

Intellectual Property & Technology Law Journal

formerly *Journal of Proprietary Rights*

Edited by the Technology and Proprietary Rights Group of Weil, Gotshal & Manges LLP

VOLUME 17 • NUMBER 10 • OCTOBER 2005

Drug Discovery after *Integra v. Merck* 1

Tamsen Valoir, a partner in the Houston office of Baker & McKenzie, LLP. Although it is now clear that the FDA safe harbor protects both animal and human studies, the precise boundary of the safe harbor has yet to be determined. In Dr. Valoir's opinion, we can expect future litigation on this crucial point.

Being Creative about Being Creative: 6 Why and How the Inventive Process Should Be Documented

Most companies understand the need to keep records, such as laboratory books and inventor notes, to properly document the development of an invention up to its date of conception. What is less well understood, however, is that to effectively protect an invention, thorough documentation should be kept regarding the events occurring after conception until a patent application is finally filed.

In this article, Michael I. Markowitz, an attorney with Ostrolenk, Faber, Gerb & Soffen, LLP, in New York City, examines the reasons that such documentation is necessary and describes the type and method of documentation that can and should be kept and maintained. In addition, this article proposes various improvements and suggestions for maintaining records regarding conception to accurately fix a date of conception. Finally, the desirability of filing a provisional application or applications as a substitute or adjunct in the process of documenting conception also is explored.

Diamond v. Chakrabarty: A Retrospective 12 on 25 Years of Biotech Patents

It has been 25 years since the US Supreme Court's landmark 1980 decision in *Diamond v. Chakrabarty*, in which the court held that a live, manmade micro-organism is patentable subject matter under § 101 of the Patent Act.

As explained in this article by Douglas Robinson and Nina Medlock, shareholders in the Washington, DC, office of Banner & Witcoff, Ltd., the *Chakrabarty* decision has affected the lives of virtually everyone in the United States, contributing to a revolution in biotechnology that has resulted in the issuance of thousands of patents, the formation of hundreds of new companies, and the development of thousands of bioengineered plants and food products. The authors review a few of the significant biotech patents to issue since the *Chakrabarty* decision, including the Harvard Mouse, the polymerase chain reaction, and primate embryonic stem cells.

Initiating an Anti-Cybersquatting Case: 16 Some Practical Considerations

In this article, Gary Beaver, a commercial litigator in the Greensboro, NC, office of Nexsen Pruet Adams Kleemeier, PLLC, examines the issues that have to be considered when contemplating a lawsuit challenging the use of a client's trademarked corporate or product name by another party. Mr. Beaver's analysis focuses on the Anti-Cybersquatting Protection Act of 1999, and ranges from consideration of the elements of a claim under the ACPA to whom to sue and where to bring suit.

Initiating an Anticybersquatting Case: Some Practical Considerations

By Gary Beaver

Imagine that a corporate CEO calls an attorney one Monday morning with a plaintive (soon to be "plaintiff") cry that while he was fooling around on the Internet the night before, he discovered two Web sites making prominent use of his company's trademarked corporate name in one Web site's domain name and its leading trademarked product name in the other domain name, each without any authorization from the company. What's the attorney to do?

The attorney should first recognize the potential remedies, which include:

- Seeking transfer of the domain names through the Internet Corporation for Assigned Names and Numbers' (ICANN's) Uniform Domain Name Dispute Resolution Policy (UDRP).
- Seeking damages (if the use is with bad-faith intent to profit) and transfer or cancellation of the domain names through provisions of the Anticybersquatting Protection Act of 1999 (ACPA), found at 15 U.S.C. § 1125(d).
- Seeking damages (if the dilution is willful) and injunctive relief under the Federal Trademark Dilution Act (FTDA), found at 15 U.S.C. § 1125(c) and § 1127.

Another option is a trademark infringement claim available under 15 U.S.C. § 1125(a).

Assume that the CEO wants to skip the less formal procedures of the UDRP, which are administered by the World Intellectual Property Organization (WIPO) in Switzerland, and instead go quickly to court for immediate injunctive relief, among other things, because although the WIPO can order transfer of the domain name, it cannot stop other trademark violations that may be occurring on the Web sites, such as the sale of counterfeit goods. The next issue to be considered is the ACPA.

