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**TRADEMARK LAW ON THE INTERNET—
WILL IT SCALE? THE CHALLENGE TO DEVELOP
INTERNATIONAL TRADEMARK LAW**

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TRADEMARK LAW ON THE INTERNET—WILL IT SCALE? THE CHALLENGE TO DEVELOP INTERNATIONAL TRADEMARK LAW

by DAVID W. MAHER†

I. INTRODUCTION

The rapid growth of the Internet¹ has had at least one unintended effect, a serious collision between the efficient functioning of the domain name system ("DNS") and the claims of trademark owners. The architects of the DNS originally attempted to side-step trademark issues,² but the courts in the United States and other countries have clearly recognized that domain names can have trademark implications.³ In order to

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1. See generally Byron F. Marchant, *On-Line on the Internet: First Amendment and Intellectual Property Uncertainties in the On-Line World*, 39 How. L.J. 477, 479-80 (1996) (describing the Internet as "a broadband electronic network through which digitized information, such as voice, video, or data is transmitted"); James West Marcovitz, *RONALD@MCDONALDS.COM—"Owning a Bitchin" Corporate Trademark as an Internet Address—Infringement?*, 17 CARDOZO L. REV. 85, 89 (1995) (describing the Internet as "a group of globally-networked computers containing several million 'host' or 'site' computers that provide information services" and discussing the initial stages of the "Net"); cf. Jon Postel, *Domain Name Structure and Delegation* (March, 1994) <<http://ds.internic.net/rfc/rfc1591.txt>>.

2. Alexander Gigante, *Blackhole in Cyberspace: The Legal Void in the Internet*, 15 J. MARSHALL J. COMPUTER & INFO. L. 413, 426 (1997) (stating that Internet engineering groups originally "insist[ed] that they never intended domain names to be trademarks").

3. See, e.g., *ActMedia, Inc. v. Active Media International, Inc.*, No. 96C3448, 1996 WL 466527 (N.D. Ill. July 17, 1996) (holding in favor of trademark owner and enjoining infringer from continued use of domain name which incorporated trademark owner's mark; discussing Illinois' Anti-Dilution Act); *Panavision Int'l, L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996) (holding that defendant's registration of trademark owner's marks as Internet domain names violated federal and California law); *Playboy Enterprises, Inc. v. Chuckleberry Publishing Inc.*, 687 F.2d 563 (2d Cir. 1996) (holding that Playboy Enterprises successfully enjoined the defendant from using "Playmen" as an Internet site); *MTV v. Curry*, 867 F. Supp. 202 (S.D.N.Y. 1994) (holding not entered in trademark infringement action because parties settled out-of-court). See generally John C. Yates & Michael R. Greenlee, *Intellectual Property on the Internet: Balance of Interests Between the Cybernauts*

where in the world that controls the administration of the Internet. The answer to the question "who's in charge?" is: "no one."

In the field of intellectual property law, national law (and in the United States, state law) has already been applied to a number of legal problems that have arisen because of transmissions on the Internet.¹⁰ There are now a number of well-publicized examples of the exercise of local jurisdiction over the content transmitted on the Internet.¹¹ The issues of defamation, copyright infringement, trademark infringement, and the distribution of obscene or pornographic material have all been dealt with by courts in many jurisdictions.¹² This paper will not attempt to survey the law on these issues but will focus rather on the vexing question of how to accommodate the interests and rights of trademark owners in the DNS and in the overall administration of the Internet.

II. BACKGROUND

Numerous contributors to the ongoing debate about the DNS on various Internet mailing lists (e.g., "newdom" and "domain-policy") have argued that the DNS was never intended to cope with trademarks and that domain names were simply intended to provide an easy mnemonic device for recalling the addresses of users.¹³ The argument is made that domain

("NSF"),] . . . administers the registration of domain names that end in '.com', '.edu', '.org', '.gov' and '.net,'" has faced the enormous amount of trademark issues only since mid-1994).

10. See *ActMedia, Inc.*, 1996 WL 466527, at *1 (applying the Illinois' Anti-Dilution Act); *Hasbro, Inc. v. Internet Entertainment Group Ltd.*, No. C96-130 WD, 1996 U.S. Dist. LEXIS 11626 (W.D. Wash. Feb. 9, 1996) (applying the Federal Dilution Act of 1995, whereby the court enjoined the defendants from using the domain name "Candyland.com" or similar name likely to dilute the value of Hasbro's CANDYLAND trademark); Yates & Greenlee, *supra* note 3, at 16 (discussing Georgia law restricting the "use of . . . e-mail addresses on the Internet . . . [so that] a person will be guilty of a misdemeanor by transmitting data over the Internet that uses a . . . registered trademark to falsely . . . imply that . . . [he or she] has a right to use the . . . registered trademark . . . when such authorization has not . . . been granted"); see also *California Bill Would Bar Trademark Infringement in Domain Names*, 3-5-96 WEST'S LEGAL NEWS 1166, March 5, 1996 (discussing California Senate's consideration of "legislation that would make it illegal to use a trademark in an Internet domain name without permission from the owner").

11. See generally Mark Epstein, *Dealing with Jurisdictional Issues Presented by the Internet*, MULTIMEDIA STRATEGIST, Oct. 1996, at 1 (1996) (examining cases dealing with personal jurisdiction over alleged infringers of trademarks on the Internet).

