

COMMENTS

The Questionable Legality of Online Criticism: Judicial Inconsistency in Application of the Lanham Act to Gripe Sites

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I. INTRODUCTION

Like soap boxes and town criers of the past, the Internet is today's tool used by critics and consumer activists to spread their messages to the public. While the reach of the message of a critic on a soap box is confined to the number of passersby it can attract, Internet blogs and Web sites are accessible instantaneously to Internet users around the world. Because of the ease and speed at which messages can be spread electronically, consumers are increasingly going online to voice their critiques and complaints about the conduct of corporations and public figures.¹ Those corporations and public figures are returning fire by bringing claims of trademark infringement, unfair competition, and trademark dilution against the creators of those sites in an effort to limit Internet speech.²

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1. See Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 3, 2 (2005).

2. See *id.* at 3-4.

Critics have used traditional media to voice their opposition to corporations and public figures from time immemorial. The way in which a person reads a Web site, however, has created problems for the courts in applying print, radio, and television-oriented law to Web content.³ In a traditional media advertisement, a critique or overbroad statement can be qualified with a printed disclaimer at the bottom of the page or television screen, or audibly at the end of a commercial.⁴ Unlike traditional media, a Web site does not have a conventional beginning and end, but rather a nonlinear series of hyperlinks allowing viewers to jump around throughout the site.⁵

Another issue that separates the Internet from traditional media is the entranceway to the information. Every Web site has a unique address, its domain name, that users must type into their Internet browser to access the site. While television and radio stations have unique numeric frequencies (e.g., Channel 6; 99.3 FM), a domain name typically consists of a word or name identifying the information found at the Web site. For instance, the domain name for Microsoft's Web site is *www.microsoft.com*. However, if Microsoft had not registered such a domain name, customary domain name registration may allow a Microsoft critic to use that domain name to host a Web site criticizing Microsoft's products and services.⁶

A Web site used to criticize a person or entity with a domain name that includes either the trademark or a close variation of the mark of the criticized person or entity is called a "gripe site."⁷ Corporations and public figures have threatened their most prominent Internet critics with lawsuits to stop the use of their marks alongside critical commentary.⁸ Many small gripe sites simply shut down or remove offending material to avoid the high cost of litigation.⁹ Others have raised challenges to the interpretation of trademark law and First Amendment rights of free speech.¹⁰

This Comment will address the inconsistent and contradictory analyses and decisions of federal courts regarding the application of federal law to trademark infringement claims against gripe sites. It will

3. See Peter Johnson, *Can You Quote Donald Duck?: Intellectual Property in Cyberspace*, 13 *YALE J.L. & HUMAN.* 451, 474-75 (2001).

4. See *id.* at 475.

5. See *id.*

6. See *id.* at 476-77.

7. See *id.* at 478.

8. See Travis, *supra* note 1, at 4.

9. See *id.*

10. See *id.* at 4 n.12, 38-42.

then discuss the implications presented within such broad interpretations of trademark law, including impairment of constitutionally protected speech and lack of notice to gripe site owners regarding whether their sites infringe a trademark owner's rights. Finally, it will recommend steps for the courts to unify their interpretations of trademark infringement law, absent direction as of yet from the United States Supreme Court, in a way that maintains Congress's intent for the application of the Lanham Act.

II. EVOLUTION OF TRADEMARK LAWS

The original purpose and scope of common law trademark regulations were to protect consumers by preventing a manufacturer from "passing off" his inferior goods as the goods of another more successful or well-known manufacturer.¹¹ Courts gradually moved away from this goal and began to establish standards of unfair competition without presentation of any likelihood of consumer confusion.¹² In 1946, Congress passed a federal trademark statute to standardize the method by which courts would decide such claims and to provide the greatest protection to trademarks.¹³ These statutes, together called the Lanham Act, provide trademark holders with claims of infringement and unfair competition.¹⁴ Congress later created additional protection for trademarks with the Federal Trademark Dilution Act and the Anticybersquatting Consumer Protection Act.¹⁵

The trademark infringement statute, § 1114 of the Lanham Act, forbids a party to "use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion."¹⁶ Similarly, § 1125's unfair competition statute forbids

[a]ny person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device . . . or any false designation of origin, false or misleading description of fact, . . . or misleading representation of fact, which . . . is likely to cause confusion . . . as to the affiliation, connection, or association of such person with another

11. *See id.* at 8.

