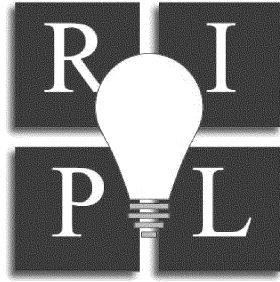


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



TWITTER'S TRADEMARK PROBLEMS: IS THE ANTICYBERSQUATTING CONSUMER PROTECTION ACT OUTDATED?

COLE C. HARDY

ABSTRACT

Under the Lanham Act there is no remedy for individuals when imposters register user names with corresponding post-domain paths containing protected trademarks on social network websites. While Twitter temporarily experimented with its own verification process, it currently does not help users of its site distinguish trademark owners' pages from the imposters' pages. Current law discouraging such activity only applies to domain names. This article proposes that with a minor change to the ACPA, the Lanham Act could be updated to help trademark owners protect their rights when infringing activity is experienced with social networking handles and the corresponding post-domain paths.

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INTRODUCTION

On February 6, 2011, 111 million viewers tuned into Fox to watch Super Bowl XLV.¹ To reach this audience, advertisers spent up to three million dollars for thirty seconds of airtime.² For the companies that could afford the time, this was a valuable way to reach an expansive audience.³ For smaller companies, however, there is an alternative to reach just as many people for a fraction of the cost.⁴ Social networking websites provide this solution and allow users to communicate with other users for a very low cost.⁵ Twitter.com ("Twitter") is the latest social network site to gain in popularity.⁶

When a company creates a Twitter account, which requires no payment, it has the ability to reach nearly as many consumers on a monthly basis as the Super Bowl does in one night.⁷ Similar to the invention of the internet, the rise in social networking sites "give[s] companies new ways to promote their brands" and interact with consumers.⁸ This avenue of promotion also provides new ways to exploit companies' trademarks.⁹ Currently, if a company wants to sign up for a Twitter

* © Cole C. Hardy 2011. J.D., May 2011, The John Marshall Law School. B.A. Economics, minor in Mathematics, Kalamazoo College, May 2006. I would like to specifically thank my editors Chris Collie and Becky Haas for their help. In addition, I would like to thank Professor Long for her thoughts and guidance. Lastly, thank you to the staff of *The John Marshall Review of Intellectual Property Law* for their editorial assistance. Any mistakes in this article are my own.

¹ See Mark Maske, *For Prosperous NFL, A Season's on the Brink*, WASH. POST, Mar. 3, 2011, at A16.

² See Eric Deggins, *Game on for Super Bowl Ads*, ST. PETERSBURG TIMES, Feb. 6, 2011, at 1E.

³ See DeAnna S. Kempf & J. Holly Hapke, *Exploring the Environmental Context in Which Super Bowl Ads Are Viewed and Its Effects on Ad Processing*, 8 INT'L J. BUS. RES. 139, 139 (2008) (suggesting that the reason companies spend exorbitant amounts of money on such little advertisement time is due to the influential impact that the advertisements have for the companies).

⁴ See, e.g., Claire Cain Miller, *Putting Twitter's World to Use*, N.Y. TIMES, Apr. 14, 2009, at B1 (stating that Twitter.com was visited over 99 million times in the month of March 2009 and charges no fee for opening up an account). See also TWITTER, <http://twitter.com/> (last visited June 9, 2011).

⁵ See generally Dana M. Boyd & Nicole B. Ellison, *Social Network Sites: Definition, History, and Scholarship*, 13 J. COMP.-MEDIATED COMM'N 11 (2007) (reporting on the history of social network sites and their increase in popularity over the years); *About Twitter*, TWITTER, <http://twitter.com/about> (last visited June 9, 2011).

⁶ Steven Johnson, *How Twitter Will Change the Way We Live (in 140 characters or less)*, TIME, June 15, 2009, at 32 (comparing the percent change in website visitors from April 2008 to April 2009 showed a 1,298% increase on Twitter compared to Google, Facebook, Amazon.com and Myspace.com with percent changes of 9%, 217%, 7% and -7% respectively).

⁷ Miller, *supra* note 4.

⁸ Brad Stone, *Keeping a True Identity Becomes a Battle Online*, N.Y. TIMES, June 18, 2009, at B1 (paraphrasing a quote from Howard H. Weller who is a trademark lawyer at Mitchell Silberberg & Knupp in New York).

⁹ *Id.*

account, there is no legal remedy available if another user is already using the desired name of the original company.¹⁰

This comment examines trademark issues that companies experience as Twitter's popularity continues to increase. Part I provides a description of Twitter, how companies use the website's services, and the problems that exist on Twitter for trademark owners. Part I also provides information regarding causes of action under the Lanham Act that protect trademark owners against unauthorized use of their intellectual property on the internet, specifically cybersquatting. Part II analyzes whether the traditional methods of assigning liability for the unauthorized use of trademarks on the internet can help cure the issues that arise from Twitter. Part III proposes that Congress and courts consider expanding the scope of current law under the Lanham Act to include unforeseen cybersquatting issues like those on Twitter, because these issues will continue to occur unless action is taken.

I. BACKGROUND

A. *What is Twitter?*

A social networking site is defined as a web-based service that allows users to do three things: create a public profile, generate a list of other users who share a common interest, and view the various connections users have among themselves and extended groups.¹¹

The first social network site, SixDegrees.com, launched in 1997.¹² Throughout the next four years, a number of social networking sites "began supporting various combinations of profiles and publicly articulated friends."¹³ For example, Facebook, which launched in 2004 as a social network site for Harvard-only users, slowly expanded to include other colleges and, within a year, the general public.¹⁴

Twitter is the latest example of a popular social network site. Twitter allows users to generate and send messages of up to 140 characters to anyone in their

¹⁰ *See id.*

¹¹ Ellison, *supra* note 5, at 12.

What makes social network sites unique is not that they allow individuals to meet strangers, but rather that they enable users to articulate and make visible their social networks. This can result in connections between individuals that would not otherwise be made, but that is often not the goal, and these meetings are frequently between 'latent ties' who share some offline connection. On many of the large SNSs, participants are not necessarily "networking" or looking to meet new people; instead they are primarily communicating with people who are already a part of their extended social network.

