MISSING THE MARK IN CYBERSPACE:

MISAPPLYING TRADEMARK LAW TO INVISIBLE AND ATTENUATED USES

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"... its chief selling points are the words 'Don’t Panic'..."1

ABSTRACT

Leading cases have misapplied ordinary principles of trademark and unfair competition law in cyberspace, especially to attenuated and invisible uses. Though the leading cases uniformly assert they are merely applying ordinary principles of trademark law to cyberspace, they are actually in conflict with one another and with ordinary principles of trademark law. The leading cases are in conflict because they tend toward the extremes of over-protecting or under-protecting marks in space, and both extremes are wrong. These cases put trademark law on a path that will either diminish the value of cyberspace by imposing liability on an indexer who tries to recover costs by selling targeted advertising, or will disfigure the law itself as it adjusts the meaning of "use" to

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exonerate such activity. This article explains why current approaches are unlikely to resolve the conflicts in the cases, and suggests a desired solution.

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SUMMARY OF THE ARGUMENT

This article explicitly defends the assertion, implicit in a prior article: there is a problem with invisible and attenuated uses on the Internet or in cyberspace. That is, the current cases really do miss the mark in space. In the three parts that follow, Part I will set forth the benchmark of ordinary principles of trademark law most relevant to invisible or attenuated uses, including a broader context of related law and social norms. Part II will summarize or count the cases that over-protect and under-protect marks in space relative to ordinary principles, and then Part III will draw upon concepts from institutional economics to explain that the systemic juridical capability problem with marks in space is not entirely surprising. A concluding postscript will suggest the outlines of a solution to the problem of marks in space.

Leading cases have misapplied ordinary principles of trademark and unfair competition law in cyberspace, especially to attenuated or invisible uses. They are wrong because they do not reach the correct results, do not do so for the right reasons, and are not persuasive. When even the more influential cases dealing with marks in cyberspace are wrong—when they miss the mark in cyberspace—it is time for a reassessment. The cases are wrong


3. A high quality opinion is one that “reaches the correct result for the right reasons in a manner that is persuasive and well-written.” 20 Questions for Howard Bashman, ACAD., May 6, 2003, http://theacademy.blogspot.com/2003_05_04_theacademy_archive.html#93864929 (emphasis added) (on file with the Rutgers Computer and Technology Law Journal). For purposes of this article, a case is “wrong” if it lacks one or more of the characteristics of a high quality opinion.

4. A well regarded source highlights the problem of marks in space: “Perhaps no issue dominated trademark law at the turn of the millennium more than the question of how to protect trademark owners from misuse of their marks and symbols in cyberspace. The problem spawned legislative solutions, alternative dispute mechanisms, and the predictable body of judicial case law.”
because they have not purposefully defined the nature of cyberspace, nor have they usefully distinguished the kinds of conflicts that typically occur among the characteristic users there. As a result, the cases do not now and cannot in the future, except by luck, hit the right target for the right reason or for any persuasive reason.

This article asserts that there is a fundamental conflict in the cases that will not be resolved by any simple application of ordinary principles of trademark law, unaided by an explicit understanding of cyberspace itself. To make this article more accessible to a general readership and to identify some of the relationships between this article and a prior article, a preliminary note follows. Readers who are specialists in trademark law in cyberspace may skip immediately to Part I of the article which follows this preliminary note, but all readers might benefit from reviewing the preliminary note, either before or after reading the rest of the article.

Preliminary Note on Law and Technology: The Prior Article

This article concerns technical trademark law in two senses, but is intended for a general audience. This is because the technical or formal aspects of trademark-related law are self-contained in Part I of this article and because the technical or "high tech" aspects of cyberspace can be, and in a prior article have been, adequately explained so that ordinary lawyers familiar with ordinary principles of law can engage in the analysis. What follows are some of the reference points contained in a prior article and which will help the reader to follow the "high tech" propositions used in this one.

It is possible to define an objective cyberspace with characteristic values. Once this is understood, conflicts in

Peter B. Maggs & Roger E. Schechter, Trademark and Unfair Competition Law, Cases and Comments 3 (6th ed. 2002) (emphasis added). Despite the spawn, the problem has not yet been solved. It is interesting to ask why, exactly, the resulting body of judicial case law might have been predictable at the turn of the millennium, but better to ask whether the problem can now be more fully specified, as a step toward solving it.

5. Cyberspace may be defined as (1) an embodied switched network for moving information traffic, (2) further characterized by varying degrees of access, navigation, information-activity, augmentation, and trust. Folsom, supra note 2, at
cyberspace can be resolved in a way that is principled, predictable and practical. Moreover, the law’s interventions might also enhance the values of cyberspace, rather than destroy them. The prior article concludes that a new factor, “the nature and place of use,” can transform existing law to accommodate cyberspace disputes generally arising in fields such as contract, trademark, copyright, personal jurisdiction, and choice of law.  

An objective cyberspace includes both a gateway and a distinctive activity set, the former defining its architecture, the latter defining its function or use, and both together defining its values. These may be summarized as follows:

A cyberspace gateway is any embodied switched network for moving information traffic which may satisfy the further characteristics of cyberspace. Examples of such gateway technologies forming the architecture of space include the Internet and the phone system. 

The cyberspace activity set is a distinctive set of activities enabled or enhanced by a cyberspace gateway or technology. These include: access, navigation, information-activity, augmentation (and trust).

80. Appendix A, infra, distills analysis of the prior article into a glossary.
7. Id. at 93-94.
8. Id. at 81-82 (the Internet as an embodied switched network for moving information traffic), 84 (the phone system likewise); see also Interview by Dan Josefsson with William Gibson, Nov. 23, 1994, http://www.josefsson.net/gibson/ (on file with the Rutgers Computer and Technology Law Journal) [hereinafter Gibson Interview] (“Well, you know, I think in a very real sense cyberspace is the place where a long distance telephone call takes place. Actually it’s the place where any telephone call takes place and we take that very much for granted. Otherwise, I would say that when people use the Internet, that’s when they’re most obviously navigating in cyberspace.”). Mr. Gibson is credited with coining the term “cyberspace.” See, e.g., 3 OXFORD ENGLISH DICTIONARY ADDITIONS SERIES 107 (John Simpson ed., 1997) [hereinafter OED]: Folsom, supra note 2, at nn.45 & 46 (connecting the OED attribution to Mr. Gibson as the original author); Shulamit Almog, Creating Representations of Justice in the Third Millennium: Legal Poetics in Digital Times, 32 RUTGERS COMPUTER & TECH. L.J. 183, 234 (2006) (noting that Mr. Gibson also uses the term “matrix” to signify what we refer to as “cyberspace”).
9. Folsom, supra note 2, at 84-92. Hence, cyberspace is, by shorthand, defined as (1) a cyberspace gateway, (2) further characterized by varying degrees of the cyberspace activity set. Id. The gateway constitutes the architecture of
Cyberspace values (characteristics or virtues) are the distinguishing features in its architecture (design) and in its function (use). Any particular event that intersects with or occurs within an objective cyberspace is more or less valuable to the extent it actually implicates the distinctive characteristics of cyberspace. Other things being equal, and the law being open for development in one way or another, there is a substantial advantage in choosing to develop the law along a path that furthers the values of cyberspace, rather than along a path that doesn’t.\(^{10}\)

As cyberspace implies navigation, the prior article suggested that “markers” in space can be used as invisible or attenuated addresses, magnets or marks (or as roadblocks or detours).\(^{11}\) Understanding the nature of use in the context of navigational interests and conflicts in an objective cyberspace may be summarized as follows:

A marker in cyberspace is any expression placed in cyberspace that functions as a visible, invisible, or attenuated address or magnet to draw a user to an expected destination. Some markers aid in the access, navigation and information activity of cyberspace; other markers retard those values while destroying trust, making augmentation dangerous, and constructively denying access. In the invisible marker include hidden text or unseen metatags placed within a web site, or deployed within keywords that trigger targeted advertisements, all of which act as magnets cyberspace, and the distinctive activity set describes its characteristic function or use. See id. This captures the notion that cyberspace is not simply “the Internet” or a “phone system”—mere technology that has no inherent nature or value at all—but is a dynamic, or a matrix, that admits of degrees. Some activities on the Internet are merely transposed transactions from ordinary space, and may not need any particular legal response at all. See id. at 93. But other transactions on the Internet may invoke much more substantially the cyberspace activity set in ways that exemplify distinctive cyberspace values, and also might require at least some explicit accommodation, recognition, or even encouragement, help, or support from the legal system. Id. at 93-94. It would be nice if the legal system were able to distinguish the important from the unimportant aspects of technology. See id. at 114-15. The importance, if any, of cyberspace comes from the new relationships and activities it enables, not from any new technological use it happens to embody. Id. at 87.

10. Id. at 93. It would be good if the legal system were able to distinguish between those juridical legal choices that would tend accidentally to destroy cyberspace and those legal choices that might actually enhance or improve it. See id. at 120.

11. Id. at 102.
to draw traffic. *Attenuated* markers include vanity domain names or phone numbers, both of which act as addresses to draw traffic to the site or to the dialed number. Other dispositions of invisible markers might occur when an expression is warehoused, or otherwise removed from circulation, effectively acting as a *roadblock* to spoil another’s use of that expression as a marker; or when an expression is used as a *detour* to trap or divert traffic from an otherwise intended destination. The spoiling or trapping marker hinders a user from reaching an otherwise expected destination, or deceives a user into going to a different destination than intended.\(^\text{12}\)

The concept of markers in space, functioning as they do, allows for a distinction between harmful or predatory activity on the one hand, and helpful or value-adding services on the other.\(^\text{13}\) This may be summarized as follows:

A *pirate* in cyberspace includes any person who changes the “map” to cyberspace by moving markers, taking markers out of circulation, or placing false markers, thereby planting deceptive magnets and addresses, or otherwise spoiling or tampering with the ability of users to navigate in cyberspace. A magnet or address is deceptive to the extent it draws a user to an otherwise unintended destination, or hinders a user from reaching an expected destination. Piracy is the more harmful to the extent it is the more uninvited, predatory and non value-adding.\(^\text{14}\)

A *guide* in cyberspace is any person (a mapper) who places or who controls the placement of addresses or magnets, publishes addresses or magnets in the form of a directory or search engine, or otherwise promotes navigation in cyberspace; or any map, chart, directory, search engine or comparable resource (a guide book) produced by a mapper or a guide.\(^\text{15}\)

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12. *Id.* at 102-04. A “marker” that serves as a trademark in space may be called a mark. Hence, markers in space can serve as addresses, magnets or *marks* (or as roadblocks or detours), and various combinations of these.
13. *Id.* at 104-07.
14. *See id.*
15. *Id.* If a *hitchhiker* in cyberspace is the prototypical surfer on the Internet, then a hitchhiker’s guide would be something highly to be desired, and perhaps even encouraged as a public good and certainly in the public interest. *See generally* ADAMS, *supra* note 1. It would seem rather remarkable that in the readily available Internet directories and search engines, something very like the hitchhiker’s guide already exists, and it would seem more remarkable still, and a
The foregoing expressions tend to define an objective cyberspace, with objective values and characteristics. The definitions are not so vaporous as to cover any or all "virtual realities" nor are they so viscous as to descend to the level of technological minutiae. These are realistic, readily observable, and useful expressions to help account for everyday experience and observation. They help to create a language in which it is possible more precisely to talk about what everybody already more or less knows is going on in cyberspace.16

Beyond the general discussion of cyberspace, there are some specific reference points contained in the prior article that will help to orient the reader to the contested points at the intersection of trademark-related law with cyberspace. There is both a technical problem and a legal problem, each summarized below:

The technical problem is that cyberspace permits cyberspace interventions: purposeful actions, consented or un-consented, harmless or predatory, value-adding or free-riding activities by an actor in cyberspace that have an objective effect on other persons or electronic agents. These include not only visible uses in matter displayed in cyberspace, but most significantly also include invisible and attenuated uses of markers as address, magnet and/or mark (and also as roadblock or detour). Indeed, these invisible or attenuated uses of markers in cyberspace have come to represent the most difficult problem for trademark-related law to handle.17

The legal problem for trademark-related law in space arises most acutely with invisible or attenuated uses of trademarked terms that draw traffic to a site that is neither owned nor sponsored by the trademark proprietor, or that block or divert traffic that was intended for the mark proprietor. Cyberspace interventions by invisible and attenuated users of markers in

pity, if the law, in its over-exuberant giddiness as it thrashes about with mark-type conflicts in cyberspace, should kill such a resource. See discussion infra Part II; cf. eBay, Inc. v. MercExchange L.L.C., 126 S.Ct. 1837, 1839-40 (2006) (patent case; injunctive relief as a remedy for infringement of an intellectual property right is properly granted only after weighing all the factors, including the public interest).

16. It is no longer appropriate to pretend that this is "new" technology. In its generally understood and commonly experienced sense, it is actually quite old. See Folsom, supra note 2, at 97-99.
17. Id. at 101.
space create a problem for trademark law precisely because ordinary trademark law deals with likelihood of confusion caused by an offending use of a designation. It is not surprising that trademark law should struggle with invisible or attenuated cyberspace interventions, even though such uses leave an objective trail, actually attract consumers, and may be designed to do so with predatory intent.\textsuperscript{18}

The prior article proposed the \textit{nature and place of use} as a new factor that can bridge the gap between cyberspace and any legal domain (including trademark law) that intersects with cyberspace.\textsuperscript{19} For trademark law, the nature and place of use helps to account for the characteristic mark-type conflicts in space arising among the typical users there because it can articulate them in a manner useful to legal decision-makers:

The \textit{typical mark-type conflict} is the invisible or attenuated use of a trademarked expression by someone other than the proprietor of the mark and that draws traffic (as address, magnet and/or mark) to a destination other than that of the mark proprietor; or hinders or diverts traffic, as a roadblock or detour.

The \textit{characteristic users} of markers in cyberspace include: surfers and mappers, trappers and spoofer, spoilers and arbitrageurs, and also consumers, mark proprietors and competitors. A cyberspace user might simultaneously act in more than one capacity to some degree, or might sequentially move from one capacity to another, with different interests and concerns in each capacity.\textsuperscript{20}

The varieties of the typical mark-type conflict, coupled with the variable (and changing) nature of the characteristic users in cyberspace, have thus far hidden the solution to the problem of markers in space. The new factor, the nature and place of use, converts the problem from one of technical mystery into one more capable of legal solution.\textsuperscript{21} As asserted in the prior article, “Once cyberspace and its typical conflicts among characteristic users are translated into the more familiar concepts with which lawyers more routinely deal, legal conflicts in cyberspace will more nearly

\begin{itemize}
\item \textsuperscript{18} Id. at 101-02.
\item \textsuperscript{19} Id. at 80, 107-09.
\item \textsuperscript{20} Id. at 104-07
\item \textsuperscript{21} Id at 78.
\end{itemize}
resemble the kinds of conflicts legal decision makers are well adapted to handle, have handled in the past, and can probably continue to handle in the future despite the new technology. 22

It must be emphasized that this preliminary note merely describes the problem in terms that appeal to common sense and to the common experience of what is actually happening in cyberspace. It does not yet solve or prescribe anything, but it does set the table for the discussion to come. It is not yet to be supposed that this article is going to suggest that every cyberspace intervention by every pirate must necessarily infringe some trademark, at least under current standards and remedies. 23 But the current case law certainly stands for the proposition that some invisible and attenuated users will be liable, and others not. It would be odd indeed if it were the guides and their guidebooks that are being threatened by the law, while the pirates are not. This would seem a perverse result, and one that risks the casual destruction of the values of cyberspace by an ironically clumsy juridical interference, presumably meant to do some good but actually creating the opposite effect. And yet this oddly perverse condition seems to be just what the current law is in the process of achieving.

This article asserts that the leading cases are putting trademark law on a path that will either overprotect and thereby diminish the value of cyberspace by imposing liability on a guide who tries to recover costs by selling targeted advertising, or will under-protect and simultaneously disfigure the law itself by adjusting the meaning of “use” to exonerate such activity—meanwhile winking at real pirates running rampant, untouched by the current law’s misguided unimaginative reach. This article will have satisfied its modest goal if it convinces the reader that there is an irreducible conflict in the cases that will lead to undesirable results, and is highly unlikely to be resolved by current approaches in trademark-

22. Id. (footnote omitted).

23. This article will, however, eventually suggest, under a modified but recognizably trademark-style approach that is different from current law, that many pirates should be required to undertake remedial steps that will better ensure the integrity of markers as guides to the navigation of cyberspace. See discussion infra Part III.C.
related law. The broader goal of this article is to suggest the problem can be resolved by the introduction of a new factor (the nature and place of use) into any analysis of mark-type conflicts in cyberspace.

This article does not assume every reader is already familiar with the leading cases in cyberspace or even that there is general agreement among the “experts” as to what those cases might be. Thus, it would not be amiss to say here at the beginning that this article designates two leading cases to represent the asserted extreme of over-protection of marks in cyberspace,24 two leading cases to represent the asserted extreme of under-protection of marks in space,25 and a sampling of well known cases to represent all those ad hoc cases in between.26

I. THE BENCHMARK: ORDINARY PRINCIPLES OF TRADEMARK-RELATED LAW

The benchmark must be “ordinary principles” of trademark-related law as applied in ordinary space. The leading cases make no attempt to create any sort of new or special law for trademarked expressions on the Internet or in cyberspace. Instead, even as they

24. Playboy Enters., Inc. v. Netscape Commc‘ns Corp., 354 F.3d 1020 (9th Cir. 2004); Brookfield Commc‘ns, Inc. v. W. Coast Entm’t Corp., 174 F.3d 1036 (9th Cir. 1999). This article asserts that both Netscape and Brookfield “over-protect” marks in cyberspace compared to ordinary space by creating trademark liability in cyberspace greater than, and in conflict with, ordinary principles of trademark-related law. See discussion infra Part II.A.

25. 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400 (2d Cir. 2005); Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619 (6th Cir. 1996). This article asserts that both 800 Contacts and Holiday Inns “under-protect” marks in cyberspace compared to ordinary space by refusing, in conflict with ordinary principles of trademark-related law, to find any basis upon which even to apply the law to allegedly offensive or clearly predatory mark-type activity in cyberspace. See discussion infra Part II.B.

26. Playboy Enters., Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002); PETA v. Doughney, 263 F.3d 359 (4th Cir. 2001); Sporty’s Farm, L.L.C. v. Sportsman’s Mkt., Inc., 202 F.3d 489 (2d Cir.), cert. denied, 530 U.S. 1262 (2000); Panavision Int’l, L.P. v. Toeppen, 141 F.3d 1316 (9th Cir. 1998). This article asserts that these cases (and dozens of others) under the shadow of the over- and under-protection extremes are interesting but ultimately unsatisfying ad hoc solutions to trademark-type disputes involving invisible or attenuated conflicts in cyberspace. See discussion infra Part II.C.
conflict with each other, they claim to be doing nothing more than applying ordinary principles of trademark law to invisible or attenuated uses in cyberspace (or on the Internet). For purposes of this article, ordinary principles of trademark law are defined as those commonly set forth in the Restatement, in the leading treatises, in popular law school teaching materials on trademark or so-called "Internet" law, in the guidelines used by federal trademark examiners, and, unless otherwise noted, in the Federal Trademark Act. These provide the benchmark against which to measure the cases that take trademark law to the Internet and into

27. Compare, e.g., Brookfield, 174 F.3d at 1066 ("As we have seen, registration of a domain name for a Web site does not trump long-established principles of trademark law... Similarly, using a competitor's trademark in the metatags of such a site is likely to cause what we have described as initial interest confusion. These forms of confusion are exactly what the trademark laws are designed to prevent."). With, e.g., Holiday Inns, 86 F.3d at 626 (an activity that was held not to be a "use" of a trademarked term did not constitute trademark infringement, nor would it justify "stretching the plain language" of the Lanham Act to reach the offending conduct).


cyberspace.

The touchstone of trademark infringement is likelihood of confusion.34 This is because the root of trademark law is deceit, and accordingly its concern is with the protection of consumers from source or sponsorship confusion.35 Although mark proprietors might devoutly wish they could, as if by something like the now-discredited “sweat of the brow” theory,36 simply protect their investment in advertising or promoting a word or other designation by claiming rights in the designation per se, it is not any part of ordinary common law trademark or unfair competition law to award property-like rights in designations themselves in the absence of likelihood of confusion.37 But likelihood of confusion analysis has developed in such a way as to require doctrinal sophistication. Meanwhile, ordinary trademark law is suffering from what has nicely been called “doctrinal creep” as increasing

34. 3 Mccarthy, supra note 29, § 23.01(1) (according primacy to likelihood of confusion).

35. Id. (quoting Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 157 (1989) (“The law of unfair competition has its roots in the common-law tort of deceit; its general concern is with protecting consumers from confusion as to source”)). For more on the relationship between trademark infringement and unfair competition, see infra notes 132-35.

36. See generally Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 352-54 (1991) (a copyright case rejecting the sweat of the brow theory: “Making matters worse [some courts] developed a new theory to justify the protection of factual compilations ... the underlying notion [of the “sweat of the brow” theory] was that copyright was a reward for the hard work that went into compiling facts ... [b]ut to accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of ‘writings’ by ‘authors’”). Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111 (1938) (no amount of hard work could create a monopoly in the words “shredded wheat” by establishing trademark rights in a generic expression). Perhaps there might be some relief, in some cases, under some theory of unfair competition. See Feist, 499 U.S. at 354 (preserving the unfair competition possibility); Int’l News Serv. v. Associated Press, 248 U.S. 215, 221 (1918) (recognizing some sort of unfair competition remedy for certain non-copyrighted, non-trademarked news materials gathered at some expense), criticized and explained in Restatement (Third) of Unfair Competition § 38 cmts. b & c (1995).

37. Some other statutory liabilities outside of trademark law, including protection against dilution of famous marks in the absence of confusion, resemble property rights. See Lanham Act § 43(c), 15 U.S.C. § 1125(c) (federal remedies for dilution of famous marks).
pressure has been brought to bear to expand rights in designations
to create liability in the absence of likelihood of confusion.38
Finally, it must be remembered that trademark law is not the only
game in town, but coexists within and with other legal domains.
Some amplification of each (likelihood of confusion, doctrinal
creep, and other legal domains) will help to orient the reader
toward the benchmarks that comprise “ordinary principles of
trademark-related law” and without which the cases in cyberspace
cannot be understood.

A. Trademark Law and Likelihood of Confusion

A trademark is any word, name, symbol, device, or other
designation that is distinctive of a person’s goods or services and is
used in a manner that identifies those goods and services and
distinguishes them from the goods or services of others.39 At
common law a trademark is acquired by appropriation,40 sometimes
amplified as “adoption, affixation, and use.”41 To create the
necessary association in the minds of consumers or prospective
purchasers between the designation and the related goods or
services, the “use” must be an actual “use in commerce” in the
ordinary course of business or trade which connects the designation
to products of the proprietor that are offered or sold to prospective
purchasers.42 When two users attempt to establish trademark rights
in the same designation, one has priority over the other in the
geographical and product markets in which it is first to use, or
where an applicable statutory provision provides for priority on

38. See discussion infra Part I.B (doctrinal creep).
40. Id. § 18.
41. See id. §§ 18-19. The designation must be selected (adopted), and
associated with some goods or services (affixed) that are sold in commerce (used)
to create an impression in the minds of consumers in the geographic area in which
the association occurs. See id. § 18 cmt. d (noting changing commercial and
marketing practices and consequent relaxation of the more rigid formulations).
42. Id. § 18 (“A designation is ‘used’ as a trademark when the designation is
displayed or otherwise made known to prospective purchasers in the ordinary
course of business in a manner that associates the designation with the goods,
services or business of the user”); Lanham Act § 45, 15 U.S.C. § 1127 (“use in
commerce” means “the bona fide use of a mark in the ordinary course of trade”).
See infra notes 89-93 for other senses of “use” in trademark law.
some other basis.\textsuperscript{43}

Having obtained a mark, the proprietor has acquired not a property in the designation, but a right to prevent an offending use that creates a likelihood of consumer confusion.\textsuperscript{44} While “likelihood of confusion” seems disarmingly simple, and sometimes is,\textsuperscript{45} it does have at least five doctrinal generalizations and two observations most relevant to invisible and attenuated uses on the Internet or in cyberspace. These generalizations also tend to approach the metaphysics of the other branches of intellectual property law.\textsuperscript{46}

\textsuperscript{43} See Restatement § 19. The “statute” to which the Restatement refers is the Federal Lanham Act, which provides for certain nationwide geographic rights upon filing (nationwide constructive use, contingent upon eventual registration) and registration (nationwide constructive notice) of a mark. See Lanham Act § 7(c), 15 U.S.C. § 1057(c) (“Contingent upon registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute nationwide constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration’’); id. § 22, 15 U.S.C. § 1072 (“Registration of a mark on the principal register provided by this chapter . . . shall be constructive notice of the registrant’s claim of ownership thereof.”).

\textsuperscript{44} See Restatement §§ 18-20.

\textsuperscript{45} “Confusion is most likely to result when an unauthorized party uses a mark identical to that of the [proprietor] on the exact same type of goods or services as are sold by the [proprietor] and sells those in the exact same geographic area.” See Schechter & Thomas, supra note 30, at 637. Such cases would be relatively simple, but:

Of course most litigated cases of trademark infringement are not this easy. It is quite common to encounter legal controversies where the [offending party] is using a similar, but not identical version of the [proprietor’s] trademark . . . or where the [offending party] is using the same marks on different types of goods . . . or where the [offending party] is doing business in a region of the country remote from the [proprietor’s] area of operations . . . . Moreover these permutations can be combined.

\textit{Id.}

\textsuperscript{46} It is famously observed that copyrights and patents “approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle [sic] and refined, and sometimes, almost evanescent.” Folsom v. Marsh, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4901) (Story, J.). If trademark is in any sense a species of intellectual property like copyrights and patents, then it should be expected to carry at least a trace of its own metaphysics.
1. The first generalization: not mere inconvenience or possibility of confusion

"Likelihood of confusion" does not require that any confusion actually occur, and yet it demands more than a mere possibility of confusion. 47 "Many consumers are ignorant or inattentive so that some are bound to misunderstand no matter how careful a producer is." 48 If liability attached merely at the level of "possible" confusion, then trademark law would overprotect the proprietor by reference to "a small and naïve segment of the public." 49 What is protected against is confusion and its likelihood, not some inconvenience or frustration, and not naïveté or their likelihood (or their actuality). 50 The harm of overprotection would be to take words or other designations out of common usage to a degree greater than necessary to prevent a likelihood of confusion. 51

2. The second generalization: sponsorship as well as source

Liability attaches for "likelihood of confusion" either over the source of the goods or services or over their sponsorship. 52 Source confusion exists if consumers are likely to think the proprietor of the mark provided the goods or services that are offered by the offending user. 53 This would tend to involve direct or indirect competitors offering the same or related goods or services, perhaps including complements and substitutes, where the offending party is seen to be trading off the goodwill of the mark proprietor. 54

47. See Schechter & Thomas, supra note 30, at 638.
48. Id. (quoting August Stork K.G. v. Nabisco, Inc. 59 F.3d 616 (7th Cir. 1995)).
49. Id.
50. See id.
51. The starting point, or null hypothesis, is that anyone is free to compete against anyone else, using any word, phrase, or designation unless prohibited by some principle of trademark law or other legal regime. See Restatement (Third) of Unfair Competition § 1 (1995).
53. Schechter & Thomas, supra note 30, at 639.
54. See id. See generally Richard A. Posner, Economic Analysis of the Law 44 (7th ed. 2007) ("A screwdriver and a screw are complements; a screwdriver and a hammer are substitutes.").
Sponsorship confusion exists if consumers are likely to think the proprietor has licensed or otherwise endorsed the goods or services of the offending party. This can involve non-competing goods and promotional goods. What is protected against is not only source confusion but also sponsorship confusion, and sponsorship confusion is increasingly important in a merchandising and franchising commercial culture.

3. The third generalization: not for the small number of confused consumers

Liability will not attach for “likelihood of confusion” unless an “appreciable” or “substantial” number of consumers are likely to be confused. This disregards conduct that will confuse only the “(hopefully small number of) inattentive or foolish consumers.” Trademark protects the substantial number of consumers, not the few, and this is increasingly important as new technological uses invite users of different attention levels to participate in conduct that implicates trademarked designations, and then habituates those users to the customs, or at least the architecture, of the new technological environment. Neither the foolish nor the few should be a drag on the others who know what they are doing in cyberspace, nor should the interests of those few who are just learning to surf in cyberspace dominate the interests of the substantial numbers who have been in cyberspace for more than a

55. See Schechter & Thomas, supra note 30, at 63.
56. Id.
57. Id. at 661-63. (“It has become routine to see shirts, caps, jackets, coffee mugs, mouse pads, key rings and a host of other similar and relatively inexpensive items, often called ‘promotional goods,’ emblazoned with well-known trademarks. Usually those trademarks belong to firms that are not in the clothing or coffee mug business.”).
58. Id. at 639 (discussing the absence of any bright line, noting various rules of thumb, and observing an equivalent formulation involving confusion of the “reasonably prudent consumer”). While the first generalization may go to the quality of the confusion in the mind of any one consumer, this third generalization goes to the quantity of those confused—the absolute number or relative proportion of those consumers who are reasonably confused compared to those not.
59. Id. at 640.
60. See infra note 161 and accompanying text (some of Professor Lessig’s observations on the architecture of electronic commerce).
few minutes or outweigh the public interest in a robust and navigable cyberspace.\textsuperscript{61}

4. The fourth generalization: questions of fact

"Likelihood of confusion" is determined as a fact question, depending on a multi-factor analysis, which differs in its precise formulation while maintaining substantial commonality in various jurisdictions.\textsuperscript{62} Each of the federal circuits has its own variation of the list of factors,\textsuperscript{63} and so does the \textit{Restatement}.\textsuperscript{64} But the factors are not meant to be rigid formulae, and are only meant as a guide to resolving the ultimate question, which remains "likelihood of confusion."\textsuperscript{65} At the level of \textit{competing} goods and services, the common core factors include: (1) similarity or dissimilarity of the subject mark and the offending designation as to sight, sound, and meaning, (2) similarity or dissimilarity in channels of distribution and marketing of the goods and services, (3) the sophistication and degree of care likely to be exercised by prospective consumers, and (4) the degree of distinctiveness of the subject mark.\textsuperscript{66} At the level of \textit{non-competing} goods and services, there is an additional factor: (5) the likelihood that the prospective consumers of the offending designation would expect a person in the position of the mark proprietor to expand its goods or services or to expand its sponsorship into the non-competing goods or services of the

\textsuperscript{61} See infra notes 79, 244 (\textit{eBay} as at least suggesting that the public interest in a navigable cyberspace might be a factor deserving of greater consideration).

