company because it usually consists of words that make sense to the human mind. The domain name often carries an additional significance that is connected with the name or mark of a business or its product and services. *Id.*

transactions.<sup>66</sup> The “relatively small cost of registering a series of domain names does not compare to the hundreds or millions of dollars of value that those same domain names might carry in the future.”<sup>67</sup> Therefore, it is to each company’s benefit to increase traffic to its Web site to improve name recognition and increase business.<sup>68</sup> Competing with businesses for domain names are individuals, educational groups, and nonprofit organizations trying to register domain names and use the Internet for communication purposes.<sup>69</sup>

When multiple parties desire the same domain name, a need arises for mechanisms to resolve the issue of rightful ownership. Because domain name registration lies outside the typical boundaries of intellectual property, unique regulation is required for resolving disputes.<sup>70</sup> Enterprises having exclusive rights in a trademark or trade name have recourse to compel another registrant to cease use of a domain name under intellectual property law, while noncommercial domain name holders must seek other avenues for legal protection.<sup>71</sup> The question is whether such avenues exist under current dispute resolution policies.

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66. Anson, *supra* note 61, at 40.

67. *Id.*

68. See Barbara Anna McCoy, Comment, *An Invisible Mark: A Meta-Tag Controversy*, 2 J. SMALL & EMERGING BUS. L. 377, 397 (1998). As part of the commercial nature of the Internet, companies often try to lure users into their Web site when the user is searching for a competitor’s site. This is done primarily through the use of “metatags,” which are part of the programming code containing information about the content on the Web site. Tech Web, *Tech Encyclopedia*, at <http://www.techweb.com/encyclopedia/defineterm?term=metatag> (last visited Oct. 15, 2002). Because a consumer searching for a specific company on the Internet will likely use that company’s trademark as a search request, competitors will receive more hits on their sites if they include that company’s trademark in their metatag. Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 COLUM. J.L. & SOC. PROBS. 439, 441 (2000). When a company includes a competitor’s trademark in its metatags, both companies will show up in a search. *Id.* This practice is known as “manipulative metatagging,” and because it is the equivalent of “baiting” in the physical world, it may amount to trademark infringement, dilution, and unfair competition. *Id.*

69. See generally Brian Fitzgerald, *Software as Discourse: The Power of Intellectual Property in Digital Architecture*, 18 CARDOZO ARTS & ENT. L.J. 337 (2000).

70. See Falzone, *supra* note 44, at 294.

71. Because trademark law serves to protect consumers, it only protects marks of users who are “doing business.” See *infra* note 77 and accompanying text. By its nature then, trademark law excludes individuals from legal protection.

### III. TAKE YOUR PICK FOR RESOLVING THE DOMAIN NAME OWNERSHIP ISSUE: TRADEMARK LAW, LEGISLATIVE ACTION, OR PRIVATE RESOLUTION

The International Organization for Standardization (ISO)<sup>72</sup> has spent years developing uniform international standards for the Internet, but the public and commercial sectors have not been able to wait for this tediously slow process.<sup>73</sup> In response to market pressures, Internet developers continue using technology to expand the Internet's global presence.<sup>74</sup> Regulation has thus been primarily reactive, as the Internet has grown too quickly for anybody to proactively anticipate its regulatory needs.<sup>75</sup> As part of this explosive growth, demand for domains has created a need for new dispute resolution methods.<sup>76</sup> Unfortunately, existing law does not provide sufficient protection for users like Pokey who do not own trademarks in their names.

#### A. Trademark Law: Too Narrow to Address Personal Domain Names

Trademark law aims primarily to protect against consumer confusion.<sup>77</sup> Trademark owners may bring a dilution action under the

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72. The ISO is a nongovernment organization established to standardize worldwide activities, including intellectual property and Internet activities. International Organization for Standardization, at <http://www.iso.ch> (last visited Nov. 9, 2002).

73. KROL, *supra* note 34, at 13. As an early attempt to standardize Internet policies, an effort at cataloging all current domain names began in the 1970s. See Management of Internet Names and Numbers, 63 Fed. Reg. 31,741 (June 10, 1998). The remainder of Part III explores other attempts at standardizing Internet regulation.

74. See Luke A. Walker, *ICANN'S Uniform Domain Name Dispute Resolution Policy*, 15 BERKELEY TECH. L.J. 289, 290 (2000).

75. See *id.*

76. The need for dispute resolution arises out of what is often coined the "trademark problem"—determining who should retain rights to a domain name when two registrants each have legitimate claims to the name and one or both parties have trademarks. Falzone, *supra* note 44, at 294.

77. See The Lanham Act, 15 U.S.C. § 1052(d) (2000) (stating that no person may register a "mark or trade name previously used . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive"). Trademark law protects consumers from inferior goods by forcing businesses to claim responsibility for their products, and it protects businesses by preventing others from taking advantage of their goodwill. McCoy, *supra* note 68, at 397. See *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 873 (9th Cir. 1999) (outlining the functions of trademark law). Two relevant factors used in assessing the likelihood of confusion are (1) the existence of other legitimate uses for the mark and (2) the context of the mark within the domain name. *Ford Motor Co. v. Great Domains, Inc.*, 141 F. Supp. 2d 763,

Lanham Act<sup>78</sup> if use of their famous mark or name “begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”<sup>79</sup> Dilution claims protect trademark owners’ goodwill and reputation against unauthorized use and tarnishment of their mark.<sup>80</sup> The other common trademark claim is infringement, which requires a showing that the infringer’s use is commercial and is likely to cause consumer confusion.<sup>81</sup> The U.S. trademark system is a common law, use-based system, with optional registration on a registry with the Patents and Trademark Office (PTO).<sup>82</sup>

Under this use-based system, bona fide usage of the mark determines priority.<sup>83</sup> Because of its limited application to famous or commercial names and marks, the bona fide usage criterion precludes personal, noncommercial domain name registrants from protection under trademark

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776 (E.D. Mich. 2001). Under the second factor the court can take into consideration whether the registrant is likely to cause confusion by registering a domain that is a common typographical error of a legitimately trademarked name, such as mustan.com instead of mustang.com. *See id.*

78. Enacted in 1946 as the federal trademark statute under 15 U.S.C. §§ 1051–1127, the Lanham Act provides a national system for trademark registration and protection. BLACK’S LAW DICTIONARY, *supra* note 2, at 885. The Lanham Act operates independently of, and concurrently with, state law. *Id.*

79. 15 U.S.C. § 1125(c)(1) (2000). In deciding whether a mark is distinctive and famous, a court may consider the following nonexhaustive list of factors:

(A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

*Id.*

80. *Id.*

81. Infringement claims require a showing that use of the mark or name (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her own goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities.

*Id.* § 1125(a)(1).

82. Yan, *supra* note 1, at 780.

83. *See* 15 U.S.C. § 1127 (2000); Bell v. Streetwise Records, Ltd., 640 F. Supp. 575, 580 (D. Mass. 1986) (“Priority is established not by conception but by bona fide usage.”); La Societe Anonyme des Parfums LeGalion v. Jean Patou, Inc., 495 F.2d 1265, 1272 (2d Cir. 1974) (holding that the claimant “must demonstrate that his use of the mark has been deliberate and continuous, not sporadic, casual or transitory”).

law.<sup>84</sup> Under a domain name system dominated by trademark law, good faith registrants will lose their first-registered personal domain names to trademark owners.<sup>85</sup> Good faith users' claims will be denied under trademark analysis, virtually shutting out nontrademark owners' domain name ownership in cyberspace.

Although it protects consumers and trademark owners in the real world, trademark law fails to provide sufficient protection for the totality of Internet users in cyberspace for four reasons. First, trademark law only protects marks that are used commercially, therefore leaving a gap in protection afforded to noncommercial Internet users such as Pokey or nonprofit organizations that are not "doing business."<sup>86</sup> Second, trademark law allows for concurrent use of the same mark, as long as no consumer confusion is caused by the concurrent use.<sup>87</sup> Under this doctrine a traditional mark can be validly used by more than one party.<sup>88</sup> Concurrent use generally occurs where the two marks are used in different product lines or contexts. But because domain names cannot concurrently identify more than one source, concurrent registration is an impossible solution to domain name disputes, except across TLDs.<sup>89</sup> Third, typical trademark law allows for geographic limitations on a mark's use so that two parties can each have priority with respect to the

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84. See Walker, *supra* note 74, at 296.

85. See Proffitt, *supra* note 34, at 616 (discussing the premise that trademark holders generally win rights to domain names). Courts have tended to show deference to trademark rights, accepting the Internet as a commercial medium. *Id.* at 621.

86. 15 U.S.C. § 1051(a)(1) (2000) (permitting registration of trademarks that are "used in commerce"); see also Melinda Giftos, *Reinventing a Sensible View of Trademark Law in the Information Age*, 2 J. INTELL. PROP. 2 (2000), [http://www.kentlaw.edu/student\\_orgs/jip/Vol2No1/trademark.htm](http://www.kentlaw.edu/student_orgs/jip/Vol2No1/trademark.htm). "Doing business," defined liberally, must involve more than merely exchanging information over the Internet. *Desktop Tech., Inc. v. Colorworks Reprod. & Design, Inc.*, No. 98-5029, 1999 WL 98572, at \*5 (E.D. Pa. Feb. 25, 1999). Thus, to attain domain name rights by showing trademark protection, the registrant must overcome the hurdle of showing that products or services, not merely information, were exchanged over the Internet. See *id.*

87. 15 U.S.C. § 1052(d) (2000); see *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979) (noting that concurrent use of a trademark is permissible where there is no likelihood of consumer confusion).

88. 15 U.S.C. § 1052(d). Proposed solutions regarding the concurrent use issue in cyberspace include a graphically based Internet directory that would allow users to see trademarks in conjunction with logos, new TLDs for different classes of goods, or new TLDs for trademarks only. G. Gervaise Davis III, *Internet Domain Names and Trademarks: Recent Developments in Domestic and International Disputes*, 21 HASTINGS COMM. & ENT. L.J. 601, 623 (1999).

89. See *supra* note 42 (explaining how a domain name operates). For example, concurrent use of a mark across TLDs could exist under Ford.com and Ford.org.

same mark in different geographic regions.<sup>90</sup> With cyberspace's lack of geographic limitations, trademark law cannot adequately be applied, and parties that use the same mark in different territories may be in conflict when they both go online.<sup>91</sup> Fourth, the typically liberal granting of trademarks does not apply well in the context of domain names due to the first come, first served nature of domains, combined with the limited availability of word and spacing combinations.<sup>92</sup>

Fortunately, some courts recognize the limitations of trademark rights in cyberspace and do not automatically award trademark owners the rights to domain names that match their marks. The court in *Hasbro, Inc. v. Clue Computing, Inc.* determined that Clue Computing, Inc. had a stronger claim to clue.com even though Hasbro, Inc. owned a trademark for the game, Clue.<sup>93</sup> In his opinion, Judge Woodlock noted that Clue Computing had registered the name first and used its Web site to advertise its consulting and network design business and "does almost all of its business over the Internet," while only a small portion of Hasbro's business resulted from Internet sales of the game, Clue.<sup>94</sup>

Although this court deemed the domain name most valuable in the hands of the party who would make the best *commercial* use of it, the Pokeys of the Internet can rely on the holding to demonstrate that trademark rights are not absolute. The strength of trademarks are not necessarily determinative of domain name rights. The application of the case is limited, however, because the party that won the dispute still had to show commercial use of the mark. Thus, such a decision would probably not help protect noncommercial, personal names.

The court in *Strick Corp. v. Strickland* also made a progressive decision by narrowing the definition of "initial interest" consumer confusion.<sup>95</sup> The Strick Corporation, a transportation equipment manufacturer, sued James Strickland, a computer consultant who had

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90. Posner, *supra* note 68, at 449. Where the same trademark can be used in different geographic areas without causing consumer confusion, neither mark will infringe on the other. *Desktop Tech., Inc.*, 1999 WL 98572, at \*6 (dismissing the case for lack of personal jurisdiction over the Canadian company, subsequently allowing "Colorworks" to be separately protected in the U.S. and Canada).

91. Posner, *supra* note 68, at 449.

92. See Proffitt, *supra* note 34, at 613.

93. *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 117, 126 (D. Mass. 1999).

94. *Id.* at 123.