The ACPA

The ACPA¹ was enacted to stop (or at least reduce) cybersquatting and the cybersquatters' efforts to try to insulate themselves from liability that might be imposed through an FTDA claim.² Cybersquatting is the practice of registering domain names incorporating trademarks and famous names for the purpose of holding them hostage if the mark holder or famous person wants to use the mark or name for their own domain names. Some cybersquatters have registered hundreds, even thousands, of domain names using trademarks or famous names and variations of them in a practice known as "warehousing."³

The ACPA helps mark owners obtain jurisdiction to stop cybersquatting with provisions creating in rem jurisdiction over the domain name when the plaintiff cannot find a proper defendant over whom personal jurisdiction can be had. The ACPA also gives federal courts authority to order the remedies of forfeiting, canceling, and transferring domain names. After a quick read of the ACPA, there are some initial steps that should be taken.

Protectable Mark

One element of an ACPA action for damages is showing that the domain name in issue is identical to or confusingly similar to a distinctive mark⁴ or famous mark.⁵ If the company's trademark is not protected by the ACPA, there is no point wasting money tilting at windmills through an ACPA claim. Therefore, before spending a lot of time developing other aspects of an ACPA claim, the attorney must make sure that the client has a distinctive or famous trademark. "Famous" has its usual meaning; "distinctiveness" is the origin-indicating quality of the mark. If its trademark is registered with the US Patent and Trademark office, the client at least has prima facie evidence that it owns a distinctive mark.⁶ However, even if the client has a registered trademark and the benefits of certain presumptions that come with such registration, the attorney should make sure that the client actually has a trademark that is distinctive, because, upon proper evidence, courts have ruled against plaintiffs with registered marks.⁷

The attorney must apply traditional trademark analysis to the protectability issue and determine where the

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client's trademark "fall[s] along the established spectrum of distinctiveness."⁸ Trademarks either can be inherently distinctive or can acquire distinctiveness through secondary meaning.⁹ The attorney must determine whether the mark is generic, descriptive, suggestive, or arbitrary or fanciful to ascertain the strength and distinctiveness and the level of protection the mark will merit.¹⁰

Generic terms receive no protection (i.e., they cannot be registered or used exclusively by anyone).¹¹ At the other end of the spectrum, arbitrary or fanciful terms are inherently distinctive. A mark is arbitrary or fanciful if there is no logical relationship between the mark and the product bearing the mark.¹² Descriptive marks receive protection if they have acquired secondary meaning, whereas suggestive marks qualify for registration without proof of secondary meaning.¹³

As noted above, registration creates a presumption that the mark is, at minimum, descriptive and worthy of protection. If the client's mark has been registered for more than five years, it gains a further presumption of incontestability that will affect the analysis.¹⁴ If the mark has qualified for incontestable status, a conclusive presumption of validity and ownership arises against any challenge that the mark is merely descriptive and lacks secondary meaning.¹⁵ That presumption, however, will not prevent a challenge that the mark is generic.¹⁶ The challenger will have to prove that the mark is generic (and, therefore, improperly registered) by a preponderance of the evidence.¹⁷

The most difficult fights are often centered on whether a mark is descriptive or suggestive. In many cases, the analysis requires more than a little effort, and determining the mark's category of distinctiveness is not always easy to do.¹⁸

Occasionally, counsel will encounter a situation in which a word is generic for one purpose but is not generic for indicating the origin of certain goods or services. The word "ivory," for example, generically refers to elephant tusks or piano keys but also serves as an arbitrary mark for a well-known soap. One also may encounter marks that began as suggestive or arbitrary marks and evolved into generic terms (e.g., "thermos," "Xerox," and "aspirin"), thereby losing their protection.

For purposes of this analysis, assume that the client's corporate name is a registered trademark (giving rise to a presumption of prima facie validity) and is an arbitrary mark that by its nature is easy to put into the protectable category—for example, a foreign-sounding family name with an unusual spelling that gives no one a clue about what the company does or produces. Assume that the product name is arbitrary and has been

registered for more than five years and, therefore, is conclusively presumed to be valid so that no proof of secondary meaning is required.