\textsuperscript{62} See \textsc{Schecter} \& \textsc{Thomas}, supra note 30, at 640.

\textsuperscript{63} \textsc{Dinwoodie} \& \textsc{Janis}, supra note 30, at 470-71, fig.7-1 (listing the criteria by Circuit); see, e.g., Synergistic Int'l, LLC v. Korman, 470 F.3d 162, 170 n.9 (4th Cir. 2006) ("The test for trademark infringement and unfair competition under the Lanham Act is essentially the same as that for common law unfair competition under Virginia law because both address likelihood of confusion as to the source of the goods or services involved.").

\textsuperscript{64} \textsc{Restatement (Third) of Unfair Competition} §§ 21-23 (1995).

\textsuperscript{65} See \textsc{Schecter} \& \textsc{Thomas}, supra note 30, at 640; \textit{Gen. Motors Corp. v. Lanard Toys, Inc.}, 468 F.3d 405, 412 (6th Cir. 2006) ("These factors imply no mathematical precision, but are simply a guide to help determine whether confusion is likely.").

\textsuperscript{66} See \textsc{Restatement} § 21(a)-(d). These factors are abstracted from cases that articulate particular lists, not identical to one another, but substantially similar. See, e.g., 3 \textsc{McCarthy}, supra note 29, § 23.01[1], 23.03[1] (noting provenance and similarity to tests for non-competing goods).
offending user.\textsuperscript{67} And, as the Restatement puts it, there are two permissive factors: (6) the intent of the offending user,\textsuperscript{68} and (7) the existence of actual confusion (or not).\textsuperscript{69}

5. The fifth generalization: special cases and context

There are several other peculiarities in determining "likelihood of confusion," each of which makes sense in context but each of which can be taken dramatically out of context. One peculiarity is this: likelihood of confusion is usually assessed at the point of sale, but sometimes before.\textsuperscript{70} This temporal disruption can lead to a finding of likelihood of confusion (prior to sale) in the absence of

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\textsuperscript{67} See Restatement § 21(e). This is often a function of the similarity or dissimilarity of the goods and services themselves. See, e.g., 3 McCarthy, supra note 29, § 24.06[4][a].

\textsuperscript{68} See Restatement § 22. Infringement is based on "likelihood of confusion" and does not require any intent at all on the part of the offending user. See id. § 22(1). The intent factor is permissive in the sense that intent to cause confusion may be considered, and occasionally is a strong, almost conclusive factor, id. ("likelihood of confusion may be inferred from proof that the [offending user], used a designation... with the intent to cause confusion or to deceive"), but the strength of the intent factor can be dispelled if the offending user was acting "in good faith under circumstances that do not otherwise indicate an intent to cause confusion or to deceive," id. § 22(2). The point is that an innocent user may cause an actionable likelihood of confusion without any intent to do so, but a person who is trying to cause confusion will be presumed to have been successful at it. See id. § 22(1). Yet, if the offending user believes in good faith that the subject mark is invalid, weak, or non-competing as to goods or services or geographically, then even an "intent" to compete by using the same or similar mark does not suggest any intent to cause confusion or to deceive. See id. § 22(2).

\textsuperscript{69} Id. § 23. This is permissive in the sense that "likelihood of confusion" does not require any actual confusion at all, but if there is proof of actual confusion, then there is a strong, almost conclusive inference that confusion was at least "likely." See id. §23(1). But any actual confusion still must be among an appreciable number of reasonable prospective consumers and not some small and na"ive subset, if it is to be probative. See supra notes 48, 58 and accompanying text. At the same time, the absence of any actual confusion, at least where the offending user and the mark have coexisted for a substantial period of time, supports the inference that there is no likelihood of confusion. See Restatement § 23(2).

\textsuperscript{70} See 3 McCarthy, supra note 29, § 23.01[4][b]. There may be liability for confusion after the point of sale as well, id. § 23.01[4][c], but such "post sale" confusion does not presently pose the same problem for invisible and attenuated uses in cyberspace as does "pre sale" (or "initial interest") confusion.
any possible confusion whatsoever (at the time of sale).  
This, in turn is complicated by disclaimers that sometimes suffice to dispel any confusion (at the point of sale) but at other times fail to dispel confusion. A presale problem gives rise to what is called “initial interest confusion”—the actionable harm to the proprietor of the mark occurs if, because of likely confusion prior to the point of sale, the proprietor “may be precluded from further consideration by the potential purchaser in reaching his or her buying decision.”

Initial interest confusion might seem very like a finding of trademark infringement liability in the absence of likelihood of confusion, but its rationale is in fact based on a temporal likelihood of confusion (presale) that likely deprives the mark proprietor of a potential customer (at the point of sale). The problem with point of sale disclaimers is that, even though they may be clearly worded, it is not so clear whether they are effective. Sometimes disclaimers are sufficient, sometimes not, depending on the circumstances. It is debatable whether the findings of initial interest confusion liability, when they are based on confusion created prior to a sale even though dispelled by the time of sale, are

71. See id. § 23.01[4][b].
72. See SCHECHTER & THOMAS, supra note 30, at 649.
73. 3 McCARTHY, supra note 29, § 23.01[4][b] (emphasis added) (citing HRL Assocs., Inc. v. Weiss Assocs., Inc., 12 U.S.P.Q.2d 1819 (Trademark Tr. & App. Bd. 1989) (determining that initial interest confusion constitutes a ground to deny registration under Lanham Act §2(d) in a PTO inter partes proceeding, and that injury to the proprietor of the mark occurs “if a potential purchaser is initially confused between the parties respective marks in that [the proprietor] may be precluded from further consideration by the potential purchaser in reaching his or her buying decision.” (emphasis added)), aff’d on other grounds, 902 F.2d 1546 (Fed. Cir. 1990)); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254 (2d Cir. 1987) (liability even though any confusion between “Pegasus” and Mobil Oil’s “flying horse” would be dispelled prior to sale, and the purchaser entered into a business transaction in an unconfused state of mind).
74. See 3 McCARTHY, supra note 29, § 23.01[4][b].
75. See SCHECHTER & THOMAS, supra note 30, at 649. As a result, while courts “naturally will consider” any disclaimer when analyzing the likelihood of confusion, the use of a disclaimer “does not provide a ‘safe harbor’” especially when the disclaimer is small, inconspicuous, or not clearly worded. Id.; see Jacob Jacoby & George J. Szymbro, Why Disclaimers Fail, 84 TRADemark REP. 224 passim (1994) (presenting empirical evidence that many disclaimers are ineffective).
76. See SCHECHTER & THOMAS, supra note 30, at 649.
in the nature of a prophylactic remedy, a moral condemnation of nearly fraudulent conduct, an economic calculus, or are simply irrational, but it is beyond debate that the tendency to make such findings of liability exists.\footnote{See sources cited supra note 73; cf. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 cmt. d (1995). The reporters’ note to section 20 of the Restatement perhaps casts doubt on the doctrine by faint allusion to its existence: “Several cases suggest that pre-sale confusion of source or association that is likely to harm the commercial interests of the trademark owner is actionable as an infringement even if the confusion is dispelled before the actual purchase.” RESTATEMENT § 20 reporters’ note, at 222-23. Were there a blank slate on which to write, it might have been more correct to conclude that such initial interest confusion should not constitute trademark infringement because of the absence of any likelihood of confusion at the point of sale, but that certain instances of initial interest confusion might constitute unfair competition because of the combination of quasi-fraud and quasi-theft at the (resale) point of consumer diversion, coupled with a resulting sale that the mark proprietor was precluded from winning. As to unfair competition and its quasi-fraud and quasi-theft strands, see generally infra notes 132-34.}

6. An almost-final, sixth observation: a flexible remedy (and eBay)

The remedy in trademark law is one that fits the nature of the harm. The standard remedy is often an injunction.\footnote{See RESTATEMENT § 35(1) (“Unless inappropriate under the rule stated in [§ 35(2)], injunctive relief will ordinarily be awarded”), § 35(2) (the “appropriateness and scope” of injunctive relief depends upon factors including the nature of the interest to be protected, § 35(2)(a), the nature and extent of the wrongful conduct, § 35(2)(b), and the interests of third person and the public, § 35(2)(e), among other factors).} This is because of the ordinary injunction factors, and not because of a property analysis or automatic rule.\footnote{See id. cmt. a (“the judicial preference for injunctive relief in unfair competition cases is not an exception to ordinary remedial principles, but rather an application of those principles in a context in which injunctive relief is ordinarily the most appropriate remedy”), cmt. b (“a prevailing plaintiff is ordinarily awarded injunctive relief to protect both the plaintiff and the public from the likelihood of future harm . . . . Although injunctive relief is routinely granted in unfair competition cases, the remedy remains subject to equitable principles . . . [t]he plaintiff’s interest in protecting the good will symbolized by its trademark or in preserving a truthful marketplace is unlikely to be adequately secured by monetary relief, and the equities thus normally favor the award of an injunction. The public interest in preventing confusion and deception also typically weighs in favor of an injunction.”). The ordinary injunction factors are irreparable injury,
purpose and rationale of trademark law—if there has been something very like deception, then there is no remedy unless and until the deception stops, and the nature of the injunctive relief is tailored to the nature of the harm against the public interest. Beyond the injunction, a monetary remedy, when available, will include the possibility of damages and of disgorgement of the offending party’s profits. The disgorgement remedy exists not because the law has forgotten that normal remedies are based on the injured party’s loss, nor because it is squarely a punitive measure based on willful injury. Instead, it is a consequence of the rationale of trademark law—if there has been something like the hijacking of sales that were likely to have gone to the true owner, then there is no remedy unless and until there has been something like an accounting. If the trademark proprietor can show actual lost sales or other pecuniary loss then, of course, the proprietor’s losses will be part of a damages remedy. This recovery for monetary damages to the trademark proprietor is not a necessary part of the remedy, nor is it necessarily common.

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the inadequacy of money damages, balancing of the hardships between plaintiff and defendant, and the public interest. See eBay, Inc. v. MercExchange L.L.C., 126 S.Ct. 1837, 1839 (2006). If the mark proprietor’s losses cannot be demonstrated with certainty, then this is functionally equivalent to saying that there are no monetary damages, and so strictly speaking, there is no dollar loss; and yet the interest of a consumer in being free from a likelihood of confusion typically drives the injunction.

80. RESTATEMENT § 35. The trademark injunction in its most common form prevents further offending use of the mark. See id. cmt. a.

81. Id. § 35 cmt. d (an absolute injunction prohibiting further use is the ordinary remedy, but a tailored or qualified injunction is appropriate where there is a legitimate interest in continued use of the designation).

82. Id. § 36 (damages), 37(1) (disgorgement, accounting for net profits).

83. See id. § 37(2) (disgorgement depends upon factors in addition to the actor’s intent).

84. See id. § 36(3)(a) (stating that “Whether an award of damages for pecuniary loss is appropriate depends upon . . . the degree of certainty with which the plaintiff has established the fact”).

85. Id. § 36(1). For these purposes “losses” include not only losses to the proprietor from lost sales, but losses due to price reductions, corrective advertisements, and harm to reputation. See id. § 36(2).

86. See id. § 36 cmts. b (discussing historical basis of the damages remedy at law and in equity), c (“An injunction is the most common remedy in unfair competition cases.”).
is not merely because lost sales are difficult to prove. Instead, it is a consequence of trademark law itself. If the proprietor can recover in the absence of any actual confusion (but is entitled to relief upon the lesser showing of a likelihood of confusion), then it follows in many cases that there will be no actually demonstrable lost sales at all, and the remedy tailored to the harm by way of injunction or accounting need not wait upon proof of actual damages from lost sales, which the cause of action never required.

7. The final, seventh observation: the multiple ambiguity of “use”

Of course, before there can be any liability for likelihood of confusion, there must be an offending use. But “use” is an equivocal word, and there are at least four senses in which trademark law considers “use.” There must be (1) some offending use that causes a likelihood of confusion (2) in respect of a designation that is itself being used as a mark by a senior user. Moreover, if the Federal Lanham Act is invoked against infringement or to support registration, there must also be (3) a

87. Compare id. § 36(3)(a) (whether damages are available, depending upon the degree of certainty with which the proprietor has established both the fact and amount of loss), with id. § 36(3)(b)-(f) (other factors relevant to determining whether damages are available, including adequacy of other remedies and the intent of the offending party). It should be evident that trademark remedies flip ordinary remedy benchmarks upside down only because the circumstances do. In trademark, the injunction is the presumptive remedy, and it is the damages remedy that might be allowed only if the other remedies (including an accounting of the offending party’s profits) are inadequate. See supra notes 79-81 and accompanying text.

88. See RESTATEMENT § 20.

89. Id. (“One is subject to liability for infringement of another’s trademark . . . if . . . in identifying the actor’s business or in marketing the actor’s goods or services the actor uses a designation that causes a likelihood of confusion” (emphasis added)); see also Trademark (Lanham) Act of 1946 §§ 32(1), 43(a), 15 U.S.C. §§ 1114(1), 1125(a) (2006) (following the common law by predicing liability upon offending uses).

90. RESTATEMENT §§ 20(1) (“One is subject to liability for infringement of another’s trademark . . . if the other’s use has priority under the rules stated in § 19” (emphasis added)), 19 (“One who has used a designation as a trademark . . . has priority in the use of the designation over another user [giving rules for geographic allocation of priority rights]” (emphasis added)).

91. Lanham Act trademark infringement under § 32 is limited to federally
use in interstate commerce subject to federal jurisdiction, and (4) if the Federal Lanham Act is invoked in order to support registration, there must be a use which is evidenced by a formally submitted specimen of the mark as used and sufficient in the eyes of the Patent and Trademark Office (PTO) to obtain registration. This creates at least a four-way equivocation in the word "use."

registered marks. 15 U.S.C. § 1114. Lanham Act liability for unfair competition under § 43 extends both to federally registered marks and unregistered marks and to other matters. Id. § 1125.

92. In some respects, the Lanham Act's "use" requirements mirror the common law. First, there must be an offending use. Lanham Act § 32(1)(a), 15 U.S.C. § 1114(1)(a) (trademark infringement liability based upon an offending "use in commerce"); id. § 43(a), 15 U.S.C. § 1125(a) (unfair competition liability attaching to a person who "uses in commerce"). Second, the use must be in respect of a designation being used as a mark in commerce. See id. § 1(a)(3)(C), 15 U.S.C. § 1051(a)(3)(C) (trademark applications open to marks that are "in use in commerce"); id. § 1(b)(2), 15 U.S.C. § 1051(b)(2) (applications open to marks intended for use in commerce); see also id. § 7(a), 15 U.S.C. § 1057(a) (registration certificate to include "the date of first use of the mark, [and] the date of the first use of the mark in commerce."). But these are rather obvious. Equally obvious, and more significant for this purpose, federal trademark jurisdiction is based on the commerce clause of the United States Constitution, and not on the copyright and patent clause. See id. § 45, 15 U.S.C. § 1127. Therefore, "use" in commerce in the Lanham Act is also a jurisdictional requirement without which Congress is powerless to regulate trademarks. See id. (defining "commerce" as "all commerce which may lawfully be regulated by Congress" and stating that "[t]he intent of [the Lanham Act] is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce" (emphasis added)).

93. Id. § 1(a)(1), (d)(1), 15 U.S.C. § 1051(a)(1), (d)(1). This is because a proprietor's mark cannot obtain federal registration without a statement that the mark is in use, and a specimen that evidences the fact of use under standards promulgated by the Patent and Trademark Office. Id. § 1(a)(1), 15 U.S.C. § 1051(a)(1) (specimens needed for marks registered on the basis of use in commerce as of the application filing date); id. § 1(d)(1), 15 U.S.C. § 1051(d)(1) (specimens eventually needed for marks registered on the basis of bona fide intent to use in commerce). See infra Appendix B (the PTO's regulations for specimens).

94. It might even be possible to conjure up a fifth: that "use" sufficient to create liability, including criminal liability, for "using" a counterfeit mark under § 2320 of the Trademark Counterfeiting Act. 18 U.S.C. § 2320 (2006). Compare, e.g., United States v. Torkington, 812 F.2d 1347, 1347, 1350-1351 (11th Cir. 1987) ("post sale" confusion in the sale of counterfeit Rolex watches held to support criminal sanctions against a defendant who "knowingly uses" a spurious mark "used in connection with trafficking in goods or services" and "the use of which is likely to cause confusion, to cause mistake, or to deceive" within the
In the first sense of the word, a use that is an offending use must cause a likelihood of confusion. In the second sense—the use that creates a trademark right in the first place—in order to create an association in the minds of consumers or prospective purchasers, the “use” by the proprietor of the mark must be a “use in commerce” in the ordinary course of business or trade. This is use of the designation “as” a mark, sufficient to create rights in the user. For a common law trademark under state law, that is the end of the matter, but in order to qualify for federal regulation under the Lanham Act, the “use in commerce” by the mark proprietor must also meet the third sense of the word—it must be in “interstate commerce” in the federal jurisdictional sense. Finally, in the fourth sense of the word, in order to support federal registration of a claim to hold a common law trademark, the applicant is required both to make an averment of use and also to deposit a “specimen” evidencing use of the designation as a mark.

meaning of § 2320), with United States v. Giles, 213 F.3d 1247, 1247 (10th Cir. 2000) (trafficking in naked trademarks by selling logo-bearing “patch sets” by themselves and not attached to any product held not to constitute “using” the counterfeit mark “on or in connection with any . . . goods.”). For purposes of this article, four senses of the word “use” may be enough.

95. See supra notes 34-46 and accompanying text.

96. See Restatement (Third) of Unfair Competition § 18 (1995) (“A designation is ‘used’ as a trademark . . . when the designation is displayed or otherwise made known to prospective purchasers in the ordinary course of business in a manner that associates the designation with the goods, services, or business of the user” (emphasis added)); Lanham Act § 45, 15 U.S.C. § 1127 (“‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade”). The necessary “association” may be so strict as to require “affixation” of the mark to goods, may be necessarily loosened so as to permit some strong connection between the mark and intangible services to which no mark can be affixed, and might be realistically adjusted in light of advertising and promotions that might create an association independent of commercial affiliation. See infra Appendix B, notes 401, 405-12 (strict requirement as to goods), 402-04 (necessarily loosened requirement as to services), 413 (some trend towards realistic adjustment, under pressure) and accompanying text. However, some association is always required to create a use “as” a mark.

97. See Restatement § 18.


99. For applications based on use as of the time of filing, Lanham Act § l(a)(3)(C) and § l(a)(1) govern. 15 U.S.C. § 1051(a)(3)(C) (statement that the
The specific requirements concerning acceptable specimens are both detailed and lengthy, and perhaps too burdensome to include here.\textsuperscript{100}

Since "use" creates at least a four-way equivocation, and only one of the senses of the word—the first—turns exclusively on the conduct of the offending party, all four senses of the word provide an additional complication to ordinary principles of trademark law.\textsuperscript{101} As to two of the proprietor-side senses of the word—the quality of use by a proprietor that is sufficient to create trademark rights, and (by logical extension) the evidence of use by a proprietor that might be sufficient to constitute a specimen acceptable to the Patent and Trademark Office examiners—there has been some movement in the law.\textsuperscript{102} As to the third proprietor-side sense of the word—the kind of use that affects interstate commerce—there seems to have been an already settled movement in the law generally.\textsuperscript{103}

mark "is in use in commerce"); \textit{id.} § 1051 (a)(1) (the applicant shall also file "specimens or facsimiles of the mark as used"). For applications based upon an intent to use after the time of filing, Lanham Act § 1(c) and § 1(d) apply. 15 U.S.C. § 1051(c) (the applicant of an application filed on the basis of "intent to use" may amend the application at any time after use has occurred to bring the application into conformity with §1(a); \textit{id.} § 1051(d) (prior to obtaining registration, an applicant of application on an intent to use basis must file an averment of actual use, accompanied by specimens or facsimiles of the mark "as used in commerce"). It is apparent that the Lanham Act permits an application to be filed on the basis of an intent to use, but that no registration will issue unless there has been a use after the filing date sufficient to support the required statement and accompanied by a qualifying specimen. \textit{See} Lanham Act § 1(b), 15 U.S.C. § 1051(b).

100. \textit{See infra} Appendix B for a summary of the specimen requirements.

101. \textit{See supra} notes 89-93 and accompanying text.

102. \textit{See, e.g.,} New West Corp. \textit{v. NYM} Co. of Cal., 595 F.2d 1194, 1197, 1200 (9th Cir. 1979) ("totality of the circumstances" test used for creation of trademark rights when 430,000 solicitation letters bearing the asserted mark were mailed prior to any product available or bearing the mark); Marvel Comics Ltd. \textit{v. Defiant}, 837 F. Supp. 546, 549 (S.D.N.Y 1993) (announcement of new title, including a new mark, to 13 million comic book readers); S\textit{CHECHTER & THOMAS, supra} note 30, at 552-53 (citing \textit{RESTATEMENT § 18 & cmt. d}); \textit{but cf.} \textit{TMPEP, supra} note 32, § 1301 (evidencing some softening of the specimens required, at least for services, but not going so far as to embrace a "totality of the circumstances" test).

103. \textit{See generally} LOUIS LOSS, \textit{FUNDAMENTALS OF SECURITIES REGULATION} 92-94 (Little, Brown & Co. 2d ed. 1988) (the reach of federal securities laws
But none of the concerns about how much use suffices to create or evidence rights in the mark proprietor, or to trigger federal jurisdiction over interstate commerce, would seem to have anything to do with the quantity or quality of use by the offending party.\textsuperscript{104} Hence the remaining concern—the sense in which there is some question whether the offending party has somehow “used” the mark in connection with the offending conduct itself—seems to be nothing more than a rephrasing of the ultimate question of whether the offending party has caused a likelihood of confusion by having done something actionable. This last usage appears largely illusory. However if it is understood to add any additional content beyond merely restating the requirement that the complaining party show the offending party did something to create a simple likelihood of confusion, it would seem to be an erroneous requirement, more likely to mislead than to aid analysis.\textsuperscript{105}

\textsuperscript{104} Indeed, to try to imagine “use” in those terms leads to a dead end. The offending party is not required to “use” an offending expression as if it were a mark of the offending party, nor must the offending party advertise or promote its offending use. See Restatement § 20; Lanham Act § 32(1), 15 U.S.C. § 1114(1). The offending party will not be liable unless it uses a designation in such a way as to cause a likelihood of confusion, but this means only that a defendant in a trademark case, as in any other action at law or in equity, must act (or refrain from acting where there is a duty to act) in a way that violates the law or offends against equity. See Restatement § 20 cmt. b (“The rule stated in this Section... prevents the misappropriation of good will through the use of confusingly similar designations by others”). Though the Restatement commentary explains that an actor is subject to liability “only if it uses another’s mark or name in identifying the actor’s own goods, services or business,” and explains that the “use of a term, not as a trademark, but solely to describe the actor’s goods or services is not an infringement,” the context makes it clear that the offending actor need not advertise or promote its offending use. See id. (discussing the liability of a street vendor who sells counterfeit watches, presumably without advertising or promotion, and also discussing the liability of a seller who responds to a request for trademarked goods by substituting different goods without the knowledge of the purchaser, and presumably without advertising or promotion). But see infra note 105.

\textsuperscript{105} This mistaken approach appears to have been embraced in both 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400 (2d Cir. 2005), and Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619 (6th Cir. 1996). Each of these cases is
There are many other matters that surround likelihood of confusion, and likelihood of confusion is not the only issue in trademark law. However, the foregoing list of five common generalizations, followed by two observations, is the core set from which this article will draw upon as a benchmark to compare the treatment accorded to marks on the Internet and in cyberspace against their treatment in ordinary space. This is a well developed web of legal rules and standards that have applied in ordinary space. The desired solution to the problem of marks in cyberspace or on the Internet should fit recognizably within the constraints of existing likelihood of confusion standards.

B. Extreme Trademark Cases and Doctrinal Creep

One doctrinal problem haunting ordinary trademark law is a trend towards propertization. In ordinary space, as well as in cyberspace, it has been said that courts “seem to be replacing the traditional rationale for trademark law with a conception of trademarks as property rights” without much thought for the social costs of doing so. One reason for this is a casual cross-pollination from an extraordinary case back to the mundane. Professor Lemley puts it this way: “[W]e sometimes seem to be making trademark law for the extreme case, but we then apply that commendable for having avoided the peril of over-protecting marks in cyberspace, but at the expense of erring in the opposite direction by under-protecting marks. See discussion infra Part II.B. But see Uli Widmaier, Use, Liability, and the Structure of Trademark Law, 33 Hofstra L. Rev. 603, 704 (2004) (no mistake at all, but rather cases like Holiday Inns have “stubbornly insisted upon proof of trademark use of the allegedly infringing mark by the defendants themselves. That is the correct viewpoint, and the doctrinal nail in the coffin of the Brookfield . . . aberration.”). To the contrary, the need for an offending use is nothing more than an application of the commonplace notion that any plaintiff must allege that any defendant has done (or failed to do) “something” that is actionable. In trademark parlance, that something is simply a sufficient action, a “use,” that causes a likelihood of confusion. See discussion supra note 104, RESTATEMENT § 20.

106. 3 McCarthy, supra note 29, §23.01[1] (assigning first importance to likelihood of confusion, but at the same time not overlooking “issues of priority, secondary meaning, assignment and the like”).

law to a large number of run-of-the-mill trademarks." He speaks both of statutory innovations having to do with dilution and also of judicial stretches to cover "cybersquatting" on the Internet (both before and after the addition of statutory provisions addressing the subject).

The dynamic is that when some expansion of an old doctrine (or creation of a new doctrine) offers an enhanced degree of protection to "some but not all trademark owners," then "every trademark owner will want his or her mark to be included in the new group and will seek to receive the added protections of the new rule." Professor Lemley warns, "[i]f courts are not careful to restrain the new doctrine, it will soon take on a life of its own." Professor Lemley styles this as the problem of "doctrinal creep" in trademark law. By such doctrinal creep, there is a tendency recognizably in conflict with ordinary principles of trademark law to extend a backdoor, de facto patent- or copyright-level protection to trademarked words or other designations in the abstract. It is this tendency toward the propertization of trademark, and which would create rights "in gross," that complicates any understanding of ordinary principles of trademark law. If propertization should be resisted, then any analysis of cyberspace must account for the fact, in ordinary space at least, that there are careful commentators who believe we "do not need new legal rules" but instead, "what we

108. Id.
109. Lemley, Death of Common Sense, supra note 107. at 1697-1701
110. Id. at 1698.
111. Id.
112. Id.
113. Id. at 1702
114. See id. at 1699. Rather than rights in gross, which would comprise rights in an expression itself, trademark rights are considered to be rights "appurtenant" to the distinctive use of an expression in association with some goods or services, and thus comprise rights limited to protection against consumer confusion in the context of the use in question. See RESTATEMENT § 34 cmt. b (explaining that the "conception of the nature of trademark rights" gave rise to the common law rule prohibiting the transfer of a mark in gross); John F. Hacking, Comment, Trademark Dilution: Setting the Dilution Standard Under the Federal Trademark Dilution Act, 5 TUL. J. TECH. & INTELL. PROP. 115, 117 n.16 (2003) (citing United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918)). This ensures that no one will come to own words themselves, the building blocks of free speech.
need is the principled and vigorous application of the old rules."\textsuperscript{115}

The first level of doctrinal creep in trademark law in cyberspace is the tendency to find liability in the absence of likelihood of confusion. An example is the tendency to apply "initial interest confusion"\textsuperscript{116} in cases that are not as fitting (or extreme) as the cases that spawned the doctrine. Another example is the tendency to apply dilution analysis to cases that are not as extreme as the cases that led to the rationale,\textsuperscript{117} or that do not fit the statutory definitions that created the doctrine.\textsuperscript{118}

At another level, there might also be some anticipated doctrinal creep in cyberspace as to what constitutes use by a proprietor sufficient to create trademark rights, and as to what sort of evidence can constitute acceptable specimens to prove such use sufficient to support the federal registration of the proprietor's claim to such rights.\textsuperscript{119} Regardless of the competing formulations, it remains the

\textsuperscript{115} Lemley, Death of Common Sense, supra note 107, at 1713.

\textsuperscript{116} See supra note 73 and accompanying text; see also HRL Assocs., Inc. v. Weiss Assocs., Inc., 12 U.S.P.Q.2d 1819, 1823 (Trademark Tr. & App. Bd. 1989) (initial interest confusion, confined to only those cases in which the proprietor's goods or services are precluded from subsequent consideration because of likelihood of confusion prior to the point of sale), aff'd on other grounds, 902 F.2d 1546 (Fed. Cir. 1990).

\textsuperscript{117} Among other limitations, the original anti-dilution rationale and the statutes restricted themselves to "famous" marks only. See Act of May 2, 1947, 1947 Mass. Acts 300, ch. 307 (first state anti-dilution statute); 15 U.S.C. § 1125(c) (federal anti-dilution provision, added to the Lanham Act in 1995); Frank J. Schechter, The Rational Basis of Trademark, 40 HARV. L. REV. 813, 831 (1927) (articulating the rationale for dilution: to preserve the uniqueness of a trademark).

\textsuperscript{118} There is increasing recognition that branding is creating pressure on trademark law perhaps to recognize some rights in the absence of likelihood of confusion and in situations in which the existing anti-dilution statutes do not yet reach. See, e.g., DINWOODIE & JANIS, supra note 30, at 23 (the term "brands" has moved beyond traditional trademark-style "signals" relating to source, to "symbols" that generate a "broader array of associations and images" (quoting Jerre B. Swann, Sr., Dilution Redefined for the Year 2002, 92 TRADEMARK REP. 596 (2002))); id. at 24-25 (when trademarks are used on T-shirts to telegraph brand loyalty, or as bumper stickers, "they acquire certain functional characteristics that are different from—and sometimes inconsistent with—their traditional role as identifiers of source." (quoting Alex Kozinski, Trademarks Unplugged, 68 N.Y.U. L. REV. 962 (1993))).