95. See generally *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372 (E.D. Pa. 2001). Initial Interest Confusion is a deliberate attempt to confuse consumers. An example of this type of action in the physical world would be Burger King putting an advertisement on the freeway advertising a McDonald's restaurant, so as to lure customers into Burger King. ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 690 (2d ed. 2000). An example of this in the Internet world would be Burger King registering the domain name "McDonalds.com" where it hosts a Burger King site, to attract consumers to Burger King's site.



registered his nickname as the domain name “strick.com.” Strick Corp. claimed that because they owned and had registered the trade name “Strick” with the PTO, they had stronger claims to the same domain. They further argued that if they did not own that domain name, initial interest consumer confusion would occur because consumers would realize they were at the wrong site and would have to use “an Internet search engine to find the right [site].”<sup>96</sup> The court, however, held that this type of initial interest confusion was “not substantial enough to be legally significant.”<sup>97</sup> The court also found that Strickland’s use of the domain name would not cause dilution of Strick Corp.’s trademark because of the difference in the nature of each party’s business.<sup>98</sup> Furthermore, the court supported the notion that “nothing in trademark law requires that title to domain names that incorporate trademarks or portions of trademarks be provided to trademark holders.”<sup>99</sup>

This case followed a commercial trademark analysis to examine a personal, noncommercial name registered as a domain and came out in favor of the nontrademark owner. This analysis demonstrates again that trademark rights are not absolute. A trademark owner cannot rely on an initial interest argument to trump the rights of a personal name registrant.

A California district court used a public policy rationale to bolster the current domain name registration system in *Academy of Motion Picture Arts & Sciences v. Network Solutions, Inc.*<sup>100</sup> The court found that in the interest of public policy the Academy could not compel Network Solutions, Inc. (NSI) to change its registration procedures to require the prescreening of registrants against a list of trademarks to prevent infringement and dilution. The court noted that such a prescreening process would change the nature of NSI’s business, slowing the registration process and increasing costs that would ultimately be passed along to consumers.<sup>101</sup>

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96. *Strick Corp.*, 162 F. Supp. 2d at 377; see also *TeleTech Customer Care Mgmt., Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1414 (C.D. Cal. 1997) (noting that initial interest confusion that dissipates once a viewer sees the Web site’s contents “is not cognizable under the trademark laws”).

97. *Strick Corp.*, 162 F. Supp. 2d at 377.

98. “[I]f a reasonable buyer is not at all likely to link the two uses of the trademark in his or her own mind, then there can be no dilution.” *Id.* at 378.

99. *Id.* at 380.

100. 989 F. Supp. 1276, 1281 (C.D. Cal. 1997).

101. *Id.* Using a famous mark as a domain name “cannot always be deemed proof” that registering the domain name was specifically intended to infringe or dilute the

If such prescreening were required, Mr. Van Allen would have learned immediately upon trying to register the domain that the name, “pokey.org,” contained a Prema trademark. Although this process would improve efficiency, it would deny individuals *any* name that contained a trademark. The problem here is the slippery slope. Could Chris Van Allen have pokey.name? Would he be precluded from registering Chris.com if a company such as Ruth’s Chris Steakhouse had a trademark and the word “Chris” was part of that mark? A system where the registrar must run a trademark search for all potential registrants would ultimately deny domain name rights to *any* personal name resembling a trademark. Pokey would lose rights to domain names that had personal meaning for him.

In *Ciccone v. Parisi* the dispute resolution panel<sup>102</sup> noted that “it would be a mistake to conclude that mere registration of a trademark creates a legitimate interest under the [dispute resolution] Policy.”<sup>103</sup> Madonna Ciccone, rock star Madonna, filed a complaint against Parisi, a cybersquatter who registered madonna.com.<sup>104</sup> Parisi had registered the trademark, “Madonna,” in Tunisia. However, the panel denied Parisi’s rights to the name, implying that he had registered in Tunisia only for the purpose of being able to claim *some* international trademark rights.<sup>105</sup> Thus, even arbitrators agree that the commercial value of the specific domain name should not automatically trump all other uses, but that the entirety of the circumstances must be considered.

Based on the above decisions, a nontrademark owner may sometimes use another’s trademark as his own domain name. Trademark owners must overcome the hurdle of showing a likelihood of confusion or dilution or alternatively showing that the registrant has tried to solicit payment for transferring the domain name to the trademark owner in order to exclude others from using the mark.<sup>106</sup> Although the above

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owner’s mark. *Ford Motor Co. v. Great Domains, Inc.*, 141 F. Supp. 2d 763, 775 (E.D. Mich. 2001) (noting that an Internet search of Ford’s trademark “Stang” produced valid Web sites for a variety of things, including personal Web pages, Mustang fan sites, a guitar sales site, and other car-related sites, therefore demonstrating “the broad, legitimate uses that may be made of protected marks in domain names”).

102. See discussion *supra* Part III.C (describing private domain name dispute resolution procedures).

103. *Ciccone v. Parisi*, WIPO Case No. D2000-0847, ¶ 6(c) (Oct. 12, 2000), available at <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0847.html>.

104. *Id.* ¶ 4; see *infra* note 106 (discussing the definition of cybersquatting).

105. *Ciccone*, WIPO Case No. D2000-0847, ¶ 6(c).

106. REED, *supra* note 39, at 76. This practice is also known as cybersquatting, which is defined as “registering an Internet name for the purpose of reselling it for a profit.” Tech Web, *Tech Encyclopedia*, at [http://www.techweb.com/encyclopedia/define\\_term?term=cybersquatting](http://www.techweb.com/encyclopedia/define_term?term=cybersquatting) (last visited Oct. 14, 2002). NSI policies were designed to ensure that domain name registrants were actually using the domain names rather than selling them for profit. But the registration fee has hardly deterred parties from buying

mentioned courts and tribunals show signs of equally protecting noncommercial Internet users, the majority of courts appear to stretch laws as much as possible to favor trademark owners.<sup>107</sup>

Protecting intellectual property rights in cyberspace will arguably decrease consumer confusion, encourage registration of trademarks, and protect companies' investment in their marks. One criticism of the current state of the domain name system is that the existing first come, first served policy does not respond *enough* to trademark owners.<sup>108</sup> As one critic noted: "Rather than rewarding the first person who attempts to register a domain name, the allocation of property rights over Internet domain names should favor those that have exerted greater efforts in establishing the distinctive qualities and fame of a trademark by applying trademark analysis."<sup>109</sup> Such a view, however, undermines the value of personal domain names. Identity, and thus one's personal name, are "fundamental attributes of the 'inherent dignity of the human person.'"<sup>110</sup> One's personal name helps create distinctiveness and individuality and further serves as a signal for associations others have with that person.<sup>111</sup> But thanks to the power and pervasiveness of technology, personal identities often get lost among the modern day enhanced visibility of public figures, leading businesses, sports stars, and

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domain names with the intent to sell them for profit later. Proffitt, *supra* note 34, at 605–06. Registration of certain domain names (such as microsoftoffice.com or Hollywood-Video.com) by third parties (cybersquatters) is seen as an investment. JEREMY HARRIS LIPSCHULTZ, *FREE EXPRESSION IN THE AGE OF THE INTERNET: SOCIAL AND LEGAL BOUNDARIES* 250 (2000).

107. In resolving domain name disputes "courts have generally given relief to trademark holders, validating the legitimacy of their complaints and recognizing the Internet as a predominantly commercial arena." Proffitt, *supra* note 34, at 616; *see Cardservice Int'l, Inc. v. McGee*, 950 F. Supp. 737 (E.D. Va. 1997) (holding that where the defendant acted in bad faith after initiation of the trial, rights to the domain name of the plaintiff's trademark would remain with the plaintiff, thus strengthening the connection between trademark rights and domain name rights); *Panavision Int'l v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996) (awarding domain name transfer to Panavision, the trademark owner), *aff'd*, 141 F.3d 1316 (9th Cir. 1998). On the other side of the coin, registering a domain name is generally insufficient for the trademark owner to bring an infringement or dilution action unless the name was already registered as a trademark. REED, *supra* note 39, at 46.

108. Ughetta Manzone, *Intellectual Property: Trademark: Dilution: Panavision International, L.P. v. Toeppen*, 13 BERKELEY TECH. L.J. 249, 258 (1998).

109. *Id.*

110. SECOND WIPO REPORT, *supra* note 36, at 84 (quoting the International Covenant of Civil and Political Rights).

111. *Id.* ("The importance of personal names to dignity is evident from the dark days of totalitarianism and nazism, when names were only numbers.").

entertainment personalities.<sup>112</sup> The burying of personal identities of nonfamous individuals in this environment makes protection of personal names even more imperative.

The first come, first served policy fails to satisfy proponents on both sides of the argument. Individuals like Pokey argue that the policy deprives the public of the opportunity to fairly compete for domain names. This type of registrant therefore might next look to legislation to find protection.

### *B. Legislative Regulation: Another Dead-End for Noncommercial Parties*

Although the U.S. government maintains oversight of the Internet, strong movements have been made toward privatization, rather than toward government regulation.<sup>113</sup> Thus in the absence of legislation, few cyber cases can be resolved under statutory law outside of the Lanham Act. One avenue for legal protection against a narrow class of claimants is the Anticybersquatting Consumer Protection Act (ACPA), which was signed into law on November 29, 1999.<sup>114</sup> This Act provides a cause of action for registration, trafficking in, or use of “a domain name that . . . is identical or confusingly similar to . . . or dilutive” of the mark or name of another.<sup>115</sup> The ACPA is narrowly tailored to address cases of “bad faith intent to profit”<sup>116</sup> from the trademark holder’s goodwill and does not extend to cases where the registrant was unaware of such trademark ownership or registered for use other than intent to profit.<sup>117</sup>

The ACPA has a narrow application to domain name disputes

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112. *Id.*

113. Management of Internet Names and Addresses, 63 Fed. Reg. 31,741, 31,744 (June 10, 1998).

114. John F. Delaney & M. Lorrane Ford, *The Law of the Internet: A Summary of U.S. Internet Caselaw and Legal Developments*, in COUNSELING CLIENTS IN THE NEW ECONOMY: OPPORTUNITIES FOR THE EMERGING AND ESTABLISHED COMPANY 103, 116–17 (PLI Corp. L. & Practice Course, Handbook Series No. B-1244, 2001).

115. See 15 U.S.C. § 1125(d)(1)(A)(ii)(II) (2001).

116. See *id.* § 1125(d)(1)(A)(i).

117. Delaney & Ford, *supra* note 114, at 239. In determining whether a registrant has acted in bad faith, a court may consider the following factors: (1) existing trademark rights in the domain name, (2) *the use of a personal name as the domain name*, (3) registrant’s use of the domain name in offering goods or services, (4) registrant’s bona fide *noncommercial* use of the mark, (5) registrant’s attempts to divert consumers onto its site by causing initial interest confusion, (6) offers to sell or transfer the domain name for remuneration, (7) use of false contact information, (8) acquisition of multiple domain names, and (9) the extent to which the mark is not distinctive and famous. 15 U.S.C. § 1125(d)(1)(B)(i). The statute therefore lays the foundation for enabling certain bona fide, good faith, noncommercial uses of a domain name to trump trademark owners’ rights to the domain. This statute provides no solid “use in commerce” requirement. See *id.*

involving personal names.<sup>118</sup> This Act sets a foundational requirement that both the registrant and the trademark owner must act in good faith.<sup>119</sup> The good faith requirement provides some protection for users that register their personal names. The broadly defined element of good faith can be shown if the registrant registers his personal name or has another bona fide, noncommercial claim to the domain.<sup>120</sup>

Even though the ACPA addresses good faith, noncommercial registrants like Pokey, it applies only where the registered domain name contains a trademark.<sup>121</sup> Individuals cannot avail themselves of this legislation if they have not registered their names as trademarks. Furthermore, because the ACPA only protects domains in commercial use, it potentially leaves open the possibility of cybersquatters in a different form—those registering personal names in bulk. Cybersquatters then might not be barred from registering johnsmith.com or janesmith.com and later selling these domain names to individuals at a premium.

In *Jack in the Box, Inc. v. Jackinthebox.org*, the court used the ACPA to find that mere registration of a domain name could per se violate trademark rights.<sup>122</sup> In this case an individual had registered jackinthebox.org, and the trademark owner, Jack in the Box, Inc., sued to have the domain name transferred. While noting that pretextually, mere registration of the domain did not violate the plaintiff's trademark rights, such registration was sufficient to invoke protection under a jurisdictional provision in the ACPA.<sup>123</sup> Therefore, the domain name was transferred to the trademark owner.<sup>124</sup>

The two exceptions to the ACPA are domain names registered in good faith and domain names used in, or related to, a “work for hire.”<sup>125</sup>

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118. See 15 U.S.C. § 1125(d).

119. *Id.*

120. *Id.* § 1125(d)(1)(B)(i). Note also that a court usually will not find for a trademark owner where the owner has *knowingly* and *materially* misrepresented to a domain name registrar that the registrant of the trademark as a domain name is infringing. Delaney & Ford, *supra* note 114, at 241. Both injunctive relief and damages are available to the domain name registrant when the trademark owner has acted in bad faith. *Id.*

121. 15 U.S.C. § 1125(d).