12. *See id.* at 8-9.

13. *See id.* at 10; *see also* Trademark Act of 1946 (Lanham Act), ch. 540, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (2000)).

14. *See* Travis, *supra* note 1, at 10-11; *see also* 15 U.S.C. §§ 1114(1), 1125(a)(1) (2000).

15. *See* 15 U.S.C. § 1125(c), (d)(1)(A).

16. *Id.* § 1114(1)(a).

person, or as to the origin . . . of his or her goods, services, or commercial activities by another person¹⁷

To prevail on a trademark infringement claim, therefore, the mark holder must prove that (1) she possesses a mark; (2) the defendant used the mark; (3) the defendant's use of the mark occurred "in commerce"; (4) the defendant used the mark "in connection with the sale, offering for sale, distribution, or advertising" of goods or services; and (5) the defendant used the mark in a manner likely to confuse consumers.¹⁸ Accordingly, the Supreme Court has interpreted the Lanham Act infringement law as prohibiting only unauthorized uses of a trademark *in connection with a commercial transaction* by which the mark is *likely to cause consumer confusion*.¹⁹ However, the infringing use need not be identical to the protected mark to constitute a violation.²⁰

Courts have interpreted these requirements as having a broad scope, and at times with little regard to Congress's primary intent that the Lanham Act protect consumers from being misled about the source of a commercial product. In 1979, the United States Court of Appeals for the Second Circuit held that a film company infringed the copyright of the Dallas Cowboys Cheerleaders for having a character in a film wear a uniform similar to that worn by the plaintiff.²¹ The court rejected the film company-appellant's argument that no reasonable person would conclude the film was associated with the Dallas Cowboys Cheerleaders.²² The court found the argument to be too narrow a view of the confusion requirement, and that the film's tendency to injure the plaintiff's business reputation constituted interference with a trademark holder's right to control his product's reputation.²³

The United States Court of Appeals for the Eighth Circuit used similar reasoning when it upheld an injunction against the designer of a T-shirt displaying "Mutant of Omaha" that parodied the Mutual of Omaha Bank's logo.²⁴ The shirt also displayed the slogan "Nuclear

17. *Id.* § 1125(a).

18. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 364 (4th Cir. 2001) (citing 15 U.S.C. §§ 1114, 1125(a); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 930 (4th Cir. 1995)).

19. *See Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676 (9th Cir. 2005) (citing *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924); *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.* 316 U.S. 203, 205 (1942)).

20. *See Lone Star Steakhouse*, 43 F.3d at 936.

21. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 (2d Cir. 1979).

22. *See id.* at 205.

23. *See id.* at 204-05.

24. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987).

Holocaust Insurance.”²⁵ Over the dissent’s objection that the differences between the two marks were unmistakable, the majority affirmed that a likelihood of confusion existed.²⁶

As demonstrated by the two decisions above, some courts have become less interested in protecting consumers from being misled as to the source of goods and services and have moved toward a goal of preventing anyone but the mark holder from any use whatsoever of the mark in commerce, regardless of the presence of a likelihood of confusion or Congress’s legislative intent. The real confusion came with the widespread use of the Internet and the courts’ scramble to apply precedent to issues never before presented by traditional media.

