4 Va. J.L. & Tech. 8 (Fall 1999) <http://vjolt.student.virginia.edu>
1522-1687 / © 1999 Virginia Journal of Law and Technology Association

VIRGINIA JOURNAL *of* LAW *and* TECHNOLOGY

UNIVERSITY OF VIRGINIA	FALL 1999	4 VA. J.L. & TECH. 8

Information Superhighway Robbery: The Tortious Misuse of Links, Frames, Metatags, and Domain Names

By Robert L. Tucker[*]

I. Introduction
II. Potential Liability For Unauthorized Links To Other Sites Using Hypertext Links, Image Links, Or "Frame" Technology
A. The Use And Misuse Of HREF And IMG Links
B. The Use and Misuse of "Frames" Technology
III. Liability For Incorporating Other's Trade Names Or Trademarks In Web Site Metatags
IV. Liability For Incorporating Other's Trade Names Or Trademarks In Web Site Domain Names
A. Misappropriation Of Domain Names By "Cybersquatters"
B. Competing Claims To A Domain Name By Companies With The Same Or Similar Names
C. Intentional Use Of Another's Marks As Part Of A Domain Name
D. Registration Of Domain Names By Parody Sites
V. The Duty Of Web Site Owners To Monitor The Internet For Unauthorized Links Or Others' Use Of Their Trade Names Or Marks, And To Minimize Or Mitigate Any Resulting Damages
A. The Principle of Avoidable Consequences
B. The Significance Of The Doctrine Of Avoidable Consequences To Potential Liability For Unauthorized Linking Or Framing Of Others' Web Sites
C. The Difficulty of Applying the Doctrine of Avoidable Consequences
VI. Conclusion

I. Introduction

1. Time marches on, and the law marches with it.[1] But the law sometimes marches to the beat of a different drummer. "The law is generally 50 to 100 years behind any kind of technological advance."[2] Certainly, the law has not kept pace with the changing needs of users of the Internet, a non-traditional communications medium that has come into its own only within the last decade.[3]

2. The United States Supreme Court recently commented on the industrial, technical and societal changes that have been caused by the creation and use of — and the public's increasing reliance upon — the Internet. While

recognizing the enormity of the impact new technologies can have on the law, the Supreme Court has nevertheless declined to clarify some of the vague and unsettled legal questions that have resulted regarding such developments.[4] In *Denver Area Educ. Telecom. Consortium, Inc. v. FCC*, Justice Breyer expressed the view that "the changes taking place in the law, the technology, and the industrial structure, related to telecommunications, we believe [make] it unwise and unnecessary definitively to pick one analogy or one specific set of words now."[5] Justice Breyer's refusal to lay down broad rules about the applicability of traditional legal concepts to new media has been hailed as an example of a "reasonable" and "minimalist" judicial approach to contentious questions regarding rapidly changing technology.[6] At least one district court has taken heed of the Supreme Court's admonition, choosing not to "impose traditional territorial concepts on the commercial uses of the Internet. . ."[7] But this "minimalist" approach has done nothing to provide predictability of the law or reasonable levels of comfort to those doing business on-line.

3. The history and the origin of the Internet are described at length in the existing literature.[8] The United States Supreme Court also had occasion to recount the genesis and development of this now-ubiquitous telecommunications medium in *Reno v. ACLU*.[9] The Internet is essentially an international network of interconnected computers. It is the outgrowth of what began in 1969 as a military computer network called ARPANET,[10] "which was designed to enable computers operated by the military, defense contractors, and universities to communicate with one another by redundant channels even if some portions of the network were damaged by war."[11] The Supreme Court in *Reno* expressly acknowledged the special character of the Internet, referring to it as "a unique and wholly new medium of worldwide human communication."[12]

4. People can access the Internet in many different ways. Colleges and universities often provide access for students and faculty; corporations frequently provide Internet access to their employees; public access is offered by community and local libraries; entrepreneurs have opened so-called "computer coffee shops" or "cybercafes" that provide Internet access for affordable hourly fees; national "on-line services" such as America Online, Compuserve, Prodigy, and the Microsoft Network offer access to the Internet for customers who own personal computers; and local or regional Internet service providers (often referred to as ISP's) provide unlimited Internet access to personal computer owners for flat monthly fees.[13]

5. Generally speaking, anyone with access to the Internet can take advantage of the panoply of methods of communication that it offers. These include electronic mail (commonly referred to as e-mail), automatic mailing list services (sometimes referred to as "list-servs" or "mail exploders"), news groups, chat rooms, and the World Wide Web.[14]

6. The best known of these categories of communication — and the one that is the subject of this article — is the World Wide Web. The Web allows users to search for and retrieve information stored in other computers connected to the Internet.[15] The Web consists of a vast number of documents — including both text and images — stored in different computers all over the world. Some of these documents are merely computer "files" composed of written text. Perhaps more prevalent are those documents commonly known as Web "pages" or "sites" that are often considerably more elaborate. Web sites generally contain text, photographs, artwork, and animated cartoon-like images, and sometimes allow the viewer to communicate directly with the operator of the Web site via e-mail.[16] Web sites usually include one or more "links" to other Web sites generally related to the same subject matter.[17]

7. The hypertext link — or "link" for short — now used on the World Wide Web was invented in 1989 by Tim Berners-Lee.[18] Shortly thereafter, a graphical user interface was developed which enabled users to negotiate their way through the Internet by pointing and clicking with a mouse. Together these two inventions marked the beginning of the World Wide Web.[19]

8. Moving from one "page" or "site" on the Internet to another is simple. Using the so-called "browser" software [20] on the user's personal computer, the user may type the Uniform Resource Locator (or "URL") of a Web site

that the user wishes to see. Alternatively, a user may instead enter one or more key words into a commercial "search engine" to locate Web sites on any specified topic.[21] A third method of "surfing" the Web is to use the hypertext links found on many Web sites. Clicking on one of these links immediately transfers the user to another Web site elsewhere on the Web.[22] Users move from one Web site to another using these hypertext links by pointing and clicking on an icon (picture image) or words (which often appear as underlined and/or blue text).[23]

9. The United States Supreme Court has likened the World Wide Web to "a vast library including millions of readily available and indexed publications" as well as "a sprawling mall offering goods and services."[24] The "sprawling mall" analogy is certainly appropriate. In just the last few years, the amount of business done on the Internet — especially on the World Wide Web — has increased exponentially. For 1998, it is estimated that sales of products and services through the Web reached $7.8 billion.[25] This is more than double the estimated $3 billion in sales over the Web that occurred in the 1997 calendar year.[26] Sales made over the Internet are skyrocketing so fast that a recent Commerce Department report claimed that American companies will conduct $300 billion worth of business on-line by the year 2002.[27]

10. Advertising is the primary source of revenue for many Web site operators.[28] Operators of these Web sites often sell "banner ads," which appear at the top of the Web site pages. When a user arrives at the site, the first thing the user will see is the large (and usually colorful) banner ad at the top of the site paid for by an advertiser. Advertisers generally pay Web site owners based on the number of "hits" a Web site receives, which is the number of times the site is accessed by users.[29] Estimates show that in the first three quarters of 1996, businesses spent more than $150 million advertising on Web sites.[30] Just one year later, the advertising revenue had more than doubled. For the first half of calendar year 1997, advertising expenditures on the World Wide Web reached $217.3 million.[31] By the year 2000, it is predicted that annual advertising expenditures on the Web will reach $2 billion.[32]

11. As the Supreme Court noted in *Reno*, the Internet's novel nature has raised many interesting, and as-yet unresolved, legal questions because there is no other medium of communication that truly parallels it. For example, when a business — no matter how small — advertises its wares for sale on the World Wide Web, that advertisement is accessible to any person in the world sitting in front of a computer with Internet access. The fact that the seller's goods are now arguably being "offered for sale" in every state and country on the planet has raised issues about which courts have personal jurisdiction over the seller.[33]

12. A computer that is more-or-less permanently attached to the Internet is sometimes referred to a "host."[34] To facilitate communication between hosts, each host has a numerical Internet Protocol (or IP) address comprised of four groups of numbers separated by decimals.[35] Each host also has a unique "fully qualified domain name," which is more commonly referred to as the host's URL. If, for example, an Internet user wants to establish a connection with the Web site operated by the American Bar Association, the user might type into his browser program the URL "http://www.abanet.org". The first element of this particular URL is called the "transfer protocol." On the World Wide Web, this is almost invariably "http," which stands for hypertext transfer protocol. The remaining elements of the ABA site's URL (the "www.abanet.org" part of the URL) amount to a more user-friendly version of the numeric Internet Protocol address for the American Bar Association's host computer.[36] Once a URL is typed into the browser, the corresponding numeric IP address is then looked up by a "top-level server" computer.[37] These special computers perform the function of matching the fully qualified domain name to the corresponding numeric Internet Protocol address for the desired Website.[38] The query is then shuttled to another computer that directs the user to the host Web site. All of this, of course, is invisible to the user who typed in the URL for the desired Web site.

13. The first three alphabetical characters to the right of the decimal point (the decimal point is called a "dot" in computer parlance) in a fully qualified domain name are sometimes referred to as the "tag," although the true name for these three character suffixes is the "top-level domain." For example, ".edu" is the top-level domain

reserved for educational institutions, ".gov" is the top-level domain reserved for government entities, and ".net" is the top-level domain reserved to networks. Although the tag ".com" is short for "commercial," it is the catch-all top-level domain and is the only one generally available to Internet users that have no special attributes (i.e., they are not a school, a government, or a network).[39]

14. Domain names using the ".com," ".org," ".net," and ".edu" suffixes have historically been established by registration with an organization called Network Solutions, Inc. ("NSI").[40] NSI no longer holds the exclusive worldwide right to assign Internet addresses that it once held pursuant to a contract between NSI and the National Science Foundation.[41] By April of 1999, it is expected that at least five other companies could be authorized to also issue domain names in the ".com," ".net," and ".org" domains.[42]

15. Defamation, privacy, copyright and trademark issues have cropped up in the on-line world in ways not previously contemplated. Consider, for example, the case of the woman who placed a picture of her recently deceased daughter on a Web site in honor of her memory. Later, to her horror, she found that another Web site called "Babes on the Net" established a link to her daughter's picture.[43] Defamation and disparagement issues can arise simply because a link to a plaintiff's Web page may be found next to a derogatory comment. A case for defamation or disparagement could be made, for example, if a defendant puts the phrase "Go to this site if you want to visit a lying, cheating company that screws all its customers" next to a hypertext link to a plaintiff's site.[44]

16. Other still-uncharted Internet defamation issues include 1) whether the publisher of a Web site that links to a second site is legally liable for any infringing or defamatory content that may be found on the second site; 2) whether the operator of a Web site is obligated to review all of the content on another site before linking to it; 3) whether, after a link is established, the operator of the first site is under a continuing duty to revisit the second site to determine whether any subsequently-created defamatory material appears in the second site, 4) whether some type of "knew or should have known" standard applies in such a situation; and 5) what, if any, liability arises if the operator of the first site receives actual notice that the linked site contains defamatory, infringing, or otherwise inappropriate content.[45] So far, the courts have not yet passed upon these issues.[46]

17. The potential for liability in these situations has not escaped the notice of the insurance industry. In August 1997, the Chubb Group of Insurance Companies made headlines by offering insurance to protect Internet content companies and Internet service providers that inadvertently misuse copyrighted material or allegedly defame a person or business.[47]

18. These Internet-related tort liability questions have no clear answer because the Internet is so new and because it is not like the more traditional communications media.[48] The uncertainty is compounded by the fact that the courts have recognized — largely on First Amendment grounds — that the Internet "deserves special protection as a place where public discourse may be conducted."[49] The Co-Chair of the American Bar Association Litigation Section's Computer Litigation Committee recently remarked on the "unsettled nature of Internet law, as new forms of technology must be evaluated under the more traditional principles of intellectual property law."[50] The Internet has been likened to a "new frontier," with the corresponding observation that traditional legal principles developed in a less technological era "no longer seem to apply."[51]

19. The existing body of tort, contract, and intellectual property law obviously was not created with the Internet in mind. One frustrated federal appellate judge concluded that attempting to apply established tort law principles to the Internet "is somewhat like trying to board a moving bus."[52] Another computer law practitioner described the effort as one of "'trying to take 19th century rules regarding the media and seeing to what extent they're applicable to a 21st century medium.'"[53]

20. This article will focus on just three of the many current issues in Internet law. First, this article will address whether and under what circumstances tort liability may be imposed merely for establishing a link to a Web site

owned by another (apart from any defamation issues that may result from unfavorable commentary that may be associated with the defendant's link to the plaintiff's site). Second, this article will discuss potential liability for Web sites that incorporate another company's trade name or marks in their own site's metatags (which are essentially invisible lists of key words pertaining to the subject matter of the site) or their domain name (which is essentially the site's URL). Finally, this article will address whether Web site owners have a duty under the doctrine of avoidable consequences to take reasonable, technologically-feasible steps to minimize or mitigate their damages.

II. Potential Liability For Unauthorized Links To Other Sites Using Hypertext Links, Image Links, Or "Frame" Technology

A. The Use And Misuse Of HREF And IMG Links

21. As noted above, there are basically three methods for an Internet user to get to any given site on the World Wide Web. First, the user can directly type in the URL of the desired site (if it is known to the user). Second, the user can locate a Web site through one of several search engines available on the Web. Finally, the user can access a Web site through a "link" to that site from some other site on the Web.

22. Two types of "links" used on the World Wide Web. Hypertext reference (HREF) links are the most fundamental hyperlinks.[54] An HREF link is a piece of text that is differentiated from regular text by a special color (usually blue) or special formatting (such as underlining).[55] An HREF link is comparable to "a footnote reference in an article or a road sign" in that it directs the user from one source or location to another.[56] Furthermore, "when a hypertext link is activated, the browsing computer establishes a new connection with the linked site. Hypertext links allow the viewing of content from only one site at a time."[57]

23. The other type of link, the "image" (or IMG) link, makes use of "in-lined" images and does not share the hypertext link limitation that only content from one site can be viewed at a time. In-lined images are graphics that are visible on screen as part of a Web document's main body (as opposed to being within a separate window), but which originate at a source other than the site that stores the document being viewed.[58] These images appear on a Web site much in the same way photographs appear in a newspaper.[59] But the in-lined images themselves may come from absolutely anywhere on the World Wide Web, including Web sites having no connection whatsoever to the Web site that incorporates the in-lined image.[60] This means that unless the party originally placing an image onto their Web site takes affirmative steps to limit access to it, other Web site operators can "in-line" the image into their own Web sites.[61]

24. When a user initially accesses a Web site that incorporates an in-lined image originating elsewhere, the accessed Web site literally instructs the browser's computer to temporarily disconnect from it and to establish a temporary connection to the Web site containing the in-lined image.[62] The browser's computer then copies the in-lined image directly from the third-party Web site into the browser's memory.[63] The browser's computer then reestablishes the connection with the first Web site, and the browser's own computer inserts the in-lined image onto a specified portion of the browser's computer screen. To put it somewhat differently, no copy of the image is ever in existence in any form whatsoever on the "host" server (the computer with the hypertext code that tells the browser's computer to retrieve the in-lined image from some other source).[64] Rather, the image comes directly from the third-party Web site to the browser's computer without ever passing through the computer hosting the site that the browser is visiting.

25. The Web was built upon a foundation of linking.[65] The prevalent view in the Internet community is that the operator of a Web site is conclusively presumed to have made the site available for linking without any need to obtain prior consent.[66] The entire culture of the Web is based on this notion of free accessibility.[67] Moreover, the vast majority of Web sites may be visited by anyone without charge. Finally, frequency of visits to

a site serves as an indicator of the site's prestige.[68]

26. Linking to a site without obtaining prior permission is not only an unquestioned practice, but is even considered to be an advantage to the linked-to site.[69] Publication of a site on the World Wide Web is almost universally regarded as tantamount to an implied license to link by any other site.[70] For that reason, absent a violation of rights in the way the link is structured (such as an infringing or diluting use of a trademark, copyright infringement, or defamatory content), establishing a link to another site without obtaining permission in advance is not viewed as violating any rights.[71]

27. The inventor of the hyperlink, Tim Burners-Lee, has stated that "'[t]here is no reason to have to ask before making a link to another site.'"[72] In fact, Burners-Lee feels so strongly about this issue that on one occasion, when he received an e-mail message asking for permission to link to his site, he specifically declined to grant permission on the grounds that permission was not needed.[73]

28. Linking is essential to the usefulness of the World Wide Web, and should be preserved to the greatest extent possible.[74] A link, after all, is nothing more or less than a footnote or bibliographic reference that points the user to related materials of interest.[75] A link simply takes the user back to the "source" document much more quickly and easily than is the case with its hard-copy cousins. Even the American Bar Association's Commerce in Cyberspace Subcommittee has conceded that requiring permission to establish a link is inconsistent with the nature of the Internet.[76] That is not to suggest, however, that the practice of linking has not led to lawsuits or that such lawsuits have not met with at least some degree of success.

29. The very first lawsuit challenging an unlawful linking practice arose in Scotland in the case of *Shetland Times Ltd. v. Wills*.[77] The *Shetland Times* case involved two on-line news sources in the Shetland Islands. The Shetland News linked its Web site to the main headline page of the Shetland Times' Web site without getting the Times' permission. The Times then sued the News, claiming that the hypertext link to the Times headline page constituted copyright infringement. On October 24, 1996, Scotland's Court of Sessions entered a temporary restraining order until the full merits of the copyright infringement case could be heard. Significantly, however, the court's decision to grant the injunction did not turn on the legality of the linking per se, but on the narrower question of whether the Times' headlines were copyrightable expressions and whether the Times' Web site could be considered a "cable program" under a unique Scottish law.[78]

30. After the preliminary injunction was entered, the lawsuit settled. Under the terms of the settlement, the News can link to articles on the Times' Web site, but all headings of the Times' articles must have the words "A Shetland Times Story" printed underneath and typed at least as large as the headline. In addition, a button displaying the Shetland Times masthead, which will link the user to the Shetland Times' site, must be displayed adjacent to the headline from any story coming from the Times.[79]

31. Whether a claim for copyright infringement on similar facts would lie in the United States is open to question. Even after recent amendments specifically intended to address Internet copyright issues,[80] U.S. copyright law still does not parallel that of the United Kingdom.[81] For example, under U.K. law, headlines are copyrightable, but under U.S. law, they are not.[82]

32. The legality of including a link to another site without obtaining advance permission was squarely raised in the still-unresolved case of *Ticketmaster Corp. v. Microsoft Corp.*[83] That case arose out of a "Seattle Sidewalk" Web site established by Microsoft as a method of disseminating regional entertainment information. Microsoft's "Sidewalk Sites" for various cities around the country offer a free menu of leisure-time information, such as local music and sports events. Since it is necessary to purchase tickets to attend many of these events, Microsoft included a link to Ticketmaster in its Seattle Sidewalk site. During the developmental stages of the site, Microsoft and Ticketmaster began negotiations over how Ticketmaster would be compensated for this contemplated link. When the talks broke down, Microsoft included a link to Ticketmaster in its Seattle Sidewalk

site anyway. Ticketmaster filed suit, alleging that Microsoft's use of the link constituted a wrongful appropriation and misuse of Ticketmaster's name, trademarks, and Web site. The suit also alleged that Microsoft was publishing erroneous and misleading information about Ticketmaster's business.