122. *Jack in the Box, Inc. v. Jackinthebox.org*, 143 F. Supp. 2d 590, 591 (E.D. Va. 2001).

123. Mere domain name registration was held sufficient to invoke in rem jurisdiction under the ACPA. *Id.* at 591–92.

124. *Id.* at 592.

125. Delaney & Ford, *supra* note 114, at 241. Motion picture companies and music

Absent either of these defenses, remedies under the ACPA include damages between \$1000 and \$100,000 per domain name, plus forfeiture, cancellation, or transfer of the domain to the owner of the mark or personal name.<sup>126</sup> But for those parties not eligible to seek legal protection through the ACPA, another potential solution exists—dispute resolution tribunals.

### C. Private Dispute Resolution: A Flawed but Potential Solution

Some recently created dispute resolution tribunals provide a good starting point for equitable distribution of domains. However, the policies governing these dispute resolution procedures do not adequately address noncommercial registrants' rights. The definition of the Internet as a fully public and globally owned entity—rather than semiprivate—is an important distinction in understanding current dispute resolution procedures.<sup>127</sup> No one group owns or runs the Internet.<sup>128</sup> Just as the Internet has no single owner or operator, it has no single source of financial support; each individual user pays to connect to the network.<sup>129</sup> This decentralized financial structure adds to the lack of centralized regulation; no single group can regulate by wielding financial influence.<sup>130</sup>

Furthermore, the Internet was initially designed to encourage self-determination and independence.<sup>131</sup> The ability to choose one's own level of participation in cyberspace and to control the information received through it are part of self-determination. But "self-determination is *defined* by the absence of government control."<sup>132</sup> Meanwhile, cyber disputes are arising over various issues, including domain names.

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labels are said to have an interest in a celebrity's name as a domain where they are concerned that domain name use could negatively impact marketing efforts or campaigns for the stars. *Id.* at 264. So under the ACPA the owner of a "work made for hire" (such as a movie) has rights to use an individual's name as a domain name so long as they legitimately use that person's name to market the specific work. *Id.* at 264–65.

126. 15 U.S.C. § 1129 (2000); see Delaney & Ford, *supra* note 114, at 240. In addition to the ACPA, states have enacted legislation to deal with cyber issues. California enacted chapter 218 of the Business and Professions Code. This statute protects personal names from cybersquatters by (1) no longer requiring proof of specific intent to profit and (2) extending protection to the names of all living and deceased personalities, not just those who were famous at the time of the domain name's registration. Eric J. Moore, *Chapter 218: Stopping Cybersquatters from Harming one of California's Valuable Resources: Hollywood*, 32 MCGEORGE L. REV. 495, 504 (2001).

127. Mary J. Cronin, *Privacy and Electronic Commerce*, in PUBLIC POLICY AND THE INTERNET: PRIVACY, TAXES, AND CONTRACT 1, 11 (Nicholas Imparato ed., 2000).

128. ALLISON, *supra* note 26, at 30. By design, the Internet was intended to operate via independently functioning networks. *Id.* at 31.

129. KROL, *supra* note 34, at 17.

130. *Id.* at 16.

131. See discussion *supra* Part II.A.

132. ALLISON, *supra* note 26, at 43.

Herein lies the problem with Internet regulation—it was designed to require no single source of regulation, while our judicial and legislative structures require some control on this method of communication.

Three primary groups were established to regulate various aspects of the Internet: Internet Society (ISOC), Internet Corporation for Assigned Names and Numbers (ICANN), and the World Intellectual Property Organization (WIPO).<sup>133</sup> These international regulatory bodies were necessary because large scale government regulation in cyberspace is both undesirable and dangerous for consumers.<sup>134</sup> Because the Internet operates under policies of decentralization and self-determination, the government could never adequately punish those posting false, misleading, or otherwise controversial information while maintaining self-determination for all users. Furthermore, federal or state government enforced privacy protections or large scale sponsorship of the Internet might lull consumers into believing that the government endorses the content on individual Web sites and lead consumers to trust such sites. Thus, the government must maintain a somewhat hands-off policy.<sup>135</sup> Therefore, these groups seek to provide necessary regulatory structure by creating policies for expansion and dispute resolution.<sup>136</sup>

The first regulatory group, ISOC, was initiated in 1991 as an international, nonprofit corporation aimed at globalizing the Internet and making it a widely available resource.<sup>137</sup> By agreement of its members, ISOC's responsibilities include creating voluntary technical standards and managing Internet addresses (domain names).<sup>138</sup> Membership in ISOC is voluntary,<sup>139</sup> and the organization's primary purpose is promoting

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133. See *infra* notes 135–73 and accompanying text.

134. See ALLISON, *supra* note 26, at 43.

135. *Id.*

136. See discussion *supra* Part III.C.

137. Internet Society, *All About the Internet Society*, at <http://www.isoc.org/isoc/general> (last visited Jan. 9, 2002).

138. ALLISON, *supra* note 26, at 30. Within ISOC is a smaller council of ISOC members called the Internet Architecture Board (IAB). IAB meets regularly to bless the agreed upon standards and allocate resources such as Internet addresses. While it does not actually assign the addresses or domain names, the board makes rules governing *how* the addresses are assigned. The Internet Engineering Task Force (IETF) is another volunteer organization that meets to discuss operational and technical problems with the Internet. KROL, *supra* note 34, at 16.

139. KROL, *supra* note 34, at 16. ISOC's membership is open to any interested party or organization. The organization serves as a "means of enabling organizations, professions, and individuals worldwide to more effectively collaborate, cooperate, and innovate." Internet Society, *supra* note 137, at <http://www.isoc.org/isoc/general>.

global information exchange through Internet technology.<sup>140</sup> ISOC has also tried to promote etiquette standards for behavior on the Internet, otherwise known as “netiquette.”<sup>141</sup> Although ISOC has been vital in promoting Internet use and defining standards for users, it provides no forum for resolving legal disputes.

The second key group in Internet regulation is ICANN, which has evolved significantly from its roots in the Internet Network Information Center (InterNIC). The U.S. government’s National Science Foundation created InterNIC in January 1993 to provide technical oversight of the Internet’s growth and development.<sup>142</sup> InterNIC delegated the task of domain name registration to Network Solutions, Inc. (NSI), a private company.<sup>143</sup> NSI won a five-year, \$5.9 million exclusive contract for domain name registration rights from 1993 through October 1998.<sup>144</sup>

NSI’s inefficiency made it an unsuitable dispute resolution forum.<sup>145</sup> There were several additional concerns about NSI’s operations, the greatest of which was its lack of a policy for domain name dispute resolution.<sup>146</sup> Under the inefficient NSI registration system, registrants could place domain names on hold if there was a dispute as to ownership rights, as long as they had some claim to that name under trademark law, even if that claim was weak.<sup>147</sup> NSI’s policy was too broad to protect good faith registrants without trademarks, because their domain rights were trumped in favor of parties with barely sufficient claims, such as ownership of a trademark in a remote geographical region.<sup>148</sup> Trademark owners complained that the policy was too narrow and failed to protect their trademarks, even where a likelihood of consumer confusion existed.<sup>149</sup>

In response to complaints, the Department of Commerce issued two

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140. KROL, *supra* note 34, at 16.

141. John R. Patrick & Nicholas R. Trio, *Internet Usage Guidelines in a Commercial Setting*, at <http://www.isoc.org/HMP/PAPER/122/html/paper.html> (last updated Apr. 30, 1995).

142. Proffitt, *supra* note 34, at 604.

143. *Id.* at 602.

144. *Id.* at 602–04. This monopoly was intended to promote development of uniform, consistent policies and procedures for domain name registration. *Id.* at 604–05.

145. A list of complaints regarding NSI’s exclusive contract were addressed in the Department of Commerce’s article, *Management of Internet Names and Numbers*, also known as the “White Paper.” *Management of Internet Names and Numbers*, 63 Fed. Reg. 31,741 (June 10, 1998). Several concerns were included: widespread dissatisfaction with lack of competition for domain name registration that led NSI to charge high fees and provide poor customer service, lack of management structure to adequately deal with the growing number of commercial interests, and the need to add new TLDs in an organized manner as the value of domain names increased. *Id.* at 31,742.

146. *Id.*

147. Walker, *supra* note 74, at 296.

148. *See id.*

149. *Id.*



documents, the first one called the “Green Paper” and then a second called the “White Paper,” where it acknowledged that “[c]onflicts between trademark holders and domain name holders are becoming more common” and that existing “[m]echanisms for resolving these conflicts are expensive and cumbersome.”<sup>150</sup> Because of the growing need for new ways to address demands, the Green and White Papers declared the need for a private, nonprofit organization, independent of the government, to centralize domain name system management.<sup>151</sup> When NSI’s five-year contract was up, ICANN was born.<sup>152</sup>

ICANN was incorporated in November 1998 with the mission of “operat[ing] for the benefit of the Internet community *as a whole*, carrying out its activities in conformity with relevant principles of international law and applicable international conventions and local law.”<sup>153</sup> Therefore, ICANN’s goal was broad protection of *all* Internet users’ rights, not merely commercial groups or trademark owners. It appears that ICANN failed to meet this goal, however, in developing its policies for domain name disputes, as commercial groups are disproportionately awarded domain name rights at the expense of Pokeys with good faith claims.<sup>154</sup>

ICANN issued a list of approved providers to hear the disputes.<sup>155</sup> These providers included CPR Institute for Dispute Resolution (CPR),<sup>156</sup> the Asian Domain Name Dispute Resolution Center (ADNRC),<sup>157</sup> eResolution (eRes),<sup>158</sup> the National Arbitration Forum (NAF), and the World Intellectual Property Organization (WIPO). WIPO is the most

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150. *Id.*; Management of Internet Names and Addresses, 63 Fed. Reg. at 31,741, 31,742. NSI’s first come, first served registration policy was insufficient to deal with these complicated issues. Walker, *supra* note 74, at 295.

151. Walker, *supra* note 74, at 296–97.

152. See Proffitt, *supra* note 34, at 603.

153. ICANN, *Articles of Incorporation of Internet Corporation for Assigned Names and Numbers*, at <http://www.icann.org/general/articles.htm> (last revised Nov. 21, 1998) (emphasis added).

154. Delaney & Ford, *supra* note 114, at 265.

155. ICANN, *Approved Providers for Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/approved-providers.htm> (last modified Mar. 1, 2002).

156. CPR was approved to hear twenty proceedings during the first two months after its approval in May 2000. *Id.*

157. Alan N. Harris, *ABA Section of Litigation Intellectual Property Committee, September, 2002 Roundtable Outline*, at [www.abanet.org/litigation/committee/intellectual/sept02outline.pdf](http://www.abanet.org/litigation/committee/intellectual/sept02outline.pdf) (last visited Feb. 1, 2003).

158. eRes accepted disputes only through November 30, 2001. ICANN, *supra* note 155, at <http://www.icann.org/udrp/approved-providers.htm>.

popular dispute resolution forum, followed next by NAF.<sup>159</sup> Remedies under ICANN's policy include forfeiture, cancellation, or transfer of the domain name to the owner of the mark or personal name.<sup>160</sup>

WIPO is a specialized United Nations agency responsible for carrying out international convention decisions regarding intellectual property rights.<sup>161</sup> Parties in domain name disputes often prefer to arbitrate through WIPO to avoid the expense and prolonged nature of federal litigation.<sup>162</sup> ICANN adopted several WIPO recommendations for resolving domain name disputes.<sup>163</sup> To help decide domain name disputes, ICANN issued the Uniform Domain Name Dispute Resolution Policy (UDRP), a list of criteria that a complainant must meet to win a dispute in WIPO arbitration.<sup>164</sup> WIPO admits that the UDRP will likely offend various parties.<sup>165</sup> Clearly one offended group includes individuals like Pokey with personal claims to their domains. But WIPO goes on to recommend that no modifications be made to the existing UDRP with

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159. Eric J. Sinrod, *E-Legal: Fixing the Domain Name Dispute Process*, at <http://www.law.com/servlet/ContentServer?pagename=OpenMarket/Xcelerate/View&c=LawArticle&cid=1015973982197&live=true&cst=1&pc=0&pa=0> (Sept. 4, 2001).

160. ICANN, *Uniform Domain Name Dispute Resolution Policy*, § 4(i), at <http://icann.org/udrp/udrp-policy-24oct99.htm> (Oct. 24, 1999).

161. World Intellectual Property Organization, *About WIPO*, at <http://wipo.org/about-wipo/en/> (last visited Feb. 1, 2003).

162. Delaney & Ford, *supra* note 114, at 265.

163. *Id.* To help guide domain name dispute resolution and protect trademark owners, WIPO outlined seven factors for determining whether a mark being used as a domain is well known: (1) the degree of knowledge or recognition of the mark in the relevant public sector; (2) the duration, extent, and geographical area of the mark's use; (3) the duration, extent, and geographical area of advertisement and publicity of the mark; (4) the duration and geographical area of registration(s) for the mark; (5) any history of successful enforcement of rights in the mark; (6) value associated with the mark; and (7) "evidence of the mark being the subject of attempts by nonauthorized third parties to register the same or misleadingly similar names as domain names." FINAL REPORT, *supra* note 62, at 189.