12. See generally Karen S. Frank, *Potential Liability on the Internet*, 437 PLI/PAT 417 (1996) (discussing liability on the Internet by way of defamation, privacy, and obscenity issues).

13. Gary W. Hamilton, *Trademarks on the Internet: Confusion, Collusion or Dilution?*, 4 TEX. INTELL. PROP. L.J. 1, 3 (1995) (stating that the "domain name address . . . has far greater mnemonic potential and; therefore, is easier for users to remember . . . [therefore serving] a particularly important function on the Internet"); Brunel & Liang, *supra* note 3 (suggesting that "[o]wnership of a mnemonic and guessable Internet domain name is cru-

reduce or eliminate the conflicts, proposals have been made to change the DNS so that all domain names are meaningless, like random combinations of letters and numbers (analogous to telephone numbers).⁴ Other proposals call for the creation of new top level domains.⁵ Moving to a DNS with meaningless word and number combinations would likely make all the trademark problems disappear, but this proposal seems to have almost no support. The proposals⁶ for creation of new top level domains will alleviate some of the trademark problems that have already arisen, but there remain other problems that may be equally difficult to resolve.

In a previous paper,⁷ this author reviewed the present status of various parties' claims to govern (or even "own") the Internet. In brief summary, there are only de facto operational bodies⁸ that perform various essential administrative functions.⁹ There is no governmental body any-

and the Bureaucrats, J. PROPRIETARY RTS., Aug. 1996, at 8, 15-16 (1996) (discussing case law that deal with domain name trademark issues); Andre Brunel & Mary Liang, *Trademark Troubles with Internet Domain Names and On-Line Screen Names: Roadrunning Right Into the Frying Pan*, J. PROPRIETARY RTS., Sept. 1996, at 2 (citing to *Comp Examiner Agency v. Juris, Inc.*, 1996 WL 376600 at *4 (C.D. Cal. April 25, 1996), as "[maybe] the first case expressly recognizing that Internet domain names can act as trademarks").

4. David W. Maher, *Trademarks on the Internet: Who's in Charge?* (visited July 1, 1997) <http://info.isoc.org/conferences/inet96/proceedings/f4/f4_2.htm> (stating that Paul Vixie of the Internet Software Consortium proposed a plan to "abolish the present system and provide top level domain names that are 'meaningless yet unique,' that have no significance whatever except as addresses," but also stating that Paul Vixie "withdrew his own proposal and gave support to another proposal . . . which allows open competition in domain name registration, multiple registries and a permanent role for IANA (Internet Assigned Names Authority)").

5. See Richard Raysman, et al., *Trademark Protection*, MULTIMEDIA L. § 10.04, 1, 10-11 (1996) (discussing proposals to change the domain name system, such as using "alternate registration/numbering systems," creating "several additional top-level domains," and adding "new prefixes or suffixes representing additional and intuitive domain levels").

6. See, e.g., David B. Nash, Comment, *Orderly Expansion of the International Top-Level Domains: Concurrent Trademark Users Need a Way Out of the Internet Trademark Quagmire*, 15 J. MARSHALL J. COMPUTER & INFO. L. 521 (1997) (advocating the need of a governmental body such as the F.C.C. to decide which names should receive top-level domain names); G. Andrew Barger, *Cybermarks: A Proposed Hierarchical Modeling System of Registration and Internet Architecture for Domain Names*, 29 J. MARSHALL L. REV. 623 (1996) (arguing for the use of concurrent domain names and to bring the DNS within the guise of U.S. trademark law).

7. Maher, *supra* note 4.

8. See generally Robert Shaw, *Internet Domain Names: Whose Domain Is This?* (Sept. 9, 1996) <<http://www.itu.int/intreg/dns.html>> (discussing organizations such as the Internet Engineering Task Force ("IETF"), the Internet Architecture Board ("IAB"), the Internet Society ("ISOC"), and the Internet Assigned Numbers Authority ("IANA")).

9. See generally Maher, *supra* note 4 (stating that "Network Solutions, Inc. ("NSI"), a private corporation [that, under contract with the U.S. National Science Foundation

Putting the trademark question in computer language, the question now is: "Will trademark law scale?"

Before turning to a more detailed consideration of the problems in trademark law, it might be well to consider why trademark law is important in the first place, both on the Internet and in the rest of the world. The International Trademark Association ("INTA"),¹⁹ an organization based in the United States, which represents the interests of trademark owners from the entire world (approximately half the members are not in the United States), adopted a resolution a number of years ago which addressed an argument that trademark law is important only to major advertisers in industrial countries and should not concern the rest of the world.²⁰ The INTA resolution refutes this argument and sets forth the principles that should apply to the use of trademarks in the DNS:

Bearing in mind the increased attention trademarks have been receiving in developed countries and in various international bodies; and bearing in mind the tendency in certain countries to alter traditional concepts of trademark protection;

It is determined advisable to record that:

1. An adequate trademark system is very important to consumers in developing countries, because it permits these consumers to rely on a particular standard of quality associated with the trademark and identify the origin of the trademarked goods, rather than have no means of distinguishing goods from different sources.
2. An adequate trademark system is very important to enterprises in developing countries because it permits them to develop domestic and foreign markets for their products. Without an adequate trademark system, it is very difficult to start a new business or introduce a new product line and compete with established foreign and domestic enterprises, particularly in consumer product lines.
3. Therefore, trademark protection is at least as important for the consumers and enterprises of developing countries as it is for consumers and enterprises of developed countries.
4. Also, a trademark may be of particular assistance in the transfer of technology to enterprises in developing countries. The license recipient will have to acquire know-how and technical skills in order to maintain the quality standard required by the license supplier, and

every parameter 'scale up' and keep functioning"); see also G. Burgess Allison, *Technology Update*, LAW PRAC. MGMT., May 1996, at 14, 18 (discussing TCP/IP).