\textsuperscript{119} As to the primary inquiry, see supra note 41 and accompanying text (creation of trademark rights by adoption, affixation and use as a trademark). As to doctrinal creep in this dimension, see supra note 102 and accompanying text.
case that the primary inquiry in this usual context of "use" has to do with whether the designation has actually been associated with the proprietor's goods or services in the minds of prospective purchasers.\textsuperscript{120}

At the same level of analysis, it remains the case that "use" is a word employed in four different contexts: (1) an offending use by a person other than the trademark proprietor that creates a likelihood of confusion, (2) use of the mark by the mark proprietor sufficient to establish trademark rights, (3) use of the mark in interstate commerce sufficient to support federal jurisdiction in a Lanham Act case, and (4) use of the mark evidenced by a specimen that satisfies the regulations for Lanham Act registration.\textsuperscript{121} As a result, some courts are encouraging yet another kind of doctrinal creep by an equivocation that requires an unrealistically high level of "use" by an offending actor to constitute infringement: that is, these courts tend to inquire whether an offending "use" is of a quality so high that it might suffice to create trademark rights in the offending actor, rather than simply inquiring whether the offending actor has engaged in a "use" causing a likelihood of confusion.\textsuperscript{122}

Thus, the core of ordinary trademark law (likelihood of

\textsuperscript{120} See Restatement (Third) of Unfair Competition § 20 (1995).

\textsuperscript{121} See supra notes 89-93 and accompanying text. The combination of doctrinal creep and equivocation, coupled with a failure expressly to consider the nature of cyberspace, has complicated somewhat the problem of marks on the Internet or in cyberspace. An incidental advantage of the new factor, "nature and place of use," proposed by this article is that it also permits a designed solution to the "use" problem in cyberspace. See discussion infra Part III.C.

\textsuperscript{122} See supra note 105 and accompanying text; discussion infra Part II.B (cases that find a likelihood of confusion, but reject liability because the offending actor did not "use" the offending designation by promotional or advertising activities, apparently of the type that would have created trademark rights in the offending party in respect of the designation in question). If most doctrinal creep is generally pro-proprietor, this kind of doctrinal creep seems to be anti-proprietor. Of course, there are some cases in which there really isn't any use of the mark in cyberspace, see cases cited infra note 351, and another advantage of the new factor, "nature and place of use," proposed by this article is that it better distinguishes these.
confusion) contains its own difficulties, is pressured by doctrinal creep, and is complicated by equivocation over what quantity or quality is required to constitute “use.” As the benchmark for this article, we refer to the likelihood-of-confusion-by-an-offending-use standard as the hallmark of ordinary trademark law. But the specter of doctrinal creep as a result of a constant pressure toward converting ordinary trademark law into something more akin to a property right obscures the standard. It also merits a response. The desired solution to the problem of mark-type conflicts on the Internet or in cyberspace should not exacerbate the problem of doctrinal creep.

C. Other Legal and Extra-Legal Controls in Cyberspace

Trademark is not the only game in town. There are other statutes, private ordering arrangements, and various other self-help remedies that arise from the architecture of cyberspace itself.\textsuperscript{123} There is also unfair competition, the genus from which trademark law developed.\textsuperscript{124} As a result, even where trademark is confined to ordinary principles under the likelihood of confusion standard, there is more to consider.

Two federal statutes—the Federal Trademark Dilution Act (FTDA)\textsuperscript{125} as amended and replaced by the Trademark Dilution Revision Act (TDR\textsuperscript{A}),\textsuperscript{126} and the Anti-Cybersquatting Consumer Protection Act (ACPA)\textsuperscript{127}—are especially pertinent to the problem of marks on the Internet or in cyberspace. A significant contract of adhesion\textsuperscript{128} relevant to the private ordering of marks in cyberspace

\begin{footnotesize}
\begin{enumerate}
\item[123.] See infra notes 125-30 and accompanying text.
\item[124.] See infra notes 131-33 and accompanying text.
\item[128.] A contract of adhesion is a form of “standardized contract,” one in which
\end{enumerate}
\end{footnotesize}
imposes the Uniform Dispute Resolution Policy (UDRP)\(^ {129}\) on certain mark-type conflicts on the Internet.\(^ {130}\) An important representative of self-help remedies arising out of the architecture of cyberspace is the Mail Abuse Prevention System Realtime Blackhole List (MAPS RBL).\(^ {131}\) And, of course, there is unfair competition, the common law ground from which has sprung the quasi-fraud\(^ {132}\) actions that begat trademark law,\(^ {133}\) and the quasi-

uniformity of terms in typically recurring transactions leads to certain efficiencies in mass-produced contracts. See E. ALLAN FARNSWORTH, CONTRACTS § 4.26 (3d ed. 1999) (citing Friedrich Kessler, Contracts of Adhesion—Some Thoughts About Freedom of Contract, 43 COLUM. L. REV. 629, 631-32 (1943)). A "contract of adhesion" is a standardized contract that is imposed not only in the absence of bargaining over the standard terms (which bargaining would defeat the goal of standardization as well as the efficiencies of mass production) but also often as "a take-it-or-leave-it proposition under which the alternative to complete adherence is outright rejection." Id. (attributing coinage of the term to R. SALEILLES, DE LA DECLARATION DE VOLONTE 229 (1901) ("contrat d’adhesion").


130. A domain name registrant will be hard-pressed to find a registrar that will grant registration without requiring that the registrant adhere to the UDRP, because those two or so registrars that trace their provenance from ICANN are required to adopt a UDRP. See SCHECHTER & THOMAS, supra note 30, at 789-92 (the domain name system explained and traced through to the current "shared registration system" with oversight provided by ICANN, which has accredited almost two hundred domain-name registrars).


132. In the law, the adjectival use of "quasi" often signals "not" or "non" as, for example, in the contrast between "contract" and "quasi-contract." See, e.g., ARTHUR L. CORBIN, CONTRACTS § 19 (West One Volume ed. 1952). A quasi contractual obligation is:

One that is created by the law for reasons of justice, without any
theft actions that occasionally bedevil trademark law.\textsuperscript{134} There is

expression of assent, and sometimes even against a clear expression of
dissent. If this is true, it would be better not to use the word “contract”
at all. Contracts are formed by expressions of assent; quasi contracts
quite otherwise...[n]evertheless, the classification is logically sound,
necessary and useful.

\textit{ld.} So in this article quasi-fraud and quasi-theft, in contrast with (real) fraud and
(real) theft, signify offenses that do not constitute fraud or theft, but which the law
treats more or less as if they did. This usage is consistently applied in the field of
unfair competition, in which quasi-fraud and quasi-theft are dominant strands. \textit{See infra}
notes 133 (real fraud compared with quasi-fraud), 134 (real theft compared
with quasi-theft or misappropriation).

133. Real fraud would suffice to redress a misrepresentation of a material fact
made knowingly to induce reliance, followed by actual and reasonable reliance
and resulting damages, without the need for any special law of unfair competition.
\textit{See generally RESTATEMENT (SECOND) OF TORTS §§ 525 (elements of fraudulent
misrepresentation (deceit)), 538 (adding the materiality requirement) (1977).} It
would seem that quasi-fraud applies, if at all, when there is some sort of deception
or likelihood of deception, but not enough to constitute fraud. As to the strand of
quasi-fraud in the common law of unfair competition, see \textit{generally RALPH BROWN & ROBERT DENICOLA, COPYRIGHT, UNFAIR COMPETITION AND RELATED
TOPICS BEARING ON THE PROTECTION OF WORKS OF AUTHORSHIP 632-33 (9th ed.
2005) (stating that “[t]he law of trademarks and unfair competition has its roots in
the common law action of deceit” and discussing the basic orientation of
trademark law and the root offense of “passing off” through the “etymological
confusion” that has sometimes obscured the principle that it is “axiomatic that
attempts to pass off one’s goods as those of another are actionable” and that the
“gravamen of the original tort was the fraudulent marketing of goods through the
imitation of another’s trademark” and the “[i]njury to the aggrieved trademark
owner was direct—customers who by whim or design had chosen to patronize [the
mark owner] were diverted instead to an imposter” so that “[c]onsumer confusion
was the touchstone.”). Perhaps another reason this is a “quasi” fraud, is that
the plaintiff is \textit{not} the arguably confused, deceived, and injured potential
consumer, but the almost-certainly-not-confused proprietor of the mark in
question; and then on a lesser standard of “likelihood of confusion” rather than
upon a standard of actual confusion and actual damage.

134. Real theft, conversion, or trespass would suffice to redress the wrongful
taking of or injury to property without the need for any special law of unfair
competition. \textit{See generally RESTATEMENT (SECOND) OF TORTS §§ 217 (trespass to
chattel), 222A (conversion).} It would seem that quasi-theft applies, if at all, when
there is a misappropriation, but no traditionally recognizable property. As to the
strand of quasi-theft (sometimes called “misappropriation of intangible trade
values”) in the common law of unfair competition, see generally Int’l News Serv.
v. Associated Press, 248 U.S. 215, 232 (1918) (appropriation of news about the
European War); BROWN & DENICOLA, supra note 133, at 624-27 (commenting
upon the mysterious origin and strange continuing applications of the generalized
misappropriation doctrine, and citing commentators); and compare RESTATEMENT
(THIRD) OF UNFAIR COMPETITION § 38 (1995) (curtailing if not killing the
also the federal statutory version of unfair competition.\textsuperscript{135}

The following sections will summarize the FTDA and TDRA, ACPA, and UDRP, as well as architectural constraints. Though the exercise is somewhat tedious, the benefit of reciting each is to see the commonalities (and differences) in the respective "factor" lists. This, in turn, sets ordinary trademark law within the larger context in which cyberspace problems arise, and within what might be considered competing legal or private ordering regimes. The proposed solution ought to be one that unifies the various regimes. Such reconciliation requires some familiarity with each of them. In the sections that follow, there is no specific discussion of the general underlying common law ground of unfair competition or of the Lanham Act version, but those will be suggested later in this article.\textsuperscript{136}

1. FTDA/TDRA factors

The Federal Trademark Dilution Act (FTDA), including its re-enacted version in the Trademark Dilution Revision Act (TDRA), provides a completely different rationale from the ordinary principles of trademark law identified in this article and contributes its own set of "factors" that coexist separately from the more established likelihood of confusion factors of ordinary trademark law.\textsuperscript{137} The FTDA reaches "commercial use in commerce"\textsuperscript{138} that


\textsuperscript{136} See supra notes 132-34 and accompanying text for a general discussion and infra Conclusion and Concluding Postscript for a suggestion of integration using the new "nature and place of use" factor.

\textsuperscript{137} Compare Federal Trademark Dilution Act (FTDA) of 1995, amended by Trademark Dilution Revision Act (TDRA) of 2005 (Lanham Act § 43(c)), 15 U.S.C. § 1125(c), with, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 21-23.

\textsuperscript{138} Lanham Act § 43(c), 15 U.S.C. § 1125(c). The restriction to this kind of commercial "use" is intended to protect (non-commercial) free speech values. See William E. Ridgway, Revitalizing the Doctrine of Trademark Misuse, 21 BERKELEY TECH. L.J. 1547, 1573 & n.122 (2006). Once the FTDA all but propertizes famously trademarked words in the absence of likelihood of confusion, an extraordinary impoverishment of the language would occur if there were not
“lessens the capacity” of a famous mark to identify and distinguish goods or services. The FTDA also creates an action in favor of a mark proprietor against a “diluter” who (i) has harmed the goodwill of a strong or famous mark (ii) by blurring the capacity of the proprietor’s mark to distinguish the proprietor’s goods or services or by tarnishing the reputation of the proprietor’s mark, (iii) even in the absence of any competition between the offending party and the mark proprietor and in the absence, therefore, of any likelihood of confusion, but then only if the trademark proprietor can prove actual dilution (rather than merely a likelihood or an inference of dilution). It might be argued whether the dilution statute creates a tort-like right (in the nature of a “trespass against a trademark”) or a property-like right (creating for the proprietor of a famous mark the capacity broadly to exclude, in gross, any use of the designation in the abstract and apart from any consumer confusion), but it cannot be disputed that the FTDA is dramatically different from ordinary trademark law. It is squarely and

some other countervailing balance against ownership of words themselves. Here, then, is yet another sense of the “use” requirement, this one occurring in the context of dilution. See supra notes 89-93 and accompanying text for four senses of the word “use” in the context of trademark.


140. See Schechter & Thomas, supra note 30, at 697 (paraphrasing substantially as reproduced here); Lanham Act § 43(c)(1), 15 U.S.C. § 1125(c)(1); see also FTDA, Pub. L. No. 104-98, 109 Stat. 985 (1996) (defining “dilution” as “lessening of the capacity” of a famous mark to identify and distinguish goods or services” and thereby embracing a “blurring” view of dilution while possibly not embracing a “tarnishing” view), amended by TDRA (Lanham Act § 43(c)), 15 U.S.C. § 1125(c).

141. Prior to October, 2006, the standard under FTDA § 1125(c)(1) was “actual dilution.” See Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 432-33 (2003) (the statutory language of the FTDA described the offending use as one that “causes” dilution). Since October, 2006, the standard has been “likelihood of dilution.” See infra note 142.

142. A significant revision to the FTDA has recently been enacted. The Trademark Dilution Revision Act, H.R. 683, was passed by the House on April 19, 2005 and went into effect on October 6, 2006. Pub. L. No. 109-312, 120 Stat. 1730 (2006) (codified at 15 U.S.C. § 1125(c)). The TDRA has modified and reorganized the factors described in this article but has not changed their general thrust. See generally David Hill, The Law of Anti-Dilution—Past and Future (remarks and paper presented at the 17th Annual Fall CLE Conference of
fundamentally different from the likelihood of confusion standard characterizing ordinary trademark law, and it is exerting precisely the pressure of "doctrinal creep" already remarked upon.143

The FTDA factors come in as guidance on the question of the "fame" or "highly distinctive" nature of a mark because anti-dilution protection is strictly limited (so it was hoped) to only those marks that are famous144 and highly distinctive.145 The FTDA provides a list of eight non-exclusive factors for guidance as to what constitutes fame: (1) the degree of inherent or acquired distinctiveness of the mark, (2) the duration and extent of use of the mark in connection with the goods and services with which it is primarily associated, (3) the duration and extent of advertising and publicity of the mark, (4) the geographical extent of the trading area in which the mark is used, (5) the channels of trade for the goods and services with which the mark is primarily associated, (6) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's proprietor and by the offending party, (7) the nature and extent of concurrent use of the same or similar designations by third parties, and (8) whether the

the Intellectual Property Section of the Virginia State Bar, October 21-22, 2005). Some of the current FTDA factors will remain as guidance on the question of "fame" while others will be modified and redeployed as guidance on the question of what constitutes "blurring," and various other modifications are made in the bill that are important in the wider context of the dilution cause of action. See id. The bill has incorporated a "likelihood" of dilution standard, thereby undoing the Moseley holding, and the bill has expressly embraced a "tarnishing" view of dilution, thereby removing a possible doubt about statutory construction of the existing law. See id.; see also supra note 140.

143. See Lemley, Death of Common Sense, supra note 107, passim; Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 171 (3d Cir. 2000) (Barry, J., dissenting) (stating that "Congress sought to protect only a select and narrow class of truly famous and well-recognized marks," and that "[w]ithout such a [fame] requirement, an anti-dilution statute becomes a rogue law that turns every trademark, no matter how weak, into an anti-competitive weapon" (quoting 4 McCarthy, supra note 29, § 24:108, at 24-210)), cert. denied, 531 U.S. 1071 (2001).

144. Lanham Act § 43(c)(1), 15 U.S.C. § 1125(c)(1) ("The owner of a famous mark shall be entitled to relief").

145. Id. (In determining whether a mark is "distinctive and famous" (FTDA) or "possesses the requisite degree of recognition" (TDRA) a court may consider certain factors); see Restatement (Third) of Unfair Competition § 25 cmt. e (1995) (characterizing the standard as "highly distinctive").
mark was federally registered.\textsuperscript{146} The TDRA replaced the FTDA as of its October 6, 2006, effective date.\textsuperscript{147} It makes changes and clarifications, and continues to provide protection against dilution of famous marks in the absence of any likelihood of confusion.\textsuperscript{148}

2. ACPA factors

The Anti-Cybersquatting Consumer Protection Act contributes yet another set of “factors” that coexist with the more established likelihood of confusion factors of ordinary trademark law.\textsuperscript{149} The ACPA creates an action in favor of a mark proprietor against a “cybersquatter” who (i) has registered, is using, or is trafficking in a domain name that is confusingly similar to the proprietor’s mark, and (ii) has done so with a “bad faith intent to profi” from the designation.\textsuperscript{150} There is another related set of provisions to protect personal names against “cyberpiracy.”\textsuperscript{151}

The ACPA provides a set of nine non-exclusive factors to provide guidance on what constitutes “bad faith.” The first four ACPA factors tend to indicate good faith: (1) whether the offending party can show any trademark rights of its own in the designation, (2) whether the designation is actually the name of the offending

\textsuperscript{146} See Lanham Act § 43(c), 15 U.S.C. § 1125(c). FTDA \textit{seems} TDRA.


\textsuperscript{148} See supra notes 142 (regarding enactment of TDRA), 143 (changes and clarifications) and accompanying text.


\textsuperscript{150} \textit{Id.}

\textsuperscript{151} “Cyberpiracy protection for individuals” is provided in measures codified at 15 U.S.C. § 1129, sometimes referred to as § 47 of the Lanham Act. “Any person who registers a domain name that consists of the name of another living person . . . without that person’s consent . . . [and] with the specific intent to profit from such name by selling the domain name for financial gain . . . shall be liable in a civil action by such person.” \textit{Id.} § 1129(1)(A). It is interesting that, unlike in the ACPA, the liability appears absolute and without any express list of factors, though there is an exception for good faith domain name registration in connection with a work of authorship protected by the Copyright Act. See \textit{id.} § 1129(1)(B). The statutory remedy may be an injunction, including forfeiture, cancellation, or transfer of the offending domain name, and a court has discretion to award attorney fees to the prevailing party. \textit{Id.} § 1129(2).
party, (3) whether the offending party has ever used the designation in any legitimate business activity apart from the domain name transactions, and (4) whether the offending party is making a bona fide noncommercial or “fair” use of the designation. The next four ACPA factors tend to indicate bad faith: (5) whether the offending party has an intent to divert consumers from the mark proprietor’s online location to an offending site that could “harm the goodwill” of the proprietor’s mark, (6) whether the offending party offered to sell the designation without ever having legitimately used it or has engaged in a past pattern of making such offers, (7) whether the offending party supplied false identifying information when it applied for the domain name or has engaged in a past pattern of such conduct, and (8) whether the offending party has registered multiple domain names similar to the trademarks of multiple other persons. The last of the ACPA factors is (9) the strength or fame of the proprietor’s mark.

3. UDRP factors

The Uniform Dispute Resolution Policy provides still further “factors” that run concurrently with all of the other factor sets that we have seen. The UDRP is a contractually created proceeding required to be imposed by all domain name registrars overseen by Internet Corporation for Assigned Names and Numbers (“ICANN”), is binding on all parties that register such domain names, and has become a significant non-judicial alternative by which trademark proprietors may challenge offending domain


153. ACPA, Lanham Act § 43(d)(1)(B)(i)(V), 15 U.S.C. §1125(d)(1)(B)(i)(V). As the ACPA puts it in more detail, such a diversion will “harm the goodwill represented by the mark either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the site.” Id.


name registrations.\textsuperscript{156} Since the UDRP was put in place in October, 1999, almost 7,800 domain name disputes involving more than 13,300 domain names have been privately adjudicated under the UDRP as of May, 2004.\textsuperscript{157} A trademark proprietor will prevail against a person who has registered the proprietor’s mark as part of a domain name upon demonstrating three elements: (i) the domain name in question is identical or confusingly similar to a trademark in which the proprietor has rights, (ii) the domain name registrant has no rights or legitimate interests in the offending designation included in the domain name, and (iii) the offending domain name was registered and is being used in bad faith.\textsuperscript{158}

The UDRP provides a set of four non-exclusive factors to provide guidance on what constitutes “bad faith” as contemplated by the third element of the UDRP complaint: (1) whether the offending user (domain name registrant) registered or acquired the domain name primarily for the purpose of selling, renting, or transferring the domain name either to the trademark proprietor or to a competitor of the proprietor for a price in excess of the cost of acquiring the domain name, (2) whether the offending user registered the domain name to prevent the trademark proprietor from using its mark in a domain name, or the offending user has engaged in a pattern of such conduct, (3) whether the offending user registered the domain name primarily to disrupt the business of a competitor, or (4) whether by using the domain name the

\textsuperscript{156} See id. at 790-91. ICANN currently governs the substantial majority of domain name registrars. Id.

\textsuperscript{157} See ICANN, Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy, May 10, 2004, http://www.icann.org/udrp/proceedings-stat.htm (on file with the Rutgers Computer and Technology Law Journal) (7,790 dispositions; 13,311 domain names); see also SCHECHTER & THOMAS, supra note 30, at 805 (reporting almost 6,000 dispositions involving nearly 10,000 domain names as of 2002). Despite the decelerating rate of UDRP resolutions (or perhaps because of its effectiveness in reducing the problem), the high volume of domain names resolved under the private UDRP system, compared to the far smaller number under the public court system appears to be a significant private diversion away from, if not a vote of no confidence in, the public judicial system.

\textsuperscript{158} UDRP, supra note 129, ¶ 4.a. The remedy to the prevailing trademark proprietor is limited to requiring the cancellation of the offending domain name or the transfer of the offending domain name registration to the trademark proprietor. Id. ¶ 4.i.
offending user has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the proprietor’s marks as to source or sponsorship.159

The UDRP provides three more factors, also non-exclusive, to give guidance on how to show whether the offending user has some right or legitimate interest in the offending designation included in the domain name, as contemplated in the second element of the UDRP complaint: (5) whether, before any notice to the offending user of the dispute, the offending user had made use of or demonstrable preparations to use the designation included in the domain name in connection with a bona fide offering of goods or services, (6) whether the offending user has been commonly known by the designation included in the domain name even if the offending user never acquired any trademark rights in the designation, or (7) whether the offending user is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.160

4. Architectural factors

In addition to private or consensual ordering, there are some characteristics built in to the fabric of cyberspace itself, as part of its fundamental rules or nature: laws, norms, the market, and code.161 For commercial use of the Internet and of cyberspace, Professor Lessig observes that “the Net will need a far more general architecture of trust—an architecture that makes possible secure and private transactions.”162 The elements, or factors, of this architecture include (1) authentication, (2) authorization, (3)

159. See id. ¶ 4.b(i)-(iv) (paraphrased here).
160. See id. ¶ 4.c(i)-(iii) (paraphrased and sequentially renumbered here).
161. RADIN ET AL., supra note 31, at 33 (“Laws are rules of conduct that are enforced by the coercive power of the state,” “[n]orms are rules that arise . . . within a certain community,” the “market constrains” through price mechanisms, and “‘[c]ode,’ or ‘architecture,’ is a constraint that derives from the nature of the world.” (citing LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE (1999)) (emphasis added)).
162. Id. at 21 (quoting LESSIG, supra note 161, at 40).
privacy, (4) integrity, and (5) non-repudiation.\textsuperscript{163}

The Mail Abuse Prevention System (MAPS) may be understood as one example of a private ordering system that arises out of the architecture of cyberspace. MAPS is a self-help response that seeks to isolate abusive conduct by blacklisting and denying access not just to "spammers" but to the Internet Service Providers (ISPs) that host or otherwise enable them.\textsuperscript{164} A recipient of spam may nominate a spammer for inclusion on the Realtime Blackhole List (RBL).\textsuperscript{165} If a spammer is blacklisted, then the host ISP or other ISP that enabled the spammer will itself be blacklisted.\textsuperscript{166} Many non-offending ISPs have voluntarily subscribed to the list, and they will use the blacklist automatically to reject mail sent from any domain name hosted or enabled by any of the offending ISPs on the blacklist.\textsuperscript{167} The offending ISP is treated as an aider and abettor to the spammer that resides on the ISP or runs data through it, and the object of this private ordering system "is to provide blacklisted ISPs with a powerful incentive to get themselves off the list, which they can accomplish by conforming to MAPS' rules."\textsuperscript{168} The offending conduct is spamming, and spam is defined in the rules.\textsuperscript{169}

\textsuperscript{163} \textit{Id.}; see supra notes 5-10 and accompanying text (another view, defining an objective architecture and deriving more general values consistent with these commercial factors).

\textsuperscript{164} See RADIN ET AL., supra note 31, at 28-29 (describing the system).

\textsuperscript{165} Id.

\textsuperscript{166} Id.

\textsuperscript{167} Id.

\textsuperscript{168} Id. at 29 (observing that most offending ISPs are placed on the list because they operate "open relays"—mail servers configured so that third parties can commandeer them to send unsolicited commercial email in bulk, thereby evading their own ISP's terms of service prohibiting the practice). See generally MAPS Guidelines, supra note 131 (describing spam sources, several varieties of relays, "spamadvertised web sites," dropboxes, click-throughs, and "mailto: addresses"; and explaining how to nominate an offending party). It appears that the blacklist now has several categories, including the Realtime Blackhole List and also a Dynamic User List, a Relay Spam Stopper List, an Open Proxy Stopper List, and a Non-confirmed Mail List. \textit{Id.; see also} MAPS, Nominations, http://www.mail-abuse.com/nominats.html (last visited Apr. 6, 2007) (on file with the Rutgers Computer and Technology Law Journal).

\textsuperscript{169} See Definition of Spam, supra note 131. An electronic message is "spam" if: (i) the recipient's personal identity and context are irrelevant because the message is equally applicable to many other potential recipients; and (ii) the recipient has not verifiably granted deliberate, explicit, and still-revocable
In addition to these private self-help measures, there are laws regulating spam.\footnote{See, e.g., CAN-SPAM Act of 2003, Pub. L. No. 108-107, 117 Stat. 2699 (codified at 15 U.S.C. §§ 7701-7713, 18 U.S.C. § 1037). The point is that there are many bodies of law and social ordering outside of trademark law that affect the use of words and symbols in cyberspace.}

This article will return to these cognate fields outside of trademark law in time. For now, it is sufficient to acknowledge that any analysis of mark-type conflicts on the Internet or in cyberspace must be not only coherent in terms of trademark law, but must also fit with related or cognate bodies of law, contract terms, user norms, and the fundamental architecture, rules, or nature of cyberspace itself.

II. MISSING THE MARK IN CYBERSPACE

The most important cases on the Internet are those that threaten the ability to map (index) the contours or to catalogue the contents of cyberspace.\footnote{See Folsom, supra note 2, at 105, 116-17; see also supra Summary of the Argument: Preliminary Note on Technology; infra Appendix A ("hitchhiker’s guide").} The reason for this is apparent. Cyberspace is boundless and trackless. It contains information, but without a guide the information is as good as lost and access is essentially denied. To some surfers or hitchhikers, wandering in the expanse of cyberspace might be its own reward with no particular aim in sight, and the lack of a guide might make no difference to those few. But even such skilled surfers might want some reliable trace to follow, especially as the cyber-landscape is constantly changing,\footnote{Cf. SAMUEL CLEMENS, LIFE ON THE MISSISSIPPI chs. 6-10 (Library of America 1982) (1883) (recounting if not exaggerating the considerable skills necessary to navigate a river, day or night, high water or low, upstream or downstream, by memorizing every inch of several thousand miles of landmarks, complicated by the fact that the river was always changing, all the time, and without any reliable map; and imagine also, the phone system if there were no phone books and no directory assistance).} and everyone else needs a map or a guide.\footnote{See infra Appendix A ("hitchhiker’s guide").
important cases in cyberspace are those that affect the search engines and directories that map the Internet, such as the Google-brand search engine or the Yahoo!-brand directory services, whose providers attempt to recover the cost of providing the mapping services and also make a profit, perhaps substantial, by selling advertising or other privileges using trademarked expressions as keywords to trigger the ads or services.

Compared to ordinary principles of trademark law as applied in ordinary space, the most important cases in cyberspace tend towards opposite errors. They tend either to overprotect, incidentally raising a property-style right, or they tend radically to under-protect, incidentally eliminating trademark protection against predatory activity while avoiding the problem of overprotection. The cases are in conflict with one another and they miss the middle course between the two extremes. Trademark law can cripple the Internet if it retards the development of cyberspace mapping services by overprotecting marks in space, but trademark law will disfigure itself if it exonerates mapping at the cost of turning cyberspace into an outlaw zone by under-protecting marks in space, distorting the concept of “use” to place clearly offensive conduct outside the reach of trademark law.

This article selects two representative overprotection cases from the Ninth Circuit and two representative under-protection cases, one each from the Second and Sixth Circuits. This article asserts that these are the leading cases that miss the mark in cyberspace, swinging between the unacceptable extremes of over-protection and under-protection. In between, this article concentrates on four cases representative of the various ad hoc accommodations in a number of cases that cluster under various labels, cases that seem destined to be counted rather than analyzed because they seem to

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174. See discussion infra Part II.A.
175. See discussion infra Part II.B.
176. Playboy Enters., Inc. v. Netscape Commc'ns Corp., 354 F.3d 1020 (9th Cir. 2004); Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036 (9th Cir. 1999).
177. 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400 (2d Cir. 2005); Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619 (6th Cir. 1996).
lack any organizing rationale. As previously said, the leading cases are those that deal with attempts to recover the costs of indexing or cataloging the contents of the Internet or cyberspace by selling targeted advertising. While the other cases are noteworthy on their own merits, this article asserts that solving the leading cases will also take care of the other cases.

A. Over-Protection

This article designates two leading cases, Netscape and Brookfield, to represent the asserted extreme of overprotection. The law will miss the mark and cripple cyberspace if, as some influential cases have done, it over-protects marks in space by emphasizing "initial interest confusion" to the extent that the mark becomes the equivalent of a property interest in space. The leading overprotection case is Netscape, but because this Ninth Circuit case was constrained to follow Brookfield, an earlier case decided in that circuit, it will be useful to discuss the earlier case first.