164. The complainant must make a three-part showing that: (1) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (2) the current registrant of the domain name has no rights or legitimate interests in respect of the domain name, and (3) the domain name was "registered and is being used in bad faith." ICANN, *supra* note 160, § 4(b), at <http://www.icann.org/udrp-policy-24oct99.htm>. For purposes of finding for bad faith registration, the following nonexhaustive list of factors will be used: (1) the domain name was acquired primarily for the "purpose of selling, renting, or otherwise transferring the domain registration" for profit; (2) the domain name was registered "to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name," provided that the respondent has "engaged in a pattern of such conduct;" (3) the domain name was registered primarily "for the purpose of disrupting the business of a competitor;" or (4) the respondent has "intentionally attempted to attract, for commercial gain, Internet users to [their] 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 the site. *Id.* § 4(b), at 2-3.

165. SECOND WIPO REPORT, *supra* note 36, ¶ 199, at 85.

respect to those offended parties.<sup>166</sup> The UDRP to date remains inflexible. Fortunately, WIPO is in the process of re-evaluating the UDRP. In these evaluations, WIPO should consider the offended rights of the class of Internet users that, like Pokey, have personal claims to a domain.

Each of the above avenues for legal recourse has some merit, but noncommercial Internet users like Pokey have no fully adequate forum in which to receive a fair hearing in domain name disputes. Trademark law only addresses commercial use of names and marks, thereby excluding individuals from its scope of protection.<sup>167</sup> The legislative system has incentive to remain hands off and therefore provides only limited protection under the ACPA, granting protection only in cases where the first registrant has acted with intent to profit.<sup>168</sup> Again, this excludes noncommercial users from protection because their value in the name is personal, not profit oriented. Furthermore, a study conducted by University of Ottawa Law School Professor Michael Geist showed that three-judge panels are more likely to consider both sides of an argument and find for trademark holders less frequently than single-judge panels, demonstrating that biases exist.<sup>169</sup> The biggest flaw in the current arbitration procedure is that the arbitrations do not create binding precedents that can be used to decide future cases.<sup>170</sup>

ICANN's policy fails to address matters that do not involve bad faith domain name holders; the policy cannot be invoked where the domain name holder is merely *using* (as opposed to *selling*) the domain name, leaving only the first come, first served policy to govern.<sup>171</sup> Finally,

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166. *Id.* ¶ 200, at 85.

167. See discussion *supra* Part III.A.

168. Delaney & Ford, *supra* note 114, at 239–40 (listing the factors used in determining whether domain name registration was in bad faith).

169. Angwin, *supra* note 16, at B1. Single judge panels found for trademark holders in eighty-three percent of dispute resolution cases according to the study, whereas three-judge panels were pro trademark holder in only sixty percent of the cases. The discrepancy is largely attributed to the divergent viewpoints and critical analysis provided when more than one judge discusses the case. Further complicating matters is the fact that parties with fewer resources tend to opt for one-judge panels, which cost between \$1500 and \$2000, while those with more resources can afford the \$4000 to \$5000 that a three-judge panel costs. WIPO Arbitration and Mediation Center, Schedule of Fees under the ICANN UDRP Policy (Dec. 1, 2002), at <http://arbitrator.wipo.int/domains/fees/index.html> (last visited Feb. 1, 2003).

170. Adam Liptak, *Welcome to Our Law School, Young Man. We'll See You in Court*, N.Y. TIMES, May 6, 2002, at A12.

171. Walker, *supra* note 74, at 299. The U.S. district court in Virginia noted that a policy such as NSI's first come, first served registration "cannot trump federal law," and trademark rights will therefore dominate the outcome of the case. *Cardservice Int'l, Inc.*

under the current policy, all a party must do to initiate the inconvenient, time consuming arbitration process, is file a complaint with an approved dispute resolution provider.<sup>172</sup> These bare bones requirements shift the burden of showing valid registration onto the domain name holder, who is often an average individual like Pokey or Mr. Van Allen, whereas the complainant is frequently a large business with significant resources to pursue endless legal action.<sup>173</sup>

#### IV. REDESIGNING CYBERLAW TO GIVE POKEY HIS DOMAIN NAME BACK

The inadequacies of the existing systems in protecting individuals and other noncommercial Internet users indicate the need for reform in policies governing dispute resolution. The Internet has grown undeniably quickly due to its commercial support,<sup>174</sup> but new policies must be developed to address more than just the needs of commercial Internet users.<sup>175</sup> Focusing on “promot[ing] continued growth in Internet use by consumers”<sup>176</sup> is not the best approach to shaping reform. Such a focus risks overlooking the Internet’s role in education, communication, and entertainment.<sup>177</sup> Furthermore, WIPO considered the importance of recognizing *all* functions of the Internet and avoiding a policy that focuses primarily on one function.<sup>178</sup> To be in line with its own observation, WIPO must expand its focus and scope of protection beyond commercial Internet users. At the heart of this debate, then, is

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v. McGee, 950 F. Supp. 737, 740 (E.D. Va. 1997), *aff’d*, 129 F.3d 1258 (4th Cir. Nov. 18, 1997).

172. ICANN, *Frequently Asked Questions*, at <http://icann.org/general/faq1.htm> (last visited Jan. 5, 2002).

173. Davis III, *supra* note 88, at 614. Arguably, this policy is unconstitutional in that it potentially deprives registrants of property rights in the domain name without any due process. *Id.*

174. Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc., 202 F.3d 489, 493 (2d Cir. 2000).

Over the last few years, the commercial side of the Internet has grown rapidly. Web pages are now used by companies to provide information about their products in a much more detailed fashion than can be done through a standard advertisement. Moreover, many consumers and businesses now order goods and services directly from company web pages.

*Id.*

175. Walker, *supra* note 74, at 303–04 (“[T]he focus should shift from attempting to represent the interests of the domain name holder against the often conflicting interests of the trademark owner to a focus on representing the interests of the Internet users, both corporate and individual.”).

176. *Id.* at 304.

177. Commercial users, while prevalent, are not the only members of the online community. Yan, *supra* note 1, at 787–88.

178. SECOND WIPO REPORT, *supra* note 36, ¶¶ 64–66, at 21.

whether Internet domain name dispute policy will fairly serve the greatest number of users—the Internet community—by adding safeguards for those who use the Internet for educational, communication, and entertainment purposes or whether it will deny these users’ rights and instead protect the Internet as a primarily commerce-based resource.

A. *Expanding on Current Policy to Protect Personal Domain Name Registration*

A long line of cases demonstrates support for trademark owners’ domain name rights. In the leading trademark domain name case of *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, the Ninth Circuit enjoined West Coast, Brookfield’s competitor, from using Brookfield’s trademark in its domain name and metatags.<sup>179</sup> Both parties used Web sites to provide searchable databases with information about the entertainment industry. West Coast registered a service mark in the phrase “The Movie Buff’s Movie Store” in 1991, and in 1998 announced its intention to operate a site called “moviebuff.com” after registering that domain name.<sup>180</sup> Brookfield had received a trademark in its “moviebuff” mark in 1998, but when it attempted to register the matching domain name, Brookfield learned that West Coast had already registered it. Brookfield then sent a cease and desist letter to West Coast in 1998, asserting that the planned Web site would violate Brookfield’s trademark rights.<sup>181</sup> When West Coast continued with its plan, Brookfield filed suit in California district court, alleging, among other things, that West Coast infringed on its trademark.<sup>182</sup>

Ultimately, the court of appeals found that Brookfield had demonstrated a likelihood of success on the claims of senior use of its trademark in commerce and consumer confusion.<sup>183</sup> The court applied trademark analysis to domain name rights to determine that the senior trademark use entitled Brookfield to the domain name.<sup>184</sup> As the first domain name case heard on appeal, *Brookfield Communications* shows that rights to a trademarked domain name require a showing of sufficient

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179. *Brookfield Communications, Inc. v. West Coast Entm’t, Corp.*, 174 F.3d 1036 (9th Cir. 1999); *see supra* note 68 (discussing metatags).

180. *Brookfield*, 174 F.3d at 1042.

181. *Id.*

182. *Id.* at 1043.

183. *Id.* at 1053, 1062.

184. *Id.* at 1053.

use of the mark, and such use must consist of more than just domain name registration. This case paved the way for trademark holders to police their marks in cyberspace.<sup>185</sup> But it does so at the expense of noncommercial domain name registrants by focusing on Brookfield's financial investment in the name and considering which user demonstrated the first use in *commerce*.<sup>186</sup> A registrant like Pokey could not avail himself of this decision because his claim is personal, not commerce based. This focus on financial investment shows the value courts place on the Internet's commercial applications. This favoritism carries over into decisions so that noncommercial users do not get a fair shake in disputes.

If courts and dispute resolution tribunals continue using trademark analysis to settle disputes, they must consider all trademark claims. In the cases decided to date, courts have tended to hold in favor of the larger companies and trademark owners.<sup>187</sup> However, the types of cases at issue here warrant different consideration. Such cases more closely resemble reverse trademark infringement<sup>188</sup> than straight infringement.

Consider *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*<sup>189</sup> In the fall of 1973, Big O Tire Dealers introduced the "BigFoot" product line.<sup>190</sup> In the winter of 1973 Goodyear also introduced a "Bigfoot" product line.<sup>191</sup> Big O, a small company with a total net worth of only \$200,000, brought an action for common law trademark infringement against Goodyear, which had 1974 net sales of \$5.25 billion.<sup>192</sup> Goodyear then tried to obtain permission from Big O to use the Bigfoot name, but Big O refused.<sup>193</sup> Goodyear forged ahead with its campaign and Big O then filed suit.<sup>194</sup>

The Tenth Circuit held that Goodyear's actions constituted reverse trademark infringement and that finding for Goodyear would serve to "immuniz[e] from . . . liability . . . a company with a well established trade name and with the economic power to advertise extensively for a

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185. See Lawrence F. Grable, Note, *Cyber Pirates, Looting Trademarks on the Internet: Brookfield v. West Coast*, 36 TULSA L.J. 235, 235-36 (2000).

186. *Brookfield*, 174 F.3d at 1051, 1053.

187. See generally *id.* But see Giacalone v. Network Solutions, Inc., No. C-96 20434 RPA/PVT, 1996 WL 887734, at \*1 (N.D. Cal. June 14, 1996).

188. Reverse infringement is the practice of a large company riding on a smaller company's goodwill. MERGES ET AL., *supra* note 95, at 792.

189. 561 F.2d 1365 (10th Cir. 1977).

190. *Id.* at 1367-68.

191. *Id.* at 1368. Only Goodyear successfully registered with the PTO, although Big O had common law trademark rights. *Id.*

192. *Id.* at 1367-68.

193. *Id.* at 1368.

194. *Id.*

product name taken from a competitor.”<sup>195</sup>

This type of analysis could apply to registrants like young Pokey. Prema, a large company with extensive financial resources much like Goodyear, stepped onto the scene and wanted the same name that Chris had already registered.<sup>196</sup> And like reverse trademark infringement cases, both parties had some claim to the name, but the party with a more widely recognized name (Prema) made use of the smaller party’s resources (Pokey’s first-registered domain). In Big O’s case the resource was the marketing value of the word “Bigfoot.” Unless courts protect the small company or individual, “anyone with adequate size and resources” could infringe on the rights of others.<sup>197</sup>

There is further risk that large companies will wield their trademark power to lay claim to any suit they can, spreading their Internet presence as widely as possible. Prema, for example, was late to enter cyberspace and therefore made desperate attempts to snatch up the domains matching its trademarks that were still available.<sup>198</sup> Never mind that Prema would try to take these domains from twelve-year-old kids or owners of legitimate businesses, such as another company called Prema that makes integrated circuits.<sup>199</sup> If such actions continue, cyberspace will become a looting zone, where big companies can pirate the domains that others have registered with legitimate, good faith claims.

WIPO has similarly used trademark law in its decisions, such as *Experience Hendrix, L.L.C. v. Hammerton*, decided in August 2000.<sup>200</sup> Denny Hammerton was first to register the domain name “jimihendrix.com,” and used it in good faith to operate a fan club Web site.<sup>201</sup> But the single-judge panel denied rights to Hammerton in favor of trademark owner Experience Hendrix, the executor of Jimi Hendrix’s

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195. *Id.* at 1372. Whereas standard infringement cases “involve a claim by a plaintiff with a substantial investment in a well established trademark,” reverse infringement occurs where the “infringer’s use of the plaintiff’s mark results in confusion as to the origin of plaintiff’s product.” *Id.* at 1371. Reverse infringement involves a famous company using the mark of a smaller, less famous company. *See id.*

196. Clausing, *supra* note 11.

197. *Big O Tire Dealers, Inc.*, 561 F.2d at 1372.