III. DIFFERING JUDICIAL ANALYSES OF TRADEMARK INFRINGEMENT CLAIMS AGAINST GRIPE SITES

The objective of the creation of a gripe site is to register a domain name that includes the trademark of the object of criticism (or a close imitation thereof) and provide a forum for critical commentary.²⁷ Accordingly, the alleged infringer typically will not contest that she used the plaintiff’s mark.²⁸ The court must then determine whether the mark was used “in commerce,” “in connection with the sale . . . of goods or services,” and “is likely to cause confusion.”²⁹ The Lanham Act’s requirements for commercial use of the mark were intended to address First Amendment concerns of critics and commentators.³⁰

A. *Commercial Use Requirements*

The “use in commerce” requirement in §§ 1114 and 1125(a) of the Lanham Act is merely a “jurisdictional predicate to any law passed by Congress” to ascertain that the allegedly infringing activity may be lawfully regulated by Congress under the Commerce Clause.³¹ It reflects Congress’s intent to control interstate commerce rather than to limit

25. *Id.*

26. *See id.* at 401.

27. *See* Lucent Techs., Inc. v. LucentSucks.com, 95 F. Supp. 2d 528, 535 n.9 (E.D. Va. 2000).

28. *See, e.g.,* People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359, 365 (4th Cir. 2001); Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1432 (S.D.N.Y. 1997), *aff’d*, No. 97-7492, 1998 U.S. App. LEXIS 22179 (2d Cir. Feb. 9, 1998).

29. 15 U.S.C. §§ 1114(1)(a), 1125(a)(1) (2000).

30. *See* Lamparello v. Falwell, 420 F.3d 309, 313 (4th Cir. 2005), *cert. denied*, 126 S. Ct. 1772 (2006).

31. *Bucci*, 42 U.S.P.Q.2d at 1434.

trademark protection to profit-seeking activity.³² However, courts have had more difficulty discerning the intent of Congress when interpreting § 1114's requirement that the allegedly infringing mark be used "in connection with the sale, offering for sale, distribution, or advertising of any goods or services."³³

In 1998, Planned Parenthood Organization of America (Planned Parenthood) filed a claim of trademark infringement against the creator of an antiabortion gripe site with the domain name www.plannedparenthood.com.³⁴ The site included text from an antiabortion book written by a third party, the author's phone number to contact him for speaking engagements, and quotes of various people endorsing the book.³⁵ The Second Circuit affirmed the lower court's holding that the site satisfied the "in connection with goods and services" requirement of the Lanham Act's infringement claim.³⁶ The district court held that the promotion of the book constituted the "distribution or advertising of goods or services," even though the site owner neither profited from book sales nor provided information on where or how to purchase the book.³⁷ The court reasoned that the Lanham Act did not require personal profit by the unauthorized mark user to be liable for infringement.³⁸

The district court also held that the site used Planned Parenthood's trademark in connection with goods and services because it was likely to prevent some Internet users from reaching the plaintiff's site.³⁹ It reasoned that users searching for Planned Parenthood's Web site who reached the gripe site first were likely to become confused or frustrated and consequently give up their search for the site.⁴⁰ The district court explained that by convincing his site's viewers that abortion is morally wrong, the defendant was offering his own set of services and using plaintiff's trademark in connection with the distribution of those services over the Internet.⁴¹

32. See *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997).

33. 15 U.S.C. § 1114(1)(a); see also *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 678-79 (9th Cir. 2005).

34. See *Bucci*, 42 U.S.P.Q.2d at 1432.

35. See *id.* at 1432-33.

36. See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97-7492, 1998 U.S. App. LEXIS 22179, at *1 (2d Cir. Feb. 9, 1998).

37. See *Bucci*, 42 U.S.P.Q.2d at 1435.

38. See *id.*

39. See *id.*

40. See *id.*

41. See *id.*

The Second Circuit's agreement with the district court's decision sends a message that *any* gripe site that uses another's trademark to criticize the mark owner's conduct is using that mark in connection with goods or services merely because the site is convincing people that the mark holder's conduct is wrong. With the first two elements of infringement met simply by the inherent objective of a gripe site, the Second Circuit leaves the analysis of infringement to the lone determination of likelihood of confusion.