33. Ticketmaster asserted two principal claims. First, Ticketmaster argued that Microsoft was getting a "free ride" on Ticketmaster's value to enhance the value of Microsoft's site, thereby increasing Microsoft's own advertising revenue. In other words, Ticketmaster believed that its mere presence on the Seattle Sidewalk site somehow enhanced the attractiveness of the site to advertisers, and that Ticketmaster should therefore be entitled to share in that enhanced advertising revenue. Second, Ticketmaster argued that Microsoft usurped its navigational control of Ticketmaster's Web site. Because the Microsoft link bypassed Ticketmaster's home page and went directly to the page within the site for the purchase of tickets, Ticketmaster's customer service announcements and the advertising displayed on Ticketmaster's home page were never seen by the users who accessed the Ticketmaster site through the link on Microsoft's Seattle Sidewalk site.[84] This second argument seems somewhat spurious, however, since Ticketmaster routinely allows its customers to set their browser's "bookmarks" to pages deep within the Ticketmaster site and thereby bypass the home page every time.

34. The *Ticketmaster* case provides little guidance to the Internet community because, even after nearly two years of litigation, it remains pending (although it is reported that settlement discussions are ongoing).[85] This is so even though Microsoft removed its links to the Ticketmaster site after the complaint was filed.[86]

35. Despite the dearth of court decisions directly in point, at least one commentator has opined that copyright liability does not arise from creating an HREF link to another site because a Web site's URL is not copyrightable.[87] That author analogized a URL to a street address, in that it defines a unique location on the Internet where a piece of information can be found. As such, it has no expressive or original content protectable by copyright.[88] Collections of URL's, however, may be copyrightable and their copying may result in a copyright infringement claim.[89]

36. The prevailing view is that a hypertext (HREF) link cannot constitute a basis for copyright infringement.[90] But one author, expressing what is apparently a minority view, has argued that a link is not a simple reference like a footnote or phone book listing, but is instead a device that actually transports the viewer to the linked site, thereby infringing on protected rights of the copyright holder.[91] No court has adopted that theory, and it seems to be counterintuitive. If the copyright holder did not want viewers to visit his site, he would not have made the information available on the Web. An HREF link causes the browsing computer completely to disassociate itself from the former site and move completely to the site maintained by the copyright holder. It is hard to see how a copyright holder has any grounds for complaint because the user came to his Web site through a hypertext link rather than, for instance, through the use of a search engine.

37. Even if the existence of an HREF link arguably constituted a direct copyright violation, the creator of the link would still be entitled to utilize the traditional defenses to copyright liability. This would include the concept of an "implied license" to link, the existence of which is generally recognized. If, however, the linked site expressly prohibits linking without authorization, the implied license may be lost.[92] Furthermore, it is possible that an implied license may not extend to a competitor of the creator of the linked site.[93] The defense of fair use could also apply, although it is less likely to be applicable if the link was established for commercial purposes.[94] The fair use defense could also be negated if the link detracts from the value of the linked site, or if the link bypasses advertising on the linked site.[95]

38. Since no "copying" is involved in hyperlinking, HREF links should not give rise to claims of copyright infringement.[96] That is not the case, however, with respect to IMG links. The question of whether IMG links can give rise to liability for copyright infringement was raised with respect to the Dilbert comic strip.[97] In that case, Dan Wallach (an individual who was a fan of the Dilbert comic strip) felt that United Media (the owner of the rights to Dilbert) did a poor job in laying out the official Web site for the Dilbert comic strip.[98] Wallach

created his own "improved" Web site for the Dilbert comic strip, which he named the Dilbert Hack Page. In order to incorporate Dilbert drawings and cartoons into the Hack Page, Wallach used IMG links to call up images from the United Media server. The images then appeared at designated places on the browser's computer monitor when Wallach's Dilbert Hack Page was displayed. No actual "copy" of the images at any time was created or stored in any form on Wallach's own computer.

39. United Media sent Wallach a cease and desist letter, claiming that federal copyright law prohibits the unauthorized display of its copyrighted work.[99] United Media also claimed that if it lost control of the context in which its intellectual property is displayed, the value of its property could be eroded (such as if an in-line of the Dilbert strip was displayed on the home page of the Klu Klux Klan).[100] Ultimately, Wallach and United Media settled their differences without litigation when Wallach agreed to drop the IMG links, and instead used HREF links to the United Media home page that appropriately identified the comic strip's source.

40. An argument could also be made that even though an HREF hypertext link does not constitute direct copyright infringement, the creation of the link could nonetheless give rise to liability for contributory infringement. Liability for contributory copyright infringement may arise if a defendant, "with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another."[101] But to hold the linking site liable for contributory infringement, it would be necessary to find the user who is viewing the linked page liable for direct infringement.

41. For a number of reasons, it is extremely unlikely that a court would ever find that a user browsing a site on the Web has committed an act of direct copyright infringement (which is a necessary predicate to finding the linking site liable for contributory infringement). First, when a copyright owner posts information on a Web site that is freely accessible, every user in the world automatically has an implied license to view the copyrighted material. The fact that the user arrived at the site via a hypertext link on another site is irrelevant.[102] Second, the doctrine of fair use protects a user who downloads a copy of a Web page into his or her computer. Section 107 of the Copyright Act of 1976 lists the four factors a court must consider to determine whether "fair use" is being made of information. These include 1) the purpose of the use (i.e., commercial or personal); 2) the nature of the copyrighted work; 3) the amount of the copyrighted work that has been used; and 4) the effect of the use on the market for or value of the copyrighted work.[103] Since the owner of the copyright intentionally posted the information on his or her own Web site, the "copy" made by the user's browser's software — which was essential for the user to see the posted material on his computer screen — is certainly a "fair use" of the material.[104] Finally, since many Web site owners want to attract users so they can increase sales of their products or advertising revenue, the link arguably enhances the market for the copyrighted material and increases its value, rather than detracts from it.[105]

42. Web site owners have occasionally succeeded in bringing trademark infringement or trademark dilution claims arising out of unauthorized HREF and IMG links. In *Playboy Enterprises, Inc. v. Universal Tel-A-Talk*,[106] the defendant created a Web site that made repeated use of the Playboy name and the Playboy bunny trademark. This use of the Playboy name was combined with an actual (but unauthorized) link to the official Playboy site. The intentional use of the Playboy name and bunny trademark, combined with the unauthorized link from the defendant's Web site to the official Playboy Web site, was held to be sufficient to constitute a trademark infringement.[107] This holding is consistent with the generally recognized rule that using someone else's trade name, trademark, or protected logo or image as the icon for the hyperlink can constitute trademark infringement.[108] But the use of a trademark or trade name as a mere part of the URL of a hyperlink, standing alone, should be excused as a fair and descriptive use of the mark.[109]

43. Therefore, while including the URL of a site in block letters under the heading "other sites on this topic" is unlikely to constitute trademark infringement, the use of another's distinctive logo as the hypertext link icon could very well amount to actionable infringement. Infringement is even more likely to be found if there is an express or implied suggestion that the owner of the logo used as the link is a co-sponsor of, or is affiliated with,

the linking site.[110]

44. Some of the fog surrounding Internet trademark issues lifted in 1995, when the Federal Trademark Dilution Act [111] (FTDA) was passed into law. The FTDA provides in part that:

> The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. . . [112]

Prior to the enactment of the FTDA, approximately 25 states had substantially similar state statutes prohibiting trademark dilution.[113]

45. The FTDA defines the term dilution to mean "the lessening of the capacity of a famous mark to identify and distinguish goods or services regardless of the presence or absence of (a) competition . . . , or (b) likelihood of confusion, mistake, or deception."[114] If a trademark qualifies as "famous" and if the defendant is using that famous trademark in a "commercial use," the FTDA (and its state law counterparts) may prohibit the use of the trademark as part of a link.

46. There are two arguments that could support a trademark dilution claim in connection with unauthorized linking of Web sites. One is that the association of the linked site with the linking site somehow tarnishes, blurs, or otherwise diminishes the value of the image associated with the trademark or trade name associated with the linked site.[115] The second occurs where the link is to a page deep within the linked site, rather than its "home" or first page. Because such "deep links" bypass the customary channels the viewer would otherwise travel through to reach the internal page, the argument is sometimes made that the link distorts the image that the viewer has of the linked site.[116]

47. There is very little case law applying the FTDA in the hypertext linking context. In the *Universal Tel-A-Talk* case mentioned before, a hypertext link — together with other use of the Playboy trade name and trademark — was deemed sufficient to warrant the imposition of injunctive relief.[117] It is not clear how much of the court's decision in *Universal Tel-A-Talk* was premised on the existence of the hypertext link, rather than the clearly inappropriate use of the Playboy trade name and trademarks within the Web site and part of the site's domain name.

48. Despite the *Universal Tel-A-Talk* decision (which appears to be the only case addressing the applicability of the FTDA to an incident of hypertext linking), a stand-alone hypertext link should generally not be sufficient to invoke injunctive relief under the statute. In many cases, a mere link, standing alone, will not constitute a "commercial use" of a registered mark, nor will it amount to a dilution of that mark. And again, where there is no other offending conduct apart from the mere existence of a hypertext link, the implied license to link in most cases should serve as a defense to liability.

B. The Use And Misuse Of "Frames" Technology

49. Some Web sites consist of a collection of links to other sites. Sites that provide such collections of links are often called "metasites."[118] As central repositories of information, these metasites make the Internet more easy, efficient and convenient to use.[119]

50. "Framing" was first introduced to hypertext markup language programming in 1996 as a proprietary feature available for use with the Netscape Navigator browser.[120] "Frames" are a means of allowing Web site creators to divide their pages into multiple scrollable windows that operate independently of each other. The "frames"

technology is now widely used on Web sites and is compatible with most commercial browsers.

51. Frames operate much like picture-in-picture television.[121] They allow a user to view another site's content within a small area of the initial metasite, all without actually having to leave the metasite itself. When frames are used, the URL shown on the browser's computer does not change; the browser's computer continues to display the address of the metasite, not that of the framed site. Some have claimed that this may confuse casual Internet users who do not understand that they have not yet left the initial metasite, even though they are viewing material that comes from another source entirely.[122] This feature of the frames technology also prevents users from creating "bookmarks" for the framed sites because any bookmark the user attempts to create will take the user to the metasite, not the framed site.

52. One of the major concerns resulting from the use of frames technology stems from Internet advertising. An ad that appears on a framed site must co-exist with the ads displayed on the borders of the original metasite.[123] This has an obvious effect on ads that appear on the framed site, because the ad's visual impact will be lessened because of its reduced size and by the clutter created by the framing. Also, the physical locations of the ads on the screen are different when Web pages are framed within another site. For example, an advertiser may have envisioned (and paid for) an advertisement running horizontally all the way across the top of the computer screen. If that site is instead "framed" within another Web site, the advertiser instead receives a smaller ad running across a much smaller (and usually lower) portion of the browser's screen. If advertisers view these distortions as devaluing their ads, site owners who sell advertising space on their Web sites may lose advertising revenue.[124]

53. "Framing" is analogous to an IMG link in that, under both systems, it may appear that the original site is the authorized user of the secondary content site.[125] But unlike IMG links, frames allow Web authors to incorporate remote sites wholesale into their own local Web sites. The frames technology allows viewers to "look through" one site to another without ever terminating the connection to the framing site.[126] In this manner, site owners can incorporate entire Web sites produced by others and surround them with their own advertising, logos, or promotions.[127]

54. But framing technology does provide benefits to both Internet users and to the "framed" sites. One of the main functions of a metasite is to assist unsophisticated Web surfers, and to provide an easy means of access to related articles even for more experienced Web users.[128] Once a user finds an interesting site framed within a metasite, the user can easily determine the framed site's URL.[129] The user can then manually insert the URL of the framed site into their browser, and establish a direct link to the desired site. Once the direct link is established, the site can then be "bookmarked" for easy (and direct) access in the future. And framing, like any other form of linking, enhances the exposure of the framed site because it almost invariably increases the number of "hits" experienced by the site.[130]

55. The first U.S. case that asserted liability for unauthorized linking[131] also involved the "frames" technology. Total News, Inc. created a "metasite" that provided links to several large and well-known media outlets such as CNN, USA Today and Time. Total News was sued by a number of the media outlets whose contents were "framed" on the Total News site. The plaintiffs — which included the Washington Post[132], Time, Inc., Reuters America, and CNN — alleged that the defendant's "framing" of their sites constituted misappropriation, trademark dilution, trademark infringement and unfair competition, among other things. They claimed that the Total News site was "parasitic" and "provide[d] little or no content of [its] own." The plaintiffs described Total News' metasite as the "equivalent of pirating copyrighted material from a variety of famous newspapers, magazines or television news programs; packaging those stories to advertisers as part of a competitive publication or program produced by defendants; and pocketing the advertising revenue generated by their unauthorized use of that material."[133]

56. The Total News case settled almost immediately after it was filed, even before an answer to the complaint was

due.[134] Under the terms of the settlement, Total News may continue to provide links to the plaintiffs' Web pages, but it must do so without framing the linked sites.[135] The settlement also requires that any linking 1) not cause confusion, mistake or deception; 2) not imply endorsement or sponsorship by or association with the publishers without prior authorization; and 3) not dilute the publishers' trademarks.[136]

57. Because the case settled, no court ever decided whether the "frames" technology violated any intellectual property rights of the plaintiffs who had, after all, voluntarily made their content available to the public free of charge on the Internet. During the short time that the case was pending, the consensus in the legal and Internet communities was that Total News could not be held liable for direct or contributory copyright infringement.[137] But the greater question seemed to be whether Total News violated the plaintiffs' exclusive right to prepare derivative works under federal copyright law[138] by embedding the linked news services within the metasite's frame. The argument was that Total News may have violated the plaintiffs' exclusive derivative rights because it distorted and modified the way in which the plaintiffs intended their news services to be viewed.[139] There was at least some possibility that the doctrines of the fair use and implied license would be found to be inapplicable, because Total News' use of the plaintiffs' news reports was clearly commercial in nature, and because Total News may have diluted the plaintiffs' goodwill with their advertisers by selling ads that appeared right beside the plaintiffs' news items with their accompanying ads.[140]

58. On the other hand, Total News probably could have shown that the impact its use had on the market for the original work was difficult if not impossible to assess.[141] Total News also likely could and would have argued it had an implied license to incorporate the plaintiffs' news services within its site because the plaintiffs should have anticipated that others on the Web would use established programming techniques to access and use any posted material.[142] Because the plaintiffs chose to make their news services available without including any express-use limitations, Total News could well have argued — especially in light of the generally-recognized right to link — that the plaintiffs had granted the world at large an implied license to make use of their news services.[143]

59. Another framing case was filed later in May 1997 when Playboy Enterprises, Inc. sued a California company, Web21, for "framing" the official Playboy Web site. Web21 maintained a Web site that included hundreds of links to other sites on the World Wide Web. Playboy — which was included as one of those links until the suit was filed — contended that the framed link to its site misappropriated Playboy's information. The suit alleged unfair competition, trademark infringement, trademark dilution, and other violations. Again, no court passed on the merits of these claims because Web21 agreed to settle the case the same day that it was served with suit papers. The terms of the settlement were not disclosed.[144]

60. As with HREF and IMG links, the principal theories for liability arising out of the unauthorized use of a "frame" link include trademark infringement and trademark dilution. Although the plaintiffs in both the Total News and the Web21 cases raised infringement claims, the court did not have an opportunity to adjudicate this issue. However, both of these claims were successful in the case of *Digital Equipment Corp. v. Altavista Technology, Inc*.[145] Digital Equipment Corporation launched an Internet search engine service using the service mark "Altavista" in late 1995. In March of 1996, Digital purchased an assignment of defendant ATI's rights to the registered trademark "AltaVista." Digital then licensed back to ATI the right to use the word AltaVista as part of ATI's corporate name and as part of ATI's Web site address "www.altavista.com." The license agreement, however, specifically forbade ATI from using the Altavista trade name as "the name of a product or service offering."

61. Before this assignment occurred, ATI had its own Web site that had a western theme and motif. ATI's product offered on its site was called "MediaWrangler." The site featured a representation of a horse and the greeting "Howdy pardner!" The ATI site did not include a search engine service. Immediately after signing the license agreement with Digital, ATI dramatically changed the appearance of its Web site. Less than two months after the assignment, the ATI site began offering a link to an unnamed search engine. Although the ATI site did not say

so, the link was to Digital's Altavista search engine service. ATI then repeatedly changed its Web site over the next few months until it eventually looked, felt, and functioned virtually the same as Digital's Altavista Web site. A visitor to the ATI site could easily have the impression that they were actually at Digital's Altavista site. This deception was created, in part, by the use of "framing" technology whereby ATI was able to link directly to Digital's Altavista search engine even though the user was still linked to ATI's site.

62. Digital sued ATI and sought, inter alia, preliminary and permanent injunctive relief. After addressing jurisdictional matters, the *Digital* Court concluded that ATI's actions constituted a breach of the licensing agreement, trademark infringement, unfair competition and (although it was not discussed to any meaningful degree) trademark dilution.[146] The court granted Digital the requested injunctive relief. But the precedential value of the *Altavista* case is somewhat diluted because it is not a "pure" linking case involving two unrelated entities. At least one major factor in the *Altavista* case was the fact that Digital had not received what it paid for, which was the right to use the Altavista name in connection with its search engine service free of any competing use by ATI.