198. Flaherty, *supra* note 12, at 1. Prema has engaged in disputes with other first-registrants regarding domains matching their trademarks. *Id.*

199. *Id.*

200. *Experience Hendrix, L.L.C. v. Hammerton*, WIPO Case No. D2000-0364 (Aug. 15, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0364.html>.

201. *Id.* ¶ 5.

estate.<sup>202</sup> The tribunal determined that the commercial trademark rights outweighed the fan's right to create a Web site for entertainment purposes. WIPO's decision under the UDRP, much like trademark law, leaves good faith registrants that want to operate entertainment or noncommercial sites without legal recourse.

In cases like these, the courts and dispute resolution tribunals appear to ignore the importance of allowing Internet users such as young Chris "Pokey" Van Allen or Denny Hammerton the rights to protect their personal names or phrases that have personal significance.<sup>203</sup> Continuing to deny individuals use of their personal names will allow commercial parties to have a greater presence than noncommercial parties in cyberspace. The problem is that the Internet is a medium for "cultural exchange, political expression and social communication" in addition to being a resource for commerce.<sup>204</sup> Internet users "reflect, or potentially reflect, the diversity of the world's population."<sup>205</sup> If these individual users are not permitted to keep their personal domain names, the Internet's value as a tool for diverse communication, expression, and education will be buried by profit seeking domain name registrants.

ICANN's UDRP generally favors big businesses and commercial entities,<sup>206</sup> but still contains elements of support for noncommercial Internet users. WIPO noted that the dispute resolution policy is "not designed to combat trademark infringement on the Internet or even questionable cases of cybersquatting, but rather, abusive, bad faith cybersquatting."<sup>207</sup> The tribunal thereby recognized that the existing policy is not exclusively aimed at protecting trademarks. Therefore the policy may allow for its application to personal name registration and would thereby protect this class of Internet users.

To win a domain name dispute under the UDRP, a complainant must prove the following three elements: (1) the domain name is identical or confusingly similar to complainant's trademark, (2) the domain name was "registered and is being used in bad faith," and (3) the current registrant has no *legitimate rights* in the domain name.<sup>208</sup> A complainant

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202. *Id.* Experience Hendrix, L.L.C. was a company formed by the family of the late musician Jimi Hendrix. Experience Hendrix owns all rights relating to Jimi Hendrix. *Id.*

203. See discussion *supra* Part II (discussing personal domain name registration in light of business' claims to the same domains as trademarks).

204. SECOND WIPO REPORT, *supra* note 36, at 19.

205. *Id.* ¶ 59.

206. See ICANN, *supra* note 160, § 4(a), at <http://www.icann.org/udrp-policy-24oct99.htm>.

207. Van Halen v. Morgan, WIPO Case No. D2000-1313 (Dec. 20, 2000), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1313.html>.

208. ICANN, *supra* note 160, § 4(a), at <http://www.icann.org/udrp-policy-24oct99.htm>.



cannot win domain name rights without proving that the respondent's registration of the domain meets each of the three requisite criteria.<sup>209</sup>

The second element says that a nontrademark owner will retain domain name rights if the name was not registered in bad faith. The question arises as to how far WIPO will go in finding that no bad faith exists in the respondent's registration of the domain. Bad faith can usually be shown where the registrant has: (1) tried to sell the domain name for profit, (2) engaged in a "pattern of conduct to prevent others from using trademarks as domain names," (3) sought to disrupt competitors' business, or (4) deliberately or recklessly attempted to conduct business, benefiting by confusion it causes with use of the trademark as its domain name.<sup>210</sup> Where the "ordinary descriptive meaning of the Domain Name is apt for [its] purpose" that domain is not in bad faith use.<sup>211</sup>

WIPO noted that the UDRP "was designed to prevent the extortionate behavior commonly known as cybersquatting" but that it "cannot be used to litigate all disputes involving domain names."<sup>212</sup> This statement indicates WIPO's recognition of the limitations of its domain name policy. The bad faith requirement cannot help Pokey assert his domain name rights against Prema, because Prema's claim to the domain is also in good faith. Pokey would then have no choice but to try to prove the final criterion—legitimate use of the mark.

Under the third UDRP requirement, if the panelists find that the respondent is making legitimate use of the domain, the complainant's dispute will be dismissed. Legitimate use can arise with both commercial and noncommercial use and can be established by

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209. For purposes of this Comment, the reader should assume that the registered domain names are identical or confusingly similar to the trademark, thereby meeting the first requirement. These types of conflicts are the focus of this Comment. The threshold for the "identical or confusingly similar" requirement is low, such that it is rarely the criterion on which complainants lose disputes. SECOND WIPO REPORT, *supra* note 36, at 78.

210. T. Rowe Price Assoc. v. Rich, WIPO Case No. D2001-1044, ¶ 6(c) (Nov. 24, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1044.html>.

211. *Id.* ¶ 6(c). In this case WIPO panelist Mark Partridge determined that where the complainant owned a federally registered mark in the name "Invest With Confidence" and respondent registered the domain name "investwithconfidence.com," the name should not be transferred because complainant failed to show registration in bad faith. *Id.* The respondent had used the site to sell a book about investing, and he had not participated in any of the bad faith actions outlined by the tribunal. *Id.*

212. Oki Data Ams., Inc. v. ASD, Inc., WIPO Case No. D2001-0903, ¶ 6(b) (Nov. 6, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-0903.html>.

registering a domain name that corresponds with the registrant's own name.<sup>213</sup> However, commercial use indirectly dominates the tribunal's decisionmaking process.

In *Kendall v. Mayer*, the complainant was a well-known golfer known as Skip Kendall.<sup>214</sup> Respondent Donald Mayer was a relative of Kendall's who registered skipkendall.com and used the site to post a message about a loan that Kendall had failed to repay.<sup>215</sup> Kendall attempted to claim that his celebrity status gave him common law trademark rights to the name "Skip Kendall," but the panelists refused to consider this issue, instead deciding that Kendall had not met the burden of proving that there was any bad faith use on Mayer's part.<sup>216</sup> At the outset this case may look like a victory for noncommercial registrants. But in spite of finding in favor of the registrant who had no commercial interest in operating the Web site, the panelists noted that Kendall failed to register Skip Kendall as a trademark.<sup>217</sup> By calling the lack of trademark ownership to attention, the decision implies that had he registered his name as a trademark, Kendall might have been entitled to the domain name "skipkendall.com."<sup>218</sup>

Making domain name rights contingent on trademark ownership implies that a commercial, trademarked domain is fundamentally more important than a personal domain. Skip may claim a right to have a Web page at skipkendall.com to sell merchandise or merely display "Hi, my name is Skip . . ." and include personal information. But granting this right to Skip *only* if his name is trademarked suppresses Mayer's right to publicize his frustration about his relative's lapsed loan payment. Thus, Mayer's right to speak freely online would be trumped by Skip's intellectual property rights. Such an implication, if applied to the case of young Pokey, for example, would suggest that if he were to trademark that nickname, only then would he have a comparable claim to Prema's mark. Such a process is flawed because Pokey has a personal claim to his name that exists outside of trademark law. Other WIPO decisions, however, such as the *Clorox* case, show that the tribunal recognizes a registrant's claim to domain names even where the complainant has trademarked the name and seeks to use the domain for a commercial purpose.

In *Clorox Co. v. Marble Solutions*, a seventeen-year-old student

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213. SECOND WIPO REPORT, *supra* note 36, at 78.

214. *Kendall v. Mayer*, WIPO Case No. D2000-0868, ¶ 1 (Oct. 26, 2000), available at <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0868.html>.

215. *Id.* ¶ 4.

216. *Id.* ¶ 5(a), 6(c).

217. *Id.* ¶ 4.

218. *See id.* ¶ 6(a).

registered the domain name “clorox.org.”<sup>219</sup> Clorox Company filed a complaint, alleging that its trademark rights in the name “clorox” superseded the student’s rights to the domain.<sup>220</sup> The WIPO panelists held that the respondent student should be permitted to keep the domain name.<sup>221</sup> They found that the domain was confusingly similar to Clorox Company’s trademark and that the student was not making legitimate use of the domain.<sup>222</sup> However, the panelists did find that no evidence existed showing that the name was registered in bad faith.<sup>223</sup> For this sole reason the individual student was permitted to keep the domain name.<sup>224</sup> Thus, where the respondent cannot show a legitimate commercial use, the bad faith hurdle can be a significant barrier for complainants. This factor may be a noncommercial registrant’s best chance under the UDRP, especially where the registrant cannot show a legitimate use.<sup>225</sup>

Where both a complainant and respondent are actually using the domain name to conduct commercial transactions, WIPO will usually follow the first come, first served policy of registration by finding in favor of the first legitimate domain name registrant. In *Jadlyn, Inc. v. Excel Marketing, LLC*, the WIPO panelist found that because both the complainant and respondent were in the business of publishing bridal magazines and planners, the domain names “todaysbrideandgroom.com,” “todaysbrideplanner.com,” “todaysbride.net,” “todaysbridemagazine.com,” and “todaysbrides.com” would remain with the first registrant, the respondent.<sup>226</sup> WIPO therefore defers to the domain name system’s first

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219. *Clorox Co. v. Marble Solutions*, WIPO Case No. D2001-0923, ¶ 4 (Nov. 20, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-0923.html>. Respondent’s organization was named “Marble Solutions,” but they had mistyped their name on the registration certificate as “Marble Solutions;” thus, the styling of the case. *Id.*

220. *Id.* Demonstrating the bizarre intimidation techniques companies will use in the process of seeking domain name transfer, a representative of Clorox allegedly called the student at his high school and yelled at him. *Id.*

221. *Id.* ¶ 7.

222. *Id.* ¶ 6.

223. *Id.*

224. *Id.*

225. The WIPO decisions under the UDRP (discussed in this Part) indicate that a showing of “legitimate use” requires a showing of commercial use of the domain.

226. *Jadlyn, Inc. v. Excel Mktg., LLC*, WIPO Case No. D2001-1383, ¶ 6 (Jan. 31, 2002), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d20011383.html>; see also *Conigen Networks, Inc. v. Pharm. Outcomes Research*, WIPO Case No. D2001-1094, ¶ 6(c) (Dec. 18, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1094.html> (determining that cognigen.com was in legitimate use by the

come, first served policy when hearing two good faith commercial claims. The first come, first served system more efficiently protects registrants of personal names by precluding powerful, wealthy trademark owners from entering cyberspace and waging war against those who beat them to the punch. Adhering to this system would reward first movers and Internet users who utilize the resource first.<sup>227</sup> In determining first use, courts indicate that plans to use a domain name are sufficient to show legitimate use.

In *Scholastic Inc. v. Master Games International, Inc.*, the owner of the trademark “scholastic” filed a complaint to recover the domain name “scholastics.com.”<sup>228</sup> The respondent had plans for an online strategic games Web site.<sup>229</sup> Because the respondent presented proof of legitimate plans for implementation of the site, WIPO determined that legitimate use of the domain name was being made.<sup>230</sup> Thus, the standards for legitimate use are low, sometimes requiring only mere *plans* for a site. However, this case also involved plans for a *commercial* site. There is no indication that WIPO would interpret the clause so broadly for a respondent with plans to develop a good faith, noncommercial site, such as a fan club or Pokey.org.

As *Jadlyn, Inc.* and *Scholastic, Inc.* demonstrate, legitimate claims may be made to particular domain names in several contexts. Because

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respondent to market and advertise pharmaceutical services, even though the complainant owned the trademark of the word “cognigen”); Int’l E-Z Up, Inc. v. Affordable Instant Shelters, Inc., WIPO Case No. D2001-1244, ¶ 6(b) (Dec. 18, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1244.html> (finding that even though the complainant owned the trademark “instant shelters,” the domain name “instantshelter.com” would remain in the respondent’s ownership because the respondent made legitimate use of the domain by selling the complainant’s products on the Web site); Limco, Inc. v. Rogers, WIPO Case No. D2001-1015, ¶ 7 (Nov. 12, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1015.html> (finding that the respondent’s use of the domain “limitedtoonline.com” to sell items manufactured by the owner of the trademark “Limited Too,” was a legitimate commercial use); Oki Data Ams., Inc. v. ASD, Inc., WIPO Case No. D2001-0903, ¶¶ 6–7 (Nov. 6, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-0903.html> (finding that the complainant, owner of the trademark “okidata,” was not entitled to the domain name “okidataparts.com” because the respondent made legitimate use of the domain by selling the complainant’s products on the Web site); Am. Eyewear, Inc. v. Thralow, Inc., WIPO Case No. D2001-0991, ¶ 7 (Oct. 24, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-0991.html> (awarding the domain name “peepers.com” to the first registrant, the respondent, owner of Peepers Sunglasses, Inc., rather than peeper’s, the trademark owner and retailer of eyewear and accessories).