Id.

¹² *Id.* (stating that SixDegrees.com allowed users to create profiles, list their friends and, beginning in 1998, surf the Friends lists).

¹³ *Id.* (stating that AsianAvenue, BlackPlanet, and MiGente allowed users to create personal, professional, and dating profiles—users could identify Friends on their personal profiles without seeking approval for those connections).

¹⁴ *Id.*

contact list (“followers”).¹⁵ Though the limit of 140 characters somewhat hampers the users’ ability to communicate with others, users have found ways around this limitation by creating messages through posting links to websites, videos, and discussion boards.¹⁶ Each message posted on Twitter is called a “tweet.”¹⁷ Twitter users can post tweets through any device capable of connecting to the internet such as computers, smart phones and even cell phones.¹⁸ When a user posts tweets, the messages appear on that user’s Twitter page in reverse chronological order.¹⁹

Currently, Twitter is a free service.²⁰ Although the service started without a revenue model, the website has begun exploring avenues for commercial gain.²¹ Further, Twitter has demonstrated interest in potential revenue generators.²² One current source of revenue for Twitter is selling advertisement space on its website.²³ In addition to advertising, Twitter also allows Google and Microsoft to display tweets in their search engines, which is an additional form of revenue.²⁴

¹⁵ See Paul Boutin, *All You Need to Know to Tweet on Twitter*, N.Y. TIMES, May 7, 2009, at B8 (limiting the amount of characters per message to 140 deliberately allows the messages to be retrieved by followers on their cell phones as well as their computers). The limit cell phone service providers put on text messages is 160 characters, but Twitter allows the extra 20 characters for the user name to be displayed. *Id.*; see also Jason Pontin, *From Many Tweets, One Loud Voice on the Internet*, N.Y. TIMES, Apr. 22, 2007, at C3 (quoting Twitter.com CEO Evan Williams as saying, “Twitter is best understood as a highly flexible messaging system that swiftly routes messages, composed on a variety of devices, to the people who have elected to receive them in the medium the recipients prefer”).

¹⁶ See Johnson, *supra* note 6, at 32 (stating that users, in addition to posting text messages, can post website links to “longer articles, discussions, posts, videos” and almost “anything” that has a URL address attached to it). There is a growing number of websites which have traffic coming from Twitter rather than traditional search engines. *Id.* In fact, Twitter is now competing with traditional search engines like Google and Yahoo for directing internet users to websites. *Id.*

¹⁷ *Id.*

¹⁸ See *id.*

¹⁹ *Surf and Turf: Defining a Blog*, ECONOMIST ONLINE (Mar. 3, 2011), http://www.economist.com/blogs/babbage/2011/03/defining_blog.

²⁰ See TWITTER, <http://twitter.com/> (last visited June 9, 2011) (permitting free registration for a Twitter account).

²¹ See Jessica Guynn, *Twitter Tries to Dig Up a Profit*, CHI. TRIB., Feb. 1, 2011, at C17 (“[I]nvestors competed for the opportunity to pour \$200 million into the . . . company.”).

²² See Walt Mossberg & Kara Swisher, *Technology (A Special Report): All Things Digital—Open for Business: Twitter’s Evan Williams and Biz Stone on Finding Revenue in Tweets*, WALL ST. J., June 2, 2009, at R6 (stating that Twitter has considered the idea of commercial-accounts, which would allow businesses to learn more about their consumers); Claire Cain Miller, *Twitter’s Pitch to Businesses*, N.Y. TIMES, July 27, 2009, at B4.

Twitter has considered offering special paid services for businesses for quite a while.

Last week it took a step closer by unveiling Twitter 101, a series of Web pages and a downloadable slide show that explain[s] what Twitter is and how businesses can use it, along with case studies of a few companies that use Twitter.

Id.

²³ See Guynn, *supra* note 21 (stating that Twitter had \$150 million in revenue this year with most of it coming from selling advertising space).

²⁴ *Id.* (stating that the deals with Google and Microsoft could be worth up to \$25 million).

B. How is Twitter Used?

Through the past year, Twitter's registered users have dramatically increased by more than 100 million.²⁵ Twitter is used in a variety of ways, by hospitals to report on new procedures for surgery, by political groups to coordinate rallies or protests, by media outlets to report on the news when other traditional forms have been restricted, by politicians in order to reach out to constituents, and by financial traders in order to share real time data with one another.²⁶ Celebrities, which are a large part of Twitter's rise to popularity, have been among the most active users of the website.²⁷ As of March of 2011, the Twitter accounts with the most followers were: Lady Gaga (more than eight million followers), Britney Spears (seven million followers), and President Barack Obama (six and a half million followers).²⁸ Kim Kardashian and Ashton Kutcher are also up there each with more than six million followers.²⁹ Twitter is a new medium for celebrities to interact with fans.³⁰

Companies are using Twitter to track who is following their tweets, what is said about the company and products, and when users stop following their tweets.³¹ Furthermore, companies often use Twitter for sales pitches, to update their followers on new products, or to get instant feedback from consumers on new ideas.³² Big

²⁵ *Id.* (stating that Twitter's user base increased by more than 100 million people in 2010).

²⁶ See Miller, *supra* note 4 (Henry Ford Hospital in Detroit tweets during live procedures to update followers on the status of the procedures). In Moldova, users tweet in order to organize protests and to let outsiders know of political updates in their country. *Id.* In 2006, San Franciscans used Twitter to update people about the aftermaths of an earthquake. *Id.*; Mark Landler & Brian Stelter, *With a Hint to Twitter, Washington Taps into a Potent New Force in Diplomacy*, N.Y. TIMES, June 17, 2009, at A12 (during the recent Iranian elections, the U.S. Government convinced Twitter to postpone scheduled maintenance work as the government recognized the use of Twitter by local Iranians to disseminate the progress of the election to the outside world); Daniel de Vise, *Tweeting Their Own Horns; Study Finds Posts by Lawmakers Boastful or Boring*, WASH. POST, Sept. 20, 2009, at A13 (discussing the progress of Congress reaching out to the public through the use of Twitter); Ian Berry & Lauren Rees, *For Traders, Twitter Is One More Trading Tool*, WALL ST. J., Aug. 3, 2009, at C2 (sharing information traders, analysts, and farmers use Twitter to record and analyze the fundamentals on crops and market moves).