Identical or Confusingly Similar Marks

Domain names are in two parts: the top-level domain name (TLD) and the secondary level domain name (SLD).¹⁹ The TLD is the suffix identifying the nature of the site (e.g., .com, .net, .gov, .org, .info).²⁰ The SLD is the prefix identifying the site's owner or other identifier.²¹ Until September 1995, .net TLDs were given to Internet service providers (ISPs), .com and .org to commercial users, and .org to noncommercial or nonprofit users.²² After 1995, those distinctions were not made.²³ In analyzing whether a domain name is identical to someone else's trademark, the courts ignore the TLD.²⁴ When the domain name includes additional words or has minor variations in punctuation from the mark, the courts will look to see if the client's mark is the dominant part of the domain name.²⁵

Counsel should also be aware that if the Web site is a parody, it might be found not to infringe an intentionally copied mark. Dissatisfied customers, disgruntled former employees, people who imagine themselves funny through the infliction of verbal abuse and humiliation on others, or just plain curmudgeons with nasty opinions can establish "legitimate" parody sites. However, a bona fide parody must "convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody."²⁶ The key word is "simultaneously." Explanations and disclaimers that the Web site visitor reads upon arrival will not convert the domain name into a parody, because the domain name is the first message and must qualify on its own.²⁷ The use of the trademark followed by the word "sucks" in the domain name will often qualify as a parody when the Web site is dedicated to casting stones at the mark holder.

If counsel is asserting that a client's mark is famous and not merely distinctive, he or she has the additional option of showing that the domain name use is "dilutive of the mark" and not just "identical or confusingly similar to" the mark.²⁸ Plaintiffs frequently make trademark dilution claim under 15 U.S.C. § 1125(c) in addition to an ACPA claim under 15 U.S.C. § 1125(d)(1)(A)(ii)(II). The ACPA claim would provide the remedies unavailable under the traditional dilution claim in 15 U.S.C. § 1125(c)—the remedies of forfeiture and cancellation of the domain name or transfer of it to the plaintiff.²⁹

Under 15 U.S.C. § 1127, trademark dilution is defined as "lessening the capacity of a famous mark to identify and distinguish goods and services, regardless of the presence of: (1) competition of the owner of the

famous mark and other parties, or (2) likelihood of confusion, mistake, or deception." The US Supreme Court recently clarified that this means that a plaintiff must prove actual dilution to prove a 15 U.S.C. § 1125(c) claim.³⁰ Presumably, the same "actual dilution" requirement will apply to determining dilution under a 15 U.S.C. § 1125(d)(1) famous mark claim, though generally plaintiffs in ACPA claims simply rely on the alternative and more easily proved "identical or confusingly similar" standard. What will suffice as proof of actual dilution, however, is very much up in the air. The Court in *Moseley* also held that "that does not mean that the consequences of dilution, such as an actual loss of sales or profits, must also be proved" and that circumstantial evidence may suffice.³¹ It is wise to proceed with caution on dilution claims.

Bad-Faith Intent to Profit

The use of another's trademark in a domain name does not automatically constitute trademark infringement, dilution, or an ACPA violation. Under traditional trademark law, concurrent use of a trademark is allowed under certain circumstances, such as when "there may be no consumer confusion—and thus no trademark infringement—if the alleged infringer is in a different geographic area or in a wholly different industry."³² In other words, if there is no competition between the mark holder and alleged infringer, then there is likely no chance of customer confusion.³³ The ACPA was not intended to disrupt legitimate concurrent use,³⁴ and it is also important to keep in mind that some concurrent uses can be attacked as dilutive of a mark even if the uses are not infringing that mark. Several uses of marks, however, though potentially dilutive, are permitted: comparative advertising, noncommercial use, and news reporting and commentary.³⁵ Nevertheless, a competitor's proper use of a client's mark in a comparative advertisement on the competitor's Web site will not excuse the use of the mark in that competitor's Web site's domain name.

The ACPA lists nine nonexclusive indicators of bad faith.³⁶ Through the Internet, available facts can be gathered about the "bad guys" and the sins they are committing against a client that will help show bad faith. Counsel should first visit each infringer's Web site and inspect it for identification information and proof of infringement, including the uses of the client's mark and the efforts to profit on the client's goodwill. Typing in one of the infringing domain names as a search term on an Internet search engine (e.g., Google, Yahoo, Altavista) will produce a list of results that includes the infringer's Web site, which can be called www.infringer1.com. Clicking on that name or typing www.infringer1.com

will reach the Web site. Upon doing either, counsel will instantly reach the first infringer's main Web page.³⁷