19. The INTA has a Home Page on the Internet with the URL <<http://www.inta.org>>.

20. See generally *Copyright Protection on the Internet: Statement of the International Trademark Association Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary on H.R. 2441* 104th Cong. (1996), available in 1996 WL 50058 (testimony of Catherine Simmons-Gill, President, INTA) (referring to a September 1995 resolution approved by the INTA Board of Directors "endorsing in principle the concept that domain names can result in infringement of trademark rights").

names have no trademark significance and that all the controversy over trademarks in domain names is simply misplaced.¹⁴ This argument is no longer heard so frequently in view of the widespread use of domain names by commercial users for marketing purposes. The public at large has come to associate well known trademarks (e.g., IBM, KRAFT, etc.) with domain names and web sites associated with these companies, such as "ibm.com" and "kraft.com" respectively.¹⁵ The overwhelming success of the Internet in attracting users, especially users who are no longer at a level of engineering sophistication that was common among the Internet pioneers, has created a situation that was never foreseen by the architects of the DNS.¹⁶ When billboards and advertising panels on buses include the URLs of major national brand advertisers, the argument that domain names have no trademark significance has become irrelevant to the real world.

In light of the present situation, it is clear that the organizations responsible for allocation and registration of domain names must take account of trademarks and trademark law. The question that then must be considered is whether and how trademark law can accommodate the technical requirements of the Internet. One of the greatest achievements of the designers of the technical protocols, such as TCP/IP,¹⁷ which enable the Internet to function, is the scalability of these protocols—their ability to function as well with millions of users as with hundreds.¹⁸

cial for commercial World Wide Web (Web) sites for one simple reason: increased traffic to the Web site").

14. United States Patent and Trademark Office, *Registration of Domain Names in the Trademark Office* (visited July 15, 1997) <<http://www.uspto.gov/web/uspto/info/domain.html>>. The USPTO indicates that the top level of a domain name adds nothing of trademark significance to the mark and will not affect registerability. *Id.* Moreover, if a term that carries the trademark significance of the mark is confusingly similar to another mark, the entire mark will be denied registration. *Id.*

15. Maher, *supra* note 4 (recognizing well known trademarked domain names, such as "velveeta.com," "parkay.com," "underarm.com," and "diarrhea.com"); Kenneth Sutherlin Dueker, Note, *Trademark Law Lost in Cyberspace: Trademark Protection for Internet Addresses*, 9 HARV. J.L. & TECH. 483, 493 (1996) (stating that International Business Machines has registered "ibm.com").

16. *Id.* ("[t]he current system for registering domain names is widely recognized to be inadequate for the needs of the Internet, even without the issues raised by conflicts over trademarks").

17. Marchant, *supra* note 1, at 479-80 (noting that "TCP/IP" stands for Transmission Control Protocol-Internet Protocol and describing "TCP/IP" to be "the common baseline for Internet communications between computers").

18. Gigante, *supra* note 2, at 414-15 (discussing the key features of TCP/IP and its functions); Rolf Harold Nelson, *Is There an Economical Way to Give E-mail Users Store-and-Forward Access to the Web?*, (visited July 2, 1997) <http://www.healthnet.org/dist/agora-w3mail/agora_scale.html> (defining "scalability" as the "[a]bility of a system to have

ownership problem. There are multiple federal registrations in the United States of some popular names, e.g., GENESIS, held by different trademark owners for various products and services. The same situation prevails in other countries.

Taking GENESIS as an example, in the United States there are nine different owners of this mark in just one of the forty-three classifications of products and services recognized by the trademark authorities of most countries throughout the world. National trademark law has been able to accommodate these multiple registrations because the marks function in the marketplace without colliding with each other. According to the test established by U.S. trademark law, there is not, in practice, a "likelihood of confusion" as to the sources of the various goods and services offered by the different owners of the same mark.²⁴ It should be noted that this can change. Actual confusion may occur in the future; one user may abandon the mark; another user may embark on an expansion of its product line which causes confusion with an existing user. Trademark owners may be forced to resort to litigation as the factual situation changes, but the registration system by and large works well in the United States and in other countries.

The DNS, as presently structured, allows no such accommodation for the different owners of the same mark. Proposals have been made for the subdivision of ".com" into the internationally recognized trademark classifications of goods and services, allowing registration of "acme.1.com," "acme.2.com," and so on.²⁵ Even this expansion of the

24. Federal Trademark Act, 15 U.S.C. § 1114(1)(a) (1997) (requiring the use of a registered mark used without permission to "likely . . . cause confusion, . . . mistake . . . or to deceive"). The following factors are relevant, but not complete, in deciding whether there is a "likelihood of confusion:"

- a) the strength or distinctiveness of the mark;
- b) the similarity of the two marks;
- c) the similarity of the goods/services the marks identify;
- d) the similarity of the facilities the two parties use in their businesses;
- e) the similarity of the advertising used by the two parties;
- f) the defendant's intent;
- g) actual confusion.