²⁷ See Dwight Silverman, *Computing Twitter's Now Much More Than a Trivial Plaything*, HOUSTON CHRON., Oct. 26, 2010, at B1 (stating that Twitter's Evan Williams was contacted by Oprah to do a segment on the race that Ashton Kutcher had with CNN to be the first to get one million followers on Twitter).

²⁸ Andrea Spiegel, *We Love You, Charlie*, FORBES, Mar. 28, 2011, at 34.

²⁹ *Id.*; see Fernando Alfonso III, *A Guide to Social Media*, THE POST STAND. (Syracuse, N.Y.), Feb. 22, 2011, at F4.

³⁰ See, e.g., Spiegel, *supra* note 28 (stating that Charlie Sheen, after he left the production of his television show *Two and a Half Men*, had 900,000 Twitter followers within 24 hours of signing up).

³¹ See Raymun Flandez, *Managing Technology: Tools for Tweets: New Software Lets Small Businesses Get The Most Out of Twitter*, WALL ST. J., July 13, 2009, at R4 (stating that these capabilities are not built into Twitter yet, but there are thousands of tools accessible to companies through free software); Miller, *supra* note 22 (monitoring Twitter for users writing about competitors, Turbo Tax then offers those users its own service).

³² See Claire Cain Miller, *Mom-and-Pop Operators Turn to Social Media*, N.Y. TIMES, July 23, 2009, at B6 (using Twitter to answer customer feedback, companies such as Dell, Starbucks, and Comcast see Twitter as valuable business tool, while Umi, a sushi restaurant in San Francisco, Tweets about daily menu changes).

companies are not the only companies gravitating towards Twitter; small businesses are also attracted to the website, because it is a cheaper, simpler form of marketing.³³

C. Trademark Problems Arising from Twitter

New technology, combined with varying uses of it, is bound to create challenges for internet users and website operators alike. With the rise of social networking as an alternative form of communication, companies can no longer merely register a simple web address; they must now also assess which social networking websites are worth joining.³⁴ For example, American Airlines chose Twitter and has “registered every possible Twitter name that could be associated with [its brand].”³⁵

Other companies, rather than being proactive, discover problems with networking sites the hard way. A few years ago, a marketing consultant sent an email to amusement-park operator, Cedar Fair LP, which informed Cedar Fair that the consultant had created a Twitter account using the company’s main trademark, “Cedar Point.”³⁶ The consultant offered to trade control of the Twitter account in exchange for season passes as well as hiring his company to oversee the Cedar Point Twitter account.³⁷ The consultant transferred control of the account to Cedar Fair at the company’s request, and the Twitter account is now used to promote the park to more than 1,500 followers.³⁸

Companies are not the only Twitter users facing problems. In fact, fake celebrity Twitter accounts are just as common.³⁹ One of the more recent and famous examples was that of Rahm Emanuel during his successful mayoral campaign in Chicago.⁴⁰ During Emanuel’s candidacy, Dan Sinker, a professor at Columbia College, registered the Twitter account @MayorEmanuel.⁴¹ After hundreds of tweets invoking profanities, Rahm Emanuel offered to donate \$2,500 to the charity of the imposter’s choice in exchange for the user’s identity.⁴²

³³ *Id.* (comparing the costs of operating a website to having a Twitter account, Twitter is cheaper and easier).

³⁴ Stone, *supra* note 8.

Another problem is that no one knows whether any of this **online** terrain has any lasting value—only that accounts on sites like Twitter and Facebook tend to show up at the top of the list when people search the Web . . . so many people are plunging in—including so-called cyber squatters who hope to profit, financially or otherwise, from Web addresses and accounts.

Id. (emphasis added).

³⁵ Sarah E. Needleman, *Companies Cope with Twitter Imposters*, WALL ST. J., June 29, 2009, at B2 (stating that American Airlines registered every possible name linked with existing trademarks after they discovered a profile on Twitter called “AmericanAir”, which was shut down four weeks later).

³⁶ *Id.*

³⁷ *Id.* (reporting that Cedar Fair did not hire the consultant’s firm).

³⁸ *Id.*

³⁹ See Stone, *supra* note 8 (stating that public fights have broken out over Kanye West imposter accounts).

⁴⁰ See Mark Caro, *Tweeter Goes Out With an F-Bomb*, CHI. TRIB., Feb. 24, 2011, at C2.

⁴¹ See *id.*; Randy Kennedy, *Twitter, Twitter, Burning Bright*, N.Y. TIMES, Mar. 20, 2011, at WK3.

⁴² See Caro, *supra* note 40.

Currently, Twitter has offered little if any help to resolve the problem of imposter accounts.⁴³ In order to discourage imposter accounts, Twitter began offering companies a verification process for a small fee.⁴⁴ After a short time, however, Twitter closed this process to all but a few trusted sources.⁴⁵ If Twitter does not re-launch this feature, companies might be out of protection in the future, as current cybersquatting laws do not provide protection against this kind of trademark misuse.⁴⁶

Celebrities may be able to seek relief under various states' right of publicity laws, which protect an individual's right to control the commercial use of his identity.⁴⁷ Although companies are left without such an option, several cases over the past year have given hope to companies that suffer from Twitter imposters.⁴⁸ In

⁴³ See Stone, *supra* note 8 (although the company is beginning to put badges on user pages that it has verified are legitimate, this is only being done on a trial basis); *About Verified Accounts*, TWITTER, <http://support.twitter.com/groups/31-twitter-basics/topics/111-features/articles/119135-about-verified-accounts> (last visited June 9, 2011) ("Verification is used to establish authenticity for accounts who deal with identity confusion regularly on Twitter.")

⁴⁴ See *About Verified Accounts*, *supra* note 43.