179. 354 F.3d 1020 (keyword targeted advertising triggered when a user typed trademarked term owned by Playboy Enterprises into a search engine and resultant ad was sponsored by person other than Playboy: held, that such an invisible or attenuated use might constitute trademark infringement).

180. 174 F.3d 1036 (trademarked expression was incorporated within a domain name, and also inserted within metatags on a web site: held, that both of these uses constituted trademark infringement of a senior user's mark).

181. See Netscape, 354 F.3d at 1024-26 (discussing Brookfield, 174 F.3d 1036). The reason Netscape is so significant is that it directly concerns targeted advertising sponsored by a mapper (search engine/directory provider). See supra
The earlier case is *Brookfield.* Although relatively recent by the calendar (decided in 1999) it already is accorded a pioneering status by Internet reckoning. *Brookfield* deals with invisible and attenuated addresses and magnets on the Internet: a vanity web address, and meta-tag magnets used by a junior user to draw traffic to its site at the apparent expense of the mark proprietor. The Brookfield court claimed to merely apply ordinary principles of trademark law to find liability based on initial interest confusion in a conflict between competitors, even though it was an attenuated or invisible use in cyberspace.

The plaintiff, Brookfield, was held to be the mark’s proprietor, and the defendant, West Coast, was held to be a competitor. The expression in conflict was “MovieBuff,” used to describe video rental store services and software containing information about movies. In the litigation, both parties asserted some rights in expressions combining “movie” and “buff” with the plaintiff, Brookfield, eventually prevailing after a fashion.

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182. 174 F.3d 1036.
183. The vanity web address was “moviebuff.com” and the hidden text was “moviebuff” contained in hypertext markup language (HTML) code invisible to normal viewers, but acting as a magnet for then-existing search engine algorithms (constructed by the site designer so that third-party spider software such as Google’s would more likely “find” the site and also place it at or near the top of its relevancy list). *Id.* at 1045. The problem was that both parties claimed trademark rights in “Moviebuff” and only one of them could have priority of use. *Id.* at 1047; see also *supra* notes 9-14 (discussion of invisible and attenuated uses in cyberspace, including the use of markers as addresses, magnets, roadblocks, or detours in space).
184. *See Brookfield,* 174 F.3d at 1066. The court explained:

> [R]egistration of a domain name for a Web site does not trump long-established principles of trademark law . . . . Similarly, using a competitor’s trademark in the metatags of such web site is likely to cause what we have described as initial interest confusion. These forms of confusion are exactly what the trademark laws are designed to prevent.

*Id.*
185. *Id.* at 1053, 1055-57 (priority and, hence, trademark ownership are awarded to Brookfield, and West Coast is held to be a competitor, reversing the trial court’s contrary finding).
186. *Id.* at 1042-43.
187. *Id.* at 1061 (West Coast held liable for infringement and required to yield
Brookfield claimed entitlement based on trademark rights in "MovieBuff" because of federal registrations filed in 1997 that asserted use dating back to January 1994 on a software product, and to January 1996 for services in connection with providing information about movies. Brookfield's priority rights were evidenced by its federal trademark registrations of the expression for both goods and services. Brookfield's rights were further evidenced by a California state trademark registration for computer software. In 1996, Brookfield attempted to register the domain name "moviebuff.com" with Network Solutions, Inc., but was denied because the domain name was already registered to the

the contested domain name to Brookfield); but see id. at 1066 (injunction permitted West Coast to continue using "movie" and "buff" as an invisible meta-tag or magnet as long as there was a space between the two expressions). See supra note 12 and accompanying text for a discussion of meta-tags as invisible magnets in cyberspace.

188. Id. at 1051 n.13. Curiously, the Ninth Circuit found that Brookfield "failed to produce evidence establishing its claim that it began using the 'MovieBuff' in conjunction with its Internet database in January 1996" as Brookfield had averred in its federal trademark application, but then, instead of invalidating Brookfield's registration on that basis, proceeded to rely on the filing date of Brookfield's trademark application to give Brookfield the benefit of a statutory date of first use as of the filing date of Brookfield's application and to award Brookfield priority based on the August 1997 application filing date. Id. at 1051.

189. See id. at 1042. Brookfield's federal trademark for goods is U.S. Trademark Reg. No. 2,192,255 filed by Brookfield on August 19, 1997 (application serial number 75/343,455) and registered by the U.S. Patent and Trademark Office on September 29, 1998, for "computer software providing data and information in the field of the motion picture and television industries" in international class 9 (electrical and scientific apparatus). See Fed. T.M. App. 75343455. The application was filed on the basis of actual use, claiming first use in commerce in January, 1994. Id. Subsequently, in 2005, the registration was canceled. Id.

190. See Brookfield, 174 F.3d at 1042. Brookfield's federal service mark is U.S. Trademark Reg. No. 2,192,256 filed by Brookfield on August 19, 1997 (application serial number 75/343,545) and registered by the U.S. Patent and Trademark Office on September 29, 1998 for "providing multiple-user access to an on-line network database offering data and information in the field of the motion picture and television industries" in international class 42 (scientific, technological and legal services). See Fed. T.M. App. 75343545. The application was filed on the basis of actual use, claiming first use in commerce in January, 1996. Id. Subsequently, in 2005, the registration was canceled. Id.

191. Brookfield, 174 F.3d at 1042.
defendant, West Coast.192

Not entirely surprisingly, the defendant West Coast actually claimed to be the senior user.193 Since 1986, defendant West Coast had used various phrases including some form of the words “movie” and “buff” to promote goods and services.194 Among these were: “The Movie Buff’s Gift Guide,” “The Movie Buff’s Movie Store,” “Movie Buff Picks,” “Movie Buff Series,” and others.195 In 1991, defendant West Coast obtained federal registration of the mark, “The Movie Buff’s Movie Store,” for video sales and rentals.196 That mark became incontestable in 1996.197 West Coast asserted it had used the expression, “The Movie Buff’s Movie Store,” continuously since 1986 in all of its stores and in almost all of its promotions, including print media, broadcast media, and retail bags, and had already invested some $15 million in advertising and promotional efforts associated with its use of “Movie Buff.”198 West Coast operated a chain of over five hundred company-owned and franchised stores, one of the largest such chains then in the United States.199

In February of 1996, preparing to extend its brick and mortar video sales and rentals to cyberspace, West Coast registered

192. Id.
193. Id. at 1043. The trial court denied the requested injunctive relief on this ground, among others. Id.
194. See id. at 1042.
195. Id.
196. Id. Patent and Trademark Office records show a registration for “The Movie Buff’s Movie Store,” U.S. Trademark Reg. No. 1,635,042, filed on June 7, 1989, and registered on February 12, 1991, for “rental of video cassettes and video game cartridges” and “retail store services featuring video cassettes and video game cartridges.” See Fed. T.M. App. 73805062. The application was apparently filed by Videosmith, Inc., but West Coast Video Enterprises, Inc. also appears in the records. See id. The registration was canceled in 2002. Id.
197. Brookfield, 174 F.3d at 1043 n.5.
198. Id.; see also Answering Brief for Defendant-Appellee at 6, 13, Brookfield Commc’ns, Inc. v. W. Coast Entmt Corp., 174 F.3d 1036 (9th Cir. 1999) (No. 98-56918), available at 1999 WL 33631720 (pointing out that West Coast’s approximately $15 million of advertising and promotional efforts associated with its use of “Movie Buff” was 150 times the amount ($100,000) that the plaintiff, Brookfield, claimed to have spent promoting its MovieBuff software products) [hereinafter Appellee’s Answering Brief].
199. Appellee’s Answering Brief, supra note 198, at 6.
"www.moviebuff.com" as a domain name, but did not immediately launch any site at that address.\textsuperscript{200} It was not until late 1998 that West Coast announced its intent to load content to the site.\textsuperscript{201} But beginning perhaps as early as April of 1996, it started using "moviebuff.com" in e-mail communications.\textsuperscript{202} When West Coast rolled out the site on January 16, 1999, it included a movie information database.\textsuperscript{203} It also used "moviebuff" as embedded meta-tags,\textsuperscript{204} hypertext markup language (HTML) code which did not appear to an ordinary user, but which would be found by web search engines.\textsuperscript{205} Prior to January of 1999, West Coast's "moviebuff" meta-tags apparently led to other sites maintained by West Coast, including "www.westcoastvideo.com."\textsuperscript{206} Meanwhile, Brookfield's "MovieBuff" trademark applications matured into registered trademarks on September 29, 1998, and, shortly thereafter in October of 1998, Brookfield learned West Coast intended to launch a web site at moviebuff.com.\textsuperscript{207} On November 10, 1998, Brookfield demanded that West Coast not use "moviebuff.com" as a web site address and that it not use "moviebuff" in meta-tags within that or any other site of West Coast.\textsuperscript{208} West Coast declined to relinquish the moviebuff.com domain name, and sometime later in November, Brookfield sought an ex parte temporary restraining order in the United States District Court of the District of Delaware.

\textsuperscript{200} See Brookfield, 174 F.3d at 1042.
\textsuperscript{201} Id. In October of 1998, Brookfield learned that West Coast "intended to launch" the site, and on November 11, 1998, West Coast issued a press release announcing "the imminent launch" of the site. Id.
\textsuperscript{202} Id. at 1052 ("mid-1996"), 1053 ("April 1996").
\textsuperscript{203} Id. at 1043.
\textsuperscript{204} Id.
\textsuperscript{205} A search engine, like a directory, is a searchable index of resources. The "central difference" between a directory and a search engine is that a directory is an index compiled by human beings while a search engine is an index compiled by an autonomous software agent with search and decision criteria determined by programmed logic and algorithms. RADIN ET AL., supra note 31, at 95-96. Among current well-known search engines are Altavista and Google; among the popular directories are Yahoo! and Ask Jeeves. Id.
\textsuperscript{206} Brookfield, 174 F.3d at 1062.
\textsuperscript{207} Id. at 1042 (of course, Brookfield knew that West Coast had registered the domain name back in 1996, because that was when Brookfield itself first tried to secure the domain name).
\textsuperscript{208} See id.
Court for the Central District of California.\textsuperscript{209} Having failed to obtain a preliminary injunction against West Coast's offending conduct, Brookfield appealed.\textsuperscript{210} The Ninth Circuit ruled in favor of Brookfield and reversed and remanded to the District Court with instructions to enter a preliminary injunction in favor of Brookfield.\textsuperscript{211} The Ninth Circuit determined that the injunction ought to prohibit West Coast from using "movi buffs.com" as a domain name and from using the expression "movi buff" as a hidden meta-tag.\textsuperscript{212} But because the Ninth Circuit found the words "movie" and "buff" (with a space between them) were different from "movi buff" (without a space), the injunction described by the Court of Appeals would permit West Coast to continue to use the expressions "movie" and "buff" so long as the words were separated by a space.\textsuperscript{213}

There is overprotection in this case because the appellate finding of likelihood of confusion is dominated by the finding there was initial interest confusion, both in the attenuated use of the trademarked designation in an address and in the invisible use of the trademarked designation in a meta-tag.\textsuperscript{214} The initial interest

\textsuperscript{209} See id. at 1043.

\textsuperscript{210} Brookfield, 174 F.3d at 1043. The trial court heard arguments on Brookfield's request for a temporary restraining order on the Monday after Thanksgiving, November 30, 1998, treated it as a motion for preliminary injunction, and denied it. Id. Brookfield appealed from the denial of preliminary injunction, and then on January 20, after West Coast launched its web site on January 16, 1999, Brookfield filed an emergency motion for an injunction pending appeal with the Ninth Circuit, which was granted on February 24, 1999. Id. The case was then argued and submitted on March 10, the earlier injunction remaining in effect pending the filing of a written opinion, and the case was decided on April 22, 1999, by filed opinion. Id. at 1036.

\textsuperscript{211} Id. at 1066-67. As to the direction by the Ninth Circuit to enter the injunction, rather than only to remand, see infra notes 216-18, 225 (further fact-finding might have determined whether the case was one of reverse-domain name hijacking in which the late comer picks off a domain name legitimately acquired by a prior claimant).

\textsuperscript{212} See Brookfield, 174 F.3d at 1066.

\textsuperscript{213} Id. Apparently, it was the absence of the space that turned "movi buff" from a descriptive phrase into Brookfield's distinctive expression "MovieBuff." See id. One can surmise, on the other hand, that it was incontestability coupled with substantial and uninterrupted use that created the distinctiveness in West Coast's own "Movie Buff's Movie Store" mark.

\textsuperscript{214} See id. at 1062.
confusion analysis, in turn, demonstrates a doctrinal creep, because it does not turn upon any likelihood of customer "preclusion" but instead turns upon the mere fact of customer inconvenience (if that).215 It raises a property-like right inherent in the trademarked words alone, divorced from active consideration of the nature of cyberspace and the type of uses typical of cyberspace.

Of the five generalizations of the benchmark principles of ordinary trademark law previously set forth in this article, Brookfield pushes each of them, and certainly exceeds some of them. First, the case seems to have attached liability at the level of mere possibility of confusion or inconvenience, rather than likelihood of confusion.216 Second, instead of looking for the likelihood of sponsorship confusion upon the trial court's finding that the goods and services were non-competing, the appellate court seems to have found source confusion based on apparently unsupported appellate fact finding as to the competitive nature of the goods and services (or else something like a de novo review based primarily, if not solely, upon a reading of the complaining party's federal trademark registration and accompanying brief).217

215. See id. at 1062-63.

216. Compare id., with discussion supra Part I.A.1. If, as West Coast claimed, it really had an incontestable trademark registration and actually had spent over $15 million promoting various forms of "Movie Buff" as a trademark, as against the much smaller sums the recent user Brookfield claimed it had invested, Appellee's Answering Brief, supra note 198, at 6, 13, it seems not entirely unlikely that more persons might have been looking for West Coast at www.moviebuff.com or by "Googling" for some combination of "movie" and "buff" in a search engine than might have been looking for Brookfield. Those few, if any, who may have been trying to find Brookfield might very well have been web surfers who would perhaps have been able to find Brookfield after only a bit of inconvenience.

217. Compare Brookfield, 174 F.3d at 1056-58, with discussion supra Part I.A.2. The Ninth Circuit, reversing the District Court, determined that Brookfield and West Coast were competitors. Brookfield, 174 F.3d at 1056. Because it appears Brookfield introduced essentially no evidence outside of its federal registrations at the evidentiary hearing on the preliminary injunction, see generally id., the appellate-level fact finding seems a bit of a stretch. The trial court inferred that the parties were offering different and non-competing goods and services, but, once the appellate court decided otherwise, without giving West Coast an opportunity to rebut evidence never presented by Brookfield, the defendant was left in the unhappy position of trying to avoid an ultimate determination of likelihood of confusion in respect of essentially identical expressions, used on
Third, it seems to have extended protection beyond the substantial number of ordinary consumers or surfers in cyberspace (as to whom it is highly doubtful there was any likelihood of confusion) to the inattentive few consumers or the small number of neophyte surfers who might have been unaware that the real cyberspace is not much like an imaginary highway and that real markers in cyberspace are not much like billboards by the side of a road.218

Fourth, it essentially compressed the multi-factor analysis into one step after finding the goods and services were competing and that Brookfield’s mark was a shortened form of West Coast’s mark (with the space removed from between the words previously used by West Coast).219 Most significantly, it elevated the circumstance of initial interest confusion into an almost conclusive presumption of infringement, in the absence of any apparent indication that any consumer on the Internet would have been precluded from taking the easy step of back-clicking once having arrived at the allegedly infringing site.220 That is why, in totality, Brookfield overprotects

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218. Compare Brookfield, 174 F.3d at 1060-61, with discussion supra Part I.A.3. West Coast apparently had a long-established brick and mortar presence as a substantial chain of video rental stores, with a new online presence accompanied incidentally by some sort of online database by which customers identified desired video rentals. See Brookfield, 174 F.3d at 1042. Brookfield sold a fairly robust movie information data base product and intended to offer to sell (or perhaps actually was offering) some version of that database online, and maybe Brookfield intended to, or might have offered, some sort of online access to the contents of its database, though the record seems a bit vague on these points. See id. at 1041-43. In any event, it would seem that there was no pressure on an ordinary consumer or surfer at the West Coast site to consummate a transaction with West Coast that might have been intended for Brookfield, and it would seem relatively hard for a non-foolish customer to mistake the West Coast video rental store for the Brookfield’s enterprise. The inappropriateness of the famous billboard metaphor in Brookfield is asserted in, for example, Folsom, supra note 2, at 110-12. See also infra text accompanying notes 387-388.

219. Compare Brookfield, 174 F.3d at 1056-61, with discussion supra Part I.A.4. Because the factors are flexible and may be flexibly weighted, see Brookfield, 174 F.3d at 1053-54, there might be nothing extraordinary about this, were it the only pressure exerted by Brookfield on ordinary principles of trademark law.

220. Compare Brookfield, 174 F.3d at 1061-65, with discussion supra Part
on the Internet compared to what would have been expected under ordinary principles of trademark law in ordinary space.

Meanwhile, Brookfield's result is incongruous with other statutes, private ordering arrangements, and various other self-help remedies, and therefore cannot be attributed to any hidden influence from those directions. The plaintiff's mark was neither famous nor highly distinctive enough to qualify for anti-dilution protection under the FTDA (or TDRA). Brookfield would not have been able to show that West Coast's domain name registration constituted cybersquatting under the ACPA. Brookfield would

I.A.5. Indeed, without this last circumstance, the case might have been unexceptional because trademark law is characterized by cases that push many of the generalizations given, but this last holding on initial interest confusion in cyberspace is what propels the case into overprotection. It is hard to imagine a case in which an effective magnet or address does not draw traffic, and thus it would seem hard to resist the conclusion that every invisible or attenuated use of a marker in cyberspace that contains a trademarked expression would have to result in this sort of "initial interest confusion." Cf. Brookfield, 174 F.3d at 1061-65. The error is in making the drawing tendency, rather than the precluding effect, be the determinant factor in an initial interest confusion case. Preclusion is the tipping factor for initial interest confusion in ordinary space, see supra note 73 and accompanying text, and ought to be even more so in cyberspace. The failure to confine initial interest confusion exemplifies doctrinal creep as discussed supra Part I.B., n.116. The characteristic activity set that constitutes cyberspace—access, navigation, information-activity, and augmentation—is particularly unlikely to benefit from legal rules that defeat the ability of a user to navigate in space by aid of non-preclusive magnets that contain trademarked terms. Although typical users in cyberspace are split among surfers and mappers, trappers and spoofers, spoilers and arbitrageurs, and also consumers, mark proprietors, and competitors, there is a non-insignificant number of surfers who desire to use, and a public interest in cyberspace access and navigation enabled by invisible and attenuated addresses and magnets for traveling in cyberspace. See supra note 15.

221. Compare Brookfield, 174 F.3d 1036, with discussion supra Part I.C.1. Among other things, Brookfield's mark hadn't been in use for long, had not been extensively advertised or promoted, had not resulted in any substantial sales, and coexisted with the long prior use of West Coast's mark which contained the expression. See Brookfield, 174 F.3d at 1042-43.

222. Compare Brookfield, 174 F.3d 1036, with discussion supra Part I.C.2. Because Brookfield's mark was not particularly strong and West Coast would have been able to show that it had trademark rights of its own in expressions including "movie buff," had used the designation in a legitimate business activity apart from the domain name transaction, was making a bona fide use of the designation, had no apparent intent to divert consumers from Brookfield, had never offered to sell the designation to Brookfield or anyone else, had not supplied false identifying information when it applied for the domain name, and had not
not have prevailed in a proceeding under the Uniform Dispute Resolution Policy. In short, there is no other factor that would seem to favor Brookfield in its dispute with West Coast.

*Brookfield* reaches the wrong result for the wrong reason, and, though beautifully written and carefully fashioned, it is ultimately not persuasive. It is not persuasive because it is not reasonable to restrict non-preclusive use of markers in space by a registered multiple domain names similar to the trademarks of anyone else, see *Brookfield*, 174 F.3d at 1042-43, it would seem that Brookfield would have had no case against West Coast under the ACPA.

223. See UDRP, *supra* note 129, ¶ 4(a). *Compare Brookfield*, 174 F.3d 1036, with discussion *supra* Part I.C.3. There is no indication that West Coast registered its domain name for the primary purpose of selling it to Brookfield, to prevent Brookfield from using Brookfield’s mark (which didn’t exist at the time of West Coast’s domain name registration) as a domain name, to disrupt Brookfield’s business (which business may have been non-existent at the time of West Coast’s domain name registration), or to attract Internet users by intentionally creating a likelihood of confusion. See *Brookfield*, 174 F.3d at 1041-43, 1059. Instead, West Coast appeared to have used the designation in good faith prior to coming into conflict with Brookfield, and had previously been known by the designation included in the domain name. See *id.* at 1059.

224. *Compare Brookfield*, 174 F.3d 1036, with discussion *supra* Part I.C.4. None of the MAPS factors, see *supra* notes 168-69 and accompanying text, and none of the architecture factors, see *supra* notes 5-10, 161-70 and accompanying text, would seem to favor Brookfield.

225. The case appears to be one of reverse domain name hijacking, by which a late-comer (Brookfield) was able to seize a domain name from a legitimate prior user. See *Brookfield*, 174 F.3d at 1041. This would seem to be the wrong result, or, at best, the matter should have been remanded for further fact-finding in the trial court. On the other hand, West Coast was permitted to continue to embed meta-tags containing the words “movie” and “buff” provided they were separated by a space. See *id.* at 1065-66. This would seem to countenance the continuation by West Coast of very nearly the same invisible use of “movie” and “buff” as magnets in cyberspace as had existed prior to suit.

226. The case appears to get initial interest confusion wrong, both as a matter of ordinary trademark law, and as applied in cyberspace. *Compare id.* at 1062-65, with sources cited *supra* note 73 (ordinary trademark law), *and Folsom, supra* note 2, at 112 & n.92 (cyberspace application of initial interest confusion). As such, it is an example of doctrinal creep, as a kind of “unforced error.” See discussion *supra* Part I.B. That is, there appears no articulable reason to favor Brookfield in this lawsuit—neither to stretch ordinary trademark principles to do so nor, consequentially, to damage cyberspace in the process. Of course, the court says that it has only applied ordinary principles of trademark law, see *Brookfield*, 174 F.3d at 1062-65, but it is actually in conflict with those principles most applicable to invisible and attenuated uses of markers in space.
legitimate user to draw traffic to a site, and even less so to restrict such a use for reasons based upon an overly broad application of initial interest confusion analysis, coupled with an injunction that delivered the domain name to the plaintiff. This is far more protection than is merited by the relatively minor effect of the magnet in this case. Moreover, the case is not persuasive because its reasoning cannot overcome the strong intuition that the ordinary web surfer is not likely to be confused at all by any such use as West Coast made of its magnets. Finally, the case is ultimately unpersuasive because it doesn’t even explicitly recognize as a factor in its analysis, much less foster, the public interest in the public good of cyberspace access, navigation, and information-activity. Instead, it would remove (or limit) legitimate, non-preclusive, non-piratical makers from space, even though they are placed in aid of legitimate surfers.

Although Brookfield didn’t deal with indexing, its initial interest-style over-protection casts serious doubt upon the legality of essential value-added efforts to index and catalog the contents of space or to pay for these services by selling targeted advertising. One case that magnifies the doubt is Playboy Enterprises, Inc. v. Netscape.\textsuperscript{227} This is a 2004 decision on a dispositive motion in a case that challenged a commercial use by a third party provider of Internet resources: hidden text magnets used by a third party Internet resource provider\textsuperscript{228} to create targeted advertising for a sponsor of goods and services which competed with goods and services of the mark proprietor.\textsuperscript{229} Explicitly following Brookfield,

\begin{footnotesize}
227. 354 F.3d 1020 (9th Cir. 2004).
228. The resource was a search engine. \textit{Id.} at 1022. For the value of such guides in cyberspace, see \textit{supra} notes 15, 171-72 and accompanying text.
229. Netscape, 354 F.3d at 1022. The magnet was “Playmate,” which is also a trademark owned by Playboy Enterprises, Inc. \textit{Id.} When a person searching the Internet keyed in the trademarked expression, “playmate,” to a search engine, the search engine returned the correct web site for Playboy Enterprises, but it also generated a targeted advertisement leading to the web site of a competitor dealing in similar goods or services to those offered by Playboy. \textit{See id.} at 1022-23. The competitor had paid the provider of the search engine for the targeted advertisement. \textit{Id.} Such advertising revenues are what might allow companies to provide tools for searching the internet that are “free” to the casual user and so enable the navigation of cyberspace, making information findable and hence usable. \textit{See infra} note 234 and accompanying text.
\end{footnotesize}
as it believed itself bound to do, and extending the Brookfield rationale governing invisible and attenuated uses to those involved in targeted advertising, the Netscape court said it was merely applying ordinary principles of trademark law to permit a complaint alleging a contextual advertising offense to proceed to trial. 230

The Netscape dispute had to do generally with the problem of search costs, specifically related to goods or services of the kind associated with the “Playboy” trademark. 231 On the side of the potential consumers or customers, stand some buyers who are interested enough in sex to pay for it (or for related goods or services), and on the seller side stand commercial sex-product vendors who are ready, willing, and able to provide such products for a fee. 232 Prior to the wide-spread access to cyberspace, it might be supposed the search of buyer for seller tended to be more imperfect. 233 Even with the ubiquity (and intrusiveness) of cyberspace vendor self-promotion for such goods and services, it might be supposed the search function still remained somewhat imperfect. 234 The defendants in Netscape were attempting to match

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230. Netscape, 354 F.3d at 1024 (noting that the “‘core element of trademark infringement,’ the likelihood of confusion, lies at the center of this case” and finding that the possibility of initial interest confusion precluded the trial court’s summary judgment for the defendant (quoting Brookfield, 174 F.3d at 1053)).

231. See id. at 1022-23.

232. Id. at 1022 (“keying allows advertisers to target individuals with certain interests by linking advertisements to pre-identified terms”).

233. Just as trademarks “reduce the cost to consumers of searching for a product with specific qualities,” see, e.g., Robert Cooter & Thomas Ulen, Law and Economics 137 (3d ed. 1999), search costs might be yet further reduced if the product not only can be found, but also appropriated, in cyberspace—all depending on an efficient list of keywords.

234. See generally Edmund Kitch & Harvey Perlman, Intellectual Property and Unfair Competition 60-61 (5th ed. 1998) (information search cost and economic efficiency analysis of trademark: advertising of prices lowers the buyer’s search costs in a market of undifferentiated products emanating from several sellers (citing George J. Stigler, The Economics of Information, 69 J. Pol. Econ. 213 (1960))); id. at 61-64 (branded advertising expenditures per sales dollar are higher for small, repeat purchases of non-durable products than for large durable products (citing Phillip Nelson, Advertising as Information, 82 J. Pol. Econ. 729, 747-49 (1974) (dividing goods into “search” goods and “experience” goods))). Compared to branding in ordinary space, it seems likely an Internet facility that allows for targeted, key-word advertising for search goods (that is,
buyers with sellers, without directly charging the buyer (Internet user) for the search costs, but funding the activity by advertising revenues paid by sellers of the product.\textsuperscript{235} Clearly the case is not limited to sex, but is about targeted advertising in cyberspace—the court was quick to generalize to the more innocuous example of a person seeking information about gardening.\textsuperscript{236}

The court went on to observe that the defendants, Netscape and Excite, had created pre-identified lists of certain key words for various goods and services that could be triggers to targeted advertising.\textsuperscript{237} When it came to sex, they had generated a list of over four hundred key words.\textsuperscript{238} While the vast majority of those words were “generally un-trademarked words associated with adult entertainment, ranging from the expected (sex, parts of the human anatomy, etc.) to the disturbing” at least two of the key words constituted trademarked expressions.\textsuperscript{239} Those were “Playboy” and “Playmate,” for which the plaintiff, Playboy Enterprises, Inc. (“PEI”), is the holder of several federal trademark registrations.\textsuperscript{240} PEI sued for trademark infringement and dilution and alleged that users had input its marks, “Playboy” or “Playmate,” into defendants’ search engines, users had then seen click-through banner ads paid for by competitors to PEI, and there was a likelihood of confusion as a result.\textsuperscript{241} After some wrangling, the case was held to present a triable cause of action for trademark infringement as well as dilution.\textsuperscript{242} Initial interest confusion goods for which the purchasing decision can be made by examining the product itself) consisting of non-durable sexual images, coupled with immediate access to or delivery of non-durables, reduces the search costs for such branded goods. In this context and in this market, PEI’s marks might be expected to be high-value, high-efficiency items.

\textsuperscript{235} \textit{Netscape}, 354 F.3d at 1022-23.

\textsuperscript{236} \textit{Id.} This article will likewise use similar generalities from time to time, but will also consider the actual search terms used, as necessary.

\textsuperscript{237} \textit{Id.} at 1023.

\textsuperscript{238} \textit{Id.}

\textsuperscript{239} \textit{Id.} at 1023, n.2.

\textsuperscript{240} \textit{See id.} at 1023.

\textsuperscript{241} \textit{See id.} at 1022-23.

\textsuperscript{242} \textit{Id.} at 1034. In an earlier reported decision, PEI sought, but was denied, a preliminary injunction. \textit{Id.} at 1023. On remand, the parties filed cross motions for summary judgment, and the district court granted summary judgment in favor of
dominated the likelihood of confusion discussion. Like *Brookfield* and, indeed, as nearly compelled by *Brookfield*, *Netscape* overprotects by elevating initial interest confusion into a nearly conclusive presumption of infringement.

Like *Brookfield*, and for similar reasons, *Netscape* pushes in the wrong direction many of the ordinary rules of trademark law most relevant to invisible and attenuated uses in cyberspace. Also like *Brookfield*, *Netscape* threatens to reach the wrong result for the wrong reason and is ultimately unpersuasive. *Netscape* is reported to have settled after remand, but this leaves the state of the defendants. *Id.* The current case was an appeal from that judgment. *Id.*

243. *See id.* at 1024-26 (explaining that "PEI's strongest argument for a likelihood of confusion is for a certain kind of confusion: initial interest confusion"); *id.* at 1024 n.13 ("Indeed, we find insufficient evidence to defeat summary judgment on any other theory.").