227. The system still needs policing to keep bad faith registrants and cybersquatters from looting valuable domains from legitimate claimants.

228. *Scholastic Inc. v. Master Games Int’l, Inc.*, WIPO Case No. D 2001-1208, ¶ 3 (Jan. 3, 2002), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1208.html>.

229. *Id.* ¶ 5(b).

230. *Id.* ¶ 6.

of its geographic nature, trademark law cannot adequately cover a case where two trademark owners seek a domain, as was the case in *Jadlyn, Inc.* In that case both parties could have had legitimate claims to the disputed names in different regions. Online, however, these groups could not share the names. And as WIPO demonstrates, legitimate use neither does, nor should, determine strength of a claim based on the gross income each claimant could bring in by using the domain. Instead, cases where two good faith users come head to head are best governed by the existing first come, first served policy. Under this system, fairness governs, and the first party to initiate use of and claim to the domain wins.

Registration of personal names under the UDRP constitutes legitimate use. In *Torres v. The Torres Group* the deciding panelist noted that the respondent, an individual, “was entitled to register a domain name corresponding to his surname.”<sup>231</sup> However, the tribunal did not find in respondent’s favor under that reasoning. Instead, it found that the complainant had failed to prove that respondent registered in bad faith.<sup>232</sup> The fact that respondent had registered his personal name was only one consideration in the panelist’s reasoning.<sup>233</sup> These gaps in Internet user protection demonstrate the need for more consistency in the UDRP itself and in its application to dispute resolution.

Personal names can remain with the first registrant if the trademarked name is too common. Where a complainant claims rights in a generic<sup>234</sup> name, WIPO will find for the registrant. In *Sumner v. Urvan*, the musician Sting (Gordon Sumner) filed a complaint against Urvan for rights to *sting.com*.<sup>235</sup> The single-judge panel recognized Sumner as a world-famous musician performing under the name “Sting.”<sup>236</sup> However, Urvan had an equal claim to the domain name because his nickname was Sting,

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231. *Torres v. The Torres Group*, WIPO Case No. D2001-1200, ¶ 6 (Dec. 19, 2001), available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1200.html>.

232. *See id.*

233. *Id.*

234. A generic name is one that “describes something generally without designating the thing’s source or creator . . . .” BLACK’S LAW DICTIONARY, *supra* note 2, at 694. Examples of words that have become generic include the words “thermos” and “Murphy bed.” *See* *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 102 (2d Cir. 1989); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963).

235. *Sumner v. Urvan*, WIPO Case No. D2000-0596, ¶ 3.1 (July 24, 2001), available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0596.html>.

236. *Id.* ¶ 6.5.

and Urvan ultimately won ownership of sting.com.<sup>237</sup> Although the tribunal refused to formally determine whether Urvan had an unregistered trademark or service mark, it reasoned that the word “sting” is probably generic.<sup>238</sup> Because of the word’s common use, the musician Sting could not lay claim to the domain. The tribunal in this case allowed a personal claim to supersede the claims of a famous name. This decision thereby implies that such tribunals recognize the need to protect personal nicknames, much like those of Chris “Pokey” Van Allen.

While the musician (or, analogously, a large company like Prema) may want to have a Web site where he can display his likeness or sell merchandise, a domain name consisting of such a generic or common word could be legitimately used by any number of registrants. Restricting registration to a commercial user, or trademark owner in this case, would arguably cause some confusion among Internet users. Many users may type in sting.com and expect to land on a site other than the musician’s. Perhaps they expect to find a site about dealing with bee stings, or information about their friend whose online nickname is Sting. Whatever the intended site, not all users visiting sting.com intend to find a site about the singer’s name. For this reason, WIPO was correct in denying the musician rights to a generic domain name.

Where WIPO policies fail, community pressures can preserve rights for the respondent. In a similar case to Pokey Van Allen’s, *Giacalone v. Network Solutions, Inc.*, Mr. Giacalone registered the domain name “Ty.com” in good faith for his son Ty.<sup>239</sup> Ty, Inc., manufacturer of Beanie Babies and other children’s toys, filed for an injunction in California district court attempting to prevent Giacalone from using the domain name.<sup>240</sup> The court awarded a temporary injunction, indicating its tendency to favor the trademark holder without requiring much research into the validity of the trademark owner’s claim.<sup>241</sup> Before a permanent decision could be made, however, publicity and ensuing community outrage led Ty, Inc. to settle the dispute.<sup>242</sup> The public’s outrage seems justified, given the fact that Ty, Inc. has hassled other registrants of domains that match its trademarks.<sup>243</sup> The Internet risks losing its identity as a global resource and becoming almost exclusively a virtual shopping mall.

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237. *Id.* ¶ 7.2.

238. *Id.* ¶ 6.6.

239. *See Yan, supra* note 1, at 807.

240. *Giacalone v. Network Solutions, Inc.*, No. C-96 20434 RPA/PVT, 1996 WL 887734, at \*1 (N.D. Cal. June 14, 1996).

241. *Id.*

242. *Id.*

243. Judith Vandewater, *Beanie Baby Maker Sues Woman Over Web Site*, ST. LOUIS POST-DISPATCH, Feb. 6, 1999, available at 1999 WL 3009945.

Unfortunately, the community may have won the battle but lost the war, as Ty.com now belongs to Ty, Inc., and no trace of young Ty Giacalone's Web site can be found.<sup>244</sup> However, if the company increases its presence online it will effectively block out good faith registrants. This global support for individuals like Pokey and Ty, from sources ranging from typical Internet users to technical support companies, indicates that the public favors a policy that gives greater rights to individuals that register domain names in good faith.

As the Ty and Pokey cases demonstrate, the public wants the right to own personal domain names. Although the legal system should not be limited by public opinion, it should reflect the needs of the public. As Justice Brandeis said: "All law is dead letter without public opinion behind it."<sup>245</sup> And as an Arkansas district court noted, it is the judiciary's role to serve as "guardian of the civil liberties of the people."<sup>246</sup> Guarding liberties requires knowing peoples' desires because the justice system "can function only so long as the public . . . accepts and abides by judicial decisions."<sup>247</sup> The public's respect of the judiciary then, in large part, depends on its reflection of views that the public espouses. Therefore, in cases where the public demands that Pokey or Ty have rights to their personal domain names, the judiciary does a great disservice to its overall integrity by ignoring the public's demands. As the public is demonstrating through its backlash against these companies, it desires rights to personal domain names on the Internet.

Unfortunately however, the rights of noncommercial registrants are addressed only as exceptions to the general policy. None of these exceptions adequately address and protect the class of domain name registrants at issue in this Comment. Perhaps the whole UDRP is already outdated and Internet users are finding new ways to express their cyber identities that do not require ICANN's policy.

*B. Do Domain Names Really Still Matter? New Issues Raised by Technology and Social Changes*

Maybe domain names are no longer worth all the fuss. Existing policy falsely assumes that domain names carry more value for trademark

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244. Ty, Inc., at <http://www.ty.com> (last visited Feb. 5, 2002).

245. 1 LETTERS OF LOUIS D. BRANDEIS: URBAN REFORMER 97 (Melvin I. Urofsky & David W. Levy, eds., State Univ. of N.Y. Press 1971) [hereinafter BRANDEIS].

246. *Beshear v. Butt*, 863 F. Supp. 913, 918 (E.D. Ark. 1994).

247. *In re Winton*, 350 N.W.2d 337, 340 (Minn. 1984).

owners than for individual users. The priority value in the policy, as discussed above, is commercial and financial rather than personal value. This implicit hierarchy of values suggests that trademark owning businesses will lose customers if their trademarks are used as other parties' domain names. This assumption may be incorrect.

An economic argument states that domain names are most valuable to parties that can pay the most for them and use the domain name to generate the most revenue.<sup>248</sup> This proposition suggests that domain names will be used more efficiently by large businesses than by individuals because companies have more to gain financially from e-business.<sup>249</sup> Auctions were thus proposed to ensure economically efficient distribution of domain names.<sup>250</sup>

Under an auction system, a free market would be open for domain names. Bidders would post bids at online sites, and the trademark owner would be in equal competition with other bidders for the domain name. Under this system, presumably the parties' bids would approximate the dollar value they place on the domain.<sup>251</sup> While improving efficiency by utilizing free market influences, the auction system fails to alleviate the problems with current dispute resolution policies. The domain name would still end up in the hands of the party that can afford to pay the most for it.<sup>252</sup> So when Pokey comes head to head with Prema, Inc., Prema's vast financial resources would beat those of the twelve-year-old boy or his family. The auction system assumes that financial resources indicate the value a party places on the domain. Again, the definition of value used by this policy ignores social, cultural, or personal value.

The value of a trademark as an advertising tool lies in its ability to convey messages to consumers; trademarks help customers identify certain standards of quality by establishing a connection between the trademark and the company's level of quality.<sup>253</sup> The company can use

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248. See Gideon Parchomovsky, *On Trademarks, Domain Names, and Internal Auctions*, 2001 U. ILL. L. REV. 211, 215 (2001).

249. Commercial value of domain names will certainly continue to grow each year as the Internet grows. Davis III, *supra* note 88, at 603.

250. Parchomovsky, *supra* note 248, at 215.

251. *Id.* at 216.

252. This potentially economically efficient system overlooks freedom of expression and noncommercial free use of the Internet.

253. LIPSCHULTZ, *supra* note 106, at 247-48. A trademark's value comes from its use as an advertising and commercial shortcut that can "convey a series of complex meanings to consumers." *Id.* A trademark therefore reaffirms the adage that a picture is worth a thousand words. A simple trademark or name can lead consumers to instantly attach years' worth of thoughts, experiences, and beliefs about that product to a simple mark displayed on a package. For example, if a person grew up using Gold Medal flour, he might continue purchasing that brand under the assumption that it carries a certain standard of quality. *Id.* at 248.



those expectations of quality to sell its goods or services without having to re-send or re-advertise the message.<sup>254</sup> Therefore companies spend significant amounts of money to send messages educating consumers on their level of quality and reinforce those messages so consumers will be able to connect the trademark to the company.<sup>255</sup> The trademark owner can therefore stop others from using their same or a similar logo on the grounds that consumers might be confused and also “because their branding has value relative to the investment placed in it.”<sup>256</sup>

Intellectual property rights proponents may argue that using a trademark as a domain name makes a site more accessible to users.<sup>257</sup> Under this reasoning, businesses use their trademarks as a marketing tool so users can find the company’s Web site through their trademark and domain name and ultimately spend money at the site.<sup>258</sup> Arguably, when a company invests heavily in a trademark and uses that trademark as its domain name, the likelihood of users accessing the Web site and spending money as a result of that transaction increases, and the domain becomes an even more prized asset.<sup>259</sup> For this reason, businesses claim

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254. *Id.*

255. *See id.*

256. *Id.* at 248. In *Lagasse v. VPOP Technologies*, the court held that personal identities, like commercial products, could win domain name rights due to the investment spent in making the specific name famous. NAF Forum File No. FA0003-0000-94373 (May 8, 2000) (Crary, Arb.), at <http://www.arbforum.com/domains/decisions/94373.htm>. In this case Emeril Lagasse, a well-known television personality, filed a complaint against VPOP Technologies, which had registered *emeril.com*. While the arbitrator found that VPOP registered the name in bad faith, it also noted that, in addition to having a distinct meaning for trademark purposes, the names “Emeril” and “Emeril Lagasse” had acquired substantial goodwill due to Lagasse’s hard work, time, energy, and resources. The arbitrator then took these contributions into account when finding that the domain name should be transferred to Lagasse. *See id.*

257. Danielle Weinberg Swartz, Comment, *The Limitations of Trademark Law in Addressing Domain Name Disputes*, 45 UCLA L. REV. 1487, 1491 (1998). Internet users often guess that a product’s trademark also serves as its domain name and will enter that trademark as a domain name when attempting to find a product’s Web site. *Id.* “A customer who is unsure about a company’s domain name will often guess that the domain name is also the company’s name.” *Cardservice Int’l, Inc. v. McGee*, 950 F. Supp. 737, 741 (E.D. Va. 1997), *aff’d*, 129 F.3d 1258 (4th Cir. 1997). Therefore, “a domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base.” *MTV Networks, Inc. v. Curry*, 867 F. Supp. 202, 203–04 n.2 (S.D.N.Y. 1994). The quickest and most efficient way for Internet users to find a specific site is by typing a name into a browser. Search engines can yield hundreds of results, arguably too much for a user to navigate through, causing the user to give up entirely on finding the site. Moore, *supra* note 126, at 498–99.