⁴⁵ *Id.*

Twitter's public beta version of account verification is no longer available. After a long period of manual testing, we've closed public applications. We have removed our public-facing verification request form. In the meantime, we're still verifying some trusted sources, such as our advertisers and partners. If you're one of our partners or advertisers, please follow up with your account manager for details.

Id.

⁴⁶ Needleman, *supra* note 35.

While a 1999 law gave trademark owners the right to sue cybersquatters, it is unclear how the law would apply to false Twitter accounts. 'It's not covered by existing laws protecting against domain name abuse,' says Susan Weller, a trademark attorney in Washington, D.C., for Mintz, Levin, Cohn, Ferris, Glovsky and Popeo P.C.

Id.

⁴⁷ See, e.g., Right of Publicity Act, 735 ILL. COMP. STAT. 1075 § 5 (1999) (defining "Identity" as "any attribute of an individual that serves to identify that individual to an ordinary, reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice."). It should further be noted that whether an imposter's use of a person's name as a Twitter account is in fact a commercial purpose has not yet been decided by any court in the United States.

⁴⁸ See *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 346 (S.D.N.Y. 2010).

Defendant's actions with respect to its Twitter account violate the express terms of this Court's order, which enjoined Defendant from using any and all of Plaintiff's marks. The fact that Defendant is not accepting additional "followers" on its "nyctriclub" Twitter account and has "protected" its "tweets" (rendered them private) (*id.*), does not alter the fact that Defendant's "nyctriclub" account is publicly viewable and patently in violation of the terms of the injunction. Defendant is ordered to remove any reference to "nyctriclub" or any of Plaintiff's Marks or anything similar from all websites, social networking sites and other forms of electronic media.

Id.; *Black Sheep Television, Ltd. v. Town of Islip*, 10-CV-04926, 2010 WL 4961669, at *2 (E.D.N.Y. Dec. 6, 2010) (order granting preliminary injunction):

Pursuant to Rule 65(a) of the Federal Rules of Civil Procedure, Plaintiff and all agents, representatives or assigns thereof, including, but not limited to, Jacques Ditte and Jan Hanna, are hereby enjoined from any use of the DOMAIN NAMES and the Twitter Accounts during the pendency of this action. These domain names

New York City Triathlon, LLC v. NYC Triathlon Club, Inc., the United States District Court for the Southern District of New York granted a preliminary injunction enjoining the seller of triathlon equipment from using certain marks on the internet, which included use on Twitter accounts.⁴⁹ In *Black Sheep Television, Ltd. v. The Town of Islip*, the United States District Court for the Eastern District of New York granted a preliminary injunction enjoining Black Sheep Television from using several of its domain names and Twitter accounts that were similar to trademarks utilized by the Long Island Macarthur Airport.⁵⁰ In both cases, the parties listed both trademark infringement and cybersquatting among the claims.⁵¹

D. The Anticybersquatting Consumer Protection Act

1. What is Cybersquatting?

Cybersquatting occurs when one person registers a domain name, owned by another, with the bad faith intent to profit.⁵² The practice of cybersquatting can be carried out in a number of different ways. Methods include registration of another's mark as a domain name;⁵³ registration of a misspelling of another's trademark;⁵⁴

and Twitter Accounts shall remain in the ownership, custody, and control of the Town of Islip throughout the pendency of this litigation.

Id.

⁴⁹ *New York City Triathlon*, 704 F. Supp. 2d at 326.

⁵⁰ *See Black Sheep Television*, 2010 WL 4961669, at *2.

⁵¹ *See New York City Triathlon*, 704 F. Supp. 2d at 313; *see also* Verified Counterclaim at 5, *Black Sheep Television, Ltd. v. The Town of Islip*, No. 10-04326 (E.D.N.Y. Dec. 3, 2010), 2010 WL 4970766.

⁵² 15 U.S.C. § 1125(d) (2006).

(1) (A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

Id.

⁵³ S. REP. NO. 106-140, at 5 (1999) (“Some register well-known brand names as Internet domain names in order to extract payment from the rightful owners of the marks, who find their trademarks ‘locked up’ and are forced to pay for the right to engage in electronic commerce under their own brand name”).

⁵⁴ *Id.* at 6 (“Cybersquatters often register well-known marks to prey on consumer confusion by misusing the domain name to divert customers from the mark owner’s site to the cybersquatter’s own site. . .”).

registration of another's trademark with a suffix other than ".com";⁵⁵ the registration of another's mark as part of a domain name;⁵⁶ registration of another individual's name as a domain name;⁵⁷ registration of the mark of a competitor;⁵⁸ and registration of the mark of an organization opposed by the registrant.⁵⁹

The Anticybersquatting Consumer Protection Act ("ACPA") was enacted in 1999 to protect consumers and American businesses from the registration of domain names containing imposter trademarks.⁶⁰ Prior to the ACPA, trademark owners had limited recourse against such practices.⁶¹

2. Key Definitions of the ACPA

According to the Lanham Act, the term "domain name" means "any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet."⁶² The Senate Reports elaborate as to what Congress intended by that definition.⁶³ Congress only intended to protect whatever words are between "www" and ".com," ".net," ".org," ".edu," or other top-level domain names ("TLD").⁶⁴

In *Interactive Products Corp. v. A2Z Mobile Office Solutions*, the United States Court of Appeals for the Sixth Circuit held that,

"each web page within a website has a corresponding uniform recourse locator ('URL') (e.g., a2zsolutions.com/desks/floor/laptraveler/dkfl-lt.htm), which consists of a domain name and a post-domain path. A post-domain path consists of any combination of

⁵⁵ Steven R. Borgman, *The New Federal Cybersquatting Laws*, 8 TEX. INTELL. PROP. L.J. 265, 266–67 (2000).

⁵⁶ 145 CONG. REC. S. 9744, 9749 (July 29, 1999) (statement of Sen. Orrin Hatch (R-Utah)).

⁵⁷ Borgman, *supra* note 55, at 266–67.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ S. REP. NO. 106-140, at 4 (1999).

The purpose of the bill is to protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks a practice commonly referred to as 'cybersquatting.'

Id.