Cardservice Int'l, Inc. v. McGee, 950 F. Supp. 737, 740 (E.D. Va. 1997).

25. Moreover, to further alleviate the problem of trademark collisions and the Internet, the IAHC has defined an additional set of generic Top-Level Domain names ("gTLD"):

- .firm for businesses, or firms
- .store for businesses offering goods to purchase
- .web for entities emphasizing activities related to the www
- .arts for entities emphasizing cultural and entertainment activities
- .rec for entities emphasizing recreation/entertainment activities
- .info for entities providing information services
- .nom for those wishing individual or personal nomenclature.

the licensed trademark, particularly if it is known in his country, will help the license recipient develop the market faster than would otherwise be possible.

5. The question of the significance of trademark systems in developing countries is worthy of further investigation and analysis by The [International] Trademark Association, providing essential trademark information to national and international governmental bodies and, particularly, enterprises in developing countries.²¹

III. ANALYSIS

A. THE PROBLEMS OF SCALING TRADEMARK LAW

The collisions between trademarks and the DNS are occurring more and more frequently. The first type of collision is the demand for the same domain name by multiple owners of the same mark (the "access conflict"). This problem would be bad enough if the only conflicts arose among owners of registered trademarks. In the United States, it is exacerbated by legal recognition of so-called "common law" marks. Judicially recognized rights in a "common law" mark in the United States arise from use of the mark alone. There is no registration requirement of any kind. As a result there can be multiple users of marks such as ACME or EAGLE who have never registered the marks. Under the present DNS, however, there can be only one "acme.com," putting the ACME owner who got there first and registered "acme.com" in a significantly advantageous position.²²

In most countries outside the United States, there is no concept comparable to "common law" marks; most countries require that a mark be registered in order to gain recognition by the courts and other government bodies.²³ Registration systems, however, do not solve the multiple

21. INTA, POLICY MANUAL 18-24 (1997) (on file with THE JOHN MARSHALL J. OF COMPUTER & INFO. L.).

22. Richard Zaitlen & David Victor, *The New Internet Domain Name Guidelines: Still Winner-Take-All*, COMPUTER LAW., May 1996, at 12, 16. Another example of a common mark who could not use the mark due to the "first come, first take" rational of present DNS is the case of Fry's Electronics, Inc. *Id.* Fry's Electronics, an electronic distributor in California sued Frenchy Frys, a vending machine repair shop operating out of Seattle. *Id.* The defendants argued that the two services are totally unrelated to each other. *Id.* If Fry's Electronics were to lose, then they would have to register a new trademark, which is especially troubling considering Fry's Electronics is a computer company who does a great deal of business via the Internet. *Id.*

23. See generally Beth K. Neelman et al., *Trademark Rights in Europe: The EC Moves to Uncomplicate the Process*, J. PROPRIETARY RTS., April 1993, at 11 (explaining the European Community's directive to "creat[e] . . . a more unified and liberalized trademark system" which would "minimize the difficulties" of "obtaining and protecting trademark rights simultaneously in many countries").

added complication that separate national trademark laws, which may be significantly different, govern the issues.

All of these collisions of trademark law and the DNS have already resulted in litigation.²⁹ Most lawsuits have arisen in the United States, probably reflecting the fact that there are far more users of the Internet in the United States than in any other country. However, there has also been litigation in England,³⁰ Germany,³¹ and a number of other countries, and it seems fair to assume that this curve will continue geometrically, following the expansion of the Internet itself. This paper will not attempt to examine the current state of national law in the United States or elsewhere on these court cases.

It should be noted that the legal situation is complicated by the fact that there are other legal issues in addition to the technical trademark questions. The trademark-DNS cases that have already arisen present intriguing new problems about jurisdiction over the parties.³² In the United States, a domain name owner in California may be the subject of a lawsuit filed by a trademark owner in New York. United States law has well established statutory and constitutional requirements (the "long-arm statute" and "due process" concepts) that have been applied to decide whether the Californian must come to New York to defend against the suit, or the New Yorker must go to California.³³

In the international arena, there are no such well-established rules. The trademark owner in India who finds that its mark is being used as a domain name in .com by a U.S. company can probably not force the U.S. entity to come to India to defend a claim of trademark infringement (assuming that the U.S. company is not doing business in India). Conceivably the Indian company can go to the United States and file a lawsuit in a court having jurisdiction over the U.S. company, but the expense may

29. See, e.g., *CompuServe, Inc. v. Patterson*, 89 F.3d 1257 (6th Cir. 1996); *Sega Enterprises, Ltd. v. Maphia*, 1997 WL 337558 (N.D. Cal. June 9, 1997); *Desknet Systems, Inc. v. Desknet, Inc.*, 1997 WL 253246 (S.D.N.Y. May 14, 1997).

30. *Harrods Limited v. UK Network Services Limited*, 1996 H 5453 (Mr. Justice Lightman presiding, ordered December 9, 1996) (litigation over the domain name "harrods.com").