244. The *Brookfield* decision has already been analyzed against those generalizations. *See supra* notes 216-220. To be sure, *Netscape* does not replicate all of them—there is no appellate fact-finding in *Netscape*, and the disposition in *Netscape* was a reversal and remand, as opposed to *Brookfield*’s reversal accompanied by direction to enter an injunction—but the basic difficulties remain essentially the same. Perhaps it should be emphasized that one compelling common basis of error is the inability of current trademark analysis to provide a factor explicitly weighing the public good, and the corresponding public interest in preserving the characteristic cyberspace activity set: access, navigation, information-activity, augmentation (and trust). *See supra* notes 15, 79. Though a patent case, *eBay* carries the suggestion that the public interest in a robust and navigable cyberspace may need to be taken into account in mark-type disputes in space. *See eBay v. MercExchange L.L.C.*, 126 S. Ct. 1837 (2006).

245. Unlike *Brookfield*, *Netscape* remained in a non-final stage, remanded for further proceedings. *See Netscape*, 354 F.3d at 1841. Moreover, and interestingly enough, there is something in *Netscape* that might actually point to an unheralded and unnoticed preclusion-type of initial interest confusion that could have, consistently with the ordinary application of initial interest confusion, pushed the case in the direction of reaching the right result, albeit by accident. *See Folsom, supra* note 2, at 112 & n.92. The risk remains that the rationale of *Netscape* will adversely affect the bulk of other invisible marker cases that lack the preclusive-style initial interest effect perhaps lurking in *Netscape*.

246. Neither the majority opinion nor the concurring opinion seems much to relish the result, *see infra* note 248, and this, if nothing else, weakens its persuasive power.

247. Jason Krause, *Google Targeted in Trademark Disputes: Rulings Should Help Define What Is Protected in Internet Advertising*, A.B.A. J. E-REP., May 28, 2004, at 1 ("Netscape and Excite quickly settled for an undisclosed amount... 'My sense is that they had to settle or Netscape potentially risked putting a fundamental part of its business model at risk. This was a bet-the-company kind
the law itself unsettled and in a state of uneasy doubt about the extent of an index provider’s ability to pay for its services by sponsored advertising involving the invisible and attenuated uses of magnets that incorporate a trademarked expression. In short, there is doubt about the continuing viability of a Yahoo!-style directory or a Google-style search engine supported by targeted advertising sponsorship triggered by trademarked terms.

The problem is not so much *Brookfield*, which is a bit of a sport, but *Netscape*, which extends the Brookfield rationale from competitor cases to those involving search engine providers. *Netscape* overprotects because it follows *Brookfield* which was overly naïve about the Internet. *Netscape* is important because, unless its rationale is modified, it will retard the development of cyberspace mapping resources.

To the extent *Brookfield* and *Netscape* make initial interest confusion the driving factor of likelihood of confusion analysis they over-protect marks in space by making them like property, but without the countervailing factors of the FTDA/TDRA, ACPA or

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248. The opinion for the *Netscape* court suggested the dispute could be resolved by an accommodation between the mark proprietor and the search engine provider—perhaps some sort of disclaimer or other flag could be tagged to the resultant ads. *Netscape*, 354 F.3d at 1030 n.43 (majority’s view that “[d]oing so might eliminate the likelihood of initial interest confusion that exists in this case”). But the rationale of the case seems to put the mark proprietor in a dominant position in the hypothetical negotiations and, at best, leaves the search engine provider or guide with a series of doubtful negotiations with an indeterminate number of other potentially offended mark proprietors. The Netscape court expected some further appellate resolution after trial, and the concurring opinion signaled that *Brookfield* might have to be revisited, but there is nothing in *Netscape* that authoritatively puts a principled limitation to the provider’s potential liability. See id. at 1034 (Berzon, J., concurring) (based on the controlling rationale of *Brookfield*, “there could be a [trademark infringement] even if the banner advertisements were clearly labeled”), 1036 (“There will be time enough to address the continuing vitality of *Brookfield* should the labeled advertisement issue arise later . . . . Should the question arise again, in this case or some other, this court needs to consider whether we want to continue to apply an insupportable rule.”); see also Julie Rrzer, Comment, *Misunderstanding the Internet: How Courts Are Overprotecting Trademarks Used in Metatags*, 2001 Mich. St. L. Rev. 427, 462-63 (cited by Judge Berzon in *Netscape*, 354 F.3d at 1035).

249. See cases cited infra note 343 for other lawsuits involving Google’s uses of trademarked expressions.
UDRP. If *Brookfield* and *Netscape* define an extreme approach to marks in space that over-protects marks to such an extent that value added indexing and cataloging on the Internet (or at least the ability to sell high value targeted advertising to pay for those services) is put in doubt, the attempt to fashion a more even-handed solution is limited by the existence of cases reacting in a way that pushes to the opposite extreme of under-protection.

B. Under-Protection ("no use, no foul"—no remedy)

This article designates two leading cases to represent the asserted extreme of under-protection. The law will miss the mark, and disfigure itself if it avoids the perils of *Brookfield* and *Netscape* by under-protecting marks.

One such limiting case is *800 Contacts*. This is a 2005 decision involving a third party provider who was able to insert resources for generating external calls for “pop-up” advertisements into an application program that was “voluntarily” downloaded by Internet users onto their own computers. The offending

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250. Among other limiting factors, dilution under the FTDA/TDRA requires that the offended mark be famous, and anti-cybersquatting under the ACPA requires that the offending conduct be accompanied by bad faith, as does the UDRP domain name dispute resolution policy. See supra notes 221-223, applying these in *Brookfield*.

251. *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400 (2nd Cir. 2005) (Internet case) (keyword advertising popup was triggered when a user typed a trademarked term: held that such an invisible use is not a “use” and so could not constitute infringement); *Holiday Inns v. 800 Reservation* 86 F.3d 619 (6th Cir. 1996) (Phone system case) (an allegedly infringing “complementary number” to a vanity phone number that included a typo on a trademarked mnemonic expression, purposely designed and deployed to trap prospective consumers who were trying to reach the trademark proprietor but who misdialed a ‘zero’ for the letter ‘o’ in “1-800-holiday”: held that such an attenuated use is not a “use” and so could not constitute infringement).

252. *1-800 Contacts*, 414 F.3d at 400. The plaintiff, *1-800 Contacts, Inc.* ("Contacts, Inc."), claimed trademark rights in 1-800 CONTACTS (a composite mark, including a distinctive logo, color, and design) apparently for contact lenses. *Id.* at 402, n.2. Contacts, Inc. also maintained a website, apparently including the textual and numerical portion of its mark as part of the web address. *Id.* at 402; see also, 1-800 Contacts, http://www.1800contacts.com/ (last visited May 16, 2007) (on file with the Rutgers Computer and Technology Law Journal).

253. *800 Contacts*, 414 F.3d at 404. The defendant and allegedly offending user, WhenU.com, Inc. (“WhenU”), provided a proprietary software application
application program triggered sponsored advertising by yet other third parties upon keyed terms input by the user into the user’s computer. Even though some of the keyed terms included trademarked expressions, the conclusion was that this type of invisible and attenuated use of magnets did not constitute a “use.”

Though the specific technology, packaging and marketing strategy for popup ads in 800 Contacts differs from that used for triggered keyword ads in Netscape, the effect in both is remarkably similar. Both are examples of attenuated or invisible makers in cyberspace intended to influence traffic, by the use of trademarked expressions, toward a site other than one sponsored by the trademark proprietor. Independent of the specific technology, in called SaveNow “without charge” to individual computer users “usually as part of a bundle of software” that the computer user downloaded from the Internet. Id. The SaveNow application program then proceeded, without any further action by the computer user, “to activate its operations.” Id. This would seem to constitute “spyware” inserted into a user’s computer.

Having created a set of captive computer users by way of the inserted and self-activating SaveNow application program, WhenU used keywords to create a triggered advertising venue. Id. at 404-405. WhenU, the allegedly offending user, did not “sell” specific trigger words to particular ad sponsors, but instead created “category” triggers and sold categorical associations to vendors: the offending software application randomly selected one of the sponsored pop-up ads associated with the category to send to the consumer’s computer screen whenever it detected one of those trigger words. Id. There were legends displayed in text boxes that informed the computer user what was going on, which also provided information on how to uninstall the SaveNow application software. Id. at 405, n.7. The SaveNow application program had an ability to detect and react to some 32,000 website addresses or address fragments, some 29,000 search terms, and about 1,200 keyword algorithms for correlation to expressions typed by a computer user, or that “appear within the internet sites” visited by the computer user. 800 Contacts, 414 F.3d at 404. Apparently by the time a computer user on a SaveNow-equipped machine reached the plaintiff’s website, the term “contacts” (or perhaps the entire website address, or some fragment of it including some or all of the expression “1-800 Contacts”) would already have been detected by the SaveNow application program and the program would have triggered a category association with some randomly selected competitor’s advertisement. Id. at 404-05. One of those competitors was Vision Direct, Inc., the other defendant in the case. The court noted that these ads might be characterized variably as “pop-up,” or “pop-under,” or banner ads (“panoramic” ads). Id. This article will refer to all three varieties as “pop-up” ads.

254. See id. at 404.
255. See id. at 404.
both Netscape and 800 Contacts a user input a word that happened to be a trigger (keyword) activating an advertisement. The keyword has some value because it is a trademarked term, but it creates a problem because the trademark is associated with someone other than the person who placed the advertisement. As previously discussed, the Netscape-style over-protection analysis leads to a conclusion of infringement based on an extreme application of initial interest confusion.\textsuperscript{256} In contrast, the 800 Contacts-style under-protection analysis reaches the opposite conclusion of non-infringement, but based on an extreme application of an offending use requirement. It holds that the use of a trademarked term as a trigger is not a “use” at all, or at least not a use “as a trademark” that can cause any likelihood of confusion.\textsuperscript{257} Since it is evident that there can be no likelihood of

\textsuperscript{256} See supra Part IIA.

\textsuperscript{257} 800 Contacts, 414 F.3d at 409 (noting the technological details of the allegedly offending user’s conduct in this case and analogizing it to an “internal use” of the mark in question (a company’s “internal utilization of a trademark in a way that does not communicate it to the public is analogous to [an] individual’s private thoughts about a trademark. Such conduct simply does not violate the Lanham Act, which is concerned with the use of trademarks in connection with the sale of goods or services in a manner likely to lead to consumer confusion as to the source of such goods or services.”)). It might be noted, however, that the analogy to private thought seems unable to account for the objective cyberspace intervention that created a demonstrable effect. See supra notes 12, 17 (markers in cyberspace and cyberspace interventions); cf. Lotus Development Corp. v. Borland International, Inc., 49 F.3d 807, 821 (1st Cir. 1995) (Boudin, J., concurring) (“the question is not whether Borland should prevail but on what basis . . . [n] all events, the choices are important ones of policy, not linguistics, and they should be made with the underlying considerations in view.”). Another way that WhenU might have prevailed here would have been on the absence of any likelihood of confusion, as a matter of law, when the offending use involved only the non-distinctive (or perhaps generic) text string “contacts” or the equally non-distinctive or generic string “1-800-contacts.” See 800 Contacts, 414 F.3d at 411, n.14 (suggesting though not deciding that the claim of likelihood of confusion on this record is “fairly incredulous”). The record revealed (at most) a possibility of calling to mind or a possibility of inconvenience, but not a likelihood of confusion. Compare supra notes 45-47 (possibilities, inconvenience, or frustration are not enough to create a likelihood of confusion) with 800 Contacts, 414 F.3d at 412 (arguably expressing the same concept, but citing cases in which such inconvenience might erroneously have been held to “create a likelihood of confusion” absent the “use” of a trademark). It might have been better to accept the findings of “use” in such cases, but to disapprove their inference of “likelihood of confusion” as a result of such uses.
confusion without an offending “use” it necessarily follows there
can never be any actionable confusion in a keyword-triggered
popup ad under this rationale.258

Though the 800 Contacts rationale might produce a better result
in many cases than the result reached in Netscape, it is still not
grounded in any correct understanding of ordinary trademark law
and so is without a guiding principle. By refusing even to consider
whether an invisible or attenuated use in cyberspace might actually
have an observable impact, this rationale broadly immunizes a wide
range of cyberspace interventions, despite their objective effects,
their deliberate employment259 and their sometimes predatory

258. 800 Contacts, 414 F.3d at 410-11. The court takes some pains to
distinguish without endorsing various other views. Id. at 411, n.15 (including
Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp., 174 F.3d 1020, 1034-36
(9th Cir. 1999) and Playboy Enter., Inc. v. Netscape, Inc., 354 F.3d 1020 (9th Cir.
2004)). The distinctions seem based on rather fine technological or semantical
differences. First, metatags might be used for ranking purposes (a “use” in
Brookfield), but there was no such ranking style-use here. 800 Contacts, 414 F.3d
at 411. Second, there exists the use of a keyword to trigger an unidentified banner
ad, which could be a “use” in Netscape, but there was no such unidentified ad
style-use here. Id. Third, there exists the act of selling particular trigger words to
specific sponsors (as in other cases) and simply selling random category
placements as in 800 Contacts. Id. at 411-12. As a result, perhaps the rationale is
best explained by the court’s ultimate challenge to the plaintiff. Id. at 412. It
appeared to the court quite simply that the plaintiff was “unable to explain
precisely how” the allegedly infringing user was using its mark. Id. But even that
seems a bit understated—a fair inference from 800 Contacts is that, in fact, no
triggered pop-up advertisement could ever constitute “use” of the type the court is
demanding. See Rescuecom Corp. v. Google, 456 F.Supp. 2d 393, 399-401
(N.D.N.Y. 2006) (so reading 800 Contacts and extending its rationale for the
proposition that the keyword ads sold by Google do not constitute “use” sufficient
to sustain a cause of action for trademark infringement).

259. One is hard pressed to find a word other than “use” to describe the
deliberate placement of attenuated or invisible markers in space with the intent of
drawing traffic by such placement. When such placement involves using markers
that are trademarks of other persons, it is hard to characterize the resulting
question any way other than: does such placement constitute a use that is likely to
cause confusion as to source or sponsorship? To answer the question by a simple
assertion that the use in question is not a use that can ever cause a likelihood of
confusion seems to beg the question rather than answer it. While the 800 Contacts
court tried to avoid such an absolute or per se holding against invisible or
attenuated uses in cyberspace, see supra notes 251-53, its rationale strongly points
that way. The issue of “use” and its equivocal meanings in trademark law is
discussed, at supra notes 89-93 and infra Appendix B (specimens to evidence use
in connection with federal trademark registration). This article contends that
results. That is to say, it immunizes them despite the fact that some such uses almost certainly cause a likelihood of confusion.

If 800 Contacts creates a per se rule, then its rationale is far reaching. A threshold element of the proprietor’s prima facie case under federal trademark law is unconsented “use” in commerce of a mark in connection with the sale of any goods or services that causes a likelihood of confusion.\textsuperscript{260} Therefore, if no invisible or attenuated use in cyberspace can ever constitute a “use” there can never be a prima facie case, and never any liability.

An earlier case is at least as important as 800 Contacts and is deserving of more extended discussion because of its stark presentation of the problem. Although not cited by the 800 Contacts court, the pioneering “no use” case is the relatively ancient case by cyberspace standards, Holiday Inns v. 800 Reservations.\textsuperscript{261} Decided in 1996, Holiday Inns dealt with addresses and magnets on the phone and a vanity phone number.\textsuperscript{262} It was a “trapping” case in which the offending party deliberately sought to do business with consumers who were clearly trying to reach the mark proprietor but who misdialed the vanity number.\textsuperscript{263}

Holiday Inns is a good example of the sort of predatory conduct an under-protection rationale can be expected to immunize. Like the 800 Contacts court, Holiday Inns concluded an attenuated use is not a “use-for-trademark-purposes” that can cause any legally cognizable likelihood of confusion.\textsuperscript{264} Though this is the same rationale that animates 800 Contacts, the user in Holiday Inns was

\textsuperscript{260} 800 Contacts, 414 F.3d at 407 (quoting Lanham Act).

\textsuperscript{261} Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619, 619 (6th Cir. 1996).

\textsuperscript{262} The vanity phone number was ‘1-800-HOLIDAY,’ which was massively advertised by Holiday Inns as a toll free phone number for room reservations and information. Id. at 620.

\textsuperscript{263} See infra note 251 and accompanying text (the offending user selected a trapping phone number identical to Holiday Inns, except for containing a “zero” instead of the letter “O” in HOLIDAY, anticipating callers would misdial).

\textsuperscript{264} Holiday Inns, 86 F.3d at 625-26.
not so benign as the user in 800 Contacts might have appeared to be.\textsuperscript{265} As a result, Holiday Inns better illustrates the unpleasant consequences of under-protection.

The Holiday Inns court said it was simply refusing to stretch ordinary principles of trademark law, and did not find liability.\textsuperscript{266} The conclusion was based on a finding that the offending conduct, an attenuated or invisible mapping of an expression to a phone number that was not advertised or promoted as such, is not even a “use” and so cannot be an infringing activity.\textsuperscript{267} Such an approach under-proTECTs marks in space by excluding some proprietors (those victimized by semi-passive predators)\textsuperscript{268} from important minimal benefits of trademark protection. Put another way, this approach privileges predatory conduct that traps for consumers who try to find a mark because it excludes passive trapping from the domain.

\textsuperscript{265} The “benign” nature of the cyberspace intervention in 800 Contacts might be suspect. It is not entirely free from doubt, but it appears the offending user responsible for the popup ads in 800 Contacts was an “adware” or “spyware” actor. See supra note 253 and accompanying text. If the law were able more directly to consider the public interest in cyberspace navigation, the law might have noticed the offending user responsible for the targeted keyword ads in Netscape were guides who had prepared maps to cyberspace. See generally Playboy Enter., Inc. v. Netscape, Inc., 354 F.3d 1020 (9th Cir. 2004). By an unhappy coincidence, it is the spyware provider at whom the law winked in 800 Contacts, but it is the cyberspace guide whom the law found potentially liable in Netscape. See 800 Contacts, 414 F.3d at 413; Netscape, 354 F.3d at 1035. Coincident with its other failings, current law seems unable to draw a principled distinction between actors who might well differ in their contribution to the public good of cyberspace.

\textsuperscript{266} Holiday Inns, 86 F.3d at 626. The offending 1-800 phone number that mapped digits to the letters 1-800-H[zero]LIDAY and directed callers to the defendant rather than to Holiday Inns was said to present “a case in which the defendant neither used the offending mark nor created the confusion” and so did not constitute trademark infringement, nor would it justify “stretching the plain language” of the Lanham Act to cover the dispute. Id. (emphasis in the original).

\textsuperscript{267} Id.

\textsuperscript{268} In the context of trapping, an “active” trapper might both trap and advertise the typo, whereas, a “passive” trapper might just be accidentally or coincidentally assigned a vanity phone number that just happens at random to be only a typo removed from someone else’s mark (and who then profits from the circumstance by appropriating business that “just happens” to arrive via the trap). See generally Folsom, supra note 2, at 101-07 (discussing cyberspace interventions). A semi-passive trapper is one who traps (and who intentionally and actively sought to set the trap), but who does not advertise or promote it. Id.
of trademark infringement. If passive or semi-passive trapping is not a use at all, then it cannot be an infringing use.\(^{269}\)

Since 1952, Holiday Inns had operated a hotel chain under the mark “Holiday Inn.”\(^{270}\) As of the 1990’s, when this controversy was tried, it owned, operated, or licensed some 1,300 hotels in the United States and it was spending between $20 million and $30 million annually on advertising.\(^{271}\) Holiday Inns owned a series of trademarks on “Holiday Inn,” and the marks were federally registered.\(^{272}\) Holiday Inns also owned a vanity phone number that mapped the letters beneath the numbers on a standard US phone to spell 1-800-HOLIDAY.\(^{273}\) When a consumer wanting to make a reservation or to get information about Holiday Inns correctly entered\(^{274}\) the number sequence 1-800-465-4329,\(^{275}\) the resulting

\(^{269}\) See supra notes 89-93 for a discussion of the four-way equivocation in the “use” required under ordinary principles of trademark law. The discussion here concentrates on that sense of the word that concerns the offending party’s “use” of the allegedly infringed mark. Id.

\(^{270}\) Holiday Inns, 86 F.3d at 620.

\(^{271}\) Id.

\(^{272}\) There are multiple registrations. The one to which the Sixth Circuit referred was that “which was registered in 1954.” Id. That would probably be U.S. Trademark Reg. No. 592,539 filed by Holiday Inns of America, Inc. on December 8, 1952, and registered on July 13, 1954 on the word mark “Holiday Inn” for “motor hotel services—namely, providing lodging and restaurant services in motels and hotels.” See Fed. T.M. Reg. 71639168.

\(^{273}\) Holiday Inns, 86 F.3d at 620. The standard US phone number dialing convention is a 10 digit number formed by a three-digit prefix (area code or special designation) followed by 7 digits. There is no need to dial a country code for in-country calls. In this case, “800” is a special designation for a number that is toll-free to the caller, even if it would otherwise subject the caller to long-distance calling charges. Such numbers are used to solicit nationwide calls by freeing the caller from concerns about phone charges.

\(^{274}\) The opinion speaks of “dialing” (and of “misdialing”). See e.g., Holiday Inns, 86 F.3d at 621. Regardless whether phones in 1995 had rotary dials,” this article will use “dialing” to signify entering a phone number, whether by punching the buttons on a phone’s user interface, or by spinning a dial wheel.

\(^{275}\) This is a somewhat curious construct, and perhaps important to the court’s analysis. If the consumer were trying to reach Holiday Inns to make a reservation or to get information without knowing the number for Holiday Inns, it would seem that the consumer is actually looking for the letters (H=4, O=6, L=5, I=4, D=3, A=2, Y=9) and couldn’t be directly trying to dial the unknown or hard to remember number (465-4329). Because the “user interface” of the phone (the numbers around the rotary dial or the buttons on the key pad) associates both number and letter with a binary pulse (the binary-coded address preamble actually
call would be answered by a representative of Holiday Inns. A misdialled number would, presumably, be lost.

The dispute began with rent-seeking activity by a group of

transmitted over the phone line that is “really” the phone number) it is no more true that the (decimal) number 465-4329 constitutes the “phone number” than do the letters HOLIDAY. In fact, neither does. Each is an abstraction from the binary pulse that “is” the phone number, but that point would seem to be a bit of technocratic information overload that ought not to make any substantial difference.

As the court parses the question, apparently it takes seriously the notion that the plaintiff Holiday Inns is “using” HOLIDAY as a mark when it associated the letters with the numbers (so that the vanity phone number is, or contains, a trademark), but the defendants were only “using” some numbers, 405-4329, that just happened to map to H[zero]LIDAY. Id. at 623. Because “405-4329” does not look like or sound like “HOLIDAY” the court was hard pressed to find actionable conduct by the defendants. See id. (“The defendants argue, however, that Call Management never used Holiday Inn’s registered mark nor any other variant of Holiday Inn’s trademark, they only used the phone number, 1-800-405-4329—that is, a number which is neither phonetically nor visually similar to Holiday Inns’s trademark, 1-800-HOLIDAY.” (emphasis in original, internal citations omitted)).

While the defendants conceded that 1-800-HOLIDAY was a mark, the court refrained from addressing the “threshold issue” whether “an unregistered cipher is, indeed, a trademark entitled to protection” but instead considered that the “crux of defendants’ argument is that Holiday Inns’ numeric of 1-800-465-4329 is not protected as a trademark.” Id. at 623, n.5 (emphasis in original). Although the court was merely summarizing defendants’ argument, it seems perhaps to have embraced part of it. See id. at 625 (“We conclude that although Holiday Inns owns trademark rights in its vanity number 1-800-HOLIDAY, it cannot claim such rights to the 405 number. It follows that the defendant . . . is the rightful assignee of the telephone number 1-800-405-4329.”). Of course, on any apples-to-apples comparison, H[zero]LIDAY does look like HOLIDAY, and of course H[zero]LIDAY “means” the same thing as HOLIDAY to the predictably misdialed consumer, but not to the telephone switching system that decodes the binary pulses.

The court also noted that the defendants never promoted or advertised their trapping number and so, apparently, did not engage in conduct by which the defendants might have “used” their trapping number so as to establish independent trademark rights in that number (assuming it were not substantially similar to the senior user’s mark and hence were available for appropriation in the first place). See id. at 624 (“in our case, the defendants engaged in only minimal advertisement of their travel agency and never promoted a vanity number.”), 626 (“the defendants’ use of a protected mark or their use of a misleading representation is a prerequisite to the finding of a Lanham Act violation.”) (emphasis in original)). This at least avoids the illogic of defendants’ argument that played apples and oranges with words and numbers, but it would still seem to be a mistaken approach. See supra note 105; see also infra text accompanying note 288.
defendants after an observation made by one of them, an aggregator of 1-800 vanity phone numbers. What the aggregator observed was that "consumers frequently misdial vanity numbers. The most common mistakes made by consumers occur when they dial the number '0' (zero) for the letter 'O' and the number '1' (one) for the letter 'I.'" If a consumer misdial the Holiday Inns vanity number by entering the number sequence, 1-800-405-4329 (substituting a zero for the letter "o" — the letter "o" would have called for a "6"), someone other than Holiday Inns might trap for the call, and someone other than Holiday Inns might find a way to profit from the mistake.

Phone numbers that contain the unintended consumer substitutions of zero or one for the corresponding letters "o" or "i" are sometimes called "complementary numbers" to the given vanity number. More generally, from a coding perspective, these are "traps" or "trapping numbers." What the aggregator, Call Management Systems, Inc., a consulting service that obtained and serviced 1-800 telephone numbers for others, began to do was to obtain and sell trapping numbers to third parties after the principal of Call Management Systems made the value-enhancing observation that created an opportunity to appropriate a rent on the trapping number. In this case, the third party purchaser from

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276. The defendants included the aggregator, Call Management Systems, Inc. and also two hotel reservation service providers, 800 Reservations, Inc. and Earthwinds Travel, Inc. Holiday Inns, 86 F.3d at 620-21.
277. Id. at 621.
278. Id. at 620.
279. That is, they are "trapping" for predictable incorrect data entry. This is trivially common in software development, and various debugging (or program design) steps are intended, by inserting such "traps" to prevent a software program from failing to execute as the user "really" desired it to do. See e.g., SCOTT LOVE AND STEVE LANE, SPECIAL EDITION USING FILEMAKER 8 (Que. 2006) ("Trapping for errors is always a smart development practice. Get into the habit and you'll save yourself years of your life debugging."). One might be excused for thinking that trademark law already guards against trapping expressions, by finding a likelihood of confusion for non-identical expressions that nonetheless are sufficiently similar in sight, sound and meaning to the subject mark that they might "trap" or deceive consumers. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION, §§ 21(a)-(d) (1995) (factors for likelihood of confusion, including similarity in sight, sound, or meaning).
280. Holiday Inns, 86 F.3d at 620-21.
Call Management Systems was 800 Reservations, a hotel booking agent.\footnote{281}

The trial court found at least two factors justified its grant of a preliminary injunction in favor of Holiday Inns. First, the defendant 800 Reservations might erroneously inform a customer a particular Holiday Inn had no rooms available when, in fact, vacancies did exist.\footnote{282} Second, on average, a customer might be more likely to obtain a better price on a room by calling Holiday Inns directly.\footnote{283} The first factor produces a lost customer, and a lost opportunity to rent a vacant room. The second factor might produce a dissatisfied customer, perhaps directing their disappointment against Holiday Inns for having failed to give the best price. There were probably other economic factors at work: (third) the defendant 800 Reservations might redirect a customer to a hotel chain other than Holiday Inns; \footnote{284} (fourth) the defendant 800 Reservations might charge Holiday Inns a booking fee for booking Holiday Inn customers into a Holiday Inn hotel;\footnote{285} and (fifth), the

\footnote{281} Id.

\footnote{282} Id. at 622.

\footnote{283} Id.

\footnote{284} Id. at 621 (the defendant claimed that it played a recorded message at the start of every call—the text of the asserted message says that “our highly trained hotel reservation specialists will be with you momentarily to provide the Holiday Inns number or to assist you in finding the lowest rate at over 19,000 properties worldwide, including such hotel chains as Holiday Inns, Guest Quarters, Hampton Inn, Sheraton, Comfort Inn, and many more” (emphasis added)). By the defendant’s own admission, it was in the business of at least occasionally steering defendant’s callers away from Holiday Inns. \textit{Id.} In this context, “defendant’s callers” are persons who thought they were dialing 1-800-HOLIDAY in order to reach Holiday Inns. \textit{Id.} To be blunt, defendant did not have any callers, except for those who were trying to reach Holiday Inns. \textit{Id.} It is those callers who would now be offered a chance to reserve a room at a different hotel chain. \textit{Id.}

\footnote{285} Cf. \textit{id.} (the defendant, Call Management, obtained and ‘served’ the offending 800 number, and the other defendants fielded the calls for which Call Management received payment of “10% of all commissions received for placing hotel bookings”). The inference is that there is a commission received for placing hotel bookings, and the further inference is that the commission was payable by the hotels for whom the bookings were made. It follows that the defendants were in the business of at least occasionally booking defendant’s callers into Holiday Inn hotels, and then demanding a commission from Holiday Inns for the booking. In this context, “defendant’s callers” are persons who thought they were dialing 1-800-HOLIDAY in order to reach Holiday Inns. To be candid, defendant did not have any callers, except for those who were trying to reach Holiday Inns in the
defendant 800 Reservations might give erroneous information about a particular Holiday Inn hotel in respect of amenities, services and room setup. All of these consequences might follow from a likelihood of confusion caused by the trapper, and without such likelihood of confusion the trapper would not have become involved with the potential customer at all.