It will be possible to see whether the infringer is actually selling competing products or services through the Web site through interactive software, merely advertising competing products or services for sale, performing nonprofit functions, or sitting passively with little or no information. This is important because even though trademark protections are generally extended to prohibit using another's trademark whether or not such use was for a commercial purpose,³⁸ the protections against cyberpiracy are not as broad with respect to monetary damages. The ACPA specifically limits the imposition of monetary liability to cases in which the plaintiff proves a "bad faith intent to profit from that mark, including a personal name."³⁹ Counsel may find uses of a client's mark on the infringing Web site in addition to its presence in the domain name, especially if the trademark is for a particular product and the infringer is using the trademark to cause a consumer to view an advertisement for a competing product. Using others' trademarks to divert traffic to a competitor's Web site or to sell competing goods is clear evidence of bad faith.

Often, it will also be possible to ascertain who is behind the Web site. If the infringing Web site is well developed, there will be other Web pages linked to it. Typically, on a developed, noninfringing Web site, one will find a linked Web page, entitled something like "About Us," that includes information about the corporate location and telephone numbers and possibly corporate officers or other points of contact for the company operating the Web site. If it is a sophisticated cyberpirate, there will be almost nothing useful on the Web site itself to identify who is behind it. In such a case, what are the options?

It is often possible to find helpful information about the domain name registration through sources on the Internet. Someone wanting to register a domain name can pay a small fee to a registrar, which submits the domain name to a registry where the assigned domain name is listed on a database. The registrar distributes domain names on a first-come, first-serve basis and does not attempt to determine whether a registrant has the right to use the domain name.⁴⁰

On an Internet domain name registrar's Web site, it is possible to find out information about who is involved with that Web site. There is only one registry for each TLD, but many registrars are authorized to register domain names in a given TLD. Network Solutions, Inc. (NSI) was the only registry of .com and .net domain names and was also a registrar. VeriSign Global Registry Service, Inc., purchased NSI and replaced it; however,

VeriSign continues to operate NSI as a registrar. On January 1, 2003, Public Interest Registry became the registry for all .org domain names. Because the registrar, not the registry, keeps the identification of a domain name registrant, it is necessary to go to VeriSign to find out which registrar registered the .com domain names being investigated.⁴¹ There are many registrars other than NSI, and it might take some searching to find the one that registered the infringer's Web site. Assume that the infringer of the client's mark registered through NSI. On NSI's Web site at www.networksolutions.com, clicking on the WHOIS button at the bottom of the page will link to a Web page asking for a search term. One can type in the domain name of the infringer, making sure that the circle next to the "Domain Name" under "Search by" is filled in and not the circles next to "NIC Handle" or "IP Address." The entire domain name should be typed in, with the TLD of .com, .org., .info, etc., but without "www" at the beginning. The next step is to click on the Search button, which will open onto a WHOIS Search Results page that provides information about when the domain name was created (i.e., registered) and when it is due to expire; the identities and locations of the registrant and the administrative, technical, and billing contacts; and, the identity, address, and location of the Web site's server. Registrars other than NSI usually have similar search tools.

With this information, counsel may be able to obtain some additional background information by conducting ordinary searches through an Internet search engine using as search terms the identities just discovered. Sometimes such searches discover that the registrant has already been involved in domain name disputes with others. Counsel can visit the WIPO Web site, www.wipo.org, to search for evidence that the suspects have been involved in other domain name disputes. After accessing the WIPO Web site's main page, counsel can point at "Activities & Service" and a list will appear on the screen. By selecting "Internet Domain Name," it will be possible to peruse databases that provide information about past and pending domain name dispute cases.

Counsel can also find out what other domain names any of those suspect persons or entities have registered by going to the Web site for "DialogSelect" at www.dialogselect.com and running a search of its domain name database. The same search can also be done at www.openaccess.dialog.com. When reaching either of those Web sites, counsel can type the identity of the infringing Web site's registrant into the owner name box and click on the search button. One may find that the suspect registrant is a "serial" domain name registrant who is warehousing dozens or hundreds of domain names to

sell to mark owners; is using the other domain names for Web sites that compete with the client through links on the Web site with the directly infringing domain name; or has registered domain names using many trademarks in the industry, not just the client's. Counsel can search for the domain names on the Internet to ascertain whether the registrant is actually operating Web sites using those names and whether there is any evidence of the registrant's strategy for competing against the client and others in the client's industry or of cybersquatting.