31. *Landgericht Mannheim*, March 8, 1996, 7-O-60/96, available in <<http://www.inet.de/denic/hd.html>> (litigation over the domain name "heidelberg.de").

32. See David L. Stott, Comment, *Personal Jurisdiction in Cyberspace: The Constitutional Boundary of Minimum Contacts Limited to a Web Site*, 15 J. MARSHALL J. COMPUTER & INFO. L. 819 (1997) (discussing the inconsistent applications of due process on the Internet by citing the inconsistent holdings of *CompuServe, Inc. v. Patterson*, 89 F.3d 1257 (6th Cir. 1996); *Inset Systems, Inc. v. Instruction Set, Inc.*, 937 F. Supp. 161 (D. Conn. 1996); and *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1328 (E.D. Mo. 1996)).

33. See *Bensusan Restaurant Corp. v. King*, 937 F. Supp. 295 (S.D.N.Y. 1996), *aff'd*, No. 96-9344, 1997 U.S. App. LEXIS 23742 (2d Cir. Sept. 10, 1997).

DNS would not accommodate the multiple owners of GENESIS in a single classification nor would it accommodate the owners of common law marks.

Another area of collisions is the practice sometimes referred to as "piracy" and "extortion," on the one hand, or "free enterprise," on the other, depending on one's point of view. A number of entrepreneurs have registered domain names, using trademarks (some famous, some not so famous) that belong to others.²⁶ These entrepreneurs have then offered to transfer the domain name registration, for a price, to the owner of the trademark.

Yet another type of collision occurs when a trademark owner who does not have a domain name registration believes that the use of the identical mark by another on the Internet is itself an infringement of the first owner's trademark rights (the "infringement" conflict).

The best known example of an attempt to resolve these conflicts is the dispute resolution policy of Network Solutions, Inc., the administrator of the .com domain. The policy allows the owner of a U.S. federal or other national registration to put "on hold" a domain name registration held by another party that has not registered the name as a trademark. This policy is applied even though the domain name registrant may have acquired significant and well-recognized common law trademark rights. The policy has led to numerous lawsuits involving trademark owners who are concerned about access or infringement or both.²⁷

Collisions on the international level are occurring where the same trademark is owned by different parties in different countries.²⁸ This can lead to an access conflict or an infringement conflict or both, with the

International Ad Hoc Committee, *Final Report of the International Ad Hoc Committee: Recommendations for Administration and Management of gTLD's* at § 3.1 <<http://www.iahc.org/draft-iahc-recommend-00.html>> [hereinafter *Final Report of the IAHC*].

26. See *Panavision Int'l L.P. v. Toeppen*, 938 F. Supp 616 (C.D. Cal. 1996); *Internatic, Inc. v. Toeppen*, 947 F. Supp 1227 (N.D. Ill. 1996) (holding that "cyber-squatters," people who attempt to profit from the Internet by reserving and later reselling or licensing domain names back to companies, violates § 1125 (c) of the Federal Trademark Dilution Act).

27. See, e.g., *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, No. C96-130WD, 1996 U.S. Dist LEXIS 11626 (W.D. Wash. Feb. 9, 1996); *American Standard, Inc. v. Toeppen*, No. 96-2147, 1996 U.S. Dist LEXIS 14451 (N.D. Ill. Sept. 3, 1996); *Panavision*, 938 F. Supp. 616; *Internatic*, 947 F. Supp. 1227.

28. See *Prince PLC v. Prince Sports Group, Inc.*, CH1997-P2355 (Mr. Justice Neuberger presiding, filed July 30, 1997), available at <<http://www.prince.com/frames/judge.htm>>; *Prince Sports Group v. Prince PLC, et al.*, No. 97cv03581 (D.N.J. filed July 3, 1997), for an example where one party is a company in the United States with the trademark PRINCE, and the other is a company in the United Kingdom with the trademark PRINCE.

peal to universally accepted principles of law when disputes arise in an international arena.

A court today, in most instances, applies the law of the nation where the court is located to disputes that come before it.³⁷ An important exception is that, when the parties to the lawsuit have agreed upon a choice of law provision,³⁸ most courts will respect that choice, so long as there is some reasonable connection between the transaction and the law that is specified.³⁹

B. CONFLICTS IN NATIONAL TRADEMARK LAW

Although there are basic similarities among the various national laws governing trademarks, the differences introduce an element of uncertainty that can be a matter of real concern to the owners of trademarks, especially those whose trademarks are well-known and international in scope. These marks, known generally as "famous" marks,⁴⁰ are usually those that are supported by the largest expenditures for advertising and marketing.

The major differences in national treatment of trademarks are in the areas of dilution, geographical terms, famous marks, rights of publicity, and religious and social issues.

Dilution⁴¹ is a concept of trademark law that allows the owner of a famous mark to assert an infringement claim against an entity using the same mark even though there is no competition between the two parties. In U.S. law, it is defined as "where the use of the trademark by the subsequent user will lessen the uniqueness of the prior user's mark with the

37. Goldsmith, *supra* note 35, at 392.

38. The Supreme Court has endorsed choice-of-forum provisions as "an almost indispensable precondition to achievement of the orderliness and predictability essential to any international transaction." *Scherk v. Alberto-Culver Co.*, 417 U.S. 506, 516 (1974).