258. Yan, *supra* note 1, at 777.

259. Herman and McChesney suggest that: “The Internet and digital revolution do

that for cyberspace to function as an effective commercial market, their sites must be accessible by clients, and this accessibility will occur only if trademarks are given priority protection in domain name disputes.<sup>260</sup>

Trademark owners argue that the domain name potentially loses value each day it remains registered to a nontrademark owner, because the business loses potential customers that cannot find their site.<sup>261</sup> This erosion of customer base then allegedly decreases the value of the business and lowers the amount the business would be willing to pay for the domain. Thus, the domain's overall financial value would decrease. Because approximately thirty million people use the Internet everyday, a forty-five day dispute resolution can potentially cost far more in lost business revenues than the average \$1000 final cost for resolution of the dispute itself in particular tribunals.<sup>262</sup> However, this grim picture may be inaccurate.

The need for easily recognizable domain names is arguably decreasing.<sup>263</sup> Although courts have expressed concern about the sophistication of most Internet users,<sup>264</sup> data indicates that most Internet surfers are still well-educated individuals.<sup>265</sup> Therefore, even if they exercise an unsophisticated

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not pose an immediate or even foreseeable threat to the market power of the media giants." MIKE FEINTUCK, MEDIA REGULATION, PUBLIC INTEREST AND THE LAW 23-24 (1999). Furthermore, some experts argue that registering a trademark as a domain name is effective only as part of a company's overall marketing campaign. Under this argument, the Internet's potential is maximized only by companies who can best advertise through other, more widely accessible channels (such as existing big-league media players), and utilize the synergy that exists in cross-media campaigns. FEINTUCK, *supra*, at 24.

260. Yan, *supra* note 1, at 779; see also Falzone, *supra* note 44, at 293.

261. Walker, *supra* note 74, at 307. One firm noted that during a change of Internet address, where Internet users were temporarily directed to a different Web site, traffic on some sites dropped by as much as seventy-five percent within a few days because consumers were unable to locate the desired site. Davis III, *supra* note 88, at 607.

262. Subcommittee on Courts and Intellectual Property Committee on the Judiciary, U.S. House of Representatives at the Oversight Hearing on Internet Domain Names and Intellectual Property Rights, 106th Cong. (1999) (statement of Jonathan C. Cohen, President, Intellectual Property Constituency of the Domain Name Supporting Organization (DNSO)); see Walker, *supra* note 74, at 300.

263. In fact, most company Web pages cannot be found easily by guessing their domain names. Other options for finding domain names include search engines, online directories, online advertising, and other more traditional advertising, such as print, radio, and television. Scher, *supra* note 46, at 553.

264. See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 952 (C.D. Cal. 1997), *aff'd*, 194 F.3d 980 (9th Cir. 1999); *Panavision Int'l, L.P. v. Toeppen*, 945 F. Supp. 1296, 1299 (C.D. Cal. 1996), *aff'd*, 141 F.3d 1316 (9th Cir. 1998).

265. Approximately twenty-five percent of Internet users in 1998 had college degrees. LIPSCHULTZ, *supra* note 106, at 182. Income and age are the most determinate factors in Internet user profiles, and such use is generally concentrated among high income, well-educated people. ORGANISATION FOR ECONOMIC CO-OPERATION AND DEVELOPMENT, OECD ECONOMIC OUTLOOK No. 67, at 193 (2000).

analysis when searching for Web sites,<sup>266</sup> ordinary Internet users can distinguish based on the content of Web sites whether they are viewing the site they intended to view.<sup>267</sup> Additionally, users have and are aware of other options for finding specific Web sites beyond simply typing in a trademark or other memorable domain name. While a white pages or yellow pages Internet directory is not yet available for domain name listings, the existence of search engines such as Yahoo! and Google makes finding Web sites relatively simple.<sup>268</sup> Even Web browsers like Microsoft's Internet Explorer include search functions. By typing "go" followed by a search term, Explorer will direct the user to the Web site or a list of related sites best matching that term.<sup>269</sup> These technology improvements allow easier searches online, lowering search times and costs.

User sophistication is also increasing.<sup>270</sup> The defendant in *Green Products Co. v. Independence Corn By-Products Co.* argued that even though Internet users "may have some reasonable expectation that typing in a famous mark<sup>271</sup> of a huge corporation like nike.com or ibm.com will lead to those corporate web sites, the same cannot be said for . . . a [non]-famous mark . . . which is made up of common generic words that are used in many contexts."<sup>272</sup> This argument implies that most consumers know they might need to do extra searching to find Web sites for companies with only marginally famous trademarks and acknowledges that the name of the site should have some rational, not

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266. *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F. Supp. 1070, 1079 (N.D. Iowa 1997) (arguing that Internet users exercise a low level of care when surfing the Internet, but upholding the idea that these users would expect a company's trademark to be its domain name, thereby leading to consumer confusion when another registrant's site uses the first company's trademark as its domain name).

267. The *Green Products* court acknowledged that the content of the site mattered. Chief Judge Melloy wrote that initial interest confusion was to be discouraged, but seemed to point out that customers may be more frustrated at not being able to find the desired Web site than confused as to the source of a particular site's content. *Id.* at 1076.

268. *Id.* at 1073 (recognizing that search engines are available to help locate sites). The creation of some sort of Internet directory continues to be considered among Internet developers. See Yan, *supra* note 1, at 794. The creation of such a directory would further decrease the importance of immediately recognizable domain names.

269. If a user enters the terms "go" and "University of San Diego," Explorer will automatically forward the user to [www.sandiego.edu](http://www.sandiego.edu).

270. LIPSCHULTZ, *supra* note 106, at 182. While the court rejected this argument, the fact remains that Internet users are becoming more and more aware of the Internet's content and how to find it. *Id.*

271. Although "famous" is a term of art, the term is used in its colloquial sense in this context. See discussion *supra* note 79.

272. *Green Products Co.*, 992 F. Supp. at 1078.

necessarily commercial, relation to its content.

Companies are also responding to the domain name issue by taking more measures to ensure that their Web sites are available through alternate means. Experts recognize three key steps for Web site promotion: (1) registration with key search engines, (2) use of a site promotion company, and (3) use of site promotion software.<sup>273</sup> As more companies take these key steps, consumers become more proficient in finding Web sites, technology decreases search efforts, and domain names become less important for finding specific Web pages.

If, however, one believes that memorable domain names are the only adequate way to attract users to a site, the problem of small companies' domain name rights still must be addressed. Precluding large businesses from choosing the popular domain names will give smaller businesses a chance to claim recognizable domains. The Internet has created a paradigm shift for marketing services, providing an opportunity for small businesses to communicate to potential customers around the world for limited cost.<sup>274</sup> This puts small businesses with few financial resources in equal competition with companies that in the physical world have greater resources for reaching a wider customer base.<sup>275</sup> Allowing businesses to compete equally recognizes the Internet's role as both a "medium for international commerce" and a place for cultural exchange.<sup>276</sup> Therefore, small and large companies alike will seek to register their unique domain names so they can compete in cyberspace.<sup>277</sup> In order to keep the cultural and commercial benefits of the Internet alive, domain name rights must be available to mom-and-pop businesses and large businesses alike, thereby preserving the variety of ideas, services, and products available in cyberspace. The dispute resolution policies must be changed to maintain this even and diverse playing field.<sup>278</sup>

Although competing businesses big and small may own trademarks that they could use to assert rights to a domain name, trademark law does not sufficiently apply in these cases. If trademark law were applied, the parties with a wider reach and more famous mark, usually bigger companies, would win most often. Mom-and-pop businesses would be unable to assert claims to domains, and large companies would edge them out of cyberspace. A resource must be available for parties

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273. Kolzow & Pinero, *supra* note 30, at 97.

274. Davis III, *supra* note 88, at 606.

275. See McCoy, *supra* note 68, at 378.

276. SECOND WIPO REPORT, *supra* note 36, at 19.

277. See Davis III, *supra* note 88, at 606.

278. See McCoy, *supra* note 68, at 378. As the Internet exists currently, "Mom and Pop shops are now competing on a level playing field with 'the big boys.'" Gautier, *supra* note 26, at 119.

whose Web sites would benefit the overall Internet society, so that money and power do not drive the information that users receive online.

### C. *The Strength of the “Information Society”*

The emergence of an information society highlights the incredible success of the Internet and its role as a noncommercial resource. The information society is a new social structure that has arisen with the onset of the Internet.<sup>279</sup> The mere existence of this structure demonstrates the powerful role the Internet now plays in our daily lives. Internet users send mail, experience virtual reality, and have real-time conversations online. Proposals are in the works to allow users to vote and obtain professional advice online.<sup>280</sup> These changes demonstrate that the Internet community far exceeds a commercial environment; we now communicate, find entertainment, and perform research online. Furthermore, in today’s diverse society the Internet provides a venue where all users have an equal voice, regardless of resource, class, or other distinctions.<sup>281</sup> Extending protection primarily to trademark owners (who are generally corporations backed by substantial resources) transforms this level playing field into a structure resembling the rest of society where the most powerful voice is frequently the only one to be heard.<sup>282</sup> This development of a power structure paralleling that of the physical world eliminates the unique benefits of interacting in cyberspace.

In addition to its commercial growth, the Internet has been praised for its exceptional educational value. In 1997, when schools and libraries were incorporating Internet access, the federal government expressed fear that the Internet’s “potential as an educational and informational resource would be wasted” if parents were unwilling to allow kids to use the resource for fear they might access adult material online.<sup>283</sup> The U.S. Justice Department filed a legal brief with the Supreme Court in an attempt to ban sexually explicit content from the Internet, calling the

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279. See Fitzgerald, *supra* note 69, at 338.

280. *Id.*

281. David Crowther, *Corporate Reporting, Stakeholders and the Internet: Mapping the New Corporate Landscape*, 37 URB. STUD. 1837, 1839 (2000).

282. See *id.* at 1846. E-commerce has the potential to level the playing field so amateurs and commercial organizations can sell their goods and services with the same global coverage. Gautier, *supra* note 26, at 134.

283. Gautier, *supra* note 26, at 128–29.

Internet “an unparalleled educational resource.”<sup>284</sup> Although the ban was not approved, the government’s action demonstrates the value it places on the Internet as an educational tool, not merely a commercial resource. The government was willing to risk some public exposure to undesirable material to allow utilization of the great benefits of the Internet.

Conversely, the digital economy highlights the Internet’s dependence on commercial support.<sup>285</sup> The Internet economy supports 2.5 million workers,<sup>286</sup> and approximately eighty percent of all e-commerce consists of business-to-business transactions.<sup>287</sup> However, a combination of factors is causing changes in user statistics. Technology is improving and becoming more cheaply available. With the increased availability, Internet use is no longer restricted to educated, wealthy individuals; the average income and education level of users is decreasing.<sup>288</sup> Thus, while a majority of online transactions are business related, an increasing number of Internet users are not part of this commercial sector.<sup>289</sup> These users are entitled to as much protection as large business users in domain name disputes, as the Internet was designed and has been promoted as a resource where no one group would have a larger stake in it.<sup>290</sup>

The Boston Consulting Group study, “Winning the Online Consumer: Insights Into Online Consumer Behavior,” exposed some key statistics regarding Internet users.<sup>291</sup> According to this study, consumers view the Internet as more about communication than commerce, and more than eighty percent originally used the Internet for communication purposes.<sup>292</sup> Only two percent of consumers went online to shop.<sup>293</sup> The public’s use of the Internet needs to play a part in the policy designed to serve that public.<sup>294</sup>

Even government officials have demonstrated a reluctance to treat the

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284. *Reno v. ACLU*, 521 U.S. 844 (1997).

285. The “digital economy” consists of commerce conducted via or with the Internet, including e-commerce, e-business, and other Internet-based commercial transactions. See Kolzow & Pinero, *supra* note 30, at 82.

286. ANITESH BARUA ET AL., THE UNIVERSITY OF TEXAS AT AUSTIN, MEASURING THE INTERNET ECONOMY: AN EXPLORATORY STUDY, available at [http://crec.bus.utexas.edu/works/articles/internet\\_economy.pdf](http://crec.bus.utexas.edu/works/articles/internet_economy.pdf) (last visited Jan. 5, 2002); see also Kolzow & Pinero, *supra* note 30, at 82.

287. Kolzow & Pinero, *supra* note 30, at 84 (citing Forrester research).

288. *Id.* at 92 (citing Forrester research).

289. *Id.*

290. See discussion *supra* note 37 (explaining that no one single group owns the Internet). See *Am. Libraries Ass’n v. Pataki*, 969 F. Supp. 160, 169 (S.D.N.Y. 1997).