63. Despite the dearth of useful precedent, it appears that the kind of copyright claims known as derivative works claims (as opposed to direct or contributory copyright infringement) have at least some chance of succeeding in "framing" cases. In *Futuredontics, Inc. v. Applied Anagramics, Inc.*,[147] a California federal court denied a motion to dismiss a claim that presenting the content of a linked site through the host's "frame" constituted a derivative work in violation of copyright laws. In that case, the defendant's Web site included a link through which it reproduced pages from the plaintiff's Web site within a "frame." That frame included the defendant's logo, information about the defendant, and links to all of the defendant's Web pages. The plaintiff contended that it was the owner of the copyrighted material that was reproduced without permission through the "frames" link to the plaintiff's Web site on the defendant's site. The plaintiff argued that the defendant was infringing its copyright by reproducing the plaintiff's copyrighted material on the defendant's Web site without plaintiff's permission.

64. The court initially denied the plaintiff's request for a preliminary injunction in part because the defendant — unlike the defendants in *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*[148] — had not affixed an image created by the plaintiff to some permanent object such as a ceramic tile.[149] On the other hand, the court also did not find that the facts before it were directly in point with the facts in *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*,[150] in which the Ninth Circuit Court of Appeals held that a "Game Genie" that enhanced audiovisual displays originating in Nintendo cartridges did not constitute a derivative work because it did "not incorporate a portion of a copyrighted work in some concrete or permanent form."[151] The *Futuredontics* Court distinguished *Galoob* on the grounds that it was possible that the plaintiff could establish that the defendant's Web site incorporated the plaintiff's Web page in some "concrete or permanent form," or that the defendant's framed link amounted to a duplication or recasting of the plaintiff's Web page.[152]

65. For those reasons, the trial court concluded that the plaintiff's complaint sufficiently alleged a claim for copyright infringement under a "derivative works" theory.[153] But because the plaintiff had not shown that the defendant's framed link to the plaintiff's Web site constituted an irreparable injury or that the balance of hardships tipped sharply in favor of the plaintiff, the court refused to grant preliminary injunctive relief in advance of a full trial on the merits.[154] The Court of Appeals for the Ninth Circuit affirmed the trial court's denial of preliminary injunctive relief.[155]

66. Consistent with the *Futuredontics* ruling, it is generally agreed that the strongest case for copyright infringement in "framing" cases is a derivative works claim.[156] Unlike the reproduction rights context, a copyright owner's exclusive right to prepare derivative works is infringed even if no unlawful copy of the material is made.[157] The copyright owner's exclusive right to prepare derivative works is violated if a legally-owned copy of the copyrighted work is altered, modified or presented to the public in a distorted form.[158] A finding that the exclusive derivative right is infringed may result even if only minimal unauthorized additions are made to the

copyrighted work.[159]

67. Suits in future "framing" cases can also be expected to include Lanham Act unfair competition claims, as they did in *Digital* and *Total News*. Unfair competition may be established if the use of the link falsely states or implies that a person or a company has endorsed, sponsored or approved certain goods or services.[160] The relevant test for determining liability under a Lanham Act unfair competition theory is whether it is likely that consumers will be misled into believing that a product or service has been endorsed or approved when in fact it has not.[161]

68. It is also possible that state common law unfair competition claims could arise in this setting as well. Traditional state law unfair competition generally does not describe a single course of conduct for a tort with specific elements. Instead, it describes a general category into which a number of new torts may be placed when they are recognized by the courts.[162] Because of the novel nature of the Internet and the new kinds of attendant tort claims that may result, it would not be surprising to see such claims brought under the rubric of state law unfair competition with its shifting and amorphous boundaries.

69. Given the unsettled nature of the law, a large number of potential theories for the imposition of tort liability will likely be included in complaints arising out of the use of frames. These will doubtlessly include — as they did *Total News* — claims for tortious interference with advertising contracts, false and deceptive advertising, state law unfair trade practices claims, false designation of origin, and/or some sort of negligent or intentional misrepresentation theory under state law. At this juncture, no court decisions have relied upon any of these miscellaneous theories upon which to premise liability in "frames" or other linking cases.

III. Liability For Incorporating Other's Trade Names Or Trademarks In Web Site Metatags

70. Metatags are key words used by search engines like Yahoo, AltaVista, Web Crawler, and InfoSeek to find sites relevant to a user's query.[163] These metatags are words included in the computer code that is part of many Web sites.[164] When these metatags match a search term submitted by a search engine user, the search engine includes the Web site in its search results.[165] The search engine ranks the relevant sites according to the relative frequency that the key words appear within the metatags and in the text on the relevant sites.[166] Most — but not all — search engines use these metatags as at least one factor in determining what sites are responsive to a search inquiry submitted by a user of the search engine.[167]

71. Search engines use programs called "spiders" to roam the Web and create indices based upon key words in the metatags and other information appearing on the Web pages visited by the spider.[168] Typically, a search engine spider makes a daily excursion throughout the Internet collecting information about millions of Web sites. This information is then used by separate indexing software to create the indices which allow the search engine to identify Web sites of interest to a searcher.[169] In addition to a site's metatags, the spider generally also looks at the title of the page, the text on the page, the URL, and the domain name of the page.[170] The indexing software uses a proprietary formula to figure out the ranking order of the various sites that appear to be relevant to the inquiry submitted by the searcher.[171]

72. Metatags are not (ordinarily) seen by the user.[172] There is a method by which a visitor to a Web site can determine what metatags (if any) have been established for the site.[173] Using this method, one can review a competitor's Web site to determine whether one's trade names or trademarks are improperly being used as metatags by the competitor. There are now Internet consulting companies that will perform this type of monitoring service on a continuing basis.

73. Since no one but the Web site publisher controls the key words included in a given site's metatag, the system is subject to abuse by the unscrupulous. While most companies use their own trademarks and other appropriate descriptive words within their site's metatags, some also use trademarks owned by others, hoping that Internet

users searching for the competition will instead be led to their own site.[174] One such instance mentioned in the literature illustrates the point. In that instance, a consumer interested in information about Phoenix Tools typed the word "Phoenix" as a search term. One of Phoenix' main competitors, Poseidon, embedded the word "Phoenix" as an invisible metatag in its Web site. The search engine — seeing the word "Phoenix" in the metatag — included the Poseidon site in its search results. But when the consumer visited the Poseidon site, the consumer saw lots of information about Poseidon's products, but nothing about the Phoenix products. Indeed, the word "Phoenix" was never mentioned anywhere in the visible text on Poseidon's site, leaving consumers confused about how the site was selected by the search engine as being relevant to the query.[175] Poseidon obviously hoped that the consumer would put aside the confusion and simply purchase Poseidon's competing products.

74. The first lawsuit arising from a deceptive metatag was brought by Playboy Enterprises, Inc. against an adult entertainment site that used the word "playboy" in its metatag. Finding trademark dilution, the court in *Playboy Enterprises, Inc. v. Calvin Designer Label*,[176] entered an injunction forbidding the defendant from including the Playmate or Playboy trademarks in buried code or metatags on their home page or Web pages.[177]

75. Two other trademark owners also filed similar suits in 1997 and obtained quick settlements. In *Insituform Technologies, Inc. v. National Environmental Group, LLC*,[178] National Envirotech embedded the trademarks of Insituform, its competitor, on its Web site. Once again, although the search engines searching for Insituform's name would identify National Envirotech site as a "matching" site, the National Envirotech site itself had no visible references to Insituform or its products. As part of the settlement, National Envirotech agreed to remove Insituform's trademark from the metatags on its Web site, and to resubmit its Web site to commercial search engine services to be re-indexed.

76. The law firm of Oppedahl & Larson also filed suit against others that used the marks "Oppedahl" and "Larson" as metatags in competing sites.[179] That suit also settled, with most of the defendants agreeing to a consent order requiring them to stop the use of the offending metatags.[180]

77. Another recent case involving inappropriate use of metatags is *Playboy Enterprises, Inc. v. Asiafocus Int'l, Inc.* [181] In the *Asiafocus* case, the defendant embedded the trademarks "Playboy" and "Playmate" within its site's metatag. The court concluded that this conduct constituted trademark infringement under Sections 32[182] of the Lanham Act, false designation of origin under Section 43(a)[183] of the Lanham Act, and trademark dilution under Section 43(c)[184] of the Lanham Act. In fact, the court went so far as to hold Asiafocus liable for statutory damages in the maximum amount of $1 million per counterfeit mark. The court found that the defendant's intentional inclusions of the trademarks "Playmate" and "Playboy" in the metatag demonstrated that the defendant's conduct was willful and was calculated to lead consumers to believe that the defendant's Web site was somehow affiliated with Playboy.

78. To date, plaintiffs have succeeded in cases against defendants who have improperly used their trademarks or trade names in their site's metatags on a variety of legal theories. These theories include both direct[185] and contributory[186] trademark infringement, trademark dilution[187] (which applies only to marks that qualify as "famous"[188]), tortious interference with contract,[189] and unfair competition.[190] While these cases are not many in number, they are certainly consistent in their results. The unauthorized inclusion of another's trade names or trademarks in a Web site metatag will not be tolerated if it has the purpose and the effect of confusing or misleading potential customers, or of diluting the value of famous trade names or marks.

79. That is not to say, however, that there are no instances in which someone else's trademark or trade name can properly be included in another site's metatag. Suppose, for example, that an automotive industry trade magazine publishes an article on its Web site that is critical of the 1999 Pontiac Grand Am manufactured by General Motors. The automotive industry publication could legitimately include the trademarks "Grand Am," "Pontiac," and "General Motors" among the metatags for the site. This use is justified on the grounds that the publication is not trying to divert business away from the business or trademark owner.[191] While in theory the trademark

owner could still bring suit alleging trademark dilution or unfair competition, trademark law experts believe that it is unlikely that a court would prohibit this type of use of a trademark in a site's metatag.[192]

80. The point raised by these commentators is well-taken. It is not necessarily true that a person running an inquiry on a search engine using the terms "General Motors," "Pontiac," and "Grand Am" is necessarily looking for sellers of Pontiac Grand Am automobiles. It is instead possible — in some cases, even likely — that the searcher is instead looking for reviews, comments, or complaints made by others about the product he may be thinking of purchasing.

81. "Metataggers" have sometimes argued that their conduct fools only search engines, not consumers.[193] Their opponents generally respond that the "invisibility of the metatag certainly makes a defendant seem deceitful and, in any event, does not change the fact that the metatagger's Web site is presented to the consumer as a direct result of the consumer's request for information about the trademark owner's (not the metatagger's) product.[194] The superficial appeal of the counter-argument fails upon closer analysis. First, the fact that metatags are invisible is no fault of the so-called metatagger. Rather, the fact that metatags are (ordinarily) invisible is simply a function of the manner in which hypertext mark-up language was designed. Taken to its logical conclusion, the counter-argument implies that any company that uses *any* metatag at all must be "deceitful" because all metatags — good and bad — are "invisible" to the end user.

82. Second, the counter-argument improperly assumes that everyone searching for the terms "General Motors," "Pontiac," and "Grand Am" is seeking out a seller of those products. The argument completely ignores the possibility that the seeker may be searching for comment or criticism of those products, and ignores the rights of competitors or third parties to offer any commentary they may have about the product. If, for example, Ford Motor Company has a page on its Web site displaying the results of a comparison test between a Ford Taurus and a Pontiac Grand Am, it would be irrational to prohibit Ford from using "Pontiac" and "Grand Am" as metatags on that page.

83. Finally, distributors of a product (and others legitimately involved in its stream of commerce) should be permitted to use the product's trademark as a metatag, even though they do not own the mark. As noted by Murray and Rosenthal, general principles of trademark law permit a distributor to advertise the availability of trademarked products, even if the distributor is not authorized by the trademark owner to do so.[195]

84. As is the case with hypertext links, the use of a trademark or trade name in the text of a Web site or in a metatag does not necessarily imply that the trademark owner has authorized, approved, or granted permission for the use of the name or mark. The determination of whether the unauthorized use of a trade name or mark in a metatag is tortious will depend generally on whether the use rises to the level of trademark infringement under Section 32 (1) of the Lanham Act, false designation of origin (also sometimes referred to as unfair competition) under Section 43(a) of the Lanham Act, or trademark dilution (which incorporates the concepts of both blurring and tarnishment) under Section 43(c) of the Lanham Act.

85. In what is being hailed as the "second generation" of such suits,[196] Estee Lauder filed a suit in early 1999 against the search engine Excite. The suit alleges that Excite committed trademark infringement, unfair competition, and false advertising when it sold Estee Lauder's trademarked names as "key words" that would call up banner ads for one of Estee Lauder's competitors. For instance, when the Estee Lauder suit was filed, a computer user who typed in the words "Estee Lauder" on Excite's Web site would get a list of Web pages mentioning Estee Lauder by name. But across the top of Excite's page showing the search results, a large banner ad for Fragrance Counter, Inc. (a small on-line retailer of perfume and make-up) would always appear. Fragrance Counter paid Excite for the right to have its banner ad displayed every time any user of the Excite search engine typed in the words "Estee Lauder."

86. Just a few weeks later, Playboy filed a similar suit against both Excite and Netscape based on the same sort of

conduct. Typing in the words "Playboy" or "Playmate" on either of these sites would result in a list of sites mentioning those words, but also would result in a banner ad for "Tease.com" — a hard-core, x-rated site — appearing across the top of the search results page. Playboy alleged that this sale of its trademarks and trade names as "key words" to a hard-core sexually-explicit site sullied Playboy's name and "highjacked and usurped" Playboy's good will and reputation.[197]

87. The *Estee Lauder* and *Playboy* suits are the first time that the courts will be asked to decide whether search engines can sell "key words" composed of someone else's trademarks without restriction.[198] Opinions in the legal community as to whether such conduct is proper are sharply divided.[199] However, it seems clear to this author that the search engines, by selling the right to have someone else's banner ads appear each time any given registered trademark or trade name is typed in, will at a minimum be found to have diluted those marks under federal and state anti-dilution statutes.

88. The stakes are not inconsequential. Ad sales based on key words account for roughly one-quarter of the advertising revenue generated by search sites like Excite.[200] This category of Web sites generated more than $450 million from advertising last year.[201] Five percent of overall revenues by Web site search engines come from sales of trademarked "key words."[202]

89. But once again, there is a low-cost technological means for companies to determine how often their trade names or marks are being used as "key words" sold by search engines to others. A free on-line service called BannerStake[203] will display all ads associated with any given trade name. While the legality of a search engine's sale of someone else's registered trade name to be used as a key word to prompt another company's banner ad to appear may still be an open question, all companies have a no-cost method available to determine which search engines, if any, may have sold that company's registered marks to another as a "key word" to prompt a banner ad to appear.

IV. Liability For Incorporating Other's Trade Names Or Trademarks In Web Site Domain Names

A. Misappropriation Of Domain Names By "Cybersquatters"

90. The growing number of disputes over electronic addresses or "domain names" is yet another "visible example of how the growth of the Internet has outpaced traditional legal doctrine."[204] Any given Internet domain name — consisting of the exact combination of numbers, letters, and characters — can only be registered to one entity. As noted above, the registration of domain names in the United States has historically been handled exclusively by NSI.[205] If someone attempts to register a domain name previously registered by someone else, they will be prevented from doing so because of the prior registration of that domain name by the first user.[206]

91. Beginning in 1993, NSI granted domain names on a "first come, first served" basis without conducting any trademark search to determine whether the domain name interferes with anyone else's trademark rights.[207] In July 1995, faced with a growing number of domain name disputes, NSI adopted a policy for addressing those disputes.[208] Its domain name dispute policy was most recently revised effective February 25, 1998.[209] The NSI dispute resolution process now begins when a complainant presents NSI with satisfactory evidence of both trademark ownership and of written notice to the earlier domain name registrant describing the legal harm the trademark owner is incurring. Once this is received, NSI determines the creation of the registration date of the first user's domain name registration. If the creation date precedes the effective date of the complainant's trademark registration, NSI will take no action on the complainant's request. If the domain name was created after the registration of the trademark by the complainant, NSI will request proof of the earlier user's registered trademark or service mark. If the earlier user's certified registration was effective prior to the date of the third party's notice of dispute to the registrant, again NSI will do nothing. If the earlier user who registered the domain

name cannot provide proof of a certified registration that was in place before the notice of dispute was filed, NSI will place the disputed domain name on "hold" — which effectively prevents either the complainant, the original registrant, or anyone else from using that domain name — until the dispute is concluded.

92. NSI's policy has by no means deterred those wishing to appropriate marks or trade names owned by others. Individuals who attempt to profit by reserving domain names composed of someone else's registered marks and later reselling or licensing those domain names back to the rightful owner of the mark are called "cybersquatters."[210] Cybersquatters intentionally register domain names based on others' trademarks for the purpose of selling or canceling them in exchange for large sums of money.[211] Dozens of companies — including giants like Estee Lauder, Taco Bell, MTV, and Kentucky Fried Chicken — have had to pay or sue cybersquatters to gain the rights to domain names that matched the trademarks that they developed after significant expenditures of time and money.[212] NSI registers about 40,000 domain names each month.[213] The number of disputes over domain names was pegged at 700 back in 1996.[214]

93. The undisputed king of "cybersquatting" is Dennis Toeppen, who resides in Champaign, Illinois, where he operates an Internet service provider business known as Net 66.[215] Toeppen has registered approximately 240 Internet domain names without seeking permission from any entity that previously used the names he registered. Some of the domain names Toeppen has registered include deltaairlines.com; britishairways.com; crateandbarrell.com; ramadainn.com; eddiebauer.com; greatamerica.com; neiman-marcus.com; northwestairlines.com; ussteel.com; aircanada.com; anaheimstadium.com; arriflex.com; australiaopen.com; camdenyards.com; flydelta.com; frenchopen.com; lufthansa.com; and yankeestadium.com.[216]

94. Toeppen first made waves in the legal community when his activities were the subject of a court decision addressing Internet jurisdictional issues in *Panavision Int'l v. Toeppen*.[217] In *Panavision*, Toeppen applied for and received registration of the domain name "Panavision.com." He then established a Web site displaying aerial views of the city of Pana, Illinois. At no time did Toeppen use the "Panavision.com" name in connection with the sale of any goods or services.[218] Toeppen's registration effectively prevented the plaintiff, Panavision International, from registering and using its own trademark as its Internet domain name. After Panavision notified Toeppen of its desire to use the "Panavision.com" domain name, Toeppen demanded $13,000 to discontinue use of the name. Panavision asserted that Toeppen's sole purpose in registering the "Panavision.com" domain name — as well as his subsequent registration of Panavision's "Panaflex" trademark in the domain name "Panaflex.com" — was to extort money from Panavision.