The Sixth Circuit reversed the trial court, concluding that it was Holiday Inns who encouraged, by extensive advertising, the use of 1-800-HOLIDAY, and that defendants never advertised anything at all, never promoted anything whatsoever, never even publicized the fact that an expected misdial of “H[zero]LIDAY” would capture misdial calls by diverting callers from Holiday Inns to the defendants so they could sell the caller back to Holiday Inns (or divert the caller to a different hotel chain altogether). Putting aside the fact that this is not the sort of thing anyone would or even could well publicize, the appellate court concluded that first place. It is those callers who would now be sold back to Holiday Inns by way of a third party booking fee for the transaction. To be sure, these are callers who misdial the number, and so might have been “lost” to Holiday Inns had defendants not provided the “service” of finding them (unless the callers redialed or looked up the number in a phone book or called information or took other steps to find a Holiday Inn).

286. Id. (finding that “because Holiday Inns and the defendants use different computerized reservations systems” there might be errors in room availability, and there might be a failure to give the best price). An inference is that, because they are using different systems, it is less likely that defendants’ systems would contain the same information as Holiday Inns concerning particular properties and their amenities, facilities, and room setups.

287. In the words of the trial court, this was ‘parasitic’ conduct by the defendants. Id. at 624 (“The defendants derive benefit solely from Holiday Inns reputation. In fact, defendants have no independent reputation . . . . If not for Holiday Inns spending millions of dollars on advertising each year, defendants would have no service whatsoever to provide to the consumer.”).

288. The rhetorical question is: how do you solicit customers to make a mistake? The best answer that comes to mind would be a solicitation something like this: “Please misdial 1-800-HOLIDAY to reach us and misdial by hitting the zero for ‘0’, but not by misdialing the one for ‘i’” (no doubt a catchy jingle might be composed). The rhetorical question might be modified: how do you solicit customers intentionally to dial a competing vendor instead of the intended vendor? Then a good answer might be a solicitation something like this: “We know you want to dial 1-800-HOLIDAY to reach Holiday Inns, but please call instead 1-800-H[zero]LIDAY to reach us so that we can redirect you back to Holiday Inns or else book you into an altogether different hotel chain.”
defendants never “used” an offending expression because they
didn’t publicize or promote any expression at all.289

The defendants obtained the trapping number, left it “out there”
as a snare, and then sat back and waited until business (albeit
misdirected) fell into their lap, as if by good luck or by having
found or earned a legitimate opportunity for arbitrage.290 The Sixth
Circuit noted there can be no action under the Lanham Act if the
defendant either didn’t “use” anything at all,291 or didn’t use
anything “in commerce” to trigger the federal jurisdictional
basis.292 The defendants never (or only once) advertised their own
phone number.293 According to the Sixth Circuit, the defendants

The first solicitation is one that no one could make (it would be silly to ask
someone to make a mistake on purpose), and the second solicitation is one that no
one would make (it would be clear trademark infringement to articulate explicitly
the mistake that defendants hoped that a customer would make). This is a case
where, if the defendants said what they wanted, they would almost certainly be
liable for trademark infringement, but by keeping quiet they appropriated the
expected results without the consequences. Here, defendants’ silence was golden.
See Letter from Lewis Carroll to Edith Denman (May 17, 1878) in The Letters
Of Lewis Carroll, 311 (Morton N. Cohen ed., Oxford 1979) (“Where one is
hopelessly undecided as to what to say, there (as Confucius would have said, if
they had given him the opportunity) silence is golden.”); cf. William
Wordsworth, CLXXIX The Education of Nature, ll. 16-18 (“And hers shall
be the breathing balm, And hers the silence and the calm Of mute insensate
tings.”).

289. Holiday Inns, 86 F.3d at 624 (“In [Dial-A-Mattress Franchise Corp. v.
Page] for example, the defendant intentionally promoted his vanity number and
actively caused confusion; in our case, the defendants . . . never promoted a vanity
number.”).

290. See id.

291. Id. at 625. The trademark infringement section of the Lanham Act
prohibits any unconsented use in commerce of another’s registered mark (or of
any counterfeit, copy, or colorable imitation) which is likely to cause confusion.
section of the Lanham act prohibits the use in commerce of any word, term, name,
symbol, or device that is likely to cause confusion or to deceive as to affiliation,
connection, or association with another person or as to the origin, sponsorship or
approval of his or her goods, services, or commercial activities by another person

292. See supra note 92. There would be no use “in commerce” if there were no
use at all.

293. Holiday Inns, 86 F.3d at 624, n.6 (800 Reservations ran “a small classified
ad in a statewide newspaper during the period of July 5-25, 1993” and the ad
stated: “Call The Reservation Network at 1-800-405-4239”).
never created any confusion.\textsuperscript{294} Defendants simply were there with a trapping number that intercepted customers who dialed it by mistake when attempting to reach Holiday Inns.\textsuperscript{295} No use, no infringement.\textsuperscript{296} The Sixth Circuit concluded:

Holiday Inns does not offer, and our own research has not produced a case in which the defendant neither \textit{used} the offending mark nor \textit{created} the confusion and yet was deemed to have committed a trademark infringement. We believe that stretching the plain language of the Lanham Act to cover the present dispute is unjustified. As a matter of law, therefore, we hold that [the defendants] did not violate \ldots the Lanham Act by the \textit{use} of the 405 number.\textsuperscript{297}

In so doing, the Sixth Circuit missed its chance to reconcile invisible or attenuated uses with the five generalizations of

\textsuperscript{294} \textit{Id.} at 625 ("The defendants in this case never \textit{used} Holiday Inns’s [sic] trademark \ldots [m]oreover, the defendants did not \textit{create} any confusion; the confusion already existed among the misdialing public.").

\textsuperscript{295} \textit{Id.} ("In addition, Holiday Inns neglected to take the simple precaution [prior to the defendants’ appropriation] of reserving its complementary number").

\textsuperscript{296} \textit{Id.} \textit{Compare} "no harm, no foul" (an expression from sports contests) defined as:

The unspoken motto of the lenient referee, who won’t call a foul or penalty unless it’s absolutely necessary. Variations include ‘no blood, no foul’ and ‘swallowing the whistle’, the practice of NHL referees to not call penalties during the late stages of a game in the Stanley Cup playoffs unless a blatant penalty is committed.

The Everything Development Company, \textit{No Harm, No Foul@Everything2}, http://everything2.com/index.pl?node_id=177017 (Dec. 19, 1999) (on file with the Rutgers Computer and Technology Law Journal). The other situation, the one that occurred in \textit{Holiday Inns}, obscures the problem and also begs the question. Where there has been some harm and a court is asked to determine whether the harm is contrary to a legally protected interest it is hard to see how there can be no foul, as a matter of law. The question before the court was whether there was a use by the defendants of an expression that was confusingly similar to plaintiff’s trademark and that caused a likelihood of confusion. It begs the question to say that there is harm but no use; the purposeful act that creates a likelihood of confusion is alleged to constitute both the harm and the use. \textit{See} discussion supra notes 104, 259, 268 and accompanying text. The use by defendants was their deliberate connection of the confusingly similar mnemonic to their phone line. \textit{See id.} Given the harm caused by an act (use), this would be a time to call the foul.

\textsuperscript{297} \textit{Holiday Inns}, 86 F.3d at 626 (third emphasis added). The court seems to say that the defendants’ use of the trapping number didn’t constitute a use of the trapping number (or else that defendants’ use of “405” is not a use of “465”). \textit{See} \textit{id.}
trademark law most relevant to the problem because its approach
eliminated the very possibility of doing so.\textsuperscript{298} Instead, the Sixth
Circuit conflated the four senses of trademark "use" into just one,
and it turned the question of offending use into something very like
a question of proper specimens to evidence use for purpose of
registration, as if the offending user were trying to create trademark
rights in itself rather than offending against the rights of a prior
user.\textsuperscript{299}

This is the wrong result, for the wrong reason, and it is not
persuasive because of a fatal misunderstanding of the "use"
requirement in trademark law. \textit{Holiday Inns} confuses the four
senses of "use"\textsuperscript{300} and requires an offending "use" to rise to the
level of use that would have been sufficient to obtain trademark
rights in the first place.\textsuperscript{301} If that were the case, one could only
imagine what a court would make of any effort to sort through
"specimens" of use, presumably offered under the standards
prevailing in the PTO, by which some unfortunate plaintiff would
have to attempt to prove not only that the defendant's use had
caused a likelihood of confusion, but also that the defendant's use

\begin{itemize}
\item \textsuperscript{298} The five generalizations, including the distinction between a mere
possibility of confusion and a likelihood of confusion, and the requirement that an
appreciable number of consumers might be confused, had been violated by the
\textit{Netscape/Brookfield} line of cases, leading to over-protection. \textit{See supra} notes 46-
77 (stating the five generalizations), notes 216-220 (\textit{Brookfield} compared), notes
244-248 (\textit{Netscape} compared).
\item \textsuperscript{299} The four senses of "use" include (1) an offending use that creates a
likelihood of confusion with (2) an expression that is used by another as a
trademark, and if invoking the federal Lanham Act there must also be (3) a use in
interstate commerce, and if the offended expression is a registered mark under the
Lanham Act there must have been (4) a statement of use evidencing the
registrant's use of the expression as a mark. \textit{See supra} notes 89-93. Three of the
four senses of "use" have to do only with the proprietor of the offended mark. All
that the offending party needs to do is to "use" an offending expression in such a
way as to create a likelihood of confusion. The offending party does not have to
create a mark of its own and certainly does not have to satisfy the TMF
requirements for specimens, nor should the complaining party be required to
present the proof. \textit{See generally infra} Appendix B (summarizing the exquisite
detail of the TMF specimen regulations, none of which should apply to an
offending user).
\item \textsuperscript{300} For the four-way equivocation in the "use" requirement, \textit{see supra} notes
89-93.
\item \textsuperscript{301} \textit{See Holiday Inns}, 86 F. 3d at 624, 626.
\end{itemize}
would have sufficed to create a mark of defendant’s own, and perhaps the plaintiff would have to support such a claim with something analogous to a verified statement of defendant’s use with specimens to support the wrongdoing.\textsuperscript{302} Instead, all that is required of an offending use is that it be one that causes a likelihood of confusion.\textsuperscript{303}

\textit{Holiday Inns} reaches the wrong result because it exonerates

302. \textit{See infra} Appendix B (for the not-entirely-intuitive, and somewhat technical details of “use” sufficient to support a federal trademark registration, with subtle but important variations based upon whether goods or services are involved, and whether any particular specimen is technically sufficient under PTO guidelines as set forth in the TMEP). It would seem that merely by imagining the resulting chaos, a court would reject this approach out of hand. If need be, one might turn the phrase of the \textit{Holiday Inns} court, 86 F.3d at 626, on its head: nowhere (except for the \textit{Holiday Inns} case itself) can any case be found in which any defendant who used an expression in a way sufficient to cause a likelihood of confusion has ever avoided liability for trademark infringement on the ground that such use was made without advertising or promotional activities. What about obvious pirates and counterfeiters, or any infringer (like the one in \textit{Holiday Inns}) who is surreptitiously trading on another’s mark? The bulk of good faith infringers probably do so openly in anticipation that they are the prior user, or that they are capable of coexisting without causing a likelihood of confusion, but the bad faith of the blatant but secretive infringer has never been, nor could it be, a “get out of jail free card” (as used in the Monopoly board game).

303. To hold otherwise, it seems, would be to throw out all or most of the Coca-Cola and other product substitution cases, all or most of the “colorable imitation” cases, and all or most of the counterfeiting cases, if not also all or most of the “sight, sound and meaning” cases involving non-identical marks, which would seem to radically disfigure trademark law as it is commonly understood. \textit{See, e.g., McCarthy, supra} note 29, \textsection 25.01[3], n.24 (citing some of the Coca-Cola cases and discussing colorable imitation); \textit{see also id.} \textsection 25.01[5] (counterfeiting cases). In none of those cases would it seem the mark proprietor had to prove the offending user was actually promoting or advertising its offending conduct “as” a mark, rather than simply proving that the offending conduct caused a likelihood of confusion. \textit{Id.} As far as the “sight, sound and meaning” cases, it would appear no less wrong-headed than \textit{Holiday Inns} itself to say that the offending users of “Air-o” did not “cause” any confusion with “Arrow”; nor “B wear” with “Bee Wear”; “city bank” with “Citibank”; “cup-o-cola” with “Coca-Cola”; “dotson” with “Datsun”; “mack” with “Mac”; “esso” with S.O.; “porsha” with “Porsche,” and so on, which would be absurd. \textit{See, e.g., id.} \textsection 23.06[1] (listing pairs of non-identical expressions, including each of the foregoing, in which likelihood of confusion has been found). It seems the \textit{Holiday Inns} court could not seriously have expected each of the foregoing proprietors to secure some sort of separate trademark “registration” of all of the possible “complementary” sound alike or look alike expressions. The same applies to expressions with similar meanings. \textit{See, e.g., id.} \textsection 23.09.
willful, deliberate predatory diversion of customers by the use of an expression that is confusingly similar to another's mark. To be sure, actual confusion together with deliberate intent are not by themselves dispositive, but they certainly are highly persuasive evidence of likelihood of confusion. Holiday Inns reaches its result in a way that is not reasonable, especially in cyberspace, because it requires everyone to pretend that what actually happened never occurred. It cannot be denied that there was a real diversion, which was a real effect, which had a real and objective basis, and which found its origin in a deliberate action by the defendant to set the trap into which consumers stepped. For the court to require everyone to pretend that nothing happened—that there was no "use" though there was a real use—is to force belief contrary to fact, something not reasonable at all. It might go without saying that an unreasonable result is not a persuasive one.

In addition to disfiguring ordinary trademark law, Holiday Inns is destructive of the distinctive values of cyberspace. When pirates tamper with markers in space, setting invisible or attenuated traps to detour, divert and capture traffic intended for another destination, they ruin the activity set that characterizes cyberspace. Navigation becomes problematical, access is effectively denied, information-activity hampered, augmentation dangerously vulnerable to abuse by strangers pretending to be at friendly destinations, and the trust necessary to make cyberspace valuable destroyed. Holiday Inns cannot coexist with ordinary principles of trademark law, and it does not coexist with Brookfield or Netscape, though it certainly does rein in the excesses of Brookfield and Netscape-style initial interest confusion overprotection.  

304. See supra notes 68-69.

305. Ironically, Holiday Inns might well be a proper case to consider a true, preclusion-style initial interest confusion analysis. The preclusion might be evidenced by the active intervention of a salesperson who picks up the phone and who might well urge the trapped consumer to consummate a transaction on the spot rather than to redial the intended number to get to the intended destination. See supra note 284 (some doubt whether there really was a prerecorded message played at the offending site or whether the trapped callers were immediately confronted with a sales representative on the line). With almost equal irony, so might Netscape actually qualify as a proper case for a more narrowly applied preclusion-style initial interest confusion analysis. The preclusion might be evidenced by the opportunity to appropriate nearly immediately at the offending
Holiday Inns might have been thought to be a mistake, but one that could largely and safely be ignored.\textsuperscript{306} The problem that cannot be ignored, however, is \textit{800 Contacts}, which radically under-protects on the Internet because it follows at least the rationale of \textit{Holiday Inns}.\textsuperscript{307} Like \textit{Holiday Inns}, \textit{800 Contacts} is overly scrupulous to avoid expansion of trademark’s domain.\textsuperscript{308} But, like \textit{Holiday Inns}, it is so scrupulous as to extend dramatically the simple “offending use” requirement, turning it instead into the more radical requirement of something very like a “use” sufficient to create or to evidence trademark rights, turning cyberspace into an outlaw zone against the interests of all users and contrary to the ordinary principles of trademark law.\textsuperscript{309} The good news of \textit{800 Contacts} site some substitutionary goods or services being displayed there, thus arguably depriving PEI of a chance to be considered by the potential customer because of the initial exposure.

\textsuperscript{306} It could be largely ignored if the doctrine were confined to some special category of trademark law, perhaps “telephone number trademark law” that created its own rules but didn’t harm anyone else by doctrinal creep. Some of the “phone number law” cases include DaimlerChrysler AG v. Bloom, 315 F.3d 932 (8th Cir. 2003) (following \textit{Holiday Inns}) and Dial-A-Mattress Franchise Corp. v. Page, 880 F.2d 675 (2d Cir. 1989) (distinguished in \textit{Holiday Inns}). But \textit{800 Contacts} proves that the phone system cases cannot be so confined, and moreover, the phone system shares the distinctive aspects of cyberspace, and therefore the same problems. \textit{See} Folsom, \textit{supra} note 2, at 81–84.

\textsuperscript{307} \textit{See} 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 410-412 (2d Cir. 2005).

\textsuperscript{308} \textit{See id.}

\textsuperscript{309} To be sure, the \textit{800 Contacts} court did not see it that way, but explicitly delineated three senses in which “use” is required in ordinary trademark law and then requiring all three, plus a “threshold” finding of use in cyberspace. 414 F.3d at 412 (“Not only are ‘use,’ ‘in commerce,’ and ‘likelihood of confusion’ three distinct elements of a trademark infringement claim, but ‘use’ must be decided as a threshold matter because while any number of activities may . . . create a likelihood of confusion, no such activity is actionable under the Lanham Act absent the ‘use’ of a trademark.”).

The court took pains to address the “use” question, but it might better have indicated that the activity did not cause any likelihood of confusion rather than holding that the use wasn’t a “use.” \textit{See supra} notes 257 and accompanying text. The expression “outlaw zone” is meant to connote this: if \textit{few or no} invisible or attenuated uses of markers in cyberspace, whether as address, magnet, roadblock, or detour, can \textit{ever} constitute an offending “use” sufficient to invoke any application of trademark law then trademark (and perhaps unfair competition) law will, to that extent, have no ability to regulate any such invisible or attenuated use in cyberspace. Such conduct will be outside of the law’s domain, hence “outlaw”
Contacts is that it resists the pressures of overprotection to marks in space: it avoids the mistake of Netscape/Brookfield. The bad news of 800 Contacts is that it disfigured trademark law to do so, thereby committing the opposite mistake of radically under-protecting marks in space.

C. Counting Cases on the Internet

This article designates a sampling of ordinary cases to represent the ad hoc cases between the extremes. This article asserts that the extreme cases are the leading cases because they most directly affect the ability of a guide to index or map resources in cyberspace, and so threaten to cause the greatest harm against cyberspace values. It might be desirable to limit the scope of this article to only those leading cases, but the conflict within the leading cases between the extremes of radical over-protection as in the Netscape/Brookfield line and radical under-protection as in the 800 Contacts/Holiday Inns line casts a shadow over all of the other

seems fairly to apply. This article has already asserted that ordinary principles of trademark law can (and routinely do) prevent any use that causes a likelihood of confusion regardless whether such use might also qualify to create trademark rights in the user, supra notes 104, 302-03, and it would be good if trademark law continued to do so in cyberspace as well.

310. See, e.g., Playboy Entm’t, Inc. v. Welles, 279 F.3d 796, 799-801 (9th Cir. 2002) (finding no liability but permissible, nominative use when a former Playboy-brand Playmate-style naked model used trademarked expressions belonging to Playboy Enterprise in invisible meta-tag magnets to draw traffic to her website; use was presupposed); PETA v. Doughney, 263 F.3d 359, 367-69 (4th Cir. 2001) (finding use, likelihood of confusion, and liability under the ACPA anti-cybersquatting provisions when a spoiler’s registration of a domain name contained the mark of another in an attempt to prevent a trademark owner from obtaining the domain name); Sporty’s Farm, L.L.C. v. Sportsman’s Mkt., Inc., 202 F.3d 489, 493 (2d Cir.), cert. denied, 530 U.S. 1262 (2000) (finding liability for cybersquatting under the ACPA, and for dilution under the FTDA when blocking a competitor by registering a domain name including the competitor’s mark and then assigning the domain name to a non-competing wholly-owned subsidiary; use was presupposed and no appeal was taken from the trial court’s rejection of trademark infringement claims because the parties were operating in wholly unrelated businesses); Panavision Int’l, L.P. v. Toeppen, 141 F.3d 1316, 1324-27 (9th Cir. 1998) (finding commercial use of the mark and liability for dilution under the FTDA when Mr. Toeppen obtained domain name registrations covering more than 100 well-known marks, including “Panavision” and “Panaflex,” and then set himself up in the “business” of selling them back to the trademark proprietors).
cases on the Internet or in cyberspace. This article is not primarily about those other cases, but because this article suggests a solution to the problem of invisible and attenuated uses of marks in space it will be essential to account for them both before and after the suggested solution. This part of the article deals with the “before” and a later part of the article will suggest how to deal with the “after.”

Trademark-like conflicts on the Internet or in cyberspace have been handled on an ad hoc basis. The cases are sometimes sorted by the kind of technological marvel that gave rise to the conflict, sometimes by the type of legal tool with which the particular problem was resolved, and sometimes by the analogy preferred.311 Leaving the analogical approach aside for the moment, either of the other two approaches reduces to counting cases. What follows is a brief recount of the many varieties, cross-sorted by technology class and legal taxonomy. The list also includes some conflicts that are readily recognizable and, in fact, common even though not yet represented, or under-represented in the reported cases.

Trademark-like conflicts can arise on the Internet or in cyberspace with respect to:

(a) Domain names (or subdirectory names) that include the trademark of a person other than the domain name registrant312—

311. See Folsom, supra note 2, at 110-12 (stating the perils of making law based on analogy). The point is that cyberspace, while sometimes like any number of things (i.e. a billboard, or a highway), actually is something. See Brookfield Commc'ns, Inc. v. West Coast Entm't Corp., 174 F.3d 1036, 1064 (9th Cir. 1999) (for the famous but backward simile of the billboard by an information superhighway); Folsom, supra note 2, at 110 & n.90 (the billboard is backwards). It would be better to make law based on reality rather than metaphor, at least where possible. Folsom, supra note 2, at 110 & n.93 (comparing Hamlet's cloud that only looked like a whale with Captain Ahab's nemesis that, whatever else it might have suggested, actually was a whale).

312. A domain name is "a string of characters forming the core of the addressing scheme that allows resources to be made available on the Internet." See RADIN ET AL., supra note 31 at 1214-24 (explaining the domain name system), 1237 (glossary). Persons who collected well known trademarks, obtained domain name registrations on them, and offered them for sale back to the trademark proprietors became known as "cybersquatters." Sporty's Farm, L.L.C., 202 F.3d at 493. The commercial value inheres to the extent that potential Internet customers would assume that the domain name of a company having a well-known trademark would be in the form of http://www.TRADEMARK.com and
currently resolved by varieties or combinations of “anti-cybersquatting” provisions, sometimes balanced by a concern against reverse domain name hijacking. Legal regimes include the conventional trademark infringement analysis; anti-dilution analysis under the FTDA and TDRA; anti-cybersquatting analysis under the ACPA, and application (non-judicially) of the

that such company would be found by keying the domain name into the address window of a web browser. Now that there are search engines and directories, it might seem that the value proposition no longer applies, but the fact remains that the phenomena illustrates an unconsented appropriation of a trademark which prevents the mark proprietor from making the same appropriation of its own mark. This is because domain names are “rivalrous” uses, and only one person may hold any given domain name at any one time, which permits blocking uses. Not all rival domain name registrants are squatters, however, some simply want the domain name for various other reasons.

313. Generalizations and observations concerning likelihood of confusion are set forth in Part 1A above. Following an ordinary trademark infringement analysis, some squatters are found to be liable for infringement, but others are not. Compare, PETA, 263 F.3d at 362 (liability for trademark infringement, and under the ACPA anti-cybersquatting provisions; domain name ordered to be transferred without damages), with Sporty’s Farm, L.L.C., 202 F.3d at 489 (finding no trademark infringement because no likelihood of confusion, but finding dilution, and a violation of the ACPA).

314. The FTDA and TDRA elements and factors are set forth at supra notes 138-48. Following a trademark dilution analysis, some squatters are found to be liable for dilution. See, e.g., Panavision Int’l, L.P., 141 F.3d at 1327 (Toeppen had obtained domain registrations covering more than 100 well-known marks, including “Panavision,” and was held to have diluted the value of the mark).

315. The ACPA elements and factors are set forth supra notes 149-55 and accompanying text. Following the ACPA factors, some courts find liability, with or without “use.” Compare, Coca-Cola Co. v. Purdy, 382 F.3d 774, 774, 792 (8th Cir. 2004) (liability under the ACPA; domain name ordered to be transferred); Faegre & Benson v. Purdy, 367 F.Supp. 2d 1238, 1240-43 (D. Minn. 2005) (further proceedings involving the defendant in the Coca-Cola case, after Mr. Purdy subsequently registered domain names confusingly similar to that of the law firm that had represented the Coca-Cola Company against him); Sporty’s Farm, L.L.C., 202 F.3d at 489 (trial court found liability for dilution pursuant to the FTDA; the Second Circuit affirmed and also found liability under the newly-enacted ACPA; domain name ordered to be transferred, without damages); with Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 682 (9th Cir. 2005) (a no-use finding on a dilution claim, but remanded on the ACPA claim which did not require “use”). Because the ACPA factors include a bad-faith requirement, often determined by an offer to sell the domain name to the proprietor of a corresponding trademark, initiated by the squatter, some “second generation” squatters are apparently registering a domain name and then waiting for the proprietor to take the initiative, thereby engaging in essentially the same
private contractual regime for resolving domain name disputes in panels organized under the UDRP. 316

(b) Meta-tags that include the trademark of a person other than the person placing the tag and other than the person to whom the tag points—currently resolved by varieties or combinations of conventional trademark analysis,318 with some traces of anti-dilution analysis,319 often running off the ordinary track of misconduct as inspired the ACPA in the first place while possibly avoiding the reach of that statute.

316. The UDRP elements and factors are set forth supra notes 157-60 and accompanying text. Following the UDRP factors, most complaining parties have prevailed. See, e.g., Hershey Choc. & Confect. Corp. v. Ralph Ward, Case No. FA051200608687 (National Arbitration Forum (NAF) Jan 20, 2006); Superstation Inc. v. Dinner@aMovie, Case No. FA97635 (National Arbitration Forum (NAF), Aug 14, 2001); Phoenix Mortgage Corp. v. Toggas, Case No. D2001-0101 (WIPO Arbitration and Mediation Center, Mar. 30, 2001). It might be that most proprietors prevail because the UDRP factors have been interpreted rather objectively and mark proprietors tend to bring such cases when the offending party has no colorable claim to the use trademarked expression.

317. See supra note 12 and accompanying text for a general discussion of meta-tags (invisible and attenuated uses of markers as magnets in cyberspace), which have already been seen in Brookfield Commc‘ns, Inc. v. West Coast Entm‘t Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

318. See Brookfield, 174 F.3d at 1036; Playboy Entm‘t, Inc. v. Welles, 279 F.3d 796, 800-806 (9th Cir. 2002) (recall that Ms. Terri Welles is the former Playboy-brand Playmate-style naked model who uses meta-tag magnets to draw traffic to her website using trademarked expressions belonging to Playboy Enterprises).

319. See Brookfield, 174 F.3d at 1056 (finding of non-competing goods and services reversed by the court of appeals). There is a tension between the trial court and the court of appeals on the question of whether there were competing goods or services; if the providers were, as the trial court held, non-competitors, then the result begins to approach shades of dilution, but in respect of a proprietor’s mark that was not famous. Id. However, because the appellate court held that the providers were “[n]ot only not non-competitors” but that “the competitive proximity of their products is actually quite high” the result fits at least nominally within a trademark infringement rather than a dilution analysis. Id. West Coast claimed to be a large movie rental chain with an incidental data base about movies. Id. at 1041. Brookfield claimed to have provided software and services for professionals in the entertainment industry, and to have recently expanded into a broader consumer market for comprehensive, searchable, entertainment industry databases. Id. In the absence of any trial or any substantial evidence introduced by the plaintiff at the hearing on the injunction below, apparently the appellate court’s guess was as good as any one else’s.
trademark law into curious versions of initial interest confusion, use/no use metaphysics, and variations on classic fair use or nominative use doctrines.

(c) Hidden text that includes the trademark of a person other than the person placing the hidden text and other than the person to whom the hidden text points—not many reported cases.

(d) Keyword triggers to targeted advertising (pursuant to negotiated transactions) where the keywords include trademarked designations of persons other than the ones arranging for the advertising, and accomplished by varieties of negotiated or at least partially negotiated popup techniques, and search engine or directory mechanics—currently resolved, much like the meta-tag

320. Brookfield, 174 F.3d at 1062-65 (initial interest confusion without preclusion).

321. This arises out of the conflict between cases like Brookfield, 174 F.3d at 1036 (where attenuated and invisible uses in meta-tags and hidden text were sufficient to support trademark infringement), PETA v. Doughney, 263 F.3d 359, 365-66 (4th Cir. 2001) (where a blocker prevented a trademark owner from obtaining a domain name, the blocking itself constituted a use sufficient to support a trademark infringement action), and Panavision Int'l v. Toeppen, 141 F.3d 1316, 1324-26 (9th Cir. 1998) (where a cyber squatter's warehousing of marks and then offering to sell them back to the mark proprietor was sufficient "commercial use" to support a trademark dilution action), and cases like 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 412 (2d Cir. 2005) and Holiday Inns v. 800 Reservation, 86 F.3d 619, 626 (6th Cir. 1996) (where attenuated and invisible uses in key word-targeted advertising and vanity phone numbers were held not to constitute use sufficient to support trademark infringement).

322. See Brookfield, 174 F.3d at 1065-66 (discussing fair use or nominative use). Compare Welles, 279 F.3d at 801 ("nominative fair use" approved on a three-factor test: the mark may be used when "no descriptive substitute exists," when there is use of "no more of the mark than necessary," and there is "nothing to suggest sponsorship or endorsement by the mark holder") with RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 28 (1995) (descriptive/fair use formulated: "it is a defense that the term used by the actor is descriptive . . . of the actor's goods, services, or business . . . and the actor has used the term fairly and in good faith solely to describe" the actor's goods or services or business (emphasis added)).

323. Hidden text (or invisible text) is not the same as meta-tags, but instead involves text that is not viewable by a human reader—if the background color of a web page is blue, then blue text of the identical color will be "hidden." Like meta-tags, hidden text can be found by a web search engine crawler and so can act to draw searchers to a site. See RADIN ET AL., supra note 31, at 95-96.