291. Kolzow & Pinero, *supra* note 30, at 92 (citing Forrester Research).

292. *Id.*

293. *Id.*

294. Cf. BRANDEIS, *supra* note 245, at 97 (discussing the relationship between public opinion and the law).

Internet as a predominantly commercial arena. In 1997 then-Vice President Al Gore declared the government's intention to ensure Internet access in all classrooms by the year 2000.<sup>295</sup> Clearly, access for schools is based on the educational and informational, not commercial, value of the Internet. Gore would unlikely advocate Internet availability to encourage or enable students to participate in e-commerce transactions during school time.

At the state level, California Governor Gray Davis vetoed a first-ever bill that would have forced Internet businesses to charge sales tax.<sup>296</sup> The government's unwillingness to tax online transactions demonstrates that cyberspace is an arena unlike any other known thus far. The Internet is not considered a business environment in the traditional sense.

Similarly, the federal government enacted the Internet Tax Freedom Act.<sup>297</sup> This Act placed a moratorium on taxing Internet access or e-commerce.<sup>298</sup> Enacting this statute may indicate the federal government's hesitance to treat the Internet as analogous to other commercial arenas. This moratorium was extended through November 1, 2003.<sup>299</sup>

The Internet has become an important resource for both commercial and noncommercial communications.<sup>300</sup> Community use and government action reflect this view. Online advertising has certainly resulted in greater access to goods and services. But individuals, small community organizations, large corporations, government agencies, and courts all share the Internet.<sup>301</sup> Many users are online for noncommercial purposes.<sup>302</sup> Therefore, the goals of dispute resolution policies should include safeguarding both corporate *and* individual Internet users' rights.<sup>303</sup> Changes to the existing system will ensure that these goals are realized.

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295. Press Release, The White House, Office of the President, Statement of the Vice President on the FCC E-Rate Decision (May 7, 1997), at <http://www.ed.gov/PressReleases/05-1997/97-05-07.html>.

296. Kolzow & Pinero, *supra* note 30, at 89.

297. 47 U.S.C. § 151 (2000).

298. *Id.*

299. *Id.*

300. Yan, *supra* note 1, at 787.

301. *Id.* at 788.

302. See Kolzow & Pinero, *supra* note 30, at 92.

303. Walker, *supra* note 74, at 302.

## V. PROPOSALS FOR CHANGE: PROVIDING RIGHTS FOR FUTURE POKEYS

Domain name dispute resolution policies need revamping to protect registrants of personal names. As they currently stand, policies favor trademark owners, and therefore wealthy companies, over smaller businesses or individuals that do not have trademarks. A solution to the domain name problem that adequately protects Internet users, commercial and otherwise, is necessary.<sup>304</sup> This solution must afford greater protection to individuals and noncommercial registrants, while simultaneously protecting trademarks as domain names, particularly where the mark carries goodwill and heavy financial, time, and energy investments. Several alternatives to current domain name dispute resolution policies have been proposed.

### A. Solutions in the Works

One proposed solution is to place greater emphasis on TLDs.<sup>305</sup> The focus would be on differentiating [www.sandiego.edu](http://www.sandiego.edu) from [www.sandiego.com](http://www.sandiego.com).<sup>306</sup> This suggestion, however, is more of a cosmetic, temporary fix than a long term solution. Eventually the TLD registration systems will be as flooded as the current SLD systems. Furthermore, the onset of the new TLDs will only be an adequate fix if dispute resolution tribunals police the proper use of the TLDs.

Based on the few cases that have been arbitrated thus far under such new TLDs as “.biz” and “.tv,” tribunals are allowing trademark claims to supersede genuine claims to these TLDs.<sup>307</sup> For example, in *Harrods Ltd. v. Wieczorek*, Harrods Ltd., a London based department store, sought to have [harrods.tv](http://harrods.tv) transferred from the registrant, Wieczorek.<sup>308</sup> The panelist determined that because the respondent had registered [harrods.tv](http://harrods.tv) in bad faith and was not actually using the site, it should be transferred to Harrods.<sup>309</sup> The panelist further found that because Harrods has an internationally recognized trademark in its name and respondent failed to show any claim to the site, it should be transferred.<sup>310</sup>

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304. *But see* Gautier, *supra* note 26, at 135 (suggesting that a digital legal system should be rooted in trademark law).

305. Carl Oppedahl, *Analysis and Suggestions Regarding NSI Domain Name Trademark Dispute Policy*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 104 (1996).

306. *See id.*

307. *See generally* Harrods Ltd. v. Wieczorek, WIPO Case No. DTV2001-0024 (Dec. 18, 2001), available at <http://arbitrator.wipo.int/domains/decisions/html/2001/dtv2001-0024.html>.

308. *Id.* ¶ 6.

309. *Id.* ¶ 7(d)–8.

310. *Id.* ¶ 7(a); *see also* Jadlyn, Inc. v. Excel Mktg., LLC, WIPO Case No. D2001-1383 (Jan. 31, 2002) (finding that the domain name “[todaysbride.net](http://todaysbride.net)” should remain in



This decision indicates that the new TLDs can be transferred to the trademark owner if that trademark matches the SLD. In this case Harrods owned harrods.com where it sold products online. However, Harrods is a department store. As far as the facts indicate, Harrods does not operate any type of television communications business, and it has legitimate claims only in the .com TLD because it is a *commercial* venture. By extending Harrods's trademark claim to the .tv TLD, which is unrelated to the business Harrods conducts, WIPO demonstrates that TLDs are not taken seriously. It allows commercial entities to own .tv domain names. If TLDs are not taken seriously, they will not provide any solution to domain name issues. Instead, Harrods could own harrods.com, harrods.tv, harrods.pro, and harrods.name, until it owns that domain name across all TLDs. Thus, an individual named Harrod would still be unable to register his personal name as a domain name. Rather than being denied his name only under .com, he would be denied the domain in each of these TLDs. So Pokey would not only be denied pokey.org, but pokey.com, pokey.tv, pokey.name, and all other TLDs.

Furthermore, WIPO applies no distinction in adding words such as "my," "sucks," or "dot" to a trademarked word when considering the similarity of the domain name and the trademark.<sup>311</sup> In *Gorstew Ltd. v. Superman*, WIPO panelist David Lametti determined that sandalsdot.com would most likely be read aloud as "sandals dot com" rather than "sandals dot dot com," and was therefore confusingly similar to sandals.com.<sup>312</sup> Thus the complainant, a vacation planner, could show that his trademark was affected by the confusing similarity of the domain registered by an online sandal business-person.<sup>313</sup> The problem with this reasoning is that allowing registrants to keep hold of any

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the possession of a company using it as a site to conduct business for the registrant's publication of bridal magazines and planners, ignoring the fact that .net is intended to refer to network-oriented sites), *available at* <http://arbiter.wipo.int/domains/decisions/html/2001/d20011383.html>; *Clorox Co. v. Marble Solutions*, WIPO Case No. D2001-0923, ¶ 6–7 (Nov. 20, 2001) (determining that the respondent should keep the domain name "clorox.org" only because the complainant presented no evidence of the respondent's bad faith registration, but ignoring the fact that .org TLDs are intended not for commercial ventures but rather for nonprofit organizations), *available at* <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0923.html>.

311. *Gorstew Ltd. v. Superman*, WIPO Case No. D2001-1103, ¶ 6 (Nov. 5, 2001), *available at* <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1103.html>.

312. *Id.*

313. *Id.* The respondent ultimately won rights to the domain because the complainant failed to show that the domain was used in bad faith. *Id.* ¶ 7.

variation of their trademark, say the word “sandals,” makes room for a slippery slope. If the trademark owner of sandals can protect sandalsdot, mysandals, and sandalssucks, then what would keep them from also being able to protect redsandals, bigsandals, or joesandals? Under WIPO’s reasoning (that Internet users will not likely distinguish the trademark from domain names when simple words are added to the domain names), eventually *any* word added to the domain name could be protected. So if a person named Joe Sandals or a business that sells red sandals wants to register those domains, they would lose their rights to the vacation planner.

Another proposed solution is placing greater emphasis on whether the registrant has a pre-existing, legitimate claim to the domain name. In *Ford Motor Co. v. Great Domains, Inc.*, the court indicated several relevant factors to use in assessing whether the registrant has purposefully targeted the trademark owner’s mark to infringe or dilute the trademark.<sup>314</sup> While these factors are meant to determine the extent to which the trademark was targeted in bad faith, they might just as easily be applied in cases of good faith registration. The factors are: (1) whether the registrant directly solicited the trademark owner to transfer the domain name; (2) whether the registrant has registered other trademarked names as domain names; (3) whether the registrant has offered the domain name for sale;<sup>315</sup> (4) whether the registrant has a pre-existing, legitimate use for the domain; and (5) any other relevant factors tending to show purposeful targeting of the trademark owner’s mark.<sup>316</sup> Tribunals could use the fourth factor, legitimate use, to determine the extent to which the nontrademark owner has a legitimate claim to the domain, and the remaining factors could determine the extent to which the nontrademark owner actually intended to register a name that would interfere with a trademark. Under this system good faith users would keep their domains if they could show a legitimate reason for registering that name. Courts would have to use discretion in evaluating the claim’s legitimacy, but beyond that could apply the first come, first served rule to ultimately award the rights to the first-registered, legitimate claimant.

Another key in designing domain name dispute law is focusing on regulating behavior, not just technology.<sup>317</sup> Focusing on behavior would allow courts to consider good faith registration and use while weeding out bad faith cybersquatters or others intending to infringe or dilute a

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314. *Ford Motor Co. v. Great Domains, Inc.*, 141 F. Supp. 2d 763, 777 (E.D. Mich. 2001).

315. These first three factors presumably aim to prevent cybersquatting.

316. *Ford Motor Co.*, 141 F. Supp. 2d at 777.

317. David Bicknell, *Hurdles to Be Tackled*, COMPUTER WKLY., July 2, 1998, at 30, LEXIS, Nexis Library, Computer Weekly File.

trademark. Applying a good faith requirement equally to commercial and noncommercial domain name registrants would remove some of the advantages large corporations have in significant financial resources that back them in domain name disputes, making rights more equally available.

### B. Drafting New Dispute Resolution Policies

An ideal dispute resolution policy would accommodate both commercial and noncommercial domain name registrants. The current elements that a complainant must show in order to have a domain transferred are: (1) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (2) the current registrant of the domain name has no rights or legitimate interests in respect of the domain name, and (3) the domain name was “registered and is being used in bad faith.”<sup>318</sup>

The first element, requiring that the complainant have rights to a trademark to which the domain is confusingly similar, precludes noncommercial registrants from protection under the UDRP. If this element were written more broadly, Pokeys would also be able to avail themselves of this policy. Thus, the statement should be rewritten so the first element reads: Complainant must show (1) that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights *or that the name is identical or confusingly similar to a name in which the complainant has personal, educational, or other good faith rights*. The second element causes no problems for Pokey, but the third element also needs consideration.

The third element currently requires complainants to show that the respondent has registered and is using the domain in bad faith.<sup>319</sup> The nonexhaustive list of factors that might show bad faith use all turn on *commercial* use. In order to protect Pokeys under the UDRP, some additional factors should be added, including whether (1) the respondent has intentionally deprived complainant of a domain in which complainant has personal, educational, or other legitimate rights; (2) the respondent has attempted to profit by depriving complainant of a name to which complainant has legitimate rights; and (3) the respondent has registered the name without having any legitimate interest in it.

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318. ICANN, *supra* note 160, § 4(a), at <http://www.icann.org/udrp-policy-24oct99.htm>.

319. *Id.* § 4(a)(iii).

ICANN, which is in the process of restructuring, has agreed to include not only constituency groups of large and small business users but also academic and public entities, consumer and civil society organizations, and *individual domain name holders*.<sup>320</sup> In addition to a more broadly worded UDRP, giving these previously under-represented groups voices and voting rights in the organization that governs their Internet use will increase their power in Internet and domain name disputes. ICANN is taking a step in the right direction, leaving just simple language changes to be made to the UDRP.

Adopting these dispute resolution policies would benefit the overall Internet society. Chris “Pokey” Van Allen would be able to keep his personal domain without fear of a wealthy trademark owning corporation cornering him into giving up the name. Keystones of the American way of life are equality, fairness, and due process. Allowing Chris to display information at his personal site contributes to the diversity and communication that make cyberspace such a socially valuable resource. Equality and fairness in cyberspace demand consideration of the resource as more than just a commercial zone where wealthy corporations can trample the rights of all other users. A domain name system that provides those benefits to all Internet using citizens would thereby uphold the sense of justice upon which cyberspace was founded. A fairer system would provide liberty and Internet rights, for Pokey and all.

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320. ICANN, *ICANN: A Blueprint for Reform*, § 3, at <http://www.icann.org/committees/evol-reform/bluprint-20jun02.htm> (June 20, 2002) (providing an overview of ICANN’s proposed supporting organizations).