95. Panavision brought suit in federal court against Toeppen for trademark dilution, trademark infringement, federal and state unfair competition law, intentional and negligent interference with prospective economic advantage, and breach of contract. On cross-motions for summary judgment, the trial court found in favor of Toeppen on the tortious interference and breach of contract claims. The court found that there was no evidence of any specific economic relationship that was interfered with by Toeppen, thereby barring any claims for tortious interference with contract or with prospective economic advantage. The breach of contract claims were dismissed because the court found that Panavision had no right to attempt to enforce a contract provision between Toeppen and NSI prohibiting Toeppen from using his registered domain names in an unlawful manner. The court held that NSI's contract provisions prohibiting the unlawful use of domain names existed solely to protect NSI, and that those provisions were not intended to benefit third parties such as Panavision.[219]

96. But the trial court granted summary judgment in favor of Panavision on its federal and state trademark dilution claims. The trial court found that Panavision's marks were "famous" within the meaning of the trademark dilution statutes, and that Toeppen's attempts to register domain names composed of registered trade names and trademarks for the purpose of reselling them to the owners of those names and marks constituted a "commercial use" of the marks.[220]

97. On appeal, the Court of Appeals for the Ninth Circuit agreed, and affirmed the trial court's grant of summary

judgment to Panavision.[221] The Ninth Circuit found that an attempt to sell domain names composed of others' registered marks constituted a "commercial use" of the marks, even though the marks were not attached to any particular product.[222] The appellate court added that, in addition to the traditional state law dilution theories of "blurring" and "tarnishment," the federal trademark dilution statute was broad enough to include situations where potential customers might be discouraged if they could not find a Web site by typing in the company's registered trade name followed by the suffix ".com."[223] The court also felt that involuntarily forcing a company to leave its registered trade name and reputation to the mercy of a cybersquatter constituted a "dilution" of the trade name.[224]

98. Toeppen's activities were also the subject of a second court case, *Intermatic Inc. v. Toeppen*.[225] In that case, Intermatic owned five incontestable trademark registrations for its "Intermatic" mark. Prior to registering the domain name "intermatic.com," Toeppen had never used the term "intermatic" for any purpose. Intermatic subsequently attempted to register the "intermatic.com" domain name, but was prevented from doing so because of Toeppen's prior registration. Intermatic then demanded that Toeppen relinquish or assign the "intermatic.com" domain name registration and discontinue his use of the mark. Until Intermatic placed the "intermatic.com" domain name on hold through NSI's dispute resolution process, Toeppen maintained "intermatic.com" as an active site on the Internet. Although he initially included a page on his site about a software program that he intended to call "Intermatic," Toeppen removed that page (which was on-line for less than one week) from his site and dropped the proposed name for his software in response to Intermatic's demand. No software programs were ever sold under the "Intermatic" name. In place of the offending page, Toeppen substituted a map of the community of Champaign-Urbana, Illinois (where Toeppen resides) on the "intermatic.com" Web site.

99. At no time did Toeppen actually use the "intermatic.com" domain name in connection with the sale of any presently-available goods or services. He did not advertise the "intermatic.com" domain name in association with any goods or services, and — after NSI placed the domain name on "hold" — the "intermatic.com" domain name was not available for use by any one. Toeppen claimed that he did not seek Intermatic's permission before registering the domain name because he believed that no permission was or is necessary.[226]

100. Intermatic brought suit against Toeppen for federal trademark infringement, federal unfair competition, federal and state trademark dilution, state law deceptive trade practices, and state law unfair competition claims. On cross-motions for summary judgment, the court held that to prevail on any of those claims other than the federal and state law trademark dilution claims, Intermatic needed to prove 1) its own prior rights in the Intermatic mark; and 2) that Toeppen's use of the domain name "intermatic.com" was likely to cause confusion, deception or mistake.[227] The analysis of whether consumer confusion was likely to ensue required weighing seven factors: 1) the degree of similarity between the marks in appearance and suggestion; 2) the similarly of products or services for which the name is used; 3) the area and manner of concurrent use; 4) the degree of care likely to be exercised by consumers; 5) the strength of the complainant's mark; 6) the existence of actual confusion; and 7) an intent on the part of the alleged infringer to palm off his products as those of another.[228] After reviewing these seven considerations, the court found that there were questions of fact as to any likelihood of confusion, thereby precluding the grant of summary judgment.

101. But, as in *Panavision*, the trial court granted summary judgment to Intermatic on its federal and state trademark dilution claims. The court began its analysis with a discussion of the Federal Trademark Dilution Act.[229] The FTDA permits a court to enjoin the use of a famous trade name or mark upon proof that 1) the plaintiff's mark is "famous"; 2) the mark had been used by the defendant in the "ordinary course of trade"; 3) the defendant's use of the mark had "lessened the ability of the mark to identify goods or services"; and 4) the balancing of the equities favors the plaintiff. The FTDA defines the term "dilution" to mean "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception."[230] Unlike traditional infringement claims, an FTDA claim for dilution requires neither proof that the other is a "competitor" nor proof of likelihood of confusion. In fact, the legislative history of the FTDA

indicated that it was specifically intended to address Internet domain name issues.[231] Under the FTDA, the only remedy available is injunctive relief unless the trademark owner shows that the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark.[232]

102. In granting summary judgment to Intermatic on its dilution claims, the court first held that the Intermatic mark was famous as a matter of law.[233] The court then went on to consider whether Toeppen was making commercial use of the Intermatic mark. The court held that the fact that the Internet site name included the top level domain designation of ".com" did not in and of itself establish a commercial use.[234] However, Toeppen's admitted intention to arbitrage the "intermatic.com" domain name constituted a commercial use of the name as a matter of law.

103. The court also found that Toeppen's use of the Internet satisfied the "in commerce" requirement of the statute, and found that Toeppen's conduct had caused dilution of the Intermatic mark in at least two different ways. First, by registering the "intermatic.com" domain name, Toeppen had lessened the ability of Intermatic to identify and distinguish its goods by using its mark as its domain name on the Internet.[235] Toeppen had effectively enjoined Intermatic from using its own trademark by the simple payment of the $100 registration fee to NSI. The court believed that this de facto injunction violated the clear congressional intent to encourage registration and development of trademarks to assist the public in differentiating products.[236] The court also found that Toeppen's conduct diluted the Intermatic mark by simple virtue of the fact that the "intermatic.com" domain name appeared on the Web page itself when viewed on-screen by the user and in any hard-copy printouts. The fact that the "intermatic.com" domain name would be displayed on every aspect of the Web page was alone sufficient to show that Intermatic's mark would likely be diluted.[237] The court therefore enjoined Toeppen from preventing Intermatic from obtaining the "intermatic.com" domain name, and required Toeppen to discontinue any and all use of the Intermatic mark.[238]

104. After Intermatic was awarded this injunctive relief, it abandoned its claims for relief under the Illinois anti-dilution act, common law unfair competition, the Illinois Uniform Deceptive Trade Practices Act, or the Illinois Consumer Fraud and Deceptive Business Practices Act. Prior to the final hearing on damages, Toeppen filed a motion in limine with respect to certain issues. In ruling on that motion, the court observed that because of the prompt injunctive relief obtained by the plaintiff, the "only item of potential damages of any consequence appears to be attorneys' fees."[239]

105. The *Intermatic* decision makes two critical points. First, where injunctive relief is available under the FTDA, there is generally no need to utilize any other legal theory. Second, where plaintiff acts promptly in seeking injunctive relief — as plaintiffs are required to do anyway under traditional trademark law — virtually no consequential damages apart from attorney fees are likely to be incurred.

106. One of the more recent cybersquatting cases is *Toys "R" Us, Inc. v. Abir*.[240] In that case, the defendant was an individual who discovered that the domain name "toysareus.com" had not been registered by the well-known toy retailer, Toys "R" Us.[241] The defendant was so bold as to write to Toys "R" Us, claiming that its failure to register that name was "foolish," and informing them that he had himself registered that name. He then offered it for sale to Toys "R" Us. When his demands were rebuffed, he again wrote to Toys "R" Us, threatening to establish a competing toy company that would sell its products using the "www.toysareus.com" domain name. This demand was made despite the defendant's rather frank admission that he intentionally copied the plaintiff's trademark when he registered the "toysareus.com" domain name.

107. Toys "R" Us sued the defendant for trademark infringement (Section 32(1) of the Lanham Act), false designation of origin (Section 43(a) of the Lanham Act), and trademark dilution (Section 43(c) of the Lanham Act). In addition, Toys "R" Us brought common law claims for violation of New York's unfair competition law.

108. In granting the requested injunctive relief, the court first found that an injunction was appropriate because the plaintiff had established a likelihood of success on the trademark infringement count. Toys "R" Us proved to the court's satisfaction that it had a valid mark subject to protection, and that the defendant's mark resulted in a likelihood of confusion. For that matter, likelihood of confusion was presumed as a matter of law because the defendant admitted that he intentionally copied the plaintiff's trademark.[242] The court also found that the plaintiff established a likelihood of success on their dilution claims because it established that the "'R' Us" marks are famous, and that the defendant's use of those marks in a commercial manner diluted those marks. Since those were the only two elements that must be established to prove a claim under the Federal Trademark Dilution Act, Toys "R" Us was entitled to injunctive relief.

109. Cybersquatters have now moved beyond the realm of appropriation of trademarks and trade names. In April 1998, it was reported that another "cybersquatter" registered as Internet domain names the personal names of 27 country & western music artists. The musicians whose names had been thus appropriated by the defendant filed suit in the U.S. District Court in Los Angeles. As of this writing, this suit remains pending. This appears to be the first case involving the use of celebrities' names by "cybersquatters."[243]

110. There is, however, a recent decision that inappropriately granted injunctive relief under the FTDA in a case involving domain names based on common surnames. The plaintiff in this case — styled as *Avery Dennison Corp. v. Sumpton*[244] — was the well-known office products company, Avery Dennison. As a commercial entity, Avery Dennison had already registered the domain names "averydennison.com" and "avery.com."[245] The defendant was an Internet access provider that had registered 12,000 of the most common surnames in the United States as domain names. It then rented those domain names for use as e-mail addresses to individuals in exchange for a nominal fee. As an Internet service provider, it registered those domain names under the ".net" top-level domain (which at least originally was intended to be reserved for use by Internet service providers) rather than the ".com" domain (which was originally intended for commercial use). Because the defendant provided these domain names for e-mail use only, more than one person could "lease" an e-mail address having their own last name as the domain name.[246] The court was obviously troubled by the defendant's wholesale registration of many last names, including the registration of the domain names "Avery.net" and "Dennison.net", which were the subject of the suit. Avery Dennison sued, seeking a transfer of the domain names. It alleged federal and state claims for trademark infringement, trademark dilution, and unfair competition.

111. On cross-motions for summary judgment, the district court granted summary judgment to Avery Dennison. Because the court granted the requested injunctive relief under the FTDA, it never reached the merits of any of the other legal theories. Applying the customary four-part analysis, the court first reached the conclusion that the Avery Dennison trademark was "famous" and was therefore entitled to protection under the Act. More troubling was the court's handling of the second element, that of whether the trademark had been used by another person "in the ordinary course of trade." The defendant argued — in this author's view, correctly — that it was not using the words "Avery" or "Dennison" as marks, but were rather using them as common last names. The court disagreed, and held that for the purposes of the Act, a famous mark is being "used in the ordinary course of trade" when it is 1) registered as a domain name by a registrant who is not otherwise identified by or associated with any of the commonly accepted meanings of the domain name; and 2) is not used by the registrant as its own domain name but is held by the registrant for sale or license to others.[247]

112. Moving to the third element, the court then concluded that the defendant's use of the mark had "lessened the ability of the mark to identify goods or services." The court simply refused meaningfully to address the fact that the plaintiff already had its "first" name (Avery) and its "full" name (Avery Dennison) registered in the commercial domain using the ".com" designation. The court responded to that argument only by making a conclusory statement that the ".net designation has not been preserved according to the original intent," and that the defendant's use of 12,000 domain names solely for e-mail addresses only was "not the highest and best use" of the domain names. The court cited no authority — which is not surprising, since there is none — in support of its implicit holding that a domain name may be registered only if the contemplated use by the registrant is the

"highest and best use" for the domain name.

113. Finally, under the fourth element, the court completely abandoned its duty to balance the equities of the parties. It granted Avery Dennison the rights to the domain names "Avery.net" and "Dennison.net," despite the fact that the plaintiff already had its name registered in the ".com" domain, and despite the fact that the defendant had spent more than $1,000,000 to register all of its surnames in the ".net" domain. Rather than balancing the equities, the court instead simply insinuated that it did not believe that the defendant intended indefinitely to continue leasing the surname domain names. The court as much as said that, because it would take a long time for the defendant to recover its investment, it must have some nefarious but unidentified ulterior purpose in mind.

114. The district court plainly erred in branding Sumpton as a "cybersquatter." The marks at issue — Avery and Dennison — were last names and nothing more. The defendant was not using the two last names together in any fashion. Further, the defendant's alleged "use" of the two surnames was not associated with any commercial enterprise whatsoever. On these facts, it was a bastardization of the purposes underlying the FTDA for the district court to enjoin the defendant's use of a common surname as a domain name simply because the surname has been registered as a trademark.

115. The *Avery Dennison* decision is presently on appeal to the Court of Appeals for the Ninth Circuit.[248] Neutral observers who hope to see fairness, justice and common sense prevail must surely hope that the Ninth Circuit will reverse this aberrant and irrational decision.

B. Competing Claims To A Domain Name By Companies With The Same Or Similar Names.

116. Not every instance of registering a domain name that includes another's trademark or trade name constitutes cybersquatting. With increasing frequency, two companies that have the same name, similar names, or identical acronyms have made competing legitimate claims for the same domain name. The first such instance reported in the cases appears to be that of *Act Media, Inc. v. Active Media International, Inc.*[249] In that case, the plaintiff federally registered its trademark "Act Media." Plaintiff used this mark in promoting and selling goods and services of others through creation of in-store signs, print displays, video and audio displays, sampling and couponing events, and the like. The mark had been used by the plaintiff since 1972 and had been registered since 1986. In 1995, the plaintiff began planning to go "on-line" through the Internet. It attempted to reserve the Internet domain name of "actmedia.com." When it attempted to do so, it discovered that the defendant, Active Media International, Inc., had already reserved that name.

117. The plaintiff then filed suit contending that the defendant's unauthorized use of its federally registered trademark constituted an unauthorized use and misappropriation of the plaintiff's mark under 15 U.S.C. § 1125, a false designation of origin, and a violation of the Illinois Anti-Dilution Act.[250] The court held that the defendant's reservation of the domain name constituted unfair competition under the Lanham Act, as well as a violation of the Illinois state law anti-dilution statute. The court did not mention the FTDA even though it went into effect approximately five months before the *Act Media* decision was handed down.

118. Considerably more analysis of the applicable law is found in two federal district court decisions decided just one day apart in *Juno On-Line Services, L.P. v. Juno Lighting, Inc.*,[251] and *Hasbro, Inc. v. Clue Computing, Inc.* [252] In *Juno On-Line Services*, the plaintiff sought a declaratory judgment that it had not violated trademark law. It also separately sought declaratory, injunctive and monetary relief from Juno Lighting for trademark misuse, violations of the Lanham Act and under the Illinois unfair competition statute. The plaintiff, Juno On-Line Services, was an on-line e-mail service provider with approximately 1.5 million subscribers. The defendant, Juno Lighting, was a manufacturer and retailer of recessed and track lighting. Juno Lighting had used the Juno name in its logo since 1976 and held two federal trademarks for the name "Juno."

119. In December 1994, Juno On-Line registered the domain name "juno.com" and began providing free e-mail

service. Several months later, it applied for federal service mark and trademark protection for the word "Juno." Juno Lighting sent a letter stating its opposition to Juno On-Line's trademark applications. Juno Lighting also requested that NSI cancel Juno On-Line's "juno.com" domain name. In addition, Juno Lighting registered the domain name "juno-online.com" in its own name. It did so to prevent others from obtaining the name and to allow it to transfer the name to Juno On-Line if that would help resolve the dispute over the "juno.com" domain name. Juno On-Line took exception to that activity and included in its complaint an allegation that Juno Lighting's registration of the domain name "juno-online.com" constituted a Lanham Act violation. Juno Lighting filed counterclaims for trademark infringement, trademark dilution, unfair competition, and other violations of Illinois state law.

120. Juno Lighting filed a motion to dismiss Juno On-Line's claims for trademark misuse, violations of Section 43(a) of the Lanham Act, and its state law claims for unfair competition and deceptive trade practices. The court granted the motion, struck all of Juno On-Line's claims for monetary relief (including punitive damages), and left standing only its claim for declaratory judgment. In doing so, the court observed that "trademark misuse" has never been recognized as a claim for affirmative relief, and found no reason to create new law by doing so in this particular instance.[253] With respect to Juno On-Line's Section 43(a) claim, the court found that merely obtaining and "warehousing" a domain name (without setting up any corresponding Web site or e-mail service associated with that domain name) is not enough to find that the defendant placed the mark on goods or "used or displayed [the mark] in the sale or advertising of services."[254] Finally, for exactly the same reasons, the court found that the "warehousing" of a domain name did not constitute "trade or commerce," thereby barring any state law claims for unfair competition or deceptive trade practices under Illinois law.[255]

121. Similar facts are before the court in the *Clue Computing* case. Hasbro, the plaintiff, is the owner of the "Clue" mark for the well-known board game of that same name. The defendant, Clue Computing, is a computer consulting company that was created in 1994. The reasons that the defendant chose "Clue" for its corporate name were completely unrelated to the game of Clue. Clue Computing requested and obtained from NSI a registration of the domain name "clue.com." Hasbro, the company that has marketed the Clue board game since 1944, desired to make a computerized version of the game available over the Internet. Hasbro had previously developed CD-ROM versions of other traditional games that were offered for sale at Hasbro's Web sites "monopoly.com," "scrabble.com," and others.[256] But in 1996, Hasbro discovered that Clue Computing owned the domain name "clue.com" and filed a trademark infringement suit against Clue Computing in federal district court. Hasbro's sole claim against Clue Computing was for trademark infringement.