Another valuable resource is the Internet archive Wayback Machine at www.archive.org, which can be used to review earlier versions of infringing Web sites. The earlier versions may contain additional information.

Who Should Be Sued?

Counsel should find some registrant information that will allow it to identify and try to contact the infringing registrant. A quick demand to cease-and-desist may be sufficient, but a sophisticated infringer may have used false identification information or may be located outside the United States, thereby creating a possible personal jurisdiction problem. The ACPA was enacted to handle such problems, among others.⁴² The ACPA allows a trademark holder to bring an in rem action against the domain name itself when no person or entity can be found through due diligence to serve as a suitable defendant over which US courts have personal jurisdiction.⁴³

An in rem claim is proper if the domain name violates any right of an owner of a registered mark.⁴⁴ Thus, such a claim is not limited to 15 U.S.C. § 1125(d)(1) bad faith claims but can also be brought for infringement claims under 15 U.S.C. § 1114, § 1125(a), and § 1125(c) dilution claims.⁴⁵

An in rem action is "taken directly against the property, with the narrow purpose to adjudicate the ownership of that property against the claims of all persons."⁴⁶ The domain name is the property, or "res."

Because of the extraordinary nature of in rem jurisdiction, the trademark owner will not be able to obtain monetary damages against the infringer, because the ACPA limits the remedies in in rem cases to obtaining a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the trademark owner.⁴⁷ If the client is the plaintiff in an ACPA in rem action, counsel should file the lawsuit against the "res" seeking an order canceling the domain name registration or transferring it to the client, and the court will order the domain name registrar to deposit documents in the court sufficient to provide the court control and authority over the disposition of the reg-

istration and use of the domain name.⁴⁸ If the plaintiff prevails, the court will cancel the registration or order it transferred to the plaintiff.

Congress prefers in personam suits, and in rem jurisdiction is therefore available only when personal jurisdiction is not.⁴⁹ Although read in isolation, the language of the statute could lead to a reasonable conclusion that one could sue in both personal and in rem jurisdictions, the courts have so far held otherwise. One could envision a scenario in which the plaintiff could sue the registrant under the ACPA using personal jurisdiction and then learn that the registrant is an ISP acting as a front for an undisclosed foreign person or company that hired the ISP to register the domain name as registrant, or that the ISP is trafficking in domain names, including the one being challenged, or that the ISP is otherwise using the domain name with a bad-faith intent to profit from the mark. Thus far, the courts have not interpreted the ACPA to allow a plaintiff to use it to sue one defendant using personal jurisdiction and another using in rem jurisdiction.

In such scenarios, there appear to be two options for seeking monetary damages: (1) bring suit in a foreign court against the person profiting from the improper domain name; or (2) bring suit in a US court against the ISP registrant for the bad-faith intent to profit from the client's mark and hope that the court will not let the ISP off of the hook through a defense of nonwillful blindness to what the real culprit (the party actually using the domain name to profit from infringing a trademark) was doing. It will be interesting to see if the courts hold an ISP registrant fully responsible for damages flowing from an infringing domain name use on the basis of evidence of bad-faith acts of the person or entity that funded the registration and that is actually using the domain name to profit on another's mark. The ACPA list of factors to consider in determining "bad faith to profit from that mark" is nonexclusive, so there appears to be no reason why a court would not consider that evidence and hold the ISP responsible for the primary infringer's bad-faith efforts to profit from the use of the mark on the domain name's Web site. The registrant of the domain name should bear responsibility for how that domain name is used. Moreover, ISPs have the means to protect themselves from financial harm from infringers who use the ISPs to act as registrants of domain names using protected marks. The ISPs can require those who engage them to agree to hold them harmless and can otherwise limit liability for the acts of the infringer who hires the ISP.⁵⁰ Registries also typically incorporate ICANN's UDRP, which requires domain name registrants to submit to the WIPO administrative dispute resolution procedures if a mark

owner files a complaint that a domain name is identical or confusingly similar to the mark; thus, the WIPO option is normally available.