The United States Court of Appeals for the Fourth Circuit has followed the Second Circuit's rationale, concluding that a gripe site creator need only prevent users from obtaining the trademark holder's goods or services, or post links to others' goods or services, to constitute such a commercial connection.⁴² Ruling on the issue of whether the gripe site is likely to prevent or hinder Internet users from accessing the mark holder's services on its own Web site, the Fourth Circuit reasoned that access is hindered when prospective users of the mark holder's site mistakenly access the gripe site and fail to continue to search for the mark holder's site due to confusion or frustration.⁴³

The United States Court of Appeals for the Sixth Circuit has employed a more narrow interpretation of "in connection with goods and services." In *Taubman Co. v. Webfeats*, the domain name of defendant's gripe site used a close variation of the plaintiff's trademark (defendant dropped the word "the" from the mark) and contained two links to commercial Web sites.⁴⁴ The court found that any Web site that contains a link to a business, even if the link is an extremely minimal part of the site, is in connection with the advertising of goods or services.⁴⁵ However, because the defendant removed the commercial Web site links from his gripe site before the trial, the § 1114 requirement that the trademark be used "in connection with the . . . advertising of any goods or services" was no longer satisfied.⁴⁶ As a result, the Sixth Circuit dissolved the preliminary injunction granted by the district court in favor of the plaintiff.⁴⁷

The Sixth Circuit employed a broader interpretation of this element than other courts. Like the cases addressed above, the defendant in *Taubman* used the plaintiff's mark as his domain name, which had the

42. See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 365 (4th Cir. 2001).

43. See *id.* at 366-67.

44. See *Taubman Co. v. Webfeats*, 319 F.3d 770, 772 (6th Cir. 2003).

45. See *id.* at 775.

46. 15 U.S.C. § 1114(1)(a); see *Taubman*, 319 F.3d at 775.

47. See *Taubman*, 319 F.3d at 780.

potential to misdirect people to his Web site instead of the plaintiff's. In the view of the Second and Fourth Circuits, the potential for diversion alone would have constituted use of a mark in connection with goods and services. The Sixth Circuit, however, was more lenient in its interpretation of the Lanham Act and afforded the plaintiff less protection against the unauthorized use of his trademark on the Internet. After *Taubman*, the parties in a trademark infringement case filed outside the Second, Fourth, or Sixth Circuits cannot be certain as to whether a gripe site violates the Lanham Act merely because of the unauthorized use of a trademark in a domain name.

In April 2005, the United States Court of Appeals for the Ninth Circuit made a big leap in the direction of gripe site protection when it rejected the Fourth Circuit's infringement rationale as "over-expansive."⁴⁸ Even though the gripe site at issue, www.bosleymedical.com, may have prevented users from obtaining Bosley Medical's goods and services, it did not constitute such deviation from the consumer protection that Congress intended the Lanham Act to provide.⁴⁹ The Lanham Act only protects against mistaken *purchasing* decisions and not against confusion in general.⁵⁰ The Ninth Circuit reasoned that the determinative issue of whether a gripe site constitutes a use in connection with goods and services is resolved by answering the question of whether the mark holder and the gripe site owner offer competing services to the public.⁵¹

Typically, the gripe site owner is merely the mark holder's critic and not a competitor in commerce. As long as the gripe site does not attempt to pass off its own goods or services as those of the mark holder, the Ninth Circuit purports that the critic's use of the mark is not within reach of the Lanham Act.⁵² This decision is far removed from the rationale of the Second and Fourth Circuits, reminding the judiciary that the Lanham Act's primary intent is to protect consumers, not mark holders.