122. The reported decision in *Clue Computing* addresses jurisdictional issues only. It does not discuss the merits of Hasbro's trademark infringement claim. The *Clue Computing* case is still pending on the merits at this writing. In an earlier case against a different defendant, Hasbro used the FTDA, rather than a traditional trademark infringement claim, to obtain the domain name "candyland.com." In *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*,[257] Hasbro showed that it had owned the trademark "candyland" for the board game of the same name since 1951. The defendants had established a sexually explicit Web site using "candyland.com" as its domain name. The district court found that the defendant's Hasbro demonstrated a probability of proving that the defendant's use of the "Candyland" mark as the domain name for a sexually explicit Internet site diluted the value of Hasbro's mark. It therefore entered a preliminary injunction enjoining the defendant from using the name "Candyland" or the domain name "candyland.com."[258] The "candyland.com" domain name is now used by Hasbro to sell a variety of its products.[259]

123. Another 1997 case involving two companies with competing legitimate claims for the same domain name was *Teletech Customer Case Mgmt., Inc. v. Tele-Tech Co., Inc*.[260] In that case, the plaintiff had used the mark Teletech (without a hyphen) since 1982. The defendant had used the name Tele-Tech (with a hyphen) since 1978. The defendant registered "teletech.com" as its domain name even though the name as spelled (without the hyphen) was plaintiff's federally registered service mark. The defendant claimed that it registered the "teletech.com" domain name without a hyphen because it was unaware that a hyphen could be used as part of a

domain name. The defendant's protestations of its innocent intentions were somewhat undercut, however, by evidence that the defendant demanded that the plaintiff pay the defendant to stop using the "teletech.com" domain name, and by the fact that the defendant subsequently registered "tele-tech.com" as a second domain name.[261]

124. The plaintiff's complaint included claims of trademark infringement under Section 32(1) of the Lanham Act, false designation of origin (also known as unfair competition) under Section 43(a) of the Lanham Act, and trademark dilution under both the FTDA (Section 43(c) of the Lanham Act) and California's state law anti-dilution statute. The court concluded that due to the dissimilarity in the nature of the business between the two companies, the plaintiff could not present sufficient evidence to demonstrate a likelihood of confusion to establish trademark infringement or false designation of origin. The court nonetheless concluded that the plaintiff was entitled to an injunction under the FTDA and the California anti-dilution statute, since no showing of likelihood of confusion is needed to entitle a plaintiff to injunctive relief in trademark dilution cases. Once again, the court specifically pointed out that the legislative history of the FTDA clearly communicated Congress' intent that it be used to address the Internet domain name issue.[262]

C. Intentional Use Of Another's Marks As Part Of A Domain Name

125. True "cybersquatting" generally consists of the wholesale use of another's registered trademarks or trade name as the domain name for an Internet site. But some have appropriated registered marks to be used as part — but not all — of a registered domain name. For example, in the *Calvin Designer Label* case [263] the defendants used the plaintiff's Playboy and Playmate marks as part of their domain names. Internet addresses for the defendant's two Web sites were "www.playboyxxx.com" and "www.playmatelive.com." Playboy Enterprises, the owner of the Playboy and Playmate marks, filed suit for trademark infringement, trademark dilution, and unfair competition. The court concluded that Playboy Enterprises was likely to succeed on the merits, and granted an injunction prohibiting the defendants from, inter alia, including the Playboy or Playmate marks within their domain names.[264]

126. Similar facts were before the court in *Playboy Enterprises, Inc. v. Universal Tel-A-Talk, Inc.*[265] In *Universal Tel-A-Talk*, the defendant established a Web site with the domain name "adultsex.com/playboy." It also used Playboy's registered marks within the Web site and established an authorized hypertext link between its Web site to Playboy's Web site located at playboy.com. Playboy Enterprises brought federal claims for trademark infringement, false designation of origin, trademark dilution and trademark counterfeiting, plus state law trademark infringement, trademark dilution, and unfair competition claims. After a bench trial on the merits, the court found that the defendant had infringed and counterfeited the plaintiff's registered marks and violated the state and federal anti-dilution statutes.[266] The court granted a permanent injunction prohibiting the defendants from using the Playboy mark as a domain name, directory, computer address, or the name of any Web site service.[267] It also awarded Playboy Enterprises statutory damages in the amount of $10,000.[268]

127. The most recent case involving an intentional use of a form of another's trademark as part of a domain name is *Jews for Jesus v. Brodsky*.[269] In *Jews for Jesus*, the plaintiff was an organization that teaches that Jesus is the Messiah of Israel and the Savior of the World. Its mission includes advocacy, education and religious camaraderie for both Gentiles and Jews. The plaintiff had used the name "Jews for Jesus" continuously in interstate commerce for more than 24 years. The phrase was both a common law service mark and also a registered service mark in which the "o" in the word "for" was stylized as a Star of David. In March 1995, the plaintiff established an Internet site with a domain name "jews-for-jesus.org." The defendant, Brodsky, was an attorney who was also a professional Internet site developer. The defendant described himself as a "vocal opponent of the plaintiff's mission, teachings, message and services." In December 1997, the defendant established the Internet site "jewsforjesus.org." When he did so, the defendant was also aware that the plaintiff had established its Web site and was aware of the plaintiff's federally-registered and common law service marks. The defendant reportedly stated that he established his Web site because the plaintiff "rubs [him] the wrong

way," and also reportedly said that the "intent behind my bogus ‘jewsforjesus’ site is to intercept potential converts before they have a chance to see the obscene garbage on the j4j site." Brodsky justified his use of the "jewsforjesus.org" domain name on the grounds that it did not contain the stylized letter "o" in the word "for."

128. The plaintiff organization claimed that Brodsky’s use of the "jewsforjesus.org" domain name constituted trademark infringement, false designation of origin, unfair competition, trademark dilution, and common law unfair competition. The court began its opinion by holding that the plaintiff was entitled to relief on its trademark infringement claim. The court relied in part upon a number of other decisions that had found that substantial similarity between the registered trademark and the domain name registered by the defendant constituted trademark infringement.[270]

129. The court also found that the plaintiff was entitled to relief under its federal trademark dilution claims. The court noted that the term "dilution" encompasses both of the traditional state law doctrines of "blurring" and "tarnishment."[271] "Blurring" occurs when the selling power and value of a mark is whittled away by the unauthorized use of the mark. This occurs where a prospective customer sees the plaintiff’s mark used by other persons to identify different sources of different goods and services, thus weakening the distinctive significance of the mark to identify and distinguish the source.[272] "Tarnishment" occurs when the unauthorized use of a famous mark is either linked to products of poor quality or is portrayed in an unwholesome manner that degrades the positive associations and the distinctive quality of the mark."[273] In *Jews for Jesus*, the defendant freely conceded that it was his intention to deceive and lure people interested in the plaintiffs’ organization to the defendant’s site, where the defendant then made disparaging statements about the plaintiff. Not surprisingly, the court concluded that the purpose and effect of the defendant’s conduct amounted to both "blurring" and "tarnishment," just as the court had in *Planned Parenthood*.[274]

130. Finally, the *Jews for Jesus* Court found that since the test for unfair competition (also sometimes called false designation of origin) under Section 43(a) of the Lanham Act is essentially the same as that for trademark infringement, the plaintiff was entitled to relief on that ground as well. And since the test for unfair competition under New Jersey state law was identical to that under Section 43(a) of the Lanham Act, the plaintiff’s state law claims also had merit. The court granted a preliminary injunction to the plaintiff organization.[275]

D. Registration Of Domain Names By Parody Sites

131. Another lively source of disputes are individuals or groups that seek to parody existing organizations. The reasons for the especially strong presence of parody on the Internet include easy access to the Web, the Internet’s instantaneous worldwide distribution, its low cost, and the relative ease of mimicking the appearance of the Web site[276] that is the subject of the parody.[277]

132. Most people have heard of the organization known as People for the Ethical Treatment of Animals. But one of the earliest (and still existing) parody sites was "www.peta.org," also known as the People Eating Tasty Animals site. This parody site consists of a series of links to articles and Web sites, and refers to itself as a resource for those who enjoy eating meat, wearing fur and leather, hunting and the fruits of scientific research and more. The original PETA — whose Web address is "www.peta-online.org" — demanded that the parody site surrender the "peta.org" address. The owner of the parody site refused to do so. NSI placed the "www.peta.org" domain name on hold, where it remains today. In the meantime, the parody site can be found at "www.mtd.com/tasty,"[278] where an invitation to join the "Domain Name Rights Coalition" is also prominently featured. Perhaps not surprisingly, the People Eating Tasty Animals group seeks to change NSI’s policies with respect to registration of domain names.

133. Other parody sites abound. There are metasites — such as the "Page o’ Spoofs"[279] and "Welcome to Parodyville"[280] — that do nothing more than collect links to other parody sites. Past and present parody sites also include ones parodying newspapers, including "The New Times York," "The Street Wall Journal,"[281] and

the "Washington Pissed."[282]

134. The New York New Media Association is parodied by a site which uses its orange-and-black NYNMA logo on the front page. But the parody site makes up a constantly-changing series of words to match the acronym (e.g., the Nothing You Need Media Association).[283]

135. The computer industry absorbs its share of pot shots from parody sites. Netscape has been parodied by sites called nimscape, nutscape, netape and veggiescape, while Microsoft has been parodied as Microsnot, the Mike Rosoff Network, and Microsos. In the same vein, America On-Line has been parodied as America Offline,[284] America OuttaLine, and America OnHold.[285]

136. The government naturally shares this unwanted form of attention. The official Web site for the presidential White House is "whitehouse.gov." An adult entertainment site has selected the domain name "whitehouse.com" to market its wares to the (presumably) unwary, while another site that parodies the official White House site can be found at "www.whitehouse.org."[286]

137. Academicians specializing in the application of First Amendment law to the Internet have concluded that "there should be a very broad First Amendment defense" for parody Web sites.[287] While no clear legal precedent has yet emerged, Professor Volokh counsels that courts should be "quite skeptical" of likelihood of confusion claims in the parody context.[288]

138. Parody constitutes a recognized "fair use" exception to copyright claims.[289] Parody has also been accepted as a First Amendment defense to state law tort claims for emotional distress where the parody "could not reasonably been interpreted as stating actual facts about the public figure involved."[290] The Supreme Court has applied the First Amendment in the Internet context, holding that those portions of the Communications Decency Act [291] prohibiting the knowing transmission of "indecent" or "patently offensive" communications to minors over the Internet abridged the First Amendment protection of free speech.[292]

V. The Duty Of Web Site Owners To Monitor The Internet For Unauthorized Links Or Others' Use Of Their Trade Names Or Marks, And To Minimize Or Mitigate Any Resulting Damages

A. The Principle of Avoidable Consequences

139. The common law has long recognized the doctrine of avoidable consequences.[293] This doctrine — similar to the concept of contributory negligence — denies recovery for any damages which could have been avoided by reasonable conduct on the part of the plaintiff.[294] Both contributory negligence and the doctrine of avoidable consequences rest upon the same fundamental policy of making recovery dependent upon the plaintiff's proper care for the protection of his own interests, and both require of him only the standard of a reasonable person under the circumstances.[295]

140. Some cases equate mitigation of damages with the doctrine of avoidable consequences.[296] To some degree this is inaccurate because the phrase "mitigation of damages" has no single meaning. Rather, "mitigation of damages" has been used by the courts to describe several different problems in the law of damages.[297] But when these courts have equated the two concepts, the essence of the concept of mitigation has been that when granting compensatory damages, certain of the parties' acts or failures to act are taken into account when computing the amount of the recovery.[298]

B. The Significance Of The Doctrine Of Avoidable Consequences To Potential Liability For Unauthorized Linking Or Framing Of Others' Web Sites

141. The doctrine of avoidable consequences requires a potential plaintiff to be familiar with and to use reasonably available technology to minimize or mitigate his damages.[299] The doctrine of avoidable consequences has — or should have, at any rate — the effect of requiring Web site operators to determine whether others have created unauthorized links to their sites and, if so, to take all reasonable, technologically feasible steps to minimize or eliminate the resulting damage.

142. Surprisingly, there is virtually no discussion in the academic literature about the applicability of this doctrine in the Internet context generally, much less with respect to unauthorized linking. In fact, the only discussion of the concept at all occurred in a panel discussion on October 15, 1997 about "link law" on the Internet.[300] In that discussion, the point was made that there are simple and inexpensive technological solutions available to solve the unauthorized linking problem without resorting to the expense and uncertainty of litigation. The panel members were asked whether the argument could be made that judicial action is inappropriate where the plaintiff has failed to use simple and readily available technological means of solving the problem.[301] The response given by the first panel member was that "if you have a fundamental answer to that, there is a job waiting for you."[302] A second panel member succinctly rephrased the question — without even attempting to answer it — by asking, "What is the duty to mitigate damages by implementing technological solutions?"[303] The answer — at least so far — is that there is no answer.

143. The critical importance of this issue is that there are technological solutions to most of the unauthorized linking or framing problems. These methods — which can block or redirect unauthorized links — are so simple and readily available that it is difficult to understand why anyone would want to resort to litigation rather than use the quick, certain, and comparatively inexpensive technological fix instead. In fact, this may be the very reason why there is so little law or commentary on this issue. For example, if a Web site operator does not wish to have his site "framed" by the operator of a linking site, the linked site operator need only include readily-available anti-framing programming into his Web site.[304] Many Web site operators have already incorporated this programming that prevents others from framing their site, including The New York Times,[305] CNN,[306] The Los Angeles Times,[307] and USA Today[308].

144. With respect to ordinary hypertext or image links, it is a simple enough matter to regularly check to see who, if anyone, has linked their site to yours.[309] Using one of the major commercial search engines, a Web site owner can determine free of charge where all links to the owner's site exist.[310] Regularly checking for unauthorized links is already being described as "good commercial practice" for Web site owners.[311] Unauthorized and unwanted links can then be blocked in a number of other ways. A Web site operator can — again through the use of a few lines of programming — block anyone from linking into her site from other specified sites.[312] The technology already exists to prevent a linking site from by-passing the linked site's Home Page.[313] For example, Ticketmaster could — and now does — use technology that determines where a Net user was before arriving at its site. It could screen any travelers from Microsoft's Sidewalk sites and redirect them to Ticketmaster's home page instead of the "deep link" within the site.[314]

145. Unauthorized linking can also be prevented by limiting access to the site to paid subscribers, or by imposing registration and password requirements that allow access to the site only to those who have previously registered.[315] Alternatively, a Web site operator can program an automatic change of his URL address (rendering links established by other Web site operators obsolete) on a regular basis, although this obviously poses some problems (or at least annoyance) for users that have "bookmarked" the page for easy access.[316] In short, as one author put it, "There is usually a technological solution to any linking problem that is perceived to be offensive."[317] That same author — without explicitly referring to either the doctrine of avoidable consequences or a plaintiff's duty to minimize or mitigate damages — noted that "Some have suggested that all technological options should be exhausted before resort to litigation."[318] On both the practical and the legal levels, this author echoes that sentiment.

146. A Web site operator can, through language on the home page of his Web site, expressly require permission or the

payment of a fee to create a link to his site.[319] This is often done through the use of a list of terms and conditions for users that is displayed the first time any user accesses a site. These terms and conditions can expressly require the permission or fee before establishing a link. Where the user must "click to accept" the terms and conditions before proceeding further, it is generally believed — though far from certain — that courts will enforce a provision prohibiting the user from establishing an unauthorized link to the page.[320]

147. Such click-to-accept terms and conditions are often referred to as "clickwrap agreements." In *Hotmail Corp. v. Van$ Money Pic Inc.*,[321] the court enforced a "clickwrap" agreement in which the defendants had agreed to refrain from using their e-mail accounts with Hotmail to send spam or pornography to others. And in *Compuserve Inc. v. Patterson*,[322] the United States Court of Appeals for the Sixth Circuit stated that by typing in the word "agree" at various points in an on-line document at CompuServe, the defendant had "entered into a written contract with CompuServe" that could be enforced in court. Cyberlaw experts have concluded that, based on these authorities and others, on-line agreements to specified terms and conditions of use appear to be valid and enforceable.[323]

148. It is now fashionable in some circles for corporations to enter into "linking agreements." These linking agreements expressly permit the parties to link their respective Web sites, and often include provisions for the sharing of resources, maintaining quality standards, establishing performance criteria, and managing site availability.[324] The American Bar Association has published a handbook that includes model contract provisions and commentary on Web linking issues.[325] The ABA handbook's table of contents, preface, and introduction are available for preview on the ABA's Web Site.[326] Other publications also provide suggested language to be included in license agreements allowing the creation of a hypertext link.[327]

149. All of these self-help remedies are consistent with the notion that Web site publishers must learn to accept linking as a fact of life on the Internet, and that Web site owners should themselves take whatever measures are reasonably necessary to protect and preserve their proprietary interests.[328] The automatic assumption that the linked site is invariably harmed by unauthorized linking is neither factually supportable, nor consistent with Internet culture. In both legal and computer circles, it is generally thought that there is no infringement or other improper conduct when an unauthorized link is created unless the linking site attempts to defame, disparage, or take credit for, that which appears on the linked site.[329] An attorney who owns an Internet consulting company in White Plains, N.Y., concedes that linking liability cases can almost always be avoided by the use of technology alone without resort to litigation.[330]

C. The Difficulty Of Applying The Doctrine Of Avoidable Consequences

150. It is very easy for a Web site operator to determine whether any other sites have created an unauthorized link. If such links exist — and if they are deemed objectionable — it is very easy to restrict, block, or otherwise cope with any such unauthorized and unwanted link, and to limit any damages to the time and expense required to effectuate the blocking measures. Why shouldn't the doctrine of avoidable consequences impose such a duty to limit any recoverable damages to the costs of implementing those technological solutions?