Where to Sue

An in rem action against the domain name must be filed "in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located."⁵¹ The search for the registration data at NSI should reveal the identity and location of the registrar and registry. The ACPA has notice provisions that must be complied with in order to accomplish service of process on the unknown owner/ registrant of the domain name.⁵²

All ACPA actions brought using personal jurisdiction must meet the usual rules for such jurisdiction. Personal jurisdiction exists if (1) the defendant's actions are within the reach of the long-arm statute of the state in which the lawsuit was filed and (2) constitutional due process limitations are met. This requires analysis of the nature and quality of the commercial activity that the defendant is conducting over the Internet, including the interactivity with consumers in the forum state.⁵³ Typically, the suit is filed in the client's home district, if there are sufficient contacts between the infringing registrant and that district, or in the infringer's home district. Counsel may also be able to use Federal Rule of Civil Procedure 4(k)(2) to establish personal jurisdiction over a defendant if jurisdiction is consistent with constitutional and federal law but the defendant lacks sufficient contacts with any particular state to invoke the jurisdiction of any state's courts.⁵⁴ If filed against a foreign infringer in federal court in the client's home state, counsel may be able to obtain a default judgment if the defendant fails to answer.⁵⁵

Joining Battle

Counsel should first send cease-and-desist letters explaining the client's rights and demanding cessation of the infringing use of the client's marks and transfer of the domain name (assuming the client wants it). It is wise for the client to seek transfer for the purpose of, at minimum, creating a Web site that redirects visitors to the client's existing main Web site. There is not a lot of cost in creating such a Web site, and it bolsters the client's argument that the defendant's use of the mark in the domain name is preventing the mark-holding client from making full use of the mark in Internet commerce (which can be important in showing that dilution is taking place). The infringer's refusal to comply with the cease-and-desist letter may also serve as additional evidence of bad faith.

If the cease-and-desist letter is unsuccessful, counsel must measure the evidence of ongoing irreparable harm under the relevant circuit's case law to determine the chances of obtaining a preliminary injunction. That is often a viable option if the infringer is siphoning away the mark owner's potential customers. Whether or not one seeks a preliminary injunction, counsel should decide what are the most important factors in the client's favor or what aspect of the relief sought is most important to the client and determine if jurisdiction is available in a district that values such factors or has approved of that form of relief in the past. If, for example, the client wants a fast resolution but a preliminary injunction seems unlikely on the evidence, counsel should determine if jurisdiction exists in a district with a reputation for speedy resolution of such cases (such as the Eastern District of Virginia, with its affectionately nicknamed "rocket docket").

There are many other issues that can arise in a domain name dispute, so it is important for counsel to study the new case law and stay abreast of legislative developments in this rapidly developing area of commercial law. Also, counsel should be aware that because this is an emerging area of law and the ACPA is relatively new, the law is not well settled and can differ from one federal circuit to the next. It is important to know the case law decided in the relevant circuit before proceeding.