⁶¹ See Jennifer Golinveaux, *What's in A Domain Name: Is "Cybersquatting" Trademark Dilution*, 33 U.S.F. L. REV. 641, 652 (1999) (noting that in traditional trademark infringement cases it is difficult to prove a likelihood of confusion because the squatter is either making no use of the website, or making a use that is unlikely to confuse the viewer as to sponsorship or affiliation). In addition, cybersquatting does not fit neatly into either forms of dilution (blurring and tarnishment) as the squatter normally makes no use of the trademark in association with goods or services. *Id.*

⁶² 15 U.S.C. § 1127 (2006).

⁶³ S. REP. NO. 106-140, at 9 (1999) (providing a very narrow definition of the term "domain name"). This definition covers the name located immediately to the left of the ".com," ".net," ".edu," and ".org" generic top-level domains. *Id.* This was purposefully done to leave out such things like screen names, files names, and other identifiers not assigned by a domain name registrar. *Id.*

⁶⁴ *Id.*

numbers or letters after the top-level domain name. A post-domain path merely shows how a website's data is organized within the host computer's files."⁶⁵

The court agreed with prior decisions and held that while domain names serve a source identifying function, the post-domain paths serve as an organization for the domain name's files hosted on the host computer.⁶⁶

There are no definitions provided for terms "domain name registrar," "domain name registry," or "other domain name registration authority" that would help in further understanding what was intended by "domain name."⁶⁷ Recent case law, however, provides further insight as to the definition of a registrar.⁶⁸ In 2009, in *Solid Host, NL v. Namecheap, Inc.*, the Central District Court of California defined a registrar as an entity that is accredited by the Internet Corporation for Assigned Names and Numbers ("ICANN"), which requires the entity to sign the ICANN Registrar Accreditation Agreement.⁶⁹

⁶⁵ *Interactive Prods. Corp. v. A2Z Mobile Office Solutions Inc.*, 326 F.3d 687 (6th Cir. 2003) (deciding whether the presence of 'laptraveler' in the URL post-domain path for a2z's portable-computer-stand web page is likely to cause confusion among consumers regarding the origin of the Model Desk product). A post-domain path is anything that comes after the top-level domain name. For example, with www.Twitter.com/cocacola, ".com" is the top-level domain name and "coca cola" is the post-domain name. *Id.* Also holding that "because post-domain paths do not typically signify source, it is unlikely that the presence of another's trademark in a post-domain path of a URL would ever violate trademark law." *Id.* at 697.

⁶⁶ *Id.*

⁶⁷ See 15 U.S.C. § 1127.

⁶⁸ *Solid Host, NL v. Namecheap, Inc.*, No. 08-5414, 2009 U.S. Dist. LEXIS 63423, at *4 (C.D. Cal. May 19, 2009).

One wishing to use a specific domain name must register the name with one of numerous competing companies known as registrars. In 1993, pursuant to a contract with the National Science Foundation, Network Solutions, Inc. (NSI) became the sole registrar for domain names in the most commonly used TLD's (.com, .net, .org, and .edu). In 1998, the federal government adopted a policy favoring competitive domain name registration. In furtherance of this policy, a private, non-profit corporation, the Internet Corporation for Assigned Names and Numbers (ICANN), was formed to assume responsibilities for managing the allocation of Internet Protocol numbers and the domain name system. Also as part of the transition to a competitive system, NSI's domain name registration service was divided into two separate units: a registrar and a registry. The registry maintains a centralized, publicly accessible database of information concerning all domain names in a TLD, known as the Whois (or WHOIS) database; this database is compiled from information submitted by registrars. While there is only a single registry for each TLD, there are numerous competing registrars. Registrars control the IP addresses associated with particular domain names. Customers seeking to register specific domain names interact with registrars; the registrars submit information regarding domain names to the registry, which includes the information in the public Whois database. A registrar must be accredited by ICANN for each TLD in which it operates. As part of the certification process, all registrars must sign the ICANN Registrar Accreditation Agreement (the 'ICANN agreement').

Id.

⁶⁹ *Id.*

3. Exploring the Different Parts of the ACPA

The ACPA requires three elements to establish liability for cybersquatting: (1) plaintiff's mark was distinctive or famous at the time the domain name was registered; (2) the domain name registered by the defendant is confusingly similar or identical to the trademark; and (3) defendant used or registered the domain name with a bad faith intent to profit.⁷⁰

a. First Element: The Mark's Distinctiveness

In a cybersquatting action, a plaintiff must show his mark is distinctive or famous.⁷¹ Distinctiveness refers to the originality of a mark and is different from the concept of fame.⁷² In fact, a mark may be distinctive upon creation, prior to use in commerce and before it has developed a level of fame.⁷³ Similarly, a famous mark may lack any distinctive qualities.⁷⁴ Assessing the distinctiveness of a mark in a cybersquatting case is the same as in non-cybersquatting trademark cases.⁷⁵ Under the Lanham Act, courts have recognized five categories of distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.⁷⁶ While generic marks can never function as a trademark, descriptive marks can become valid trademarks upon a showing of acquired distinctiveness, also known as "secondary meaning."⁷⁷ The last three categories, suggestive, arbitrary and fanciful, require no secondary meaning as they are inherently distinctive and are given the most protection.⁷⁸

Some have argued that domain names acquire distinctiveness based on the number of "hits" generated by searches for the mark on internet search engines like Yahoo or Google.⁷⁹ The United States Court of Appeals for the Tenth Circuit rejected that argument in *Utah Lighthouse Ministry v. Foundation for Apologetic Information & Research*.⁸⁰ The court stated that unless there is evidence that the search engine "hits" had been made by the relevant market of consumers, such evidence would be

⁷⁰ 15 U.S.C. § 1125(d).

⁷¹ *Id.* § 1125(d)(1)(A)(ii)(I–II).

⁷² *Dudley v. Healthsource Chiropractic, Inc.*, 585 F. Supp. 2d 433, 440 (W.D.N.Y. 2008).

⁷³ *Sporty's Farm L.L.C. v. Sportman's Mkt., Inc.*, 202 F.3d 489, 497 (2d Cir. 2000).