151. There are at least two conceptual impediments to the application of the avoidable consequences doctrine in this setting. First, in a few states the doctrine of avoidable consequences does not apply in cases of intentional torts.[331] Frankly, this position is difficult to understand or justify. Taking, for example, the duty of a plaintiff to seek medical treatment after an injury, it is difficult, if not impossible, to understand why the duty should exist where the plaintiff is negligently struck by the tortfeasor, but should not exist if the physical contact was intentional. It is equally difficult to understand why the plaintiff in most such situations would not be motivated to minimize damages out of plain, old-fashioned self-interest. Other courts — apparently recognizing the lack of any justification by limiting the doctrine to negligence actions — have held that the rule of avoidable consequences does apply even in actions involving intentional tort,[332] although one of those courts held that the avoidable consequences doctrine does not apply to those intentional torts that result in a damage to property

rights.[333]

152. The American Law Institute, in the RESTATEMENT (SECOND) OF TORTS, appears to moderate the extremes of these two views. Under § 918(2) of the RESTATEMENT (SECOND), it is provided that one is not prevented from recovering damages for a particular harm resulting from an intentional tort, unless the injured person intentionally or heedlessly failed to protect his own interests. The comments to this section state that the intent was to provide that the "merely careless or stupid is thus protected from consequences that the tortfeasor intended or was willing to have occurred while, on the other hand, the person who stubbornly refuses to protect his own interests is given no legal redress."[334]

153. Anyone familiar enough with Internet technology to own and operate a Web site knows, or should easily be able to learn, how to block or restrict unauthorized links. For that reason, Web site operators that fail to take reasonable, technologically feasible steps to protect their own interest and limit their damages have, in the opinion of this author, raised themselves to the level of persons "who stubbornly refuse to protect [their] own interests." Under the RESTATEMENT (SECOND) formulation, Web site operators — especially commercial Web site operators — have a duty to minimize damages under the avoidable consequences doctrine.

154. The second possible impediment to the applicability of the doctrine of avoidable consequences is somewhat more problematic. Under the traditional common law formulation, the rule of avoidable consequences came into play only *after* the legal wrong had occurred, but while some damages could still be avoided.[335] The drafters of the RESTATEMENT (SECOND) incorporated this common law limitation in § 918(1), which provides that (except in the case of intentional torts described above) one injured by the tort of another is not entitled to recover damages that he could have avoided by the use of reasonable effort or expenditure *after the commission of the tort*.[336] But in recent years, many courts have begun to reject the notion that a plaintiff's duty to take those steps necessary to minimize or mitigate his damages is limited to post-tort conduct. This issue has most frequently arisen in the context of a plaintiff's failure to use helmets, seatbelts or child safety seats.

155. One of the first cases to stake out this position was the Arizona Court of Appeals in the case of *Law v. Superior Court*.[337] The plaintiff in *Law* was involved in a one-car rollover accident. At the time, Arizona did not have a mandatory seatbelt law. In connection with certain discovery matters, the trial court ruled that the plaintiff's failure to wear seatbelts as a cause of his injuries was irrelevant and that the plaintiff had no duty to wear seatbelts. On appeal, the court of appeals noted that the doctrine of avoidable consequences had historically been applied to the plaintiff's post-accident conduct. But the court could find no logical reason to refrain from applying the doctrine of avoidable consequences to the plaintiff's failure to take appropriate precautionary measures to minimize his damages even before the tortious conduct occurred:

> In our opinion, the failure to wear seat belts should be viewed as an aspect of the doctrine of avoidable consequences and the broader rule requiring mitigation of damages. See generally W. Prosser & W. Keeton, *The Law of Torts* § 65 at 458-59 (5th ed. 1984)(Prosser). Under the doctrine of avoidable consequences, a person who is "injured as a the result of the negligence of another is bound to exercise ordinary care to prevent or reduce the damages consequent to an injury, and cannot recover enhanced damages growing out of his failure to use such care.'" *Sanders v. Beckwith*, 79 Ariz. 67, 71-71, 283 P.2d 235, 238 (1955)(quoting 65A C.J.S. Negligence § 135 (1950)). This rule is commonly applied to post-accident conduct. We find no logical reason to refrain from applying the avoidable consequences rule to the preaccident conduct of failing to use an available seat belt. Although one has no duty to anticipate the negligence of others, we would be engaging in judicial fiction if we perpetuate the myth that the occurrence of an automobile accident is not foreseeable. Because "the seat belt affords the automobile occupant an unusual and ordinarily unavailable means by which he or she may minimize his or her damages prior to the accident," *Spier v. Barker*, 35 N.Y.2d at 452, 363 N.Y.S.2d at 922, 323 N.E.2d at 168, we hold that the doctrine of avoidable consequences applies to the pre-accident conduct of failure to use an

available seat belt. *Restatement (Second) of Torts* § 465, comment *c* (1965) (Damages may be apportioned where the antecedent negligence of the plaintiff is a contributory factor to the harm which ensues).[338]

156. The case was appealed to the Arizona Supreme Court. The Arizona Supreme Court affirmed the court of appeals, and reiterated that the doctrine of avoidable consequences could be applied to reduce the recovery of a plaintiff who failed to avail himself of reasonably available protective measures even before the tortious conduct occurred:

> Everyone has a "duty" to use due care to prevent injury to others. Nonuse of a seat belt is not a question of duty but rather a matter of conduct which only occasionally impinges on others. Thus, we believe that injuries sustained by the plaintiff as a result of his nonuse of an available seat belt are not so much a failure to use care to avoid endangering others but part of the related obligation to conduct oneself reasonably to minimize damages and avoid foreseeable harm to oneself. *Markowitz, supra*; *Coburn, supra.*
>
> Thus, the seat belt defense would ordinarily raise issues concerning the doctrine of avoidable consequences -- a theory that denies recovery for those injuries plaintiff could reasonably have avoided. W. Prosser & W. Keeton, *supra*, at 458. Plaintiffs argue that this doctrine is applied only to post-accident conduct and is inapplicable to events preceding the accident -- a time when plaintiffs supposedly had a right to assume that others would not act negligently. Assuming this is ordinarily true, we believe the common law conceptualization of the doctrine of avoidable consequences has been modified by our comparative negligence statute, which applies that doctrine to pre-accident conduct.[339]

Courts in many other states have also held that the doctrine of avoidable consequences is not limited to post-accident conduct.[340]

157. Other courts, however, have continued to limit the doctrine of avoidable consequences to post-accident conduct by the injured party. One of these cases was decided in 1976 by the Oklahoma Supreme Court, again in the context of seatbelt defense litigation. In *Fields v. Volkswagen of America, Inc.*,[341] the court concluded that the seatbelt defense should not be applied because the duty to mitigate damages is — in that court's view — limited to the plaintiff's post-tort conduct:

> During the trial on damages, the trial court sustained Fields' objections to the admission of testimony that he was not wearing his seat belt and also refused appellants' requested instruction to the jury that failure to wear a seat belt could be considered in mitigation of damages. Appellants claim error.
>
> This is a question of first impression in this court. There is no common law or statutory duty requiring the use of seat belts. Imposition of new and recent technological advances are not usually inducted into doctrines of law, until such time as they have been sufficiently tried, proven and accepted for the purpose they were intended. Historically, the seat belt phenomenon is in its infancy. It is in a state of influx.* * *
>
> If the appellants in this case are guilty of the acts of negligence as alleged, which caused the accident and resulting injuries, then they should be held accountable as constitutionally and statutorily required. If the allegations of negligence are true, appellee did nothing to cause the accident. Should he be required to anticipate the negligence of the appellants?
>
> We think not. One's duty to mitigate damages cannot arise before he is damaged. The failure to minimize must occur after the injury. At most the failure of the appellee to use the seat belt merely furnished a condition by which the injury was possible. It did not contribute to or cause the accident. It is well established in our court that if the negligence merely furnishes a condition by which the injury was

> possible, and a subsequent act caused the injury, the existence of such a condition is not the proximate cause of the injury.[342]

The number of courts that have held that a plaintiff's non-use of safety devices prior to the defendant's tortious act cannot be used to show the plaintiff's failure to minimize or mitigate his damages equals or exceeds the number of courts that have allowed such evidence.[343]

158. Many of the seatbelt, child seat, and motorcycle helmet decisions were heavily influenced by the statutes then extant requiring their use. Many of those statutes also specifically stated whether evidence of non-use was admissible for any purpose. It is this author's view — at least in situations involving business torts, property damage and/or intellectual property issues rather than personal injury —that a plaintiff's failure to take appropriate measures to block or redirect unwanted links and to minimize damages should bar recovery of all losses that the plaintiff could have avoided. This should be so regardless of whether the plaintiff's precautionary measures should have been put in place either before or after the allegedly wrongful act of the defendant occurred. The reasons why plaintiffs should be required to use existing technology for their own protection were spelled out by the Arizona Supreme Court and the lower appellate court in the *Law* case. Significantly, when the *Law* case was decided, Arizona had no statute requiring the use of seatbelts or addressing the admissibility of evidence of non-use for mitigation of damages. The expression of public policy found in the *Law* decision was therefore not affected by any prior legislative directive on how the avoidable consequences issue should be handled.

159. The available consequences doctrine should also apply to cases alleging tortious misuse of trade names or marks in metatags or domain names. The law already places an affirmative duty on trademark owners to monitor the Internet to assure that their marks are not being infringed or diluted.[344] Good commercial practice — in addition to trademark law — compels the owner of a registered mark or name to regularly search the Internet for those who may be using the owner's protected marks or names for their own commercial purposes.[345]

160. In short, commercial entities — and virtually all entities complaining about unauthorized links are commercial enterprises — should be expected to do that which is commercially reasonable to protect their own interests. Such enterprises should not be permitted to utilize the Internet as a mechanism to seek unlimited damage awards when they could and should have taken the steps that could have resulted in reducing their claim for damages to a trifle (if not eliminating the claimed damage altogether).

161. In the same vein, the FTDA provides an immediate remedy to a trademark owner who learns of an unauthorized use of his mark in someone else's metatag or domain name. If injunctive relief is promptly sought, there is rarely any significant monetary loss. If, however, a trademark owner fails vigilantly to protect the mark by monitoring the Web for unauthorized uses of it, the avoidable consequences doctrine should bar the recovery of damages that could have been avoided if the trademark owner had been vigilant.

VI. Conclusion

162. Clearly, the establishment of an unauthorized link from one Web site to another exposes the owner of the linking site to potential tort liability any number of ways. The possible tort claims that can result from an unauthorized linking range from the obvious (copyright infringement, trademark infringement, trademark dilution, false designation of origin, and unfair competition) to the sublime (invasion of privacy, defamation, tortious interference with contract, consumer fraud, or false and deceptive trade practices).

163. Technology readily available to anyone capable of maintaining a Web site readily permits the blocking of an unauthorized links, redirecting such links to the desired entry point, and the disabling of any "frames" software used on the linking site. Under these circumstances, should a plaintiff be permitted to seek an award of substantial money damages for an injury that the plaintiff could (and should) have avoided by the minimal

expenditure of time and effort before the injury occurred? No. The well-established Web culture generally implies a license to link without prior authorization. Every potential plaintiff makes a conscious decision to avail itself of the Internet knowing that unauthorized links were possible (or even probable), and every potential plaintiff has the technology available to detect and prevent unauthorized links. Given these facts, this author firmly believes that the doctrine of avoidable consequences could and should prohibit a plaintiff from claiming as damage any injury it could have avoided through the implementation of reasonable, technologically feasible safeguards either before or after the allegedly tortious conduct.

164. As for the unauthorized use of trade names or trademarks within other sites' domain names or metatags, the best remedy available — in those cases where any remedy at all is appropriate — is clearly the injunctive relief available through the Federal Trademark Dilution Act. The legislative history of the FTDA shows that it was intended to serve just that purpose.

165. It is true that the FTDA protects only "famous" marks. On the other hand, if a mark isn't "famous," it is extremely unlikely that others would have any reason to make any inappropriate use of it. It is not necessary for a plaintiff to show likelihood of confusion in order to be entitled to relief under the FTDA. And where a plaintiff is a vigilant in maintaining a lookout for others using its registered trade names or marks as metatags or domain names — which vigilance is required under existing trademark law — the cases have recognized that there generally are no other meaningful damages that result from such unauthorized uses other than attorney fees. Commercial services exist that will assist a corporation in searching for others engaging in the unauthorized use of trade names or marks as metatags or domain names.

166. Trademark owners will also have to recognize that some uses of registered trade names or marks in other sites' metatags are appropriate. These include instances where the trade name or mark is being used in connection with product comparisons, criticism, or commentary on the performance of products, or is being used by distributors of those products.

167. The same holds true for the use of trade names and marks within domain names. Such marks may properly be used by sites that enjoy First Amendment protection for parody or other protected speech. Similarly, such marks might be used by others who have the same or similar name or acronym (as in the *Juno* and the *Act Media* cases).

168. In light of the injunctive relief provided for in the FTDA — which is available on a minimal showing of blurring or tarnishment — this author believes that there is no need for similar protection to be granted to trademark owners under other tort law theories. Further development of alternative tort law remedies is therefore both unlikely and unnecessary. The FTDA provides a vigilant plaintiff with a nearly immediate method of obtaining injunctive relief in appropriate cases. Where relief is timely sought, there is rarely any significant damage incurred other than attorney fees. In those cases where a trademark owner has not been vigilant in searching out others using its name or mark, the trademark owner should be precluded from recovering damages that could have been avoided under both traditional trademark law and the doctrine of avoidable consequences.

169. The Congressional purpose behind the enactment of the FTDA was to protect owners of trademarks and trade names from inappropriate use of them on the Internet by others. The statute is fulfilling that purpose (perhaps too well, in cases like *Avery Dennison*). If any use of a trade name or mark is not prohibited by the FTDA, then it is not — and should not be — prohibited by any other body of tort law.

Footnotes

[*] B.S. 1980, University of Virginia; J.D. cum laude 1984, University of Akron School of Law. The author is an

Adjunct Professor at the University of Akron School of Law and is a partner in the firm of Hanna, Campbell & Powell in Akron, Ohio.

[1] *See, e.g.*, Klingenberg v. City of Raleigh, 194 S.E. 297, 301 (N.C. 1937) ("Time marches on — and so must the law.").

[2] Jonathan Howe, *Legal Tangles In The Web; Tips For Meeting Professionals On Setting Up Web Sites*, 33 MEETINGS & CONVENTIONS 36 (Aug. 1998).

[3] *Id.*

[4] Denver Area Educ. Telecomm. Consortium, Inc. v. FCC, 518 U.S. 727 (1996).

[5] *Id.* at 741-42.

[6] Cass R. Sunstein, *Foreword: Leaving Things Undecided*, 110 HARV. L. REV. 6, 30-33 (1996).

[7] *See*, Digital Equip. Corp. v. Altavista Tech., Inc., 960 F. Supp. 456, 463 (D. Mass. 1997).

[8] *See, e.g.*, Kara Beal, *The Potential Liability of Linking on the Internet: An Examination of Possible Legal Solutions*, 1998 BYU L. Rev. 703 (1998).

[9] Reno v. ACLU, 521 U.S. 844 (1997).

[10] *Id.* at 849-50.

[11] *Id.* at 850.

[12] *Id*. (quoting ACLU v. Reno, 929 F. Supp 824, 844 (E.D. Pa. 1996)).

[13] *Id.*

[14] *Id.* at 851.

[15] *Id* at 852.

[16] *Id.*

[17] *Id.*

[18] Beal, *supra* note 8 (citing *How the Web's Fabric Could be Torn Apart*, S. CHINA MORNING POST, Feb. 20, 1997 at 8).

[19] *Id.*

[20] The two most frequently used "browser" software packages are Netscape Navigator and Internet Explorer. *See Netscape Emerges as Most Popular Internet Browser*, INTERNET BUSINESS NEWS, Mar. 1, 1995.

[21] Reno v. ACLU, 521 U.S. at 852.

[22] *Id.*

[23] *Id.*

[24] *Id.* at 853.

[25] Jane Bryant Quinn, *Internet Can't Beat Catalogs*, Akron Beacon Journal, Dec. 15, 1998, at D7.

[26] *Id*.

[27] Michael Higgins, *Secret Messages — Tough-to-Crack Encryption Techonology Has Feds, Law Enforcement Officials, In A Code Sweat*, A.B.A. J., Jan. 1999, at 78.

[28] Frank C. Gomez, *Washington Post v. Total News*, 13 Berkeley Tech. L.J. 21 (1998).

[29] Stuart D. Levi, *Web-site Hypertext Links Raise Issues of Control*, Nat'l L. J., Aug. 12, 1996, at B12.

[30] William J. Cook, *Have You Been Framed?*, Chicago Lawyer, May, 1997, at 70.

[31] Gomez, *supra* note 28 at p. 21.

[32] *See, Study Predicts Online Ad Revenues Will Reach $2 Billion in 2000*, E.D.P. Weekly 009, July 22, 1996, at 1, *available in* 1996 WL 9720172; *see also, Web Advertising Expected to Grow 500 Pct.*, Philadelphia Inquirer, June 7, 1997 at 1, *available in* 1997 WL 8698016.

[33] Personal jurisdiction issues are beyond the scope of this article, but they have been thoroughly discussed — often with conflicting conclusions — in many court decisions and law review articles. *See, e.g., Maritz, Inc. v. Cyberbold, Inc.*, 947 F. Supp. 1328 (E.D. Mo. 1996) (holding that Missouri court had personal jurisdiction over California defendant in plaintiff's trademark action arising out of defendant's Web site); *Bensusan Restaurant Corp. v. King*, 937 F. Supp. 295 (S.D. N.Y. 1996), *aff'd*, 126 F.3d 25 (2d Cir. 1997) (holding that a New York court did not have jurisdiction over a Missouri defendant in the New York plaintiff's trademark action arising out of the defendant's Web site); Robert W. Hamilton & Gregory A. Castanias, *Tangled Web: Personal Jurisdiction and the Internet*, 24 LITIG. 27 (Winter 1998); Sean M. Flower, Note, *When Does Internet Activity Establish the Minimum Contact Necessary to Confer Personal Jurisdiction*, 62 MO. L. REV. 845 (1997); Karin Mika & Aaron J. Reber, *International Jurisdictional Issues: Fundamental Fairness In A Virtual World*, 30 Creighton L. Rev. 1169 (1997).

[34] Intermatic Inc. v. Toeppen, 947 F. Supp. 1227, 1230 (N.D. Ill. 1996).

[35] *Id.*

[36] *Id.* at 1231.