Notes

1. Pub. L. No. 106-113, 113 Stat. 1501, 1501A-545 (1999).
2. *See, e.g., Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 266 (4th Cir. 2001), (citing S. Rep. No. 106-140 at 7 (1999)).
3. *See, e.g., Pinehurst, Inc. v. Wick*, 256 F.Supp.2d 424 (M.D.N.C. 2003) (defendant registered 800-plus domain names and generated 95 percent of corporate income from selling domain names).
4. 15 U.S.C. § 1125(d)(1)(A)(ii)(I).
5. 15 U.S.C. § 1125(d)(1)(A)(ii)(I).
6. 15 U.S.C. § 1057(b).
7. *See, e.g., Retail Services, Inc. v. Freebies Publ'g*, 364 F.3d 535 (4th Cir. 2004) (presumption of validity of registered trademark was rebutted by evidence of generic nature of term at issue).
8. *Boston Beer Co. v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 180 (1st Cir. 1993).
9. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 112 S. Ct. 2753, 120 L.Ed.2d 615 (1992).
10. *See Freebies, supra* n.7, at 538-539.
11. *See, e.g., Freebies, supra* n.7.
12. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 216 (2d Cir. 1999).
13. For a detailed description of a distinctiveness analysis, *see, e.g., BigStar Entertainment, Inc. v. Next Big Star, Inc.*, 105 F.Supp.2d 185, 192-204 (S.D.N.Y. 2000).
14. 15 U.S.C. § 1115(b).
15. 15 U.S.C. § 1065, § 115(b); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 659, 83 L.Ed.2d 582 (1985).
16. *Freebies, supra* n.7, at 542-543.
17. *Id.*
18. *See, e.g., DeGidio v. West Group Corp.*, 355 F.3d 506, 510-512 (6th Cir. 2004) (lower court applied six-factor test articulated by J. Thomas McCarthy in his treatise McCarthy on Trademarks and Unfair Competition; appellate court upheld finding mark was close to the descriptive end of a descriptive-suggestive continuum).
19. *Virtual Works, supra* n.2, at 266.
20. *Id.*
21. *Id.*
22. *Id.*
23. *Id.*
24. *Sporty's Farm LLC v. Sportsman's Market, Inc.*, 202 F.3d 489, 498 (2d Cir. 2000).
25. *See, e.g., Prime Publishers, Inc. v. American-Republican, Inc.*, 160 F.Supp.2d 266, 279-280 (D.Conn. 2001) (court ignored prefix "ct" as probable geographic location identifier).
26. *PETA v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989)).
27. *PETA, supra* n.26, at 366-367.
28. 15 U.S.C. § 1125(d)(1)(A)(ii)(II).
29. 15 U.S.C. § 1125(d)(1)(C).
30. *Moseley v. V Secret Catalogue*, 537 U.S. 418, 433, 123 S. Ct. 1115, 1124, 155 L.Ed.2d 1 (2003).
31. *Id.*, at 433-434, 1124-1125.
32. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999). *See, e.g., Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 943-946 (9th Cir. 2002) (lack of confusion because of dissimilarity of products; good explanation of analysis).
33. *See Savin Corp. v. The Savin Group*, 391 F.3d 439, 458-459 (2d Cir. 2004).
34. *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214, 233 (4th Cir. 2002).
35. 15 U.S.C. § 1125(c)(4).
36. 15 U.S.C. § 1125(d)(1)(B).
37. Basic Internet background is available at *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 734, 740-742 (E.D.Mich. 2003).
38. The courts are fond of Judge Learned Hand's assertion that "if another uses [someone's trademark], he borrows the owner's reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use." *See, e.g., Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1535 (4th Cir. 1984) (quoting *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928)).
39. 15 U.S.C. § 1125(d)(1)(A) (i).

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40. See *Mirage Resorts, Inc. v. Stirpe*, 152 F. Supp. 2d 1208, 1212 (D. Nev.2000).
41. See *GlobalSantaFe Corp. v. globalsantafe.com*, 250 F. Supp. 2d 610, 619 n.25 (E.D. Va.2003). *GlobalSantaFe* provides a good explanation of the functions of the registry and the registrar. See *id.*, at 618–624.
42. *Standing Stone Media, Inc. v. Indiancountrytoday.com*, 193 F. Supp. 2d 528, 531 n.2 (N.D.N.Y. 2002).
43. 15 U.S.C. § 1125(d)(2)(A)(ii)(II).
44. *Id.*
45. *Harrods*, *supra* n.34, at 232.
46. *Caesars World, Inc. v. Caesars-Palace.com*, 112 F. Supp. 2d 505, 508 (E.D.Va.2000) (citing *Pennoyer v. Neff*, 95 U.S. 714, 5 Otto 714, 24 L.Ed. 565 (1877)).
47. 15 U.S.C. § 1125(b)(1).
48. 15 U.S.C. § 1125(d)(2)(D)(i).
49. *Porsche Cars N.A., Inc. v. Porsche.net*, 302 F.3d 248, 255 (4th Cir.2002). See *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F. Supp. 2d 528, 534 (E.D.Va. 2000) (citing Senator Leahy’s statement at 145 Cong. Rec. S14,986–03, S15,026 (daily ed. Nov. 19, 1999)).
50. See, e.g., *Size, Inc. v. Network Solutions, Inc.*, 255 F. Supp. 2d 568, 570–571 (E.D.Va.2003) (showing NSI’s provision for limitation of liability).
51. 15 U.S.C. § 1125(d)(2)(A).
52. 15 U.S.C. § 1125(d)(2)(A)(ii)(II).
53. *ALS Scan, Inc. v. Digital Service Consultants, Inc.*, 293 F.3d 707, 713–714 (4th Cir.2002); *Graduate Management Admission Council v. Raju*, 241 F. Supp. 2d 589, 592–596 (E.D.Va.2003).
54. *Graduate Management*, *supra* n.53, at 596–600.
55. *Id.*