⁷⁴ *Id.*

⁷⁵ *Utah Lighthouse Ministry v. Found. For Apologetic Info. & Res.*, 537 F.3d 1045, 1057 (10th Cir. 2008) (stating that the plaintiff failed to meet the burden of showing that its mark is distinctive under the 15 U.S.C. § 1125(a)(1)(B) analysis and, therefore, failed to meet its burden on the first element of the ACPA).

⁷⁶ *E.g.*, *Two Pesos, Inc. v. Taco Cabana*, 505 U.S. 763, 768 (1992).

⁷⁷ *Id.* at 769; *Centaur Commc'n v. A/S/M Commc'n*, 830 F.2d 1217, 1222 (2d Cir. 1987) (determining that secondary meaning is reached by evaluating these factors: advertisement expenditures effectiveness, consumer studies linking mark to the source, unsolicited media coverage of the product, sales success, attempts to plagiarize the mark, and length and exclusivity of the mark's use).

⁷⁸ *Two Pesos*, 505 U.S. at 768.

⁷⁹ *Utah Lighthouse Ministry*, 527 F.3d at 1052 ("The number of search engine hits, standing alone, is inadequate to demonstrate that consumers associated the mark with a particular product or producer").

⁸⁰ *Id.*

inadequate alone to show that consumers associated the mark with a particular product or producer.⁸¹

b. Second Element: Whether the Domain Name Is Confusingly Similar

Under the second element, the domain name registered by the defendant must be confusingly similar or identical to the trademark.⁸² When evaluating whether a domain name is confusingly similar to a mark, a court will disregard the top-level domain name, which is the ending character of the domain name, such as “.com,” “.org.”⁸³ The test for this element requires an evaluation of the domain name and protected trademark “without regard to the goods or services of the parties.”⁸⁴ When examining the domain name, the court’s analysis should include the integral sounds, sights and meanings with which the domain name is associated by the parties’ use.⁸⁵

c. Third Element: Whether the Imposter Has a Bad Faith Intent to Profit

Rather than requiring the “use in commerce” elements of the Lanham Act, the ACPA only requires “bad faith intent to profit.”⁸⁶ The APCA further provides a list of nine, non-exhaustive factors to help the courts determine whether a potential

⁸¹ *Id.*

⁸² 15 U.S.C. § 1125(d)(1)(A)(ii)(I–II) (2006).

⁸³ See *Sporty’s Farm L.L.C. v. Sportman’s Mkt., Inc.*, 202 F.3d 489, 497–98 (2d Cir. 2000) (discussing how a domain name consists of two parts separated by a period). The portion to the right of the period, *i.e.*, the “com” is known as the “top level domain” or “TLD”. The portion to the left of the period, generally a series of numbers and letters chosen by the operator of the site is known as the “second level” domain” or “SLD.” *Id.*

⁸⁴ 15 U.S.C. § 1125(d)(1)(A). This evaluation is different than that for the likelihood of confusion test for trademark infringement. See *N. Lights Tech. v. N. Lights Club*, 97 F. Supp. 2d 96, 117, 118 (D. Mass. 2000).

Congress was concerned not with activities that approximated infringement but, instead, with domain name prospecting. To interpret ‘confusingly similar’ as shorthand for the ‘likelihood of confusion’ infringement test would largely undermine Congress’s goal of stopping individuals who own domain names that approximate distinctive marks but do not actively use the domain names other than to make them available for sale. Furthermore, Congress intended to use the bad faith element of a claim not the ‘confusingly similar’ element to tailor the statute narrowly.

Id.

⁸⁵ See, *e.g.*, *Sporty’s Farm*, 202 F.3d at 498 (holding that the secondary domain name in this case (sportys) is indistinguishable from the Sportsman’s trademark (*sporty’s*)). Although the domain name sportys.com is not precisely identical to the *sporty’s* mark, it is “confusingly similar” to the protected mark. *Id.* See also *Brookfield Commc’n, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (noting that the differences between the mark “MovieBuff” and the domain name “moviebuff.com” are “inconsequential in light of the fact that Web addresses are not caps-sensitive and that the ‘.com’ top-level domain signifies the site’s commercial nature”); *Wella Corp. v. Wella Graphics, Inc.*, 874 F. Supp. 54, 56 (E.D.N.Y. 1994) (finding the new mark “Wello” confusingly similar to the trademark “Wella”).

⁸⁶ 15 U.S.C. § 1125(d)(1)(A)(i).

cybersquatter acted in bad faith with intent to profit.⁸⁷ The first four factors “suggest circumstances that may tend to indicate an absence of bad-faith intent to profit from the goodwill of a mark, and the last five factors suggest circumstances that may tend to indicate that such bad-faith intent exists.”⁸⁸ There is no simple formula, however, for evaluating and weighing these factors. These factors are given to the court as an optional guide, not as “a substitute for careful thinking about whether the conduct . . . is motivated by a bad faith intent to profit.”⁸⁹

The nine factors are fairly straight forward, but some attention should be devoted to how the courts have interpreted the factors’ language. Under the second factor, it is generally accepted that abbreviations of legal names count as though the

⁸⁷ *Id.* § 1125(d)(1)(B)(i)(I-IX). In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

- (I) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
- (III) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
- (IV) the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
- (V) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;
- (VI) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct;
- (VII) the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct;
- (VIII) the person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and
- (IX) the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of subsection (c).

Id.

⁸⁸ H.R. REP. No. 106-412, at 10 (1999).

⁸⁹ *Lucas Nursery & Landscaping, Inc. v. Gross*, 359 F.3d 806, 811 (6th Cir. 2004) (holding that defendant did not to have a bad faith intent to profit as the web site explicitly stated that the site was established by defendant for the purposes of relaying her experience with the company). The court also took into consideration that the defendant never offered to sell the site to the company, she did not provide misleading contact information when she registered the domain name, and she had not acquired any additional domain names, which would be indicative of either an intent to sell such names to those entities whose trademarks were identical or similar, or exploit them for other uses. *Id.*

legal name itself was used.⁹⁰ In interpreting the third factor, courts have held if a junior user adopted a mark after it discovered the fame or distinctiveness of the mark, then there is a presumption of bad faith that the “junior user adopted the mark for the purpose of profiting from the aura of goodwill of the senior user’s mark.”⁹¹ Regarding the fourth factor, a website that critiques a product and uses the product’s trademark as the website’s domain name may be a fair use.⁹² When analyzing the fifth factor, the courts look at circumstantial evidence because direct evidence showing intent is rarely discernible.⁹³ The rest of the factors are fairly self-evident and there is not much room for misinterpretation.⁹⁴

⁹⁰ *Dudley v. Healthsource Chiropractic, Inc.*, 585 F. Supp. 2d 433, 441–42 (W.D.N.Y. 2008) (stating that, in this case, the “Franchisor’s legal name is Healthsource Chiropractic, Inc. and its domain name, healthsourcechiro.com”, is an abbreviation of its legal name).