[37] *Id.*

[38] *Id.*

[39] *Id.*

[40] *See, Network Solutions' Domain Name Dispute Policy* (effective Feb. 25, 1998) <http://www.networksolutions.com/legal/dispute-policy.html>.

[41] *Id.;* Jeri Clausing, *Opening Up The Internet Name Game: U.S. Committee Considers A Lottery To End Net Registrar's Monopoly*, INT'L HERALD TRIBUNE, Jan. 23, 1999, at 9.

[42] Clausing, *supra* note 41.

[43] David Post, *Hypertext Attracts Users and Litigants*, LEGAL TIMES, July 14, 1997 at 23.

[44] Cook, *supra* note 30.

[45] Richard Raysman & Peter Brown, *Dangerous Liaisons: The Legal Risks of Linking Web Sites*, N.Y. L.J., Apr. 8, 1997 at 3.

[46] *Id.*

[47] Carol Ebbinghouse, *Webmaster Liability: Look Before You Link, and Other Admonitions for Today's Web Master*, 6 SEARCHER 19, n. 15 (Feb. 1998). A press release describing this coverage can be found on Chubb Insurance Company's Web site at (visited Dec. 16, 1998) <http://www.chubb.com/news/pr19970815.html>.

[48] Raysman & Brown, *supra* note 45.

[49] Playboy Enter. Inc. v. Chuckleberry Publ'g, Inc., 939 F.Supp. 1032, 1040 (S.D. N.Y. 1996) (citing *ACLU v. Reno*, 929 F. Supp. 824 (E.D. Pa. 1996)).

[50] Ralph A. Taylor, *Internet Technology Poses Legal Pitfalls*, 24 LITIG. NEWS 5 (November 1998).

[51] Stephen J. Davidson & Nicole A. Engisch, *Trademark Misuse in Domain Name Disputes*, 13 COMPUTER LAWYER 13 (Aug. 1996).

[52] Bensusan Restaurant Corp. v. King, 126 F.3d 25, 27 (2nd Cir. 1997).

[53] M. A. Stapleton, *Playboy Settles Internet 'Framing' Trademark Case*, CHI. DAILY L. BULL. 1, 1 (May 21, 1997).

[54] Raysman & Brown, *supra* note 45 at 3.

[55] *Id. See also* Martin J. Elgison & James M. Jordan III, *Trademark Cases Arise From Meta-Tags, Frames*, NAT'L L.J. (col. 3), Oct. 20, 1997.

[56] Raysman & Brown, *supra* note 45.

[57] *Id.*

[58] *Id.*

[59] *Id.*

[60] *Id.*

[61] *Id.*

[62] *Id.*

[63] *Id.*

[64] *Id.*

[65] Paul C. Van Slyke, *Hypertext Hysteria*, 13 Tex. Law. S9 (1997); Emily Madoff, *Freedom to Link Under Attack*; *Web Community Up In Arms Over Lawsuits*, N.Y.L.J., (June 23, 1997) at S1.

[66] Van Slyke, *supra* note 65; Mary M. Luria, *Controlling Web Advertising: Spamming, Linking, Framing, and Privacy*, 14 NO. 11 Computer Law. 10, 13 (1997); Beal, *supra* note 8, at 709-10.

[67] Beal, *supra* note 8, at 708.

[68] *Id.*

[69] *Id.* at 709-10.

[70] *Id.* at 709; *see also* Van Slyke, *supra* note 65; Madoff, *supra* note 65.

[71] *Clause of the Month - Linking Provisions in On-Line Agreements*, 14 No. 5 Computer L. Strategist 2 (1997).

[72] *Potential Liability of Linking*, *supra* note 8, at 709.

[73] *Id.* & n.30.

[74] *Id.* at 734.

[75] Luria, *supra* note 66, at 12.

[76] Robert Neuwirth, *Is The Simple Act Of Pointing Toward Someone Else's Online Address The Equivalent Of Stealing Private Property?*, 21 In These Times 18, Oct. 20, 1997.

[77] Scot. Sess-Cas., (Oct. 24, 1996), 1 E.I.P.L.R. 723 (Nov. 1, 1996).

[78] *Microsoft's Link to Ticketmaster Site Spurs Trademark Lawsuit*, Andrews Sports & Ent. Litig. Rep., May 30, 1997, at 15.

[79] Jonathan Wills, *Shetland Times Internet Case Settled Out of Court*, The Shetland News & Magazine, Nov. 11, 1997 (visited Nov. 13, 1999) <http://www.shetland-news.co.uk/headline/97nov/settled/settled.html>.

[80] On October 28, 1998, President Clinton signed into law the "Digital Millennium Copyright Act." Title II of the Act, called the "On-Line Copyright Infringement Liability Limitation Act of 1998" (S. 2037), protects Internet service providers from copyright liability for the mere transmission of content supplied by others. The Act does not, however, in any way address copyright liability for owners of Web sites that create HREF or IMG links to Web pages maintained by others without obtaining the prior permission of the linked site.

[81] Beal, *supra* note 8 at 712 & n.46.

[82] Under the "words and short phrases" doctrine, phrases such as titles are not copyrightable. *See, e.g., Apple*

Computer, Inc. v. Microsoft Corp., 799 F. Supp. 1006, 1036 (N.D. Cal. 1992).

[83] No. 97-3055 DDP (C.D. Cal., filed Apr. 12, 1997).

[84] Barry D. Weiss, *Metasites Linked to IP Violations*, NAT'L L.J., July 21, 1997, at B9 (col. 2).

[85] Wendy R. Leibowitz, *The Pace of Pacer*, NAT'L L. J., Oct. 19, 1998, at A20 (col. 1).

[86] David L. Hayes, *Application of Copyright Rights to Specific Acts on the Internet*, 15 COMPUTER LAW. 1, 16 (1998).

[87] Raysman & Brown, *supra* note 45.

[88] *Id.*

[89] *Id.*

[90] *See, e.g.*, Stella Plumbridge, *Webcasting Part 2: Legal and Regulatory Issues*, WORLD BROADCAST NEWS, Mar. 30, 1998 ("Since linking does not involve any copying, current copyright law is not infringed."); Beal, *supra* note 8, at 726 ("Because there is no direct copying involved in hyperlinking, these links should not be restricted by copyright law. . . ."); Kenneth Freeling & Joseph E. Levi, *Frame liability Clouds The Internet's Future, Lawsuit Protests Web Programming Trick*, N.Y.L.J., May 19, 1997, S5 (col. 1) ("There are no reported decisions on whether a Web site that simply provides a hyperlink to copyrighted material would be liable for direct copyright infringement. It is, however, unlikely that a court would find against a link problem in such a case."); Gomez, *supra* note 28, at 26 ("Currently, there is an absence of case law addressing whether linking constitutes the creation of a 'copy' of another work. A technical understanding of linking suggests that it does not.").

[91] Brad Templeton, *Linking Rights*, (visited Nov. 13, 1998) <http://www.templetons.com/brad/linkright.html>.

[92] *See* Mark Sableman, *Business on the Internet, Part II: Liability Issues*, 53 J. MO. BAR 223, 225-26 (1997) (noting that prohibitions against linking could undercut the viability of generally implied licenses). *See* also, Templeton, *supra* note 91 (stating that it is reasonable to imply a license to link if the link neither bypasses a security system nor advertising, and if there is no stated prohibition against linking).

[93] Freeling & Levi, *supra* note 90.

[94] Beal, *supra* note 8, at 726.

[95] *Id.*

[96] *Id. But see* Hayes, *supra* note 86, at 8 & 16 (noting that an argument could be made that an HREF link can lead to contributory infringement and/or constitute an unauthorized derivative work).

[97] Kristi L. Vaiden, *A Discussion of Some of The Recent Developments in Cyberlaw*, THE METRO. CORP. COUNSEL, July 1998, at 19 (col. 1).

[98] The explanation of the reasons for and history of the dispute is found at <http://www.cs.rice.edu/~dwallach/dilbert/> (visited Nov. 13, 1999). This URL includes all of the correspondence between United Media and Dan Wallach, the creator of the "Dilbert Hack Page."

[99] E-mail from Joelle Boulin, United Media (containing a letter from Jonathan Shapiro, VP Corporate Development,

United Media), to Dan Wallach, Dept. of Computer Science, Princeton University (Jul. 19, 1996) (last modified Aug. 4, 1996) <http://www.cs.rice.edu/~dwallach/dilbert/letter1.html>.

[100] E-mail from John Parker, Esq., Baker & Hostetler, L.L.P., to Dan Wallach, Dept. of Computer Science, Princeton University (Aug. 8, 1996) (last modified Aug. 8, 1996) <http://www.cs.rice.edu/~dwallach/dilbert/letter5.html>.

[101] *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971).

[102] *See*, Freeling & Levi, *supra* note 90.

[103] 17 U.S.C. § 107 (1999).

[104] *See* Freeling & Levi, *supra* note 90.

[105] *Id.*

[106] *Playboy Enterprises, Inc. v. Universal Tel-A-Talk, Inc.*, 1998 U.S. Dist. LEXIS 17282 (E.D. Pa. 1998).

[107] *Id.* at 15.

[108] Beal, *supra* note 8.

[109] *Id.*

[110] Levi, *supra* note 29 at B12.

[111] 15 U.S.C. § 1125(c) (1999).

[112] *Id.*

[113] H.R. Rep. No. 104-374, at 4 (1995), *reprinted in* 1996 U.S.C.C.A.N. 1029, 1031.

[114] *Id.*

[115] Beal, *supra* note 8.

[116] *Id.*

[117] *Playboy Enterprises, Inc. v. Universal Tel-A-Talk, Inc.*, 1998 U.S. Dist. LEXIS 17282 (E.D. Pa. 1998).

[118] Weiss, *supra* note 84; Peter Jakab, *Facts and Law of Web Linking* (visited Nov. 24, 1998) <http://www.computerbar.org/seminars/97Jakab.htm>.

[119] *Id.*

[120] Raysman & Brown, *supra* note 45.

[121] Weiss, *supra* note 84.

[122] *Id.*

[123] *Id.*

[124] *See*, Stuart D. Levi & Rita A. Rodin, *Para-sites: Eating Away At Web Profitability?*, 1 No. 11 CYBERSPACE LAWYER 2, 3 (1997), *quoted in*, Weiss, *supra* note 84.

[125] Van Slyke, *supra* note 66.

[126] Raysman & Brown, *supra* note 45.

[127] *Id.*

[128] Weiss, *supra* note 84.

[129] It is possible for a user to learn the URL of the framed site by positioning the cursor over the framed window, clicking once with the right mouse button, and choosing "properties." This will display the URL of the window.

[130] *Id.*

[131] *Washington Post Co. v. Total News, Inc.*, No. 97-1190 (P.K.L.) (S.D.N.Y. filed Feb. 20, 1997) (visited Sep. 25, 1999)< http://www.carltons-dundee.co.uk/features/wpvtotal.htm>.

[132] Interestingly, in March of 1997 when the suit against Total News was filed, the Washington Post's own Web site used frame technology to link to other sites. *See*, Todd Woody, *"We've Been Framed," Nation's Newspapers Cry*, LEGAL TIMES 35 (1997).

[133] *"Framing" of Web Content Is Infringing, Publishers Allege in NY Suit*, THE ENTERTAINMENT LITIGATION REPORTER (May 30, 1997).

[134] Van Slyke, *supra* note 66.

[135] Weiss, *supra* note 84.

[136] Vaiden, *supra* note 97.

[137] Freeling & Levi, *supra* note 90.

[138] 17 U.S.C. § 106(2) (1999).

[139] Freeling & Levi, *supra* note 90.

[140] *Id.*

[141] *Id.*

[142] *Id.*

[143] *Id.*

[144] Stapleton, *supra* note 53; Weiss, *supra* note 84.

[145] 960 F. Supp. 456 (D. Mass. 1997).

[146] 960 F. Supp. at 476-479.

[147] 1998 U.S. Dist. LEXIS 2265 (C.D. Cal. Jan. 30, 1998).

[148] 856 F.2d 1341 (9th Cir. 1988).

[149] 1998 U.S. Dist. LEXIS 2265, at *8-*9.

[150] 964 F.2d 965 (9th Cir. 1992).

[151] 964 F.2d at 968.

[152] 1998 U.S. Dist. LEXIS 2265, at *10.

[153] *Id.*

[154] *Futuredontics, Inc. v. Applied Anagramics, Inc.*, 1997 U.S. Dist. LEXIS 22249 (C.D. Cal. Nov. 24, 1997).

[155] *Futuredontics, Inc. v. Applied Anagramics, Inc.*, 1998 U.S. App. LEXIS 17012 (C.D. Cal. July 23, 1998).

[156] Freeling & Levi, *supra* note 90.

[157] *Id.*, (citing William F. Patry, Copyright Law and PRACTICE 823 (1994)).

[158] *Id.* (citing Gilliam v. American Broadcasting Cos., 538 F.2d 1424 (2d Cir. 1976) (holding that an author has the right to prevent the presentation of his work to the public in a distorted form)).

[159] *Id.* (citing, WGN Continental Broadcasting Co. v. United Video, Inc., 693 F.2d 622, 626 (7th Cir. 1982) (holding that if the publisher of a book leaves the inside covers blank, the book seller cannot add an inscription to broaden the book's appeal)); *National Bank of Commerce v. Shaklee Corp.*, 503 F. Supp. 533, 544 (W.D.Tex. 1980) (holding that the unauthorized insertion of advertisements in a book constitutes a copyright violation).

[160] Raysman & Brown, *supra* note 45.

[161] *Id.; see also, Digital*, 960 F.Supp. at 476 ("The same facts which would support an action for trademark infringement would also support an action for unfair competition").

[162] W. Page Keaton et al., Prosser and Keaton on the Law of Torts (5th ed. 1984) at 1015 (hereinafter "*Prosser*"); *see also*, Robert L. Tucker, *Vexatious Litigation As Unfair Competition and the Applicability of the Noerr-Pennington Doctrine*, 22 Ohio N.U.L. Rev. 119, 126-27 (1995) ("Rather, the foundation of an unfair competition action may consist of any conduct by the defendant of such a persistent and continuous nature as has resulted in damage to the plaintiff in the production and sale of its wares.").

[163] Vaiden, *supra* note 97.

[164] Robert Baron, *Invisible Ink and Unfair Competition: Metatags Hit The Internet*, 70 J. Coatings Tech. 92 (June

1998).

[165] *Id.*

[166] *Id.*

[167] It is interesting to note that the Excite search engine now ignores metatags in its indexing and filters to cut down on the abuse of hidden keywords and phrases in Web sites. *See* Ebbinghouse, *supra* note 47 at n.9.

[168] William H. Murray & Robert E. Rosenthal, *Examining The Use of Trademarks as Metatags On The Internet*, in THE LEGAL INTELLIGENCER, Nov. 6, 1997, at 9*; see also*, *Excite Info* (visited Nov. 13, 1999) <http://www.Excite.com/Info/listing.html>.

[169] Murray & Rosenthal, *supra* note 168.

[170] *Link Law on the Internet, A Panel Discussion*, 38 IDEA 197 (1998).

[171] *Id.*

[172] Murray & Rosenthal, *supra* note 168.

[173] To view the metatag for any given page, one first simply travels to the page itself. Then, one clicks on the "view" menu choice. From the scroll-down menu that pops up, one then clicks on the "source" menu option. A notepad screen will be displayed, which includes information pertaining to the hypertext mark-up language used to establish the site. In scrolling down this notepad, one will generally see one or more lines prefaced with "meta name equal" followed by a line beginning with "content equal." The words, phrases, or initials appearing after the "content equal" reference will be the key words incorporated as the "metatags" for that site by its developer. *Link Law on the Internet*, *supra* note 170, at 205-06.

[174] Baron, *supra* note 164.

[175] *Id.*

[176] 985 F. Supp. 1220 (N.D. Cal. 1997).

[177] *Id.* at 1221.

[178] No. 97-2064 (E.D. La. Aug. 26, 1997) (final consent judgment entered).

[179] *Oppedahl & Larson v. Advanced Concepts*, No. 97-CV-1592 (D. Colo. filed July 23, 1997).

[180] As reported in Baron, *supra* note 164.

[181] 1998 U.S. Dist. LEXIS 10359 (E.D. Va. 1998).

[182] 15 U.S.C. § 1114 (1).

[183] 15 U.S.C. § 1125(a).

[184] 15 U.S.C. § 1125(c)(1).

[185] *Calvin Designer Label*, 985 F. Supp. 1220; *Asiafocus*, 1998 U.S. Dist. LEXIS 10359; *Insituform*, No. 97-2064 (E.D. La. Aug. 26, 1997); *Oppedahl & Larson*, No. 97-CV-1592 (D. Colo. filed July 23, 1997).

[186] *Insituform*, No. 97-2064 (E.D. La. Aug. 26, 1997).

[187] *Asiafocus*, 1998 U.S. Dist. LEXIS 10359; *see also*, Murray & Rosenthal, *supra* note 168.

[188] *Link Law on the Internet*, *supra* note 170 at 214.

[189] Murray & Rosenthal, *supra* note 168.

[190] *Insituform*, No. 97-2064 (E.D. La. Aug. 26, 1997); *Oppedahl & Larson*, No. 97-CV-1592 (D. Colo. filed July 23, 1997); Vaiden, *supra* note 97.

[191] Murray & Rosenthal, *supra* note 168.

[192] *Id.*

[193] Baron, *supra* note 164.

[194] *Id.*

[195] Murray & Rosenthal, *supra* note 168.

[196] Eileen Glanton, *Companies Accuse Web Search Engines of Abusing Their Names*, A.P. World Stream (Feb. 12, 1999), *quoting* Prof. John T. Soma of the University of Denver School of Law.

[197] Greg Miller and Davon Maharaj, *Banner Ads On The Web Spark A Trademark Battle*, L.A. Times (Feb. 11, 1999) at A1.

[198] *Id.*

[199] *Id.*

[200] Laurie J. Flynn, *Several Lawsuits Challenge Internet Ads*, The N.Y. Times (Feb. 15, 1999) at C4.

[201] *Id.*

[202] Glanton, *supra* note 196.

[203] Found at www.namestake.com (visited Feb. 15, 1999). This Web site provides what it describes as "Domain Name, Trademark, and Competitive Intelligence Services." In this author's opinion, this Web site should be the first stop for every company seeking to determine whether its registered mark or name has been sold by one of the major search engines.