39. *Nedlloyd Lines B.V. v. Superior Court of San Mateo County*, 834 P.2d 1148, 1152 (Cal. 1992) (applying section 187 of Restatement second of Conflicts-of-Law whereby courts must consider whether there is a reasonable connection between the transaction and the law that is desired).

40. Agreement on Trade-Related Aspects of Intellectual Property Rights, April 15, 1994, Annex 1C, art. 16 LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31; 33 I.L.M. 81 (1994) [hereinafter TRIPS Agreement].

41. Federal Dilution Act, 15 U.S.C. § 1125(c). The Dilution Act is an Amendment to the Lanham Act, 15 U.S.C. §§ 1051-1127. The Dilution Act provides remedies for dilution of "famous" marks. 15 U.S.C. § 1125(c). If a party succeeds in showing that its mark is being diluted, the party may be awarded an injunction. 15 U.S.C. § 1125(c). Upon a showing that the infringer "willfully intended to trade on the owner's reputation or to cause dilution of the famous mark, the party may recover monetary damages." 15 U.S.C. § 1125(c)(2). Some states' anti-dilution statutes, however, differ from the Federal Dilution Act. See generally *Viacom v. Ingram Enterprises*, 465 F. Supp. 1278 (W.D. Mo. 1997) (applying Missouri's version of the Federal Dilution Act).

be prohibitive. What if the Indian company persuades the Indian courts to consider the claim even in the physical absence of the U.S. company? If the Indian company wins a judgment from the Indian court, it might then take its Indian court judgment to a U.S. court that has jurisdiction over the U.S. company, and ask the U.S. court to recognize the Indian judgment as a matter of "comity,"³⁴ a well recognized principle of international law. Comity, however, will probably not extend this far; U.S. courts can be presumed to be dubious about enforcing an Indian judgment rendered in an action where the U.S. defendant was not present, especially if the only contact between the U.S. defendant and India was its use of a .com domain name.

Where multi-national companies are doing business in jurisdictions outside their home country, the courts of the countries where business is being conducted will generally have jurisdiction, and each court will apply its own national law.³⁵ This is a problem that has already been faced by the multi-nationals in other legal contexts, but it becomes more complex because of the global scope of the Internet. A court in Malaysia may have jurisdiction over a German company because of the German company's factory in Malaysia, and the German company will take care to obey local law in its business affairs in Malaysia. However, if the German company is accused of violating Malaysian law based on something available on its web site originating in Germany, the German company may not consider it fair that it must answer in Malaysia for activity that is perfectly legal in Germany.³⁶

Returning to trademark law, the question of applying a universally accepted body of "international trademark law" has great appeal. However, there is no generally accepted international law of trademarks. While national trademark law is similar in nearly all countries of the world, there are important differences which make it impossible to ap-

34. The Supreme Court has defined comity as:

Neither a matter of absolute obligation, on one hand, nor of mere courtesy and good will on the other. But it is the recognition which one nation allows within its territory to the legislative, executive, or judicial acts of another nation, having due regard both to international duty and convenience and to the rights of its own citizens, or of other persons who are under the protection of its laws.

Hilton v. Guyot, 159 U.S. 113, 163-64 (1895).

35. Jack L. Goldsmith, *Andreas F. Lowenfeld's International Litigation and the Quest for Reasonableness: Essays in Private International Law* 91 AM. J. INT'L L. 391, 392 (1997) (noting that in deciding which law to apply in a typical choice-of-law problem, courts usually apply the least complicated law, which in most cases is the court's own national law).

36. See Gigante, *supra* note 2, at 425 (noting that a German court has already ruled that a name appearing on an American Internet site infringed upon a registered trademark in Germany).

Many geographic identifiers⁴⁷ have, over the years, become identified with products and services and are well protected in their country of origin.⁴⁸ Well-known examples abound in the food and beverage areas: Chablis wine, Chianti wine, Camembert cheese, and Champagne sparkling white wine.⁴⁹ It is equally well-known that countries outside the country of origin have generally tended not to respect the rights of the original geographic region. Even today, in the United States, gastronomic crimes are committed by the sale of sparkling white wine under the name "Champagne" with little or no relation to the famous product of the Champagne region in northern France. This gastronomic crime has no remedy in U.S. courts; despite years of effort by the French government, "champagne" is considered an unprotected descriptive term for sparkling white wine in the United States.

As noted above, famous marks⁵⁰ are generally given a broader scope of protection than the more common terms used as trademarks. "Kodak" is an example of an arbitrary, coined term which has become famous on a world wide basis.⁵¹ Protection of famous marks has long been a controversial subject in international commerce. Developing countries in particular have tended to disregard the fame of famous marks and have turned them into generic terms to describe products or services from various sources. The World Intellectual Property Organization ("WIPO") has established a program to harmonize the laws of its member nations on this subject, but the effort still has a long way to go. Trademark treaties⁵² have also brought about increased protection for famous marks in

Uruguay round of the GATT agreement included section [d], a provision to protect the dilution of famous marks. *Id.* at 222.

47. 15 U.S.C. § 1125 Annotations subdivision Index I.