⁹¹ *E.g.*, *E. & J. Gallo Winery v. Gallo Cattle Co.*, 12 U.S.P.Q.2d (BNA) 1657, 1675 (E.D. Cal. 1989) (discussing the element of bad faith in a trademark infringement case).

⁹² H.R. REP. NO. 106-412, at 11 (1999) (“the use of a domain name for purposes of comparative advertising, comment, criticism, parody, news reporting, etc., even when done for profit, would not alone satisfy the bad-faith intent requirement”); see *Lucas Nursery*, 359 F.3d at 806 (the party registering the domain name “lucasnursery.com” to complain about Lucas Nursery’s work was not liable under ACPA); *Mayflower Transit, L.L.C. v. Prince*, 314 F. Supp. 2d 362 (D.N.J. 2004) (finding no ACPA liability where defendant registered “mayflowervanline.com,” because the totality of circumstances demonstrated that registrant’s motive was to express dissatisfaction in doing business with the mark’s owner).

⁹³ See, e.g., *Audi AG and Volkswagen of Am., Inc. v. D’Amato*, 469 F.3d 534, 549 (6th Cir. 2006) (“D’Amato’s website purposefully included Audi’s trademarks in his website and affirmatively misrepresented his relationship with Audi by falsely stating that he had signed a written agreement with the company.”); See also *DaimlerChrysler v. Keith Maydak*, 388 F.3d 201, 207 (6th Cir. 2004) (inferring that the “defendants intended to divert customers from the plaintiff’s website” merely because the two domain names were phonetically identical); *HER, Inc. v. Re/Max First Choice, LLC*, No. 06-492, 2008 U.S. Dist. LEXIS 40164, at *8 (S.D. Ohio May 2, 2008) (stating that the diversion can either be for commercial gain or with the intent to tarnish or disparage the mark in order to show a bad faith intent to profit).

⁹⁴ 15 U.S.C. § 1125(d)(1)(B)(i)(VI-IX). The remaining four factors are:

- (VI) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct;
- (VII) the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct;
- (VIII) the person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and
- (IX) the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of subsection (c).

Id.

II. ANALYSIS

This section analyzes how the ACPA could apply to a hypothetical Twitter account controlled by an imposter. Section A focuses on the elements needed to fall under the scope of the ACPA. Then, Section B examines the factors enumerated in the statute and how they apply to Twitter accounts. Lastly, Section C analyzes two recent cases involving trademark rights and Twitter accounts.

A. A Hypothetical Twitter Imposter: Qualifications to be Protected Under the ACPA

Suppose Company A signed up for a Twitter account with the user name XYZ. Provided that name was not already in use, Twitter would then assign Company A the post-domain path of Twitter.com/XYZ with the corresponding screen name, @XYZ.⁹⁵ If XYZ happened to be a trademark of Company B, can the ACPA provide a remedy for the unauthorized use of that trademark in a post-domain path?

The first issue is whether the post-domain path assigned to Company A qualifies as a domain name under the ACPA. There are two qualifications required for a domain name to fall under the scope of the Act, and both are outlined in the definition of the term “domain name.”⁹⁶ First, the domain name must be any alphanumeric designation that is part of an electronic address on the internet.⁹⁷ Second, a domain name must be “registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority.”⁹⁸ Under this definition, the post-domain path assigned by Twitter to Company A does not qualify for protection. The Senate Report discussing the ACPA confirms this by revealing the creators’ intent to limit protection solely to domain names.⁹⁹

The Senate Report expressly gives “domain name” a narrow definition by limiting protection to only what is between “www” and the top-level domain name (“.com”, “.net”, “.gov”).¹⁰⁰ The only part of Company A’s post-domain path covered by the ACPA, then, would be the use of the word “Twitter.”¹⁰¹ However, the Senate’s rationale for this narrow definition would only seem to encourage the application of

⁹⁵ Donald Strachan, *Twitter: How to Set Up Your Account*, TELEGRAPH, <http://www.telegraph.co.uk/travel/4698589/Twitter-how-to-set-up-your-account.html> (last visited June 9, 2011).

⁹⁶ 15 U.S.C. § 1127 (2006).

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ S. REP. No. 106-140, at 9 (1999) (“The bill, as amended, provides a narrow definition of the term “domain name” in order to tailor the bill’s reach narrowly to the problem sought to be addressed”).

¹⁰⁰ *Id.*

This definition essentially covers the second-level domain names assigned by domain name registration authorities (i.e., the name located immediately to the left of the “.com,” “.net,” “.edu,” and “.org” generic top level domains), but is technology neutral enough to accommodate names other than second-level domains that are actually registered with domain name registration authorities, as many be the case should Internet domain name registrars begin to issue third or fourth level domains.

Id.

¹⁰¹ *Id.*

the ACPA to Twitter screen names.¹⁰² In fact, the Senate Report states that the narrow definition was intended to exclude such things as “screen names, files names, and other identifiers not assigned by a domain name registrar or registry, *which have little to do with cybersquatting in practice* [emphasis added].”¹⁰³ Cybersquatting-like activity, however, *has* been experienced with screen names and post domain-paths.¹⁰⁴ At this stage in the history of the internet it seems that Congress’ rationale for the definition of “domain name” does not support the definition itself.¹⁰⁵ Thus, it would seem that Company A’s post-domain path from Twitter should fall under the scope of the ACPA.