Shortly after the Ninth Circuit's decision, the Fourth Circuit reasserted its broad definition of "services" as applied to the Lanham Act.⁵³ It referred approvingly to cases in which the following constituted

48. See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005).

49. See *id.*

50. See *id.*

51. See *id.*

52. See *id.* at 680.

53. See *Lamparello v. Falwell*, 420 F.3d 309, 314 (4th Cir. 2005), *cert. denied*, 126 S. Ct. 1772 (2006).

“services”: points of view, dissemination of information about public causes, and a gripe site that contained two links to commercial sites.⁵⁴

As evidenced above, there is a circuit split regarding the scope of the Lanham Act’s “in connection with goods and services” requirement. It is nearly impossible for the creator of a gripe site to determine whether he may include links to noncompeting commercial sites, information opposed to the mark holder’s viewpoints, or any presentation of the criticized entity’s mark without being held liable for trademark infringement.

B. Likelihood of Confusion

To prevail on a claim of trademark infringement or unfair competition, the mark holder must demonstrate that the unauthorized use of the mark is likely to create confusion whereby “consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark.”⁵⁵ The Second Circuit developed the following list of factors to determine whether an allegedly infringing use of a mark creates a likelihood of consumer confusion: (1) the strength of plaintiff’s mark, (2) the degree of similarity between the two marks, (3) the competitive proximity of the products or services, (4) the likelihood that the plaintiff will bridge the gap between the two markets, (5) the existence of actual confusion, (6) the defendant’s good faith in adopting the mark, (7) the quality of defendant’s product, and (8) the sophistication of the purchasers.⁵⁶ Other appellate courts apply similar variations of these factors.⁵⁷

Courts often create lists of analytical factors to promote judicial consistency. Yet, the interpretations and applications of these “likelihood of confusion” factors have been far from consistent and sometimes contradictory.

54. See *id.* (referencing decisions in *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89-90 (2d Cir. 1997); *The Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003)).

55. *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978).

56. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

57. See generally *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Sun-Fun Prod. v. Suntan Research & Dev.*, 656 F.2d 186, 189 (5th Cir. 1981); *Brookfield Comme’ns, Inc. v. W. Coast Entm’t*, 174 F.3d 1036, 1053-54 (9th Cir. 1999).

1. Degree of Similarity

In *Planned Parenthood Federation of America, Inc. v. Bucci*, the Second Circuit affirmed that the “degree of similarity” factor weighed in favor of the mark holder because the mark, “Planned Parenthood,” and the allegedly infringing www.plannedparenthood.com were nearly identical.⁵⁸ The United States District Court for the District of New Jersey similarly held that a domain name virtually identical to another’s trademark weighed in favor of the infringement claim because it was likely to misguide users to the defendant’s Web site.⁵⁹

The Fourth Circuit purports to create a broader standard to determine the degree of similarity between two marks.⁶⁰ It explained that courts must determine not “how closely a fragment of a given use duplicates the trademark,” but how the mark is used *in its entirety*.⁶¹ One may interpret the “in its entirety” standard as taking into account, not just the domain name, but all facets of a gripe site, such as content, to determine the degree of similarity between the marks. In application, this standard was no broader than the Second Circuit’s analysis, even though it promised to account for the mark’s use “in its entirety.” The Fourth Circuit refused to consider the obviousness that the content on defendant’s Web site, entitled “People Eating Tasty Animals,” was completely unrelated to the plaintiff’s organization dedicated to animal rights.⁶²

More recently, the Fourth Circuit reasoned that the “degree of similarity” factor weighed in favor of the alleged infringer.⁶³ While the contested domain name www.fallwell.com was very similar to the mark holder’s domain name www.falwell.com, the content of the sites were not.⁶⁴ This example of intracircuit inconsistency is part of the larger problem of conflicting interpretations among federal courts regarding the similarity of a registered or common law trademark and the allegedly infringing use of that mark.

58. See *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97-7492, 1998 U.S. App. LEXIS 22179, at *1-2 (2d Cir. Feb. 9, 1998), *aff’g*, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997).

59. See *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 302 (D.N.J.), *aff’d*, 159 F.3d 1351 (3d Cir. 1998).

60. See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001).

61. *Id.* (emphasis added).