[204] Davidson & Engisch, *supra* note 51.

[205] Intermatic Inc. v. Toeppen, 947 F. Supp. 1227 (N.D. Ill. 1996).

[206] *Id.*

[207] Davidson & Engisch, *supra* note 51.

[208] *Id.*

[209] NSI's domain name dispute policy is found at http://www.networksolutions.com/legal/dispute-policy.html (visited Oct. 15, 1999).

[210] *Intermatic* at 1233.

[211] 1 Gilson, TRADEMARK PROTECTION AND PRACTICE, § 5.11[4] (1996) p. 5-237.

[212] Miller, *Cyber Squatters Give Carl's Jr. Others Net Loss*, L.A. TIMES (July 12, 1996) at A1 (available at 1996 WL 11004750).

[213] *Id.*

[214] *Id.*

[215] *Intermatic* at 1230.

[216] *Id.; see also,* Panavision Int'l v. Toeppen, 938 F.Supp. 616, 619 (C.D. Cal. 1996).

[217] 938 F.Supp. 616 (C.D. Cal. 1996).

[218] *Id.* at 619.

[219] Panavision v. Toeppen, 945 F.Supp. 1296, 1304-05 (C.D. Cal. 1996).

[220] *Id.* at 1303.

[221] Panavision Int'l, L.P. v. Toeppen, 141 F.3d 1316 (9th Cir. 1998).

[222] *Id.* at 1325.

[223] *Id. at 1327.*

[224] *Id.*

[225] *Intermatic*, at 1227.

[226] *Id.* at 1233.

[227] *Id.* at 1234.

[228] *Id*. at 1234-1235.

[229] 15 U.S.C. § 1125(c).

[230] *Intermatic*, at 1238 (citing 15 U.S.C. §1127).

[231] *Id.*

[232] *Id.* (citing 15 U.S.C. §1125(c)(4)(B)).

[233] *Id.* at 1239.

[234] *Id.*

[235] *Id*. at 1240.

[236] *Id.*

[237] *Id.* at 1241.

[238] *Id.* The Magistrate's Report and Recommendation was adopted by the district court the following month in Intermatic Inc. v. Toeppen, 947 F. Supp. 1227 (N.D. Ill. 1996) (decided November 26, 1996).

[239] Intermatic, Inc. v. Toeppen, No. 96-C1982, 1998 U.S. Dist. LEXIS 15431, at *5-*6 (N.D. Ill. Feb. 25 1998).

[240] No. 97.CIV.8673, 1997 U.S. Dist. LEXIS 22431 (S.D.N.Y. Dec. 19, 1997).

[241] An Internet search conducted on December 29, 1998, found that the domain name for the Toys "R" Us site is still <www.toysrus.com>.

[242] 1997 U.S. Dist. LEXIS 22431, at *8.

[243] Chet Flippo, *Country Artists Sue "Cybersquatter,"* BILLBOARD, April 25, 1998.

[244] 999 F. Supp. 1337 (C.D. Cal. 1998), *rev'd* No. 98-55810, 1999 U.S. App. LEXIS 19954 (9th Cir. 1999).

[245] It is interesting to note that another commercial entity, Dennison & Associates, had already registered the name "dennison.com." Nevertheless, that entity was not named as a party to this case and its use of the "dennison.com" domain name apparently remains unchallenged to this day.

[246] For example, if this author wished to obtain an e-mail address having his own last name as the domain, he could lease the e-mail address "Robert@Tucker.net." Others having the Tucker surname but a different first name or nickname would likewise be able to register their own e-mail addresses (i.e. "Audrey@Tucker.net" or "Daniel@Tucker.net"). Hundreds or thousands of people could share each of these domain names in this manner.

[247] *Avery Dennison*, at 1339-40.

[248] As reported in David M. Kelly & Marjorie Goux, *Taking Thy Name in Vain*, I.P. MAGAZINE (July 1998).

[249] No. 94-5647, 1996 U.S. Dist. LEXIS 20814 (N.D. Ill. July 29, 1996).

[250] *Id.* at *3-*4.

[251] 979 F. Supp. 684 (N.D. Ill. Sept. 29, 1997).

[252] 994 F. Supp. 34 (D. Mass. Sept. 30, 1997).

[253] 979 F. Supp. at 690-91.

[254] *Id.* at 691 (quoting 15 U.S.C. § 1127) (brackets in original).

[255] *Id.* at 692. Juno On-Line's claim for declaratory judgment and Juno Lighting's counterclaims against Juno On-Line remain pending at the time of this writing.

[256] 994 F. Supp. at 38.

[257] No. C96-130WD, 1996 U.S. Dist. LEXIS 11626 (W.D. Wash. Feb. 9, 1996).

[258] *Id.* at *3.

[259] <http://www.candyland.com> (visited Nov. 13, 1999).

[260] 977 F. Supp. 1407 (C.D. Cal. 1997).

[261] *Id.* at 1410, 1413.

[262] *Id.* at 1413.

[263] *supra* note 176.

[264] 985 F. Supp. at 1221. While the case is still pending at this writing, it is terminated to at least one of the defendants, Calvin Fuller, who filed a voluntary petition of bankruptcy. A notice of that filing was filed with the district court in the *Calvin Designer* case on November 6, 1998.

[265] *supra* note 106.

[266] *Id.* at *21.

[267] *Id.* at *22-23.

[268] *Id.* at *22.

[269] 993 F. Supp. 282 (D.N.J. 1998).

[270] Among others, the court cited the decision in *Planned Parenthood Federation of America, Inc. v. Bucci*, 1997 U.S. Dist. LEXIS 3338 (S.D.N.Y. 1997), *affirmed*, 1998 U.S. App. LEXIS 22179 (2d Cir. 1998), *cert. denied*, ____ U.S. ____, 119 S.Ct. 90 (1998), in which the defendant, an outspoken opponent of Planned Parenthood, registered the domain name "plannedparenthood.com." The court in *Planned Parenthood* granted a preliminary injunction after finding that the defendant's domain name was likely to cause confusion. The *Jews for Jesus* Court also relied upon the decision in *Cardservice Int'l v. McGee*, 950 F. Supp. 737 (E.D. Va. 1997), *affirmed*, 1997 U.S. App. LEXIS 32267 (4th Cir. 1997), in which the court found a likelihood of confusion between the plaintiff's trademark "Cardservice International" and the defendant's domain name "cardservice.com."

[271] 993 F.Supp. at 306.

[272] *Id.* at n. 30 (citing 3 McCarthy on Trademarks and Unfair Competition, § 24:94, at p. 24-160 (4th ed. 1997)).

[273] *Id.* at n. 31.

[274] *Id.* at 307.

[275] *Id.* at 313. As of this writing, the plaintiff's Web site is called up regardless of whether the domain name "www.jews-for-jesus.org," or "www.jewsforjesus.org," is utilized. No host site was found under the domain name "www.jewsforjesus.com." (All sites visited December 29, 1998.)

[276] Logos, graphics, and images are easily copied from other Web sites. One need only position the cursor over the desired image, click once on the right mouse button, then select the "Save As" feature. The user may then choose a name for the electronic file that will hold an electronic copy of the image in the BMP format. The user can then modify the image in any desired manner, or can instead simply incorporate the image "as is" into another Web site.

[277] Rebecca Quick, *Try http://www.thejokesonyou.com*; *Webcrawling With Pesky Parody Sites*, *Parody Sites Are Proliferating Wildly on the Web*, THE HOUSTON CHRONICLE, March 30, 1997, Business at 5.

[278] Visited December 24, 1998.

[279] Formerly found at <http://www.bcpl.lib.md.us/ndbroida/spoof.html>, but no longer available.

[280] (visited Nov. 13, 1999) <http://www.octane.com/Parodyville/>.

[281] *Id.*

[282] (visited Nov. 23, 1999) <http://c3f.com/index.html>.

[283] Quick, *supra* note 277.

[284] (visted Nov. 23, 1999) <http://www.Kelani.com/aol/about.html>.

[285] *Id.*

[286] (visited Nov. 23, 1999).

[287] Prof. Eugene Volokh of the UCLA Law School, *quoted in*, Quick, *supra* note 277.

[288] *Id.*

[289] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).

[290] Hustler Magazine v. Falwell, 485 U.S. 46 at 50 (1988).

[291] 47 U.S.C.A. § 223 (1997).

[292] *Reno*, 521 U.S. at 870 ("We agree with [the district court's] conclusion that our cases provided no basis for

qualifying the level of First Amendment scrutiny that should be applied to this medium.").

[293] *Prosser*, *supra* note 162, at 458.

[294] *Id.*

[295] *Id*. (citing CHARLES T. MCCORMICK, HANDBOOK ON THE LAW OF DAMAGES §§ 33 and 35 (1935); American Ry. Exp. Co. v. Judd, 104 So. 418 (Ala. 1925); James B. Berry's Sons Co. v. Presnall, 35 S.W.2d 83 (Ark. 1931); Stewart Dry Goods Co. v. Boone, 202 S.W. 489 (Ky. 1918).

[296] Britton v. Doehring, 242 So. 2d 666 (Ala. 1970); Darnell v. Taylor, 236 So. 2d 57 (La. Ct. App. 1970), *cert. denied*, 239 So. 2d 346 (La. 1970); Braun v. Lorenz, 585 S.W.2d 102 (Mo. Ct. App. 1979); Angelos v. First Interstate Bank, 671 P.2d 772 (Utah 1983).

[297] *See generally*, 22 Am. Jur. 2d *Damages* § 492 (1988 & Supp. 1997).

[298] *Id.* (citing White v. North Bergen, 391 A.2d 911 (N.J. 1978)).

[299] Cline v. American Aggreg. Corp., 582 N.E.2d 1, 6 (Ohio Ct. App. 1989), *motion overruled*, 48 Ohio St. 3d 708 (1990), (approving a jury instruction stating that plaintiffs could not recover damages they could have avoided "by use of reasonably available technology"); Parking Mgmt., Inc. v. H.B. Jacobson, 257 A.2d 479, 481 (D.C. Cir. App. 1969) (holding that a duty to mitigate damages may not be avoided by a claimed ignorance of the instrumentation designed to warn of the hazardous condition).

[300] The complete text of the discussion is reprinted in *Link Law on the Internet*, *supra* note 170.

[301] *Id.* at 233.

[302] *Id.*

[303] *Id.* at 235.

[304] Luria, *supra* note 68 at 14 ("It is already clear that framing can be prevented by technical means and some site owners have implemented this technology."); Post, *supra* note 43 ("[A]ny news organization can insert a few lines of code in its Web site program to prevent TotalNews from retaining its frames around the site.").

[305] *Id.*

[306] Woody, *supra* note 132 at 35.

[307] *Id.*

[308] *Link Law on the Internet*, *supra* note 170 at 208.

[309] Ebbinghouse, *supra* note 47 ("Scripts can be written that notify you when someone links to your site.").

[310] In Beal, *supra* note 8 at 710 n.32, the author explains that site owners who want to find out which sites link to theirs can tell simply by visiting the Alta Vista Web site at http://altavista.digital.com and typing "LINK: (Web address)." This command will tell the site owners where all links to their sites are coming from. The same service is offered by the search engine known as Hotbot (www.hotbot.com). *See*, Walter Effross, *Legal Responsibilities of*

Virtual Storekeepers: Rules of the Road, Steps Can Reduce Seller's Potential Liability, N.Y.L.J., Aug. 17, 1998, at S5.

[311] *Id.*

[312] Post, *supra note* 43; Gomez, *supra* note 28.

[313] Luria, *supra* note 66 ("It is also possible to technologically prevent a link from by-passing the title, index page or other authorized entry points. . . . ").

[314] Virginia Baldwin Hick, *Companies Strive to Define Law of the Net*, St. Louis Post Dispatch, Dec. 21, 1997, at E1.

[315] Raysman & Brown, *supra note* 45; Gomez, *supra* note 28; Beal, *supra* note 8.

[316] *Id.*

[317] Jakab, *supra* note 118.

[318] *Id.*

[319] Plumridge, *supra* note 90; Ebbinghouse, *supra* note 47.

[320] Ebbinghouse, *supra* note 47; Luria, *supra* note 66 ("Web click contracts may well be enforceable and the law is moving in the direction of clarifying enforceability.").

[321] 1998 U.S. Dist. LEXIS 10729 (N.D. Cal. 1998).

[322] 89 F.3d 1257 (6th Cir. 1996), *reh'g denied*, 1996 U.S. App. LEXIS 24796 (1996).

[323] Richard Raysman & Peter Brown, *Clickwrap License Agreements*, N.Y.L.J., Aug. 11, 1998, Computer Law at 3.

[324] Vaiden, *supra* note 97.

[325] *Web-Linking Agreements: Contracting Strategies and Model Provisions* (ABA 1997).

[326] (visited Oct. 15, 1999) <http://www.abanet.org/buslaw/catalog/5070311toc.html>.

[327] *Clause of the Month*, *supra* note 71.

[328] Beal, *supra* note 8.

[329] *Id.*

[330] Hick, *supra* note 314 (quoting Mark Pruner).

[331] *See, e.g.*, American Smelting & Refining Co. v. Riverside Dairy & Stock Farm, 236 F. 510 (8th Cir. 1916) (applying Utah law); Price v. High Shoals Mfg. Co., 64 S.E. 87 (Ga. 1909); Johnston v. Galva, 147 N.E. 453 (Ill. 1925); Niagara Oil Co. v. Ogle, 98 N.E. 60 (Ind. 1912); Cumberland Grocery Co. v. Baugh's Admr., 152 S.W. 565 (Ky. 1913); Allen v. Morris Bldg. Co., 103 N.W.2d 491 (Mich. 1960); Galveston H. & S. A.R. Co. v. Zantzinger, 48 S.W. 563 (Tex. 1898).

[332] *See* Underwood v. Smith, 73 So. 2d 717 (Ala. 1954); Kleinclaus v. Marin Realty Co., 211 P.2d 582 (Cal. Ct. App. 1949).

[333] *Underwood, supra* note 332.

[334] RESTATEMENT (SECOND) OF TORTS § 918 cmt. a (1979).

[335] *See Prosser, supra* note 162 at 468 n.70 (citing McCormick, supra note 295 at § 33); Dippold v. Cathlamet Timber Co., 225 P. 202 (Or. 1924); Armfield v. Nash, 31 Miss. 361 (1856); Bailey v. J.L. Roebuck Co., 275 P. 329 (Okla. 1929); Gilbert v. Mayor & Council of City of Athens, 655 F.2d 73 (5th Cir. 1981)).

[336] RESTATEMENT (SECOND) OF TORTS § 918(1) (1979).

[337] 755 P.2d 1130 (Ariz. Ct. App. 1986).

[338] 755 P.2d at 1131-32.

[339] 755 P.2d at 1141-42.

[340] *See, e.g.*, Noth v. Scheurer, 285 F. Supp. 81 (E.D.N.Y. 1968) (seatbelt case); O'Keefe v. Kansas City Western Ry. Co., 124 P. 416 (Kan. 1912); Halvorson v. Voeller, 336 N.W.2d 118 (N.D. 1983) (holding that a motorcyclist's failure to wear a helmet may constitute a failure to mitigate damages even where there is no statute requiring the wearing of a helmet.); Mikaelian v. Accurso, 422 N.Y.S.2d 750 (N.Y. App. Div. 1979) (affirming jury's one-sixth reduction of damages awarded to an infant injured in an automobile accident where that proportion of the damages was found to have resulted from the failure to use a seatbelt). *See also*: Diehl v. Ogorewac, 836 F.Supp. 88 (E.D.N.Y. 1993); Allstate Ins. Co. v. Lafferty, 451 So. 2d 446 (Fla. 1984); Vredeveld v. Clark, 504 N.W.2d 292 (Neb. 1993); Barcello v. Rubin, 578 So. 2d 58 (Fla. Dist. Ct. App. 1991); Bales v. Shelton, 399 S.E.2d 78 (Ga. Ct. App. 1990); Sewell v. Wofford, 475 N.E.2d 575 (Ill. App. Ct. 1985); Waterson v. General Motors Corp., 544 A.2d 357 (N.J. 1988).

[341] 555 P.2d 48 (Okla. 1976).

[342] *Id.* at 61-62.

[343] In many cases, the courts have held or recognized that non-use of a seatbelt by a plaintiff who was injured in a motor vehicle accident is not admissible for the purpose of reducing the damages to be awarded. *See, e.g.*: Dillinger v. Caterpillar, Inc., 959 F.2d 430 (3d Cir. 1992) (citing Pa.C.S.A. § 4581(e)); Barron v. Ford Motor Co. of Canada Ltd., 965 F.2d 195 (7th Cir. 1992) (applying N.C. law); Freeman v. Case Corp., 924 F. Supp. 1456 (W.D. Va. 1996), *rev'd on other grounds*, 118 F.3d 1011 (4th Cir. 1997), *cert. denied*, 118 S. Ct. 739 (1998) (applying Virginia law) (citing Va.Code § 46.2-1094(E)); Clarkson v. Wright, 483 N.E.2d 268 (Ill. 1985)(citing Ill. Rev. Stat., ch. 95 1/2, ¶ 12-603.1 (1985)); Partman v. Budget Rent-A-Car of Westchester, Inc., 649 A.2d 275 (Conn. Super. Ct. 1995) (citing C.G.S.A. section 14-100a(c)(4)); Miller v. Coastal Corp., 635 So. 2d 607 (La. Ct. App. 1994)(citing LSA-R.S. § 32:295.1(E)); Glyn-Jones v. Bridgestone/Firestone, Inc., 857 S.W.2d 640 (Tex. Ct. App. 1993), *reh'g denied*, (July 7, 1993) *and writ granted*, (Dec. 8, 1993) *and decision aff'd and remanded*, 878 S.W.2d 132 (Tex. 1994)(citing Tex.Rev.Civ.Stat.Ann. art. 6701d, § 107C(j) (1992).

[344] *See* Elgison & Jordan, *supra* note 55; James M. Jordan, *Get On Your Marks!*, found at (visited Nov. 23, 1999) <http://www.ipmag.com/ajordan.html>.

[345] *See* Murray & Rosenthal, *supra* note 168; Ebbinghouse, *supra* note 47 ("Vigilantly search out others who begin abusing your trade/domain name and call them on it.").