324. Id. at 96.

325. Keyword ads have already been seen in Netscape, 354 F.3d at 1023, and in 800 Contacts, 414 F.3d at 404. "Negotiated" transactions are done with the
cases, by varieties or combinations of conventional trademark analysis with some traces of anti-dilution analysis, often running off the ordinary track of trademark law into curious versions of initial interest confusion, use/no use metaphysics, and variations on classic fair use or nominative use doctrines.\textsuperscript{326}

(e) Keyword triggers to enhanced search engine or directory relevancy placement listings (pursuant to negotiated transactions) where the keywords include trademarked designations of persons other than the ones arranging for the enhanced relevancy ranking\textsuperscript{327}—not many reported cases.\textsuperscript{328}

(f) Keyword spoofing or free riding to create popup ads or to force inclusion or enhanced placement in relevancy rankings (pursuant to non-negotiated transactions) where the keyword includes trademarked designations and the result is accomplished by non-negotiated popup or spy techniques, or by manipulation of relevancy ranking criteria in order to mislead or misdirect\textsuperscript{329}—not many reported cases.\textsuperscript{330}

(g) Spam messages or other unwelcome intrusions where a trademarked designation is associated with the spammer\textsuperscript{331}—not many reported trademark-based cases, but currently resolved more

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326. See supra notes 318-22 and accompanying text.

327. Listings are often returned by a directory or a search engine, and relevancy rankings are signals of importance within a listing (the more prominent nearer the top or otherwise set off).

328. See Schechter & Thomas, supra note 30, at 816; Radin et al., supra note 31, at 97, 150.

329. “Non-negotiated” transactions in this context are those to which a user has not given consent, and in which the user might be taken off guard. “Partially negotiated” transactions in this context are those in which the user might have known. These categories include cookies, spam and spyware, and various other Trojan horse applications.

330. It is possible that 800 Contacts might be included in this category, to the extent it involved a non-negotiated spyware intervention. See supra note 253 and accompanying text.

331. See supra note 169 and accompanying text.
generally under a combination of self-help social norms like the MAPS blackhole list, and/or by various common law theories (theft of services) or by various regulations.

(h) Typo-squatting to trap customers where a trapping domain name, phone number, hidden text or meta-tag is selected with the intent to present a facsimile of a trademarked designation differing from the trademark in a way calculated to misdirect and deceive customers who can be expected incorrectly to enter the trademarked term—currently resolved by varieties or combinations of conventional trademark analysis, with some traces of anti-dilution analysis, often running off the ordinary track of trademark law into bizarre use/no use metaphysics.

(i) Registration to prevent another’s use.

(j) Email addresses that contain a trademark

These cases are, in the words any client or federal judicial law clerk hates to hear: “great fun.” As mutants, sports, and outliers between the opposite extremes of over-and under-protection, they are perhaps radically indeterminate, and they present an exciting array of gaps and inconsistencies (likelihood of confusion, or not), doctrinal creep (FTDA confined to truly famous marks, or not), and contradictory tendencies (use/no use, among others), all within the rubric that these are simply ordinary principles of trademark law,

332. See supra note 131 and accompanying text.
333. See SCHECHTER & THOMAS, supra note 30, at 816.
334. Typo-squatting involves trapping for misdialed phone numbers, and mistyped addresses, magnets, or other markers, and is a form of cyberspace intervention that is a detour. See supra notes 12 (markers in space), 17 (cyberspace interventions) and accompanying text; SCHECHTER & THOMAS, supra note 30, at 807; RADIN ET AL., supra note 31, at 203, 223-25, 227.
335. As to the four senses of the word “use” in trademark law, see supra notes 89-93. For an additional sense of the word “use” in anti-counterfeiting law, see supra note 94, and for an additional sense of the word “use” in anti-dilution law, see supra note 138. For a case that struggled with “use” even though the use was open and direct, but didn’t constitute the sort of promotional use that would have created trademark rights in the offending actor, see Holiday Inns v. 800 Reservation, 86 F.3d 619, 626 (6th Cir. 1996).
337. Id. at 186.
and all beneath the specter of over- or under-protection of the index to cyberspace. Were it not for the possibility this sport might accidentally bring down or cripple the Internet itself we might not mind continuing further to “evolve” the law in the same fecklessly blithe and nomophobic spirit of playful nonchalance that has characterized the course of the law generally during the last century. But this is too important to be left to chance, time and random change. Instead of leaving this to blind “evolution” it is time to develop the law, intentionally and by design.

Despite all these cases, and all of the rules, standards, factors, and elements, the law has not clearly answered (or has answered with conflicting decisions that split the circuits) some rather basic questions about invisible or attenuated uses on the Internet or in cyberspace:\footnote{338. In the following list, the first four questions are taken from RADIN ET AL., \textit{supra} note 31, at 97. The remaining are a number of composites, fairly inferred from \textit{id.} 25, at 150, 184-86, 225-29, SVEC \textsc{et al.} \textit{supra}, note 30, and the list of cases set forth in this article.}

- Is it trademark infringement to embed another’s trademark in HTML meta-tags?
- Is it trademark infringement to repeat another’s trademark in buried code or invisible text?
- Is it trademark infringement to sell advertising triggered by a trademarked expression?
- Is it trademark infringement to sell enhanced relevancy rankings, if the ranking is triggered by a search based upon a trademarked term?
- Is it trademark infringement to register another person’s trademark as part of a domain name address, or as a phone number? Does it make a difference whether it is done to block use by a trademark proprietor or to capture consumers from or to resell consumers back to the proprietor?
- Is a disclaimer enough to avoid liability? Can a disclaimer be required as part of a remedy? Does bad faith figure?
- What does any of this have to do with “likelihood of confusion” and what do the remedies being imposed have to do with the purpose and rational of trademark law? Do the cognate
areas of law, private contract, or social norms—FTDA (TDRA), ACPA, UDRP or basic architecture—figure?

All of these issues are dominated by the question of invisible and attenuated uses on the Internet and in cyberspace. The basic question of what invisible or attenuated uses will lead to liability for trademark infringement on the Internet currently leads to three answers: one answer is “all,” a second answer is “none,” and a third answer is “some.”

Consider that the two extremes are not only in conflict with ordinary principles of trademark law, but they are in conflict with each other:

- So it is a use, and maybe even an infringing one, almost as a matter of law, for Netscape or Excite to use “Playboy” or “Playmate” as keywords to trigger targeted advertising, because a court has announced this is initial interest confusion. And it is therefore just as probable that Google (if its uses constitute “use”) might be infringing almost as a matter of law when it places “GEICO” or “American Blinds” as keywords to trigger targeted advertising, or not. Likewise it is a use, and an infringing one, for West Coast to use “moviebuff” as an address and magnet to attract customers.

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339. This is the clear tendency of the overprotection cases.

340. This is the explicit holding of the under-protection cases.

341. This is the observed effect of the middling cases that, on an ad hoc basis, attempt to split the difference between the extremes of over and under protection.

342. But, the billboard simile aside (and backwards, see supra note 311), this is not the sort of initial interest confusion that ordinary trademark law addresses, because there was no finding that the mark owner was precluded from making the sale. See supra note 73.

At the same time it is no use, and therefore there is no infringement as a matter of law for an Internet agent to use trademarks as keywords to trigger pop up advertisements or for a competing hotel reservation broker to use “h[zero]iday” to catch customers who were trying to dial the mnemonic for “holiday” to reach Holiday Inns.

One might suppose this state of affairs will incentivize, at least in some circuits, the following conduct: X, a person with a mind to capitalize upon another’s “Moviebuff” mark, may freely appropriate (at least as an invisible or attenuated address or magnet in cyberspace) such expressions as: “moviefan,” “moviebuff,” “movieduff,” “motionpicturebuff,” or “videobuff”—indeed, X may even use “moviebuff” as long as X refrains from advertising or promoting its activities. For its part and to protect itself (because the law won’t), the mark proprietor, Y, should register the “complementary” domain names: moviebuff.com; m[zero]viebuff.com; movief.com; movieduff.com; motionpicturebuff.com; and videobuff.com (and also each of these with the .org, .net, .nu, .tv, or other extension du jour). On this logic, one might further suppose Y must somehow also try to obtain underlying trademark rights on each of “m[zero]viebuff,” “moviefan,” “moviebuff,” “movieduff,” “motionpicturebuff,” and “videobuff”—but perhaps even this wouldn’t make any

344. 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 403, 412 (2d Cir. 2005).
345. Holiday Inns v. 800 Reservation, 86 F.3d 619, 621, 626 (6th Cir. 1996).
346. Of course, because the Court of Appeals allowed the junior party to use “move buff,” see supra notes 187, 198, many of these gyrations might not be necessary.
347. This is an intentional absurdity. The first user’s single trademark already covers other non-identical expressions that are close enough in sight, sound, or meaning (and are associated with goods or services close enough, in market conditions appropriate enough) that a likelihood of confusion might result. The unintentional absurdity is the suggestion, in cases like Holiday Inns, that the possessor of a mark in a vanity phone number somehow might have gained protection if only that person had also reserved all of the complementary numbers—if there is a mark in the vanity phone number, then there would already be protection against a likelihood of confusion caused by the use of complements. Thus it is that Holiday Inns must necessarily turn on the equally untenable proposition that a predatory use that actually steals customers isn’t a “use” in the trademark sense because it isn’t a use “as” a mark.
difference against an offending invisible or attenuated user, \( X \), who simply pirates without advertising the piracy.

Between the two extremes, the cases strive mightily to make sense out of invisible and attenuated uses under various headings, but they also end up in conflict:

- Terri Welles can use the invisible magnets “playboy” and “playmate” to draw customers to her site because she once was a Playboy-style Playmate-brand naked model, and so the court announces that there is no likelihood of consumer confusion (or that the use is privileged by a nominative fair use).\(^{348}\)

- At the same time West Coast Entertainment\(^{349}\) cannot use invisible magnets (“moviebuff”) or an attenuated address (“moviebuff.com”) to draw customers to its site despite the fact West Coast is the “Movie Buff’s Movie Store,” and has some 10 years of use, $15 million of advertising, several hundred brick and mortar stores using the mark, and an incontestable federal trademark registration to prove it, because a court has announced that this creates initial interest confusion with a latecomer who was first to obtain a federal registration and then complained about the preexisting and continuing concurrent uses by West Coast\(^{350}\) (with no room for any sort of nominative fair use here as with Ms. Welles).

- Meanwhile, Dennis Toeppen cannot warehouse hundreds of domain names that contain trademarked expressions because this warehousing is itself a commercial use, and to the extent he puts up a token use (“here are pictures, providing a vision of the city of Pana, Illinois”) at a site, panavision.com, that might be accessed by persons interested in the Panavision-brand professional quality

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\(^{348}\) See Playboy Entm’t, Inc. v. Welles, 279 F.3d 796, 802-804 (9th Cir. 2002). This is not the place to dispute whether such fair use negates a finding of likelihood of confusion (that is, no one could be confused by a good faith, fairly descriptive use) or whether it is a defense to a prima facie case of likelihood of confusion.

\(^{349}\) Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp., 174 F.3d 1036, 1056-66 (9th Cir. 1999) (but it may use “movie buff”).

\(^{350}\) Id. The case might be best understood as one of reverse domain name hijacking (by the plaintiff, Brookfield) and left to languish as an oddity, were it not for the power of the incorrect premises unleashed by its view of initial interest confusion in cyberspace. See supra notes 220, 248 and accompanying text.
motion picture equipment or processes, or perhaps even an empty
domain at the warehoused sites ("this site under construction" or
"server cannot locate this page") it is a kind of use, moreover, that
will cause dilution (by discouraging consumers from continued
searching, by depriving the proprietor of a valuable way to help
consumers locate its web site, and by exposing the proprietor's
name and reputation to the mercy of the unaffiliated web page
owner). \(^{351}\)

- At the same time a hotel reservation poacher can
deliberately pick a trapping address complementary to an address
that contains a trademark, and can attract paying customers away
from the mark proprietor because a court has announced that this
use is not a use, notwithstanding it is a use that has effectively
caused confusion \(^{352}\)—because, of course, the confusion was caused
either by the mark owner (who picked a mark a consumer might
misspell, and the mark owner neglected to obtain protection on all
the misspellings) or by the consumer (who misspelled the mark) or
just in the nature of things (apparently, trademark-style mistakes
just happen and finders and thieves are privileged deliberately to
take advantage of another’s goodwill when that does happen, or
when the thief helps it along). \(^{353}\)

As soon as the cases go outside of trademark law, they bump
uncomfortably into cognate fields of law, private ordering, and
social norms. Thus, an offense that does not constitute trademark
infringement may, quite rightly, constitute dilution in violation of
the FTDA (or TDRA), but only if the subject mark is “famous” and
then only if the conduct constitutes dilution. \(^{354}\) An offense that
does not rise to the level of trademark infringement may also
properly be an episode of cybersquatting contrary to the ACPA, but
only if the conduct is in “bad faith” as by initiating an offer to sell

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\(^{351}\) Panavision Int'l v. Toeppen, 141 F.3d 1316, 1326-27 (9th Cir. 1998). If
there were a genuine “no use” case, this might, at least arguably, most nearly be it.
\(^{352}\) Compare supra, note 12 (warehousing as a commercial use of a marker, spoiling it
and hindering navigation) with supra note 343 (cases claiming no use at all).
\(^{353}\) Holiday Inns v. 800 Reservations, 86 F.3d 619, 621, 626 (6th Cir. 1996).
\(^{354}\) But that would seem to be absurd, see supra note 303 (product
substitutions, colorable imitations, counterfeiting, and “sight, sound, and meaning”
cases).

\(^{354}\) See supra notes 138-48 and accompanying text.
the domain name to the mark proprietor. Conduct beyond the reach of trademark infringement might be redressed under the UDRP, but only so long as ICANN continues to be a super monitor with plenary authority over all the domain name registrars, and then only so long as it maintains its current policies.

An observer must be forgiven for coming to the conclusion that these cases seem to be in fundamental disarray because they stand simultaneously for the opposing propositions that all, none, or some invisible or attenuated uses in cyberspace constitute trademark infringement. It might be thought that the underlying law could be clarified by some excellent rhetorical questions that will put things right. It is, perhaps, just as possible to hold all these cases together by dividing and subdividing by increasingly narrow distinctions as if the technology or some other thing were the driving factor, and yet the effort seems not worth the


356. By having resolved over 13,300 domain names compared to the negligible use of the U.S. court system, the UDRP process has either bailed out the legal system or the users have voted for their preferred regulator, and the UDRP wins in a landslide. See generally supra note 157. If, however, the United States loses the ability to influence ICANN through the Department of Commerce, as would be the case if the domain name system were to be internationalized, the odds that adherence to the UDRP would remain a universal condition to domain name registration must be lowered. The specter of at least one unconstrained domain name registrar may be remote, but should it happen in the face of the present disorder in trademark law, the results would probably be disappointing. Providing redress to the perhaps thousands of mark proprietors who might no longer control the domain names that contain their marks would be one thing, but it is also not clear how the millions of surfers and other users of cyberspace would be able to get the cyberspace navigation system repaired. Perhaps the crawlers and other mappers of cyberspace could work under new algorithms that would simply ignore the nominal domain name altogether if domain names gained the reputation of being significantly misdirecting (perhaps the crawlers already ignore the names — but who really wants to know whether they can, or do?).

357. See supra note 338 and accompanying text.

358. Let Brookfield be recharacterized in the following way: at least by the time of the appeal, the alleged infringer actually had its web site up and running, and on that site it was actually using “Moviebuff” (or “Movie Buff”) as a trademark. See generally Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp., 174 F.3d 1036 (9th Cir. 1999). Hence, on its facts, Brookfield is not a case in which there was only an invisible and an attenuated use by hidden metatags and an attenuated domain name address. Id. Instead, it is a case of actual, direct
trademark infringement by an expression used "as" a mark in cyberspace. *Id.* Therefore, the case must be rightly understood as a straight-forward finding of ordinary infringement that just happened to occur in cyberspace, and the injunction prohibiting the invisible and attenuated uses is rightly understood as nothing more than a prophylactic remedy that bars conduct, otherwise unobjectionable, in order to undo the harm of the infringement—and everything the court may have said to the contrary is simply *dicta*, not at all essential to the holding. *Id.* Hence the question whether an invisible or attenuated use *alone* might ever constitute trademark infringement is an open question, not yet decided by the Ninth Circuit, and the court might be expected to seize this interpretation to walk away from its prior ruling, when the time and circumstances are ripe. Or else the requirements of *Brookfield*, as was suggested by *Netscape*, may be satisfied by a disclaimer. *See* Playboy Entm't, Inc. v. Netscape Commc'n's Corp., 354 F.3d 1020, 1030, n.43 (9th Cir. 2004).

Similarly, *Holiday Inns* may be recharacterized in the following manner: as a matter of fact, the court wrongly supposed that the infringing use was of "405" associated with goods and services of the allegedly infringing party, and this cannot constitute infringement because "405" does not look like "465" and certainly does not look like "HOL." *See* Holiday Inns v. 800 Reservations, 86 F.3d 619, 624, n.6 (6th Cir. 1996) (the offending user at least once advertised a "naked" phone number, soliciting callers to use the digits only, by dialing 1-800-405-4239). The erroneous holding could only have happened because the court misapprehended that the dialers were picking numbers out of the air—either without having heard of or guessed at the Holiday Inn mnemonic, or else as if they were simply guessing about defendant's non-advertised number (the court had already held the defendant never, or almost never advertised or promoted anything consequential). *Id.* Hence, once this misapprehension is removed, the court may be quick to undo its ruling.

A first problem, of course, is that either of these recharacterizations requires the proponent to argue that the respective courts actually *meant* something nearly opposite to what they *said*, a thankless job for anyone, and therefore, hardly worth the candle, see *infra* note 359 (it eventually becomes too much work to save the appearances). There are probably other ways to reconcile the cases, but the better course would seem to be simply to admit that there is a conflict and to wait for the Supreme Court to resolve it if the various circuit courts do not otherwise get around to straightening things out.

A more serious problem is that if the conflict is to be resolved on the basis of carefully applied ordinary trademark law one doesn't know exactly which principle would be applied. It might be the principle that an invisible use in cyberspace is like a magnet that deposits the user at an unlooked-for site, thereby creating initial interest confusion unless dispelled by an effective disclaimer and redirect/release as recommended by the solution proposed in this article, and as left open by Ninth Circuit in *Netscape*. 354 F.3d at 1030, n.43. Alternatively, it might be the asserted principle that an invisible but unadvertised use in cyberspace can never constitute an actionable use, even though the result might be to pirate business from mark proprietors and at the same time to clog the internet with so much deceptive chatter and noise as to dramatically hinder navigation. *See* 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 410-11 (2d Cir. 2005). Perhaps
candle.\textsuperscript{359}

Those answers cannot coexist, and until they are reconciled, the law cannot provide any guidance to invisible uses in cyberspace that is principled, practical, or predictable.\textsuperscript{360} In the meantime, perhaps the best that can be done is merely to count the cases.\textsuperscript{361} This leads to a serious question that really must be answered: why does the law seem so maladroit when it comes to invisible and attenuated uses on the Internet or in cyberspace? That is, why is there a problem with applying trademark-related law to mark-type conflicts in cyberspace?

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\textsuperscript{359} Anyone might try to save the appearances by arguing that current efforts to apply ordinary principles of trademark-related law are actually handling mark type conflicts in cyberspace in a manner that can be rationally explained (or readily fixed) and anyone who is technically adept in trademark law surely might come close to doing so. \textit{Compare, e.g., supra note 358 with infra notes 380–83.}

The whole enterprise, however, is such that the layperson, or any other disinterested observer is not likely to be satisfied with all the troublesome constructs necessary to carry it off, or to allow the simple but destructive expediency of ruling that unadvertised attenuated or invisible uses that actually divert customers are not really uses just because we can’t see them with the naked eye. \textit{See Albert Einstein, Forward to Galileo Galilei, Dialogue Concerning the Two Chief World Systems—Ptolemaic and Copernican XV (Stillman Drake trans., Univ. of Cal. Press, 2d ed. 1967) (1630) (“Naturally, it is argued that it is simpler to assume a rotation of the earth around its axis than a common revolution of all fixed stars around the earth. Furthermore, the assumption of a revolution of the earth around the sun makes the motions of the inner and outer planets appear similar and does away with the troublesome retrograde motions of the outer planets, or rather explains them by the motion of the earth around the sun.” (emphasis added)); see generally, Thomas S. Kuhn, Structure of Scientific Revolutions (Univ. of Chi. Press 1996) (1962) (crisis in accepted theoretical explanations, followed by emergence of new explanations).}

\textsuperscript{360} See infra Conclusion and Concluding Postscript.

\textsuperscript{361} Here might be an instance where the proverbial dismissive: “those who can analyze; those who can’t count” may be inapt for here there is not yet matter enough to reward analysis.
III. WHY THERE IS A PROBLEM WITH MARKS IN CYBERSPACE

A. Institutional Economics

It is no longer news either that transaction costs are significant, or that among the most important transaction costs is "the limited cognitive power of a human decision maker." Rationality is bounded by "limited memories, computational skills, and other mental tools which limit a decision maker's ability to gather and process information." The phenomenon of bounded rationality "becomes a particular problem in the face of complex decisions." "A problem may be complex either because it involves many options or because a limited number of initial options cascade into a decision tree with many branches." A related problem exists "when decision makers are uncertain about the content of alternatives available to them, or otherwise lack the information necessary to make an optimizing choice." Professor Bainbridge explains: "[u]nder conditions of uncertainty and complexity, bounded rationality implies that decision makers will not be able to devise a fully specified solution to the problem at

362. See STEPHEN M. BAINBRIDGE, CORPORATION LAW AND ECONOMICS, 24-25, 254-56 (Foundation 2002). The presence of some minor paraphrasing aside, in order to adapt the discussion to trademark law in cyberspace, this entire section might as well be enclosed by quotation marks. See also, Folsom, supra note 2, at 113-14.


364. BAINBRIDGE, supra note 362, at 24.

365. Id. at 25.

366. Id.

367. Id.

368. Id.
hand or fully assess the probable outcomes of their action.\textsuperscript{369}

Bounded rationality has "pervasive implications" for any analysis of trademarks in cyberspace.\textsuperscript{370} "If mind is a scarce resource, then economizing on claims against it is plainly warranted."\textsuperscript{371} Professor Bainbridge observes that "[a]n actor can economize on limited cognitive resources in two ways. First, by adopting structures designed to promote more efficient decision making; second, by invoking heuristic problem-solving decision making processes."\textsuperscript{372}

Judges have less general computer and network expertise, and less information about the specifics of the technological problem in question than most computer and electronic engineers who have worked in the field. Most judges "probably arrive on the bench with little or no expertise" in trademark law generally and no expertise specifically in either the business side or the emerging technology side of electronic commerce, "moreover, they have little incentive to develop substantial institutional expertise in this area after they arrive" and "[b]ecause the legal, technological and business issues are complex, and because judges are as subject as anyone to the cognitive limitations implied by bounded rationality, they have an incentive to duck these cases."\textsuperscript{373}

Under such conditions, "judges will shirk, i.e., look for ways of deciding cases with minimal effort. One well-established way of doing so is to invoke shortcuts—heuristic problem-solving decision making processes." Is trademark in cyberspace an example of this tactic at work? When one considers the ways in which judges might now dispose of such cases, the idea seems plausible.\textsuperscript{374}

\textsuperscript{369} \textit{Id.} As applied to trademark law, consider the metaphysics of "likelihood of confusion" and the pressure upon it, and as applied to alternatives, consider the cognate regulations affecting dilution, cybersquatting, domain name dispute resolution procedures, and the more general law of unfair competition.

\textsuperscript{370} BAINBRIDGE, supra note 362, at 25 (discussing corporate law and economic theory, which would seem to apply, \textit{mutatis mutandis}, to trademark law and Internet or cyberspace technology).

\textsuperscript{371} \textit{Id.} at 25, n.18 (quoting Oliver Williamson).

\textsuperscript{372} \textit{Id.} at 25.

\textsuperscript{373} \textit{See id.} at 255, n.13 (modified by changing his references from business law and economics to trademark law and technology).

\textsuperscript{374} It would now be possible to dispose of invisible or attenuated uses on the
Judges in cyberspace trademark cases are both “time-constrained and resource-constrained,” they decide such cases “only episodically,” and it is not rational for them to devote the effort to master both trademark doctrine and the technological environment in which the doctrine works. 375

This article has demonstrated that the conditions for the institutional lack of capacity exist in respect of trademark-related law in cyberspace. There is an existing trademark law, together with related laws, private ordering, and norms that is more complex than commonly recognized. There is also an underlying problem in understanding both cyberspace itself and the typical mark-type conflicts among its characteristic users that is more uncertain than rational decision makers should expect themselves to know. It makes no sense for juridical decision makers to transform themselves, irrationally, into technical trademark experts who coincidentally happen to be electrical engineers. It would be patently to try, and it would be even worse if it succeeded. 376 Instead, it seems that this must be an occasion to turn to expert guidance or to find a new heuristic that will more nearly get to the

Internet or in cyberspace by always granting relief because such uses always raise concerns of initial interest confusion. See Playboy Enter., Inc. v. Netscape Commc’ns Corp., 354 F.3d 1020, 1024-1026 (9th Cir. 2004); Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp., 174 F.3d 1036, 1062-65 (9th Cir. 1999). Alternatively, judges could always deny relief for non-promoted and non-advertised invisible or attenuated uses because such uses never amount to “use” sufficient to get into court. See 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 412 (2d Cir. 2005); see also Holiday Inns v. 800 Reservation, 86 F.3d 619, 626 (6th Cir. 1996). Once a jurisdiction elects which rubric to use, at least some cases will not require much additional investment of juridical resources, but the problem is that both of these rules sacrifice too much in the name of convenience. The current extremes are suboptimal attempts at heuristic problem solving. They have the virtue of ease of application but at the cost of leading to wrong results in particular cases while incidentally distorting the law of trademarks (and introducing systemic error). Folsom, supra note 2, at 113 & n.97. Between the rule of “all” and the rule of “none” there remains the need for a workable heuristic that will distinguish permissible from impermissible uses, permitting some and prohibiting others.

375. See BAINBRIDGE, supra note 362, at 255 (modified by changing his references from business law and economics to trademark law and technology).

376. After all, someone would still have to do the corporate finance cases, the tax cases, the railroad rate regulation cases, the counting-the-crèche first amendment cases, and the other cases that would continue to arise.
right results, but without inordinate fumbling and failing, and without engaging in time wasting juridical efforts foreordained to futility.

B. Paradigms a Dozen: The Capability Problem

Perhaps one advantage of using the language of institutional economics compared with, say, the common sense explanation of the same phenomena, "art is long, life is short," is that it sticks with the facts and stays away from saying things that would wound the agents who must make decisions. Rather than saying decision makers are "incompetent" it might be better said they are institutionally not capable, and this by some measure of good sense rather than ill will. This is true not only for judicial decision makers but also for commentators.

1. The Juridical Capability Problem

There is a capability problem because of specialization of labor, with the result that judges are chosen for judgment rather than for engineering skill. A desired solution to marks in space must provide a structure and heuristic rules that will aid judges in deciding the kind of cases typical of cyberspace.

The juridical risk against which the desired rules will weigh might be likened to systemic economic or financial risk. If individual cases presented only non-systemic (or case-specific)

377. "Ars longa, vita brevis." HIPPOCRATES, THE APHORISMS OF HIPPOCRATES (Thomas Coar, trans., 1982) ("Life is short and art is long; the crisis fleeting; experience perilous, and the decision difficult"). Applied variously, but one could do worse than "Ah God! How long is art! And soon it is we die." GOETHE, FAUST, The First Part, ll. 558-59 (George Madison Priest, Trans. 1941).

378. In economic terms, systemic (or systematic) risk refers to "a financial shock that has simultaneous impact on a number of financial institutions ... [or] the chain reaction problem," causing a system wide collapse. See HAL S. SCOTT, INTERNATIONAL FINANCE: TRANSACTIONS, POLICY, AND REGULATION 140-145 (13th ed. 2006). In finance, the distinction is between diversifiable risk and non-diversifiable risk ("risk" being the expected variation in return). See generally, HOWELL E. JACKSON, ACCOUNTING AND FINANCE 109-14 (Foundation 2004). Diversifiable risk tends to be firm-specific and non-systemic, and so modern portfolio theory predicts that the "unique risks of particular firms should wash out as a result of diversification." Id. Non-diversifiable risk tends to be systemic, affects all investments, and so cannot be eliminated through diversification. Id.
juridical risk, then lawyers could help advise their clients how to diversify or otherwise lessen their risk.\textsuperscript{379} But if an entire body of law such as trademark in cyberspace should become systemically risky, there would be no way for lawyers or clients to minimize juridical risk. It is at the level of systemic juridical risk that new solutions, systemic in nature, become attractive.

2. The Academic Capability Problem: insufficiency of current trademark doctrinal solutions (looking for a new heuristic in all the wrong places)

There seems to be no fully specified expert consensus to which judges might turn for a new heuristic. Some commentators advise that the problems of marks in space may be solved by a more careful application of existing principles of ordinary trademark law.\textsuperscript{380} Others, or at least one, cautiously endorse what this article refers to as the Brookfield over-protection cases.\textsuperscript{381} Others, or at least one, strongly favor what this article refers to as the Holiday Inns type of under-protection approach.\textsuperscript{382} Though many commentators reject Brookfield's over-protection, perhaps suggesting additional factors to avoid the opposite extreme of

\textsuperscript{379} By analogy, “juridical risk” is the expected variation in outcome of any particular case currently in litigation compared to the results in similar previously adjudicated matters.

\textsuperscript{380} See, e.g., Stacey L. Dogan & Mark A. Lemley, Trademarks and Consumer Search Costs on the Internet, 41 HOUS. L. REV. 777, 838 (2004) (the law doesn’t need to change to deal with Internet keywords, but courts need to apply it correctly); David M. Klein & Daniel C. Glazer, Reconsidering Initial Interest Confusion on the Internet, 93 TRADEMARK REP. 1035, 1064 (2003) (the traditional trademark likelihood of confusion factors, excluding initial interest confusion, together with the FTDA and ACPA are adequate to protect senior users); David M. Fritsch, Searching for Initial Interest Confusion and Trademark Protection in Cyberspace, 9 U. PITT. J. TECH. L. & POL’Y 1 (2005).