62. See *id.* at 366-67.

63. See *Lamparello v. Falwell*, 420 F.3d 309, 315 (4th Cir. 2005), *cert. denied*, 126 S. Ct. 1772 (2006).

64. *Id.*

2. Competitive Proximity of Products and Services

Intercircuit and intracircuit confusion also exists in the application of the “competitive proximity of products and services” element. The Second Circuit has affirmed that a mark holder’s Web site and a gripe site criticizing that mark holder are in close competitive proximity merely because both are Web sites located on the Internet.⁶⁵

In a trademark infringement case unrelated to Web sites, the Fourth Circuit found similarity of goods and services between a sit-down Italian restaurant with a full bar and a taco drive-through with counter service.⁶⁶ Even though both parties had very different types of restaurants, the court found that they served the same purpose of providing food to customers.⁶⁷ Under this rationale, one would imagine that a gripe site criticizing a mark holder’s views offered services similar to the mark holder’s Web site espousing such views because both provide the same service of offering views on certain topics. However, the Fourth Circuit did not follow its own logic.⁶⁸ It affirmed that such a gripe site did not offer goods or services similar to those of the mark holder’s site because the two sites offer *opposing* ideas and commentary.⁶⁹ It is difficult to understand why a sit-down Italian restaurant and a taco drive-through offer similar goods and services, yet two Web sites that offer social and religious views on the same topic do not.

The courts seem to be confused as to how comparable the goods and services must be to fit under the umbrella of Lanham Act liability. The Second Circuit and the courts that follow its rationale look to the physical (or digital) location of the Web sites’ services. The Fourth Circuit, on the other hand, is concerned more with the similarity of the actual goods and services offered, although its analysis of this factor has been inconsistent.

3. Actual Confusion

In *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, the Fourth Circuit explained that courts should give substantial weight to evidence of actual consumer confusion because it provides the most

65. See *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97-7492, 1998 U.S. App. LEXIS 22179, at *1-2 (2d Cir. Feb. 9, 1998), *aff’g*, 42 U.S.P.Q.2d 1430, 1438 (S.D.N.Y. 1997).

66. See *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1535 (4th Cir. 1984).

67. See *id.*

68. See *Lamparello*, 420 F.3d at 315.

69. See *id.*

compelling evidence of a likelihood of confusion.⁷⁰ But how much evidence of actual confusion must the mark holder provide for it to weigh in his favor? What distinguishes actual confusion of the source of goods or services from an accidental visit to the wrong Web site?

In *Bucci*, the Second Circuit found actual confusion weighing in favor of the plaintiff mark holder from the testimony of two people who mistakenly went to a gripe site when in search of plaintiff's Web site.⁷¹ One user went to www.plannedparenthood.com, assuming that it would be the domain name of the mark holder.⁷² The other user found the gripe site through an Internet search engine.⁷³

The Second Circuit invoked the initial interest confusion doctrine in its likelihood of confusion analysis to find that a consumer's mistaken visit to a gripe site constitutes actual confusion.⁷⁴ This doctrine states that a producer may not lure away his competitor's customers by initially passing off his goods as those of the competitor, even if the source of the goods is obvious by the time the sale is consummated.⁷⁵ Regardless of how obvious it is that the mark holder had no affiliation with the gripe site, initial interest confusion may exist. Internet users may type or click a domain name thinking it belongs to the mark holder. The Second Circuit was content to substitute actual confusion with a finding of mere initial interest confusion.⁷⁶

The Sixth Circuit provided an escape for gripe site owners who would otherwise be held liable by the Second Circuit.⁷⁷ It found that a link on a gripe site redirecting mistaken viewers to the mark holder's site weighs against a finding of actual confusion.⁷⁸ Thus, an Internet user's mistaken entrance into a gripe site while in search of the mark holder's site will not, in itself, constitute actual confusion. The Sixth Circuit gives the gripe site the benefit of the doubt by allowing it an opportunity to remedy possible confusion.⁷⁹

The Fourth Circuit went a step further than the Sixth Circuit when it found that a consumer intending to go to a mark holder's Web site clearly

70. See *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 933, 938 (4th Cir. 1995).

71. See *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97-7492, 1998 U.S. App. LEXIS 22179 (2d Cir. Feb. 9, 1998), *aff'g*, 42 U.S.P.Q.2d 1430, 1438 (S.D.N.Y. 1997).