The second attribute a post-domain path must possess to fall under the scope of the ACPA is that it must be registered with any domain name registrar, domain name registry, or other domain name registration authority.¹⁰⁶ The Congressional intent behind the use of these terms is unclear as there are no definitions in the Act to shed light on what qualifies as a registrar or registry.¹⁰⁷ When statutes are ambiguous case law often provides a more complete explanation of what Congressional intent.¹⁰⁸ As illustrated in *Solid Host, NL v. Namecheap, Inc.*, courts view a registrar as an entity that is accredited by ICANN and has signed the ICANN Registrar Accreditation Agreement.¹⁰⁹ Twitter.com is absent from the list of ICANN’s accredited registrars, which prevents the ACPA from regulating screen names and post-domain paths given out by Twitter.¹¹⁰

B. A Hypothetical Twitter Imposter: Analysis of the ACPA’s Factors

Even though Twitter does not currently qualify as a registrar of domain names under relevant case law, further analysis provides insight as to whether the ACPA should be amended to include post-domain paths. The main focus of the ACPA is on the imposter’s “bad faith intent to profit” from use of that mark.¹¹¹ As mentioned,

¹⁰² See *id.* (“The limited nature of the definition is important in that it excludes such things as screen names, file names, and other identifiers not assigned by a domain name registrar or registry, which have little to do with cybersquatting in practice.”).

¹⁰³ *Id.*

¹⁰⁴ See discussion, *supra* Part I.C–D, notes 35–38.

¹⁰⁵ See S. REP. NO. 106-140, at 9 (1999).

¹⁰⁶ 15 U.S.C. § 1127 (2006) (showing no definition for “registrar” or “registry”).

¹⁰⁷ *Id.*

¹⁰⁸ See *generally* *Nguyen v. United States*, 556 F.3d 1244 (11th Cir. 2009) (discussing how a court should interpret a statute).

¹⁰⁹ *Solid Host, NL v. Namecheap, Inc.*, No. 08-5414, 2009 U.S. Dist. LEXIS 63423, at *4 (C.D. Cal. May 19, 2009) (“A registrar must be accredited by ICANN for each TLD in which it operates. As part of the certification process, all registrars must sign the ICANN Registrar Accreditation Agreement (the ‘ICANN agreement’).”).

¹¹⁰ See *Accredited Registrars*, ICANN, <http://www.icann.org/en/registrars/accredited-list.html> (last updated June 9, 2011).

¹¹¹ 15 U.S.C. § 1125(d)(1)(A)(2006).

A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section;

the ACPA provides a list of nine, non-exhaustive factors that a court may take into consideration when analyzing if the imposter has acted with a bad-faith intent to profit.¹¹²

1. Whether the Imposter has Intellectual Property Rights in the Domain Name and the Extent to Which the Domain Name Consists of the Legal Name of the Imposter?

Factors one and two are often analyzed together as both factors assess the legal rights a potential imposter has to use another's trademark in a domain name.¹¹³ As Twitter accounts tend to only consist of Twitter.com and a post-domain path of the user account name,¹¹⁴ the imposter would have to possess a right to use the trademark included in the name in order to avoid bad faith actions. This is seldom the case and it is the basis for most of the complaints on Twitter by companies against imposters.¹¹⁵

The second factor analyzes how much of the domain name is composed of the imposter's legal name.¹¹⁶ Looking more closely at this factor, courts have stated that abbreviations of legal names, changes in casing of letters, or words added to legal names still count as though the legal name itself is used.¹¹⁷ American Airlines recognized this as a potential problem when signing up for a Twitter account and took precautionary measures by registering every possible combination of the company's trademarks as user names.¹¹⁸ In the hypothetical, if the imposter

Id.

¹¹² *Id.* § 1125(d)(1)(B)(i)(I-IX).

¹¹³ *Id.* § 1125(d)(1)(B)(i)(I); *see, e.g.*, TMI Inc. v. Maxwell, 368 F.3d 433, 440 (5th Cir. 2004) (stating that factors I and II fall in favor of TMI because Maxwell had no pre-existing use of the TrendMaker name).

¹¹⁴ *See, e.g.*, Strachan, *supra* note 95.

¹¹⁵ *E.g.*, Needleman, *supra* note 35 (reporting that Exxon Mobil Corp. has found at least two unauthorized Twitter accounts under variations of its name; American Airlines registered every possible Twitter name that could be associated with the company after a rogue Twitter profile was discovered with a variation of their trademark; Cedar Fair LP was offered control of a Twitter account containing their trademarks in exchange for season passes to their amusement park; Elevation Burger found an unauthorized Twitter profile from a competitor, Z Burger).

¹¹⁶ 15 U.S.C. § 1125(d)(1)(B)(i)(II).

¹¹⁷ *Dudley v. Healthsource Chiropractic, Inc.*, 585 F. Supp. 2d 433, 441 (W.D.N.Y. 2008) ("The Franchisor's legal name is Healthsource Chiropractic, Inc. and its domain name, www.healthsourcechiro.com is obviously an abbreviation of its legal name."); *see Brookfield Comm'n v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (observing that the differences between the mark "MovieBuff" and the domain name "moviebuff.com" are "inconsequential in light of the fact that Web addresses are not caps-sensitive and that the '.com' top-level domain signifies the site's commercial nature").

¹¹⁸ Needleman, *supra* note 35.

In a defensive move, AMR Corp.'s American Airlines in April 'registered every possible Twitter name that could be associated with us,' a spokesman says. The move came after airline employees last summer found a rogue profile in the name AmericanAir, which was shut down four weeks later.

Id. *See, e.g.*, AAIRWAVES TWITTER, twitter.com/airwaves (last visited June 9, 2011); AMERICAN AIR TWITTER, twitter.com/americanair (last visited June 9, 2011); AMERICAN AA TWITTER, twitter.com/American_AA (last visited June 9, 2011).

registered Twitter.com/myXYZ or /xyz or any other combination that is confusingly similar to the trademark owner's mark it would violate this factor.

2. Whether the Imposter Has Used the Domain Name in Connection With the Bona Fide Offering of Any Goods or Services, Noncommercial Use or