\textsuperscript{381} Chad J. Doellinger, Trademarks, Metatags & Initial Interest Confusion: A Look to the Past to Re-Conceptualize the Future, 41 IDEA 173, 200, 219, 225 (2001) (Brookfield’s application of the initial interest confusion doctrine was too broad, but it is true that “the mere appearance of the defendant’s web site on a search engine results list necessarily indicates consumer confusion at a certain level” and the initial interest confusion doctrine, properly understood, is the correct way to apply trademark law to meta-tag and search engine use of trademarks).

\textsuperscript{382} Widmaier, supra note 105.
under-protection, others seem to be in favor of applying existing ordinary principles. There is still an untidy problem in that applying ordinary principles is exactly what the judges say they are doing, and yet the problem is that this approach does not work and probably cannot work. There is a capability problem because of an inability to reach consensus on which principles of ordinary trademark law ought to be applied, optimized, emphasized, or tailored.

It ought not to be surprising that judges lack the ability to solve the problem of marks in space when no one else seems able to suggest a better view which is workable, understandable, practical and principled.

3. The New Technological Use Problem: the elephant—or the horse, train, shoe or billboard, whale or cloud—in the living room.

There remains the uneasy notion that something is happening in cyberspace, but the law doesn’t know what to make of it or what to do about it. The problem is that the law, as it seems to be running around looking for a new heuristic in all the wrong places, currently provides no tool by which juridical decision makers can

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383. See, e.g., Zachary Zweihorn, Searching for Confusion: The Initial Interest Confusion Doctrine and Its Misapplication to Search Engine Sponsored Links, 91 CORNELL L. REV. 1343, 1357, nn.98 & 100 (2006) (the billboard analogy “widely criticized” and perhaps more so by younger persons “more attuned to how the Internet works”); Eric Goldman, Deregulating Relevancy in Internet Trademark Law, 54 EMORY L.J. 507, 584-85, 596 (2005) (new factor: relevancy, designed to weigh the surfer’s intent when using the expression with the goal to deregulate keyword use by search engines to insure that the prime purpose of the Internet—obtaining information—will not be needlessly shackled); Joseph V. Marra, Playboy Enterprises, Inc. v. Netscape Comm. Corp.: Making Confusion a Requirement for Online Initial Interest Confusion, 20 BERKELEY TECH. L.J. 209, 213 (2005) (Brookfield’s reliance on initial interest confusion is misplaced); Perry Viscounoty & Jordan Kushner, Order to Confusion: Trademark Infringement Liability for Search Engine Keying Ads, 1 HASTINGS BUS. L.J. 151, 153, 156-57 (2005) (search engines are not “using” trademarks in the traditional sense, and the logical extension of the initial interest confusion doctrine to such conduct would be overprotection); Adam Silverlight, A Look at the Assignment of Internet Domain Names Under Federal Trademark Laws, Federal Case Law and Beyond, 10 ALB. L.J. SCI. & TECH. 229 (2000) (new factor: foreseeable number of hits a web site will receive).
tell good or harmless uses from bad uses in cyberspace, and can’t
tell when the law is helping or casually crushing cyberspace itself.
It is past time to consider whether there was or should have been a
law of the horse,\footnote{384} or of the shoe,\footnote{385} or of the steam engine.\footnote{386} It is
past time to consider whether it might not be possible to move
beyond law by metaphor or bad poetry\footnote{387} to law more solidly based
upon the reality of an objective cyberspace. More to the point,
even though cyberspace sometimes seems more like a cloud than
like a horse, a shoe, or a steam engine, a “law of the clouds” would
seem much less necessary than a law tailored to the objective thing
that the cloud portends.\footnote{388}


\footnote{385} Maggs, Soma & Sprowl, supra note 31, at iii (“No one is suggesting that law students should study ‘shoe law’ as a separate course” but the Internet and computer-related law are different).


\footnote{387} See Mark A. Lemley, Place & Cyberspace, 91 Cal. L. Rev. 521, 523, 525-26 (2003) (courts are using an analogy of place to apply the law to cyberspace, but this metaphor leads to results at odds with the real characteristics of cyberspace); David Hricik, The Internet: Place, Property or Thing—All or None of the Above?, 55 Mercer L. Rev. 859, 860-61, 864-65 (2004) (courts use and rely on analogies to apply existing legal principles to new environments or activities, but the Internet is unique and no analogy can be relied upon completely to determine or apply the law to it). Folsom, supra note 2, at 79 (it would be better to stay away from bad poetry and ersatz policy).

\footnote{388} See Folsom, supra note 2, at 112 & n.93 (noting that a cloud in the shape of a whale is different from a whale, and suggesting there ought sometimes be a different reaction to each). There might, in fact, be a more compelling need for a new law, or at least a new interest in the existing law to accommodate a whale in the living room than to accommodate a cloud in the blue sky. To the extent there is an objective cyberspace with identifiable values, it may be much more like an actual whale than like a cloud of shifting shape. It is an incidental point of this article that legal analysis will be better off when it drops at least some of its “high tech” analogies, mysticism, and scientism altogether. There is an objective cyberspace that is neither cloud nor whale, but has its own significant values. This might be a case where a little understanding of the commonly observed characteristics of a technology is not only enough, but is also better than total ignorance, poetic license, or even an obsessive concentration on minute, elusive,
C. The Desired Solution

Technology Matters, but Only Sometimes: Distinguishing Cyberspace from Shmyberspace 389

The desired solution to marks in space must provide a structure and a set of default rules that will solve the capability problem explained by institutional economics: judges are not, and probably ought not to become electrical engineers or trademark experts but they must solve trademark-type disputes in cyberspace. The solution is a trademark-style approach that does not depend upon the technology de jour, but might endure regardless of new technological uses, at least as to the specifics of the technology. Generally, it is important on the Internet and in cyberspace to understand the nature of the domain and the kind of dispute typically arising among the characteristic users there.

All that is required is that a new factor, the nature and place of use, be articulated and added to the ordinary trademark-related calculus. This new factor may be used at the level of likelihood of confusion, but would also aid in resolving the question of offending "use" of marks in space by uses that are invisible or attenuated. Most importantly, it will help to fashion a remedy, a reasonable technological accommodation appropriate to the harm caused by any invisible or attenuated use. 390 The new factor also fits into the larger context of non-trademark offenses. It will harmonize trademark law with anti-dilution law, anti-cybersquatting law, private uniform domain name resolution procedures, self-help norms, and the background field of unfair competition.

This new factor divides the fanciful from the real. It avoids the problem with analogies that break down, replacing them with a healthy realism. It rejoins the authority of judicial decision makers with sufficient competence and capability appropriate for such

and fast-changing scientific-sounding details.

389. See Folsom, supra note 2, at 84-92 (degrees of cyberspace, and some activities merely transposed from ordinary space); supra note 9 and accompanying text; SCHECHTER & THOMAS, supra note 30, at 788 ("shmyberspace" suggesting hucksterism by some boosters of technology); see also Folsom, supra note 2.

390. As suggested in Appendix A as the "common remedy for attenuated or invisible uses." See infra, Appendix A (heading IIB).
decision makers.

CONCLUSION AND CONCLUDING POSTSCRIPT

Invisible and attenuated users create mark-type conflicts in an objective cyberspace. Guides can place markers as invisible addresses and magnets in space, and other guides can index or key those markers so that users can find them—all in support of the very values that enable cyberspace. But other users can spoof or trap, waste or spoil by using invisible markers in space as roadblocks or detours. Current law is unable to deal with invisible and attenuated uses of expressions in cyberspace because it has no tool by which legal decision makers can distinguish fair from unfair competition in space, and no rule or rubric by which ordinary trademark law can be extended and applied to the characteristic conflicts of marks in space in a way that is principled, practical, or predictable.

As an analytical matter, the leading cases are demonstrably in conflict with one another and with ordinary principles of trademark law. At one extreme, a first line of cases over-protects marks in space upon a radical misapplication of initial interest confusion. At the other extreme is a second line of cases that under-protects marks in space upon a radical misunderstanding of the threshold “use” necessary to any cognizable injury. Both extremes are wrong and cannot coexist with one another or with ordinary principles of trademark law. Upon analysis, the cases do not reach the correct results, do not do so for the right reasons, and are not persuasive. As a result, the cases are missing the mark in cyberspace. This article has suggested the leading cases are wrong, not only as a matter of institutional economics, but because they have not purposefully defined the nature of cyberspace or usefully distinguished the kinds of conflicts that typically occur among the characteristic users there. The introduction of a new factor, “the nature and place of use,” would afford a solution to the institutional

391. An embodied switched network for moving information traffic, further characterized by varying degrees of access, navigation, information-activity, augmentation and trust. See infra, Appendix A (heading IIA)

392. See ARISTOTLE, supra note 178, at 4 (Bk I, ch. ii.; asserting that an archer who cannot see the target, or does not even have one, is likely to miss it).
capability problem, would simplify the handling of invisible and attenuated users in cyberspace, and would no longer require juridical actors to attain the expertise of electrical engineers or network programmers in order to achieve just results.

Concluding Postscript

This article has served its purpose if it demonstrates current approaches are in conflict with one another and with ordinary principles of trademark-related law. But in addition to being grounded in such doctrinal analysis, this article is also premised on conceptual, or modern, moral realism. One concern of conceptual moral realism is that, in an analytical treatment of the law, the direct statement of fundamental principles and definitions is too often neglected. One set of such principles has to do with the object of improving the law. It would seem evidently true that any law is better than another to the extent it is more nearly: (1) a rule capable of being applied, (2) reasonable, (3) good for something, (4) articulate or at least capable of being articulated or understood, (5) delivered by some authorized juridical agent, (6) fairly predictable, (7) generally compulsory, (8) recognizably humane, (9) consistent, (10) systematic, (11) purposefully or deliberately designed to accomplish its goal, and (12) validated to see how well it is doing.

393. This was the modest goal set at the beginning of this article. See supra, note 3 and accompanying text and pp. 146-47.
395. See id.
396. If these propositions do not seem to be evidently true, try to consider the contrary: imagine a law that is a rule of coercive force but is unreasonable, good for nothing because immoral, amoral or non-moral; inarticulate and unauthorized; unpredictable but optional; inhumane; never the same yet inflexible; intentionally unsystematic; without any discernable purpose, and not validated against any standard. It is unreasonable to think anyone would find all of these contraries in any single law, but the parts seem no more appealing taken individually. See Folsom, supra note 394, at 332. It might be asked why anyone would ever want such a contrary law, much less obey it absent compulsion, and it would seem evidently true that any attempt to improve a given law in any of these aspects might, other things being equal, be welcome. See generally, Thomas Aquinas, Summa Theologica, Ia Ilae [first part of the second part] qqs. 90-108 [questions 90 to 108], the “Treatise on Law” and esp. id. q. 90, a. 4, ans. [question 90, article 4, answer] (“law” as [1] an
If we aim to determine whether the leading cases have reached the correct result, for the right reasons, in a way that is persuasive and well-written, then it wouldn’t hurt to do so with something in mind beyond the analytical. Modern moral realism asserts it is not only possible, but positively helpful to attempt to articulate what “good” any law is trying to accomplish and then to see whether the law is doing so. By stating a non-arbitrary working definition of cyberspace and of cyberspace values, and by taking a clear view of what is clearly happening there, this article creates an objective reference to consider what might be good about markers in cyberspace and to evaluate the law’s response. This article also asserts that it is analytically possible to know what “the law” is, and to explain the more commonly recognized principles even though there may be some fairly contested issues. Putting these propositions together, modern moral realism asserts it is able to solve problems that otherwise baffle or bedevil trademark law in cyberspace.

The current paradigmatic public interest-supporting use in cyberspace is indexing, cataloging, and mapping by placing or using invisible or attenuated magnets, addresses, or marks in space as an aid to a surfer’s enjoyment of access, navigation, information-activity, and augmentation (and trust). The most important test case on the current horizon is whether and, if so, under what rationale trademark law will permit an indexer or mapper to recover costs and to make a profit by selling targeted advertising, while at same time regulating trappers and spoofers, spoilers and arbitrageurs. The desired solution should permit mapping and

ordinance or rule [2] of reason, [3] directed to the common good, [4] promulgated in advance, [5] by someone who has authority to do so. These might even be considered to be rather modest criteria. See id., q. 96, aa. 2 & 3 [question 96, articles 2 & 3] (warning against the impossible, counterproductive and immodest attempt to repress all wrongs or to require every kindness by the misguided enactment of human laws that might try to forbid all vice or to mandate all the acts of virtue); cf., generally, David A. Skeel, Jr. & William J. Stuntz, Christianity and the (Modest) Rule of Law, 8 U. Pa. J. Const. L. 809 (2006) (arriving, as if by accident, at some general insights almost as astonishingly modest as those of Thomas Aquinas or those asserted in this article, but perhaps compromised by seemingly inexplicable applications to particular legal problems).

397. See supra note 3.
398. See Folsom, supra note 394, at app. 1.
make it pay by allowing the conduct to occur, but subject to a reasonable technological accommodation in favor of the mark proprietor. It should distinguish between space pirates and hitchhikers’ guides, discouraging the former while encouraging the latter.

It is, in fact, possible to distinguish guides from pirates, and to do so under a recognizably trademark-style approach. Accordingly, as said elsewhere, this article is “not just equal parts bad poetry and ersatz philosophy” but is intended to change and improve the law by providing “a recognizably legal-style solution [to the problem at hand] that appeals to the good sense of lawyers who can use it, judges who can understand and apply it, and ultimately to the public at large, who are the final consumers of the rule of law.” 399

399. Folsom, supra note 2, at 79. There may be room for a future article more clearly to specify, test, and apply the proposed solution.
APPENDIX A: CYBERSPACE GLOSSARY*

1. Standard Terms

This article uses a number of standard cyberspace or technology-related terms. Various references, definitions or descriptions are given in this article (and are, for the most part, the subject of standard definition or usages, not coined herein) at the following places.

Billboard, notes 218, 311, 342 (and accompanying text);
Directory, note 205;
Domain name, note 312;
Hitchhiker’s Guide, notes 1, 15 (and more particularly defined in this Appendix under heading 11B below);

Internet—“consists of physical connections among computers in more than 100 countries and a set of protocols that allows those computers to communicate with one another.” RADIN ET AL., supra note 31, at 1240-41 (defining “Internet”). It is a “global network of computer networks” that currently uses the Transmission Control Protocol/Internet Protocol (TCP/IP) to communicate. Id. at 1210-11, 1240 (Computer Networking and the Internet). For the Internet more generally as an embodied switched network that is a gateway to cyberspace, see notes 8, 9, 15

Matrix, see note 9;
Phone System, note 9;
Search Engine, note 205;

See Thomas C. Folsom, Defining Cyberspace (Finding Real Virtue in the Place of Virtual Reality), 9 TUL. TECH & IP LAW J. 82 (2007) (worldwide web; network; nodes; switches) (with citations to sources). At present, there are readily accessible sources sufficient to explain standard cyberspace terminology, and the

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reader may rely on them without burdening an article such as this with unnecessary definitions. See id. at 78 nn.3-4. A good
standard reference is MARGARET RADIN, JOHN ROTHCHILD & GREGORY SILVERMAN, INTERNET COMMERCE THE EMERGING
LEGAL FRAMEWORK (1st ed. 2002). Its usefulness is enhanced by
the presence of a glossary plus appendices on the domain name
system, computer networking, and the Internet.

II. New Terms

The following terms are among those introduced in this article.
While they are not inconsistent with standard terminology, they are
in some sense coined herein (or in Folsom, Defining Cyberspace).

A. Terms Generally Applicable to Cyberspace

Cyberspace — (1) an embodied switched network for moving
information traffic (a "gateway"), (2) further characterized by
varying degrees of access, navigation, information-activity,
augmentation (and trust) on the network. High (or deep) space
displays a higher degree of these further characteristics than low (or
shallow) cyberspace: an operational definition. Compare
"shmyberspace" as a rough synonym for low or shallow

Cyberspace Gateway; Gateway — an embodied switched
network for moving information traffic: the threshold or
architecture of cyberspace. Examples include the Internet and the
phone system. The gateway is a necessary, but not a sufficient
condition for cyberspace, it is one part of the operational definition
of cyberspace.

The cyberspace activity set is a distinctive set of features enabled
or enhanced by a cyberspace gateway or technology: access,
navigation, information-activity, and augmentation (and trust). The
activity set constitutes the function or use of cyberspace and is the
other part of the operational definition of cyberspace.400

400. Hence, cyberspace is, by shorthand, defined as [1] a cyberspace gateway,
Cyberspace Values, Virtues; Characteristics — though there are differences among the terms, this article refers to the "characteristics, values, and virtues" of cyberspace as near synonyms. The minimum claim of this article is that there is an objective cyberspace with objectively derived characteristics.

The characteristics of cyberspace are the distinguishing features in its architecture (design) and in its function (use). In its architecture or design, cyberspace may be characterized as an embodied switched network for moving information traffic. In its function or in use, cyberspace may be characterized as something that enables or enhances an activity set: access, navigation, information-activity, and augmentation. An additional factor, trust, seems to be a secondary inference necessary in support of the other function or use characteristics. Though in some sense secondary, trust seems to be an essential element without which the other use-characteristics fail in their purpose. To signify that "trust" is slightly different from the other characteristics, this article will sometimes enclose it in parentheses.

The values of cyberspace add another dimension to its objective characteristics. Any particular event that intersects with or occurs within an objective cyberspace would seem to be more or less valuable to the extent or degree that it actually implicates the distinctive characteristics of cyberspace. That is to say, any transaction is more or less valuable (more or less "in" cyberspace) to the degree it actually permits or enables, is distinctively permitted or enabled by, or purposefully relies upon the functional characteristics—enhanced access, navigation, information-activity, augmentation (and trust)—that may potentially occur in within an embodied switched network for moving information traffic.

The virtues of cyberspace add another way of considering the characteristics of cyberspace. A transaction in cyberspace that positively impacts, supports or enhances any objective value of cyberspace would seem to be one that has a real virtue or excellence in relation to the characteristic purposes for which cyberspace is designed and used. Other things being equal, and the law being open for development in one way or another, it would seem that there would be a substantial advantage in choosing to develop the law along a path that furthers the values of cyberspace,
rather than along a path that doesn't. This article specifies real virtue in place of the cloudy rhetoric about "virtual reality" that has obscured rather than revealed anything useful about cyberspace.

B. Terms Specifically Adapted to Trademarks in Cyberspace

1. Invisible or attenuated uses in cyberspace — expressions that operate as invisible markers in cyberspace: for example, as an address (an attenuated use, such as in a domain name or vanity phone number) or as a magnet (an invisible use, such as in metatags or hidden text). They are attenuated or invisible relative to an ordinary consumer in the context of ordinary principles of trademark law (they are markers not necessarily associated with goods or services in a way that is immediately visible to the consumer), even though they are embodied in a tangible medium of expression from which they can be perceived, reproduced, or communicated, including by way of a machine or other device. These uses are, in a sense, similar to the use of expressions in ordinary space by information aggregators/brokers, or in comparative advertising to point to another product or provider. Contrast attenuated or invisible uses with "ordinary" use of an expression as a mark, or as an "ordinary" offending and visible use causing a likelihood of confusion with another's mark. Because of the nature of cyberspace, it is also possible to use a mark as a roadblock or as a detour. These, too, constitute invisible and attenuated uses.

2. Common remedy for attenuated or invisible uses — one or more of the following: disclaimer, notice, forced redirect/release, assignment, or forced auction. The remedy is additive: if the only harm is an attenuated or invisible use, then the common remedy is the presumptive limit. If there is additional harm, including ordinary use that causes a likelihood of confusion, then the ordinary remedies may be added on to these.

A disclaimer is to this effect: X is not affiliated with, sponsored by, licensed or endorsed by Y.

A notice is to this effect: you have reached X but you might have intended to reach Y. You may reach Y [by clicking here] [by dialing this number]. If the offending actor is a search engine, a
directory, keyword advertiser or the like, the forced redirect might take the form: “you have entered (or triggered an ad based on) Y, which is a trademarked expression. If you want to continue your search by finding the owner of the trademark, click [here]; if you want to continue with a more generalized search for goods or services more or less like Y-brand products, click [here].”

A forced redirect in cyberspace is to this effect: by a technological means, the user [who is currently “at” location X] is actually rerouted from X to Y; or the user is confronted with a required choice so the user must affirmatively choose either X or Y (and though the user is “at” X, the user cannot proceed any further in either X or Y until the user elects one or the other). If the offending actor is a search engine, a directory, keyword advertiser, or the like, the forced redirect would force an affirmative election after the corresponding notice.

A forced release in cyberspace is to this effect: by a technological means, the user is given instructions about how to reach Y and then is actually dropped from X altogether with instructions to try again (and the user will also have been given instructions that if the user really intends to find X, the user must enter a new “clean” address for X that really has nothing at all to do with Y, and only the use of the clean address will actually get the user to back to X) (the user will also be given directions to Y).

A reassignment or auction is to this effect: Y becomes the owner of the offending invisible or attenuated marker, or else X is forced to auction the marker to a population of non-piratical users (perhaps including not only Y but also Z, another valid trademark proprietor).

In summary, the disclaimer is pure information about X’s [non] relationship with Y. The notice contains information about, and a realistic opportunity to find Y (but the user remains “at” X). The forced redirect/release actually deposits the user “at” Y, or at least disconnects the user from X. The assignment/auction goes so far as to put the marker into the hands of Y (or another non-piratical user).

3. Cyberspace Interventions — consented or unconsented, harmless or predatory, value-adding or free-riding activities by an actor in cyberspace that have an objective effect on other persons or electronic agents, especially by drawing other persons or agents
to a destination, or by inviting or influencing other persons or agents to list a destination, or by preventing ready navigation to an otherwise intended destination. Cyberspace interventions are usually described from the point of view of the other person or persons affected.

4. **Cyberspace Resource Provider** — anyone who provides essential value added resources in support of high cyberspace values, but especially those that are not conventionally rewarded for doing so: the search engine or directory provider. Contrast the search engine provider with the commercial hardware or software developer under existing conventions by which hardware and software developers routinely sell or license their products to end users; but by which the end user regards the search engine as something that ought to be “free,” or in which some economic or practical factor drives the search engine or directory provider’s price towards zero while the costs might be significantly higher than zero: there may also be significant barriers to entry for new cyberspace resource providers, especially those who must compete against providers who are government funded or subsidized, or who have dominant positions in other markets that support their resource-providing activities, or who have become previously entrenched.

5. **Cyberspace Users** — surfers and mappers, trappers and spoofers, spoilers and arbitrageurs, consumers and competitors: users might simultaneously act in more than one capacity to some degree; or users might sequentially move from one capacity to another (the term includes electronic agents).

6. **Gateway** — see “cyberspace” and “cyberspace gateway” above.

7. **Hitchhiker** — a surfer: anyone who is engaged in information-activity in cyberspace.

8. **Hitchhiker’s Guide** — (1) an indexer, mapper, a guide, or anyone who places or controls addresses or magnets, publishes addresses or magnets, or otherwise promotes navigation in cyberspace; (2) an index, map, guidebook, or comparable resource; something produced by a mapper or a guide, as for example, a search engine or directory; a short-hand name to describe a navigational resource provided by a cyberspace resource provider.
9. **Markers in cyberspace** — expressions placed in cyberspace and that function as address, magnet, and/or mark to draw a user to an expected destination, and sometimes as roadblock or detour to deceive or to hinder a user from reaching an otherwise expected destination.

10. **Pirate; Piracy** — (1) a person who commits piracy, but in cyberspace especially, one who does so by changing the map, moving markers, placing false markers and otherwise planting deceptive magnets or addresses; (2) the act of a pirate, activities that tamper with the map to cyberspace or the useful navigation of cyberspace, as by tampering with addresses or magnets or planning deceptive addresses or magnets. A magnet or address is deceptive to the extent that it draws a user to an otherwise unintended destination, or hinders a user from reaching an intended destination. Piracy is the more harmful to the extent it is the more uninvited, predatory, and non value-adding.

APPENDIX B: EVIDENCE OF “USE” TO SUPPORT REGISTRATION

The requirements for qualifying specimens evidencing sufficient use to support federal registration are established within the Patent and Trademark Office ("PTO"), and the PTO’s formulations differ with respect to goods and services. As to goods in ordinary space it is expected that the mark will be something like a tag or label affixed to the product or its packaging.\(^{401}\) As to services in

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\(^{401}\) As to goods, the regulations provide: "A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods." 37 C.F.R. § 2.56 (2006) (providing guidance for specimens). When, because of the mode of applying the mark to the goods, specimens of this type cannot be furnished, "satisfactory facsimiles" must be provided. U.S. Patent and Trademark Office, Trademark Manual of Examination Procedure § 904.08 (4th ed. 2005), available at http://tess2.uspto.gov/tmdb/tmep/ (internal citations omitted) (last visited May 22, 2007) (on file with the Rutgers Computer and Technology Law Journal) [hereinafter TMEP]. Furthermore, the regulations provide: "Actual specimens are preferred if they are available and not ‘bulky.’ However, a photograph, photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable." Id. The proviso for "documents associated with the goods" when placement of the mark on the goods, containers,
ordinary space which are intangible and so impossible of bearing a
tag, it is expected that the mark will nonetheless be associated in
some evidentiary manner that at least tends to demonstrate the
connection between the mark and the services even though there
is necessarily more flexibility when it comes to qualifying
specimens for services than for goods.

labels, tags, or displays is "impracticable" is "not intended as a general
alternative" to submitting the labels, tags, containers or displays, but may apply,
for example, to registrations for a mark for "natural gas, grain that is sold in bulk,
[or] chemicals that are transported only in tanker cars." Id. § 904.04. The
"specimen may not be a 'picture' of the mark, such as an artist's drawing or a
printer's proof that merely illustrates what the mark looks like and is not actually
used on or in connection with the goods in commerce." Id.

402. Unlike tangible "goods" (say, the hamburgers served in a restaurant, or
the automobiles sold by a dealership), any corresponding restaurant or car
dealership "services" remain intangible. See id. §1301.04. And, since services are
not tangible items the manner of use of a designation in respect of such intangibles
must differ from the manner of use of a designation in respect of physical goods.
Id.

403. As to services, the regulations provide: "A service mark specimen must
show the mark as actually used in the sale or advertising of the services recited in
the application." Id. § 1301.04. Acceptable specimens to show such use may
include: "newspaper and magazine advertisements as well as other types of
advertising such as brochures, billboards, handbills, direct-mail leaflets, menus
(for restaurants), and the like." Id.

404. Id. § 1301.04. For example, some forms of advertising may be acceptable
specimens of a mark used with services. Id. § 1301.04 (specimens may include
advertising, "However, printer's proofs for advertisements, publicity releases to
news media or printed articles resulting from such releases are not accepted
because they do not show use of the mark by the applicant in the sale or
advertising of the services." (emphasis added)). So also might some invoices. Id.
§ 1301.04 (invoices are acceptable "if they show the mark and refer to the relevant
services"). And so might same samples of letterhead. Id. § 1301.04(e) (letterhead
is acceptable if it "create[s] an association between the mark and the services" or if
an actual letter on letterhead stationery is submitted as a specimen and the actual
letter contains content that indicates the field or service area in which the mark is
used).

The distinctions can be rather fine: while having provided that advertising
"may" be acceptable as a specimen for a service mark, the Patent and Trademark
Office still cautions that "mere advertising" of one's goods does not constitute
service mark usage." Id. § 1301.02(e) (emphasis added). "[T]echnical bulletins
and data sheets on which mark was used merely to advertise chemicals do not
show use as a service mark for consulting services." Id. The issue is whether the
proffered specimen "shows the use of the mark in association with the recited
services (i.e., in their sale or advertising). Id. § 1301.04(a). The manner of use on
the specimens must be such that the potential purchasers would readily "perceived

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Under ordinary principles of trademark law as interpreted by the PTO in the context of specimens sufficient to support federal registration, there is some room for creativity with respect to specimens for services, but the regulations are less flexible for specimens to show use of a mark with goods. Advertising material generally is not an appropriate specimen to evidence use of a mark with goods. And because they are generally considered to be "merely" advertising, items such as the following are normally not acceptable specimens for goods: "circulars and brochures; price lists; announcements; publicity releases; listings in trade directories; and business cards." Because they are internal materials used solely to carry out the applicant’s business dealings and not used to create an impression in the minds of prospective purchasers, items such as the following are not acceptable specimens for goods: "invoices; bill heads; waybills; warranties and business letterhead or stationery. "Bags and other packaging bearing the name of a retail store" generally "are not acceptable to show trademark use of the store name for the products sold by the store." Information or instruction sheets are generally not acceptable for showing trademark use. Catalog pages have been especially difficult to categorize. Inserts packed with the goods by potential purchasers as identifying the applicant's services and indicating their source." *id.*

405. Each of these: advertising, invoices, and letterhead, are famously not sufficient, at least in the view of the Patent and Trademark Office, to evidence use of a mark in association with goods.

406. *Id.* § 904.05. According to the Patent and Trademark Office, advertising is not generally acceptable because its function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods. *Cf. id.* ("Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use." (emphasis added)). Using a designation to tell something about the goods, or to promote the goods must, therefore, be supposed to be different from using a mark in connection with the sale of the goods.

407. *Id.* § 904.05.

408. *Id.* (citing cases).

409. *Id.* ("[i]n such a case, the name so used merely identifies the store." [and not the goods sold by the store]).

410. *Id.* (citing cases).

411. The Patent and Trademark Office has held many catalogs to be insufficient, but has been reversed in court. *See id.* § 904.06. The PTO currently
are also problematic.\footnote{412}

While the PTO continues to impose its own vision of trademark use requirements for registration, perhaps in light of its administrative burden in handling the volume of \textit{ex parte} registration requests and remains unwilling to give ground, some courts are signaling their willingness to accord common law trademark rights to users who not only fail to provide the kind of specimen required by the PTO for registration, but who also fail to have any product to sell in association with the asserted mark as long supposed to be required for appropriation of trademark rights in the first place.\footnote{413} If mailers or announcements count in ordinary space as a “use” sufficient to create trademark rights, it might be surmised that an equivalent user in cyberspace might do the same.