48. *Forshner Group, Inc. v. Arrow Trading Co., Inc.*, 30 F.3d 348 (2d Cir. 1994), *on remand* 904 F. Supp. 1409 (S.D.N.Y. 1994). When a phrase or term denotes a geographical origin, the court will determine whether there is a likelihood of confusion concerning the product's geographical origin. *Id.*

49. *Chardon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531 (2d Cir. 1964). The Abbey of Hautvillers was located in Champagne, France. *Id.* at 533. The vineyards at the abbey were cared for by Dom Pierre Perignon, an eighteenth century Benedictine monk who is credited with producing the sparkling white wine known today as champagne. *Id.* at 533.

50. See 15 U.S.C. § 1125(c) (describing the eight criteria set forth by the Federal Dilution Act for a mark to be considered "famous" and thus afforded protection under the act).

51. See, e.g., *Eastman Kodak v. Photaz Imports, Ltd.*, 853 F. Supp. 667 (W.D.N.Y. 1993); *Eastman Kodak v. Fotomat Corp.*, 317 F. Supp. 304 (N.D. Ga. 1970); *Eastman Kodak v. Royal Pioneer Paper Box Mfg. Co.*, 197 F. Supp. 132 (E.D. Pa. 1961) (citing examples of cases granting the plaintiff "Kodak" injunctions against various defendants for trademark infringement).

52. See, e.g., Paris Convention 21 U.S.T. 1583, 24 U.S.T. 2140, T.I.A.S. 6923, T.I.A.S. 7727; TRIPS Agreement, *supra* note 40.

possible future result that a strong mark may become a weak mark."⁴² By contrast, infringement claims are usually based on confusion or likelihood of confusion which arises when there is competition or potential competition between two trademark users.⁴³ The rationale for dilution protection comes from two concepts of unfair competition. First, a mark's strength is diluted when a newcomer gets a free ride on the reputation established by the first user. Second, a mark can be "tarnished" by being linked to products of lesser quality or by being used in a negative way.

Dilution is now recognized as part of U.S. statutory law. The Federal Dilution Act⁴⁴ took effect in 1995 and establishes criteria for dilution protection. These are:

- (a) the degree of inherent or acquired distinctiveness of the mark;
- (b) the duration and extent of use of the mark in connection with the goods or services with which it is used;
- (c) the duration and extent of advertising and publicity of the mark;
- (d) the geographical extent of the trading area in which the mark is used;
- (e) the degree of recognition of the mark in the trade areas and channels of trade used by the mark's owner and the entity against whom the injunction is sought;
- (f) the nature and extent of use of the same or similar marks by third parties; and
- (g) whether the mark is federally registered.⁴⁵

Until recently, the dilution concept has not been part of the law of many countries other than the United States. This situation is now changing as a result of certain international treaties that require signatory nations to afford dilution protection to trademark owners.⁴⁶

42. BLACK'S LAW DICTIONARY 458 (6th ed. 1979).

43. The factors in determining the likelihood of confusion are:

[D]egree of similarity between owner's mark and the alleged infringer's mark; strength of the owner's mark; price of goods and other factors indicative of care and attention expected of consumers when making purchases; length of time defendant has used the mark without evidence of actual confusion arising; intent of the defendant in adopting the mark; evidence of actual confusion; whether goods, though not competing, are marketed through the same channels of trade and advertised through same media; relationship of good in mind of consumers; and other factors suggesting that consuming public might expect prior owner to manufacture product in defendant's market.

Fisons Horticulture, Inc. v. Vigoro Industries, Inc., 30 F.3d 466, 471-73 (3rd Cir. 1994).

44. 15 U.S.C. § 1125 (1994 & Supp. I 1995).

45. 15 U.S.C. § 1125(c)(1)(A)-(G).

46. Susan L Serad, *One Year After Dilution's Entry into Federal Trademark Law*, 32 WAKE FOREST L. REV. 215 (1997). "An impetus for the passage of the Federal Trademark Act was the belief that it would be consistent with the terms of [GATT]." *Id.* at 222. The

organization best equipped to do the job.⁵⁶ Although the two procedures do not preclude resort to litigation in the courts, they are designed to provide a fair and efficient means of dispute resolution that should have far-reaching effects.

The IAHC has established a new category of generic TLD's; initially there will be seven,⁵⁷ and in the future many more. When applicants are assigned second level domain names, information about the registrations will be available on the Internet⁵⁸ so that trademark owners (and others) will have prompt access to information about new registrations.

Under the expedited on-line mediation procedure, a WIPO mediator will be available to mediate through e-mail submissions⁵⁹ disputes between holders of second level domain names and parties who are aggrieved by the assignment of the name.⁶⁰ The aggrieved party could be a trademark owner or anyone else who objects to the assignment. The mediator will make a recommendation for resolution of the dispute; the recommendation will not be published and will not be binding on the parties. However, the United States experience with mediation as one of the new alternative dispute resolution procedures has demonstrated that a neutral mediator can often point out grounds for settlement of disputes that the parties will accept.

The other new procedure is more structured, and has the significant difference that the outcome will be binding within the DNS. Under the administrative domain name challenge procedure, an aggrieved party can within sixty days following assignment of a second level domain name file a complaint with a neutral panel of trademark experts selected

56. From an international standpoint, the WIPO has a mediator database of 700 names from sixty-five countries. *WIPO Arbitration and Mediation Center Poised to Accept Cases*, MEALEY'S INT'L ARB. REP., June 1997, at 17.