72. See *Bucci*, 42 U.S.P.Q.2d at 1438.

73. See *id.*

74. See *id.*

75. See *Lamparello v. Falwell*, 420 F.3d 309, 315-16 (4th Cir. 2005).

76. See *Bucci*, 42 U.S.P.Q.2d at 1438.

77. See *Taubman Co. v. Webfeats*, 319 F.3d 770, 777 (6th Cir. 2003).

78. See *id.*

79. See *id.*

would not be misled into thinking that the mark holder sponsored a gripe site criticizing his own goods and services.⁸⁰ In *Lamparello v. Falwell*, the mark holder, Jerry Falwell, presented evidence of people who, while searching for Falwell's Web site, mistakenly entered the plaintiff's gripe site.⁸¹ According to the Second Circuit's line of reasoning, this evidence would present clear proof of actual confusion. However, the Fourth Circuit affirmed that such evidence was actually proof that those viewers were *not* confused because they realized, upon viewing the site's content, that Falwell was not the likely source of such content.⁸²

To the contrary, the Fourth Circuit has also found that a likelihood of confusion *did* exist when *www.peta.com*, a domain name containing the acronym and trademark of People for the Ethical Treatment of Animals, was the domain name for a Web site entitled "People Eating Tasty Animals" in large, bold type on its home page.⁸³ Unlike its analysis in *Lamparello*, the court did not take into account the likelihood of whether a Web site entitled "People Eating Tasty Animals" would lead people to believe that it was hosted by an animal rights group. The Fourth Circuit contradicted itself by applying different reasoning to similar patterns of fact.

4. Consumer Sophistication

Another example of judicial inconsistency is the interpretation of and weight placed on the sophistication of consumers. One appellate court held that evidence of a consumer well versed in Internet use may still weigh in favor of likelihood of confusion because that consumer may not be knowledgeable of the actual content of the particular gripe site.⁸⁴ On the other hand, another court reasoned that few people, if any, are so unsophisticated as to think that a gripe site was sponsored by the person or entity being criticized.⁸⁵ Yet a third court found that consumer sophistication is "of limited value in determining whether the consumer is likely to be confused."⁸⁶ In one case, the efforts of a gripe site to supplement consumer sophistication with a prominently displayed

80. See *Lamparello*, 420 F.3d at 315.

81. See *id.*

82. See *id.*

83. See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366-67 (4th Cir. 2001).

84. See *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 303 (D.N.J.), *aff'd*, 159 F.3d 1351 (3d Cir. 1998).

85. See *Lamparello*, 420 F.3d at 315.

86. *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1439 (S.D.N.Y. 1997), *aff'd*, 1998 U.S. App. LEXIS 22179 (2d Cir. Feb. 9, 1998).

disclaimer would not remedy a likelihood of confusion, whereas in another case, a court found that a disclaimer weighed heavily against such a claim.⁸⁷

IV. THE NEED FOR CONSISTENT ANALYSIS OF LANHAM ACT VIOLATIONS AGAINST GRIPE SITES

Imagine a trademark infringement claim against the owner of a gripe site with the domain name *www.acme1.com*, critical of plaintiff Acme Corporation. It would be difficult to predict an appellate decision based on precedent. The obviousness that the content of the gripe site is not affiliated with the mark holder may or may not play a vital role in the court's decision. Such lack of notice as to the legality of a gripe site will deter people from exercising their First Amendment rights of criticism and parody.

Comment and critique about public issues are important to the maintenance of our free marketplace of ideas. It is a matter of public interest that consumers are well informed about the choices they make, and the Internet provides a venue virtually unlimited in its scope of audience and capacity to inform. Furthermore, because the use of one's "trademark may frequently be the most effective means of focusing attention on the trademark owner or its product, the recognition of exclusive rights encompassing such use would permit the [mark holder to] stiffl[e] unwelcome discussion."⁸⁸

Political and consumer commentary are communications promoted by the ideals of a democratic society. Gripe sites are a new and developing form of such commentary, similar in purpose to a picket line.⁸⁹ The organizers of a picket line will locate the demonstration as physically close as possible to the protested business in order to closely associate their gripe with that business.⁹⁰ Similarly, a gripe site creator uses the criticized entity's trademark in its domain name as a strategy to get as close as possible to the entity's Internet location.⁹¹ Just as picket lines are constitutionally protected, gripe sites should also be protected with clearly defined interpretations of the law.⁹²

87. *Compare Brodsky*, 993 F. Supp. at 303 (holding that the defendant's use of plaintiff's mark in a gripe site domain name cannot adequately be remedied by a disclaimer), *with Taubman Co. v. Webfeats*, 319 F.3d 770, 777 (6th Cir. 2003) (finding no likelihood of confusion partly because of a disclaimer on the gripe site that it was not the mark holder's Web site).

88. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31 (1st Cir. 1987).

89. *See Travis*, *supra* note 1, at 70.

90. *See id.* at 70-71.

91. *See id.*

92. *See id.*

In deciding trademark infringement claims against gripe sites, courts must remember that Congress created the Lanham Act primarily to protect consumers. If consumers are not likely to be confused about the source of the goods or services *in their entirety*, Lanham Act liability should not be applied. If the gripe site owner is merely offering commentary about the commercial goods or services of the trademark holder, there is little chance that even the most unsophisticated consumer would confuse such commentary with the actual purchase of goods or services. If the parties do not offer competing products, courts should not find that the mark is used in connection with the sale of goods or services, which is necessary for trademark infringement liability. However, if evidence shows that the gripe site owner is trying to pass off his goods or services as those of the mark holder, then the application of the Lanham Act is proper to protect consumers from such commercial deceit.

Courts must also consolidate their interpretations of “likelihood of confusion.” People of all levels of consumer sophistication surf the Internet. Courts should analyze whether a person of ordinary sophistication would assume that, upon opening the gripe site’s home page, the site is managed or endorsed by the mark holder. Under this analysis, evidence of actual confusion would encompass only those consumers who went to the gripe site and believed that the content was that of the mark holder. If a consumer goes to www.peta.com in an effort to visit an animal rights Web site, but realizes upon first glance that the Web site has nothing to do with animal rights, that consumer has not been misled into thinking the Web site belonged to PETA.

Furthermore, courts must agree on whether the analysis of the degree of similarity between the gripe site and the mark holder’s trademark should consider similarity in domain name or similarity of Web site content, or both. While applied inconsistently, the Fourth Circuit’s standard may provide a guideline for proper analysis. The *PETA* court held that the degree of similarity is determined by whether the mark’s use *in its entirety* creates a likelihood of confusion.⁹³ The term “in its entirety” should encompass the gripe site’s domain name and Web site content. Unless the main facets of the gripe site are considered, the court cannot determine whether the gripe site’s similarity to the trademark and the mark holder’s Web site create a likelihood of consumer confusion.

93. See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001).

Creators of gripe sites should not be deterred by overbroad or conflicting interpretations regarding their legality under the Lanham Act or the United States Constitution. Such deterrence will impede the dissemination of truthful information about negative consumer experiences with goods or services related to the contested trademark. To encourage the use of innovative means of communication and expand the marketplace of ideas, courts must provide a more uniform interpretation of federal trademark laws as they relate to gripe sites. Most importantly, courts must keep in mind Congress's intent that trademark laws protect against consumer confusion as to the source of the product upon which the mark is affixed, and not to provide exclusive ownership of a word or symbol to the first person who claims it.