57. *Final Report of the IAHC*, *supra* note 25 (providing a list of the proposed new gTLDs).

58. The Council of Registrars ("CORE") will provide the oversight and organization among the gTLD registrars, as well as allocate SLD registrations. *Final Report of the IAHC*, *supra* note 25, at §§ 6.1.1 & 6.1.3. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

59. On-line mediation will conform to the mediation rules of the Arbitration and Mediation Center of the WIPO. *Final Report of the IAHC*, *supra* note 25, at § 7.1.1. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

60. To initiate on-line mediation, a right holder should challenge the domain name applicant's right to hold and use the second level domain name. *Final Report of the IAHC*, *supra* note 25, at § 7.1.1. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

many countries.

Closely related to the trademark arena are so-called rights of publicity, the rights of publicly prominent persons to prevent the use of their names and likenesses for commercial purposes. This is also a developing area of law, and the scope of protection for individual's names varies widely from country to country.⁵³

Probably the most difficult and intractable of all problems of conflicting national law is the question of protection (or lack thereof) for religious terms and names.⁵⁴ Harmonizing the conflicting linguistic and naming issues of Buddhism, Confucianism, Christianity, Hinduism, Islam, Judaism, and Taoism, to mention only the most populous world religions, is likely to be as easy as bringing lasting peace to the areas where religious wars are still being fought. Social issues, such as what constitutes obscenity, and commercial and intellectual property issues, such as the protection afforded to patented therapeutic drugs and their names, also offer a fertile field for disagreement on an international scale. These disagreements can and will spill over into the DNS, and there is no body of international law to offer guidance to tribunals that will decide the questions.

C. NEW APPROACHES TO INTERNATIONALIZING TRADEMARK LAW

The final report of the Internet International Ad Hoc Committee ("IAHC"), published on February 3, 1997, provides for expedited on-line mediation and administrative challenge procedures for disputes arising from the assignment of second level domains in the new generic top level domains.⁵⁵ The two procedures will be administered by WIPO, the single

53. See generally Reta J. Peery, *International Considerations in Licensing*, 418 PLI/PAT 21 (1995).

54. United States courts have overwhelmingly held that religious names are not afforded trademark protection. *Christian Science Board of Directors of First Church of Christ v. Evans*, 520 A.2d 1347 (N.J. 1987) (holding that religious names and terms are "generic" and are thus not subject to trademark law); *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church*, 887 F.2d 228 (9th Cir. 1989) (holding that the term "Seventh-Day Adventist" is "generic" and thus would not cause confuse the public); *Board of Provincial Elders of Southern Province of Moravian Church v. Jones*, 159 S.E.2d 545 (N.C. 1968) (holding that the defendant was free to use the name "Moravian" although he had no affiliation with the plaintiffs, nor the church); *New Thought Church v. Chapin*, 144 N.Y.S. 1026 (N.Y. App. Div. 1913) (holding that the "New Thought Church" could not enjoin defendants from conducting services under the name "New Thought Church").

55. *Final Report of the IAHC*, *supra* note 25.

from countries other than the countries of the parties.⁶¹ Proceedings will be open for public comment, and may be conducted by e-mail or face to face, if the parties prefer. A quick decision for suspension of a domain name registration will be available, and, in any event, a final published decision will be made within thirty days.⁶² The final decision could result in cancellation of the domain name registration, or a decision that the name involves a famous mark, or a decision that the name is to be excluded from all or one or more of the generic TLDs. This decision, which will be subject to an administrative appeal, will be binding on all registrars of domain names.⁶³

IV. CONCLUSION

The scalability of trademark law is still uncertain, but the Internet, and the proliferation of domain names, are making the limitations of national laws and the absence of an accepted body of international law unacceptable to Internet users as well as trademark owners. The IAHC report and the documents implementing the report explicitly state⁶⁴ that the new administrative procedures are not intended to deprive anyone of rights under existing law. However, the self-regulation of the generic TLD registrars, as carried out by the deliberations and public decisions

61. *Final Report of the IAHC*, *supra* note 25, at § 7.1.2. The procedures for creating panels and for bringing challenges within the sixty day limit will be administered by the WIPO's Arbitration and Mediation Center (Geneva). *Id.* For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

62. *Final Report of the IAHC*, *supra* note 25, at § 7.1.3 states:

All applications for SLDs in the gTLDs will be published on a publicly available, publicized web site, immediately upon receipt by the registrar. Such publication entries will include:

Name of the SLD;

Contact and use information contained in the application;

A permanent tag of label created by CORE . . . [;]

Entry validation using accepted digital signature and timestamping techniques.

Id. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

63. However, no decision of an administrative domain name challenge panel will affect the power of national or regional sovereign courts to hear cases interpreting intellectual property rights. *Final Report of the IAHC*, *supra* note 25, at § 7.1.2. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

64. For the latest updates to the IAHC report, see *The Generic Top-Level Domain Memorandum of Understanding* <<http://www.gtld-mou.org>>.

of the administrative challenge panels, should at least point the way towards a new and creative approach to the resolution of trademark problems on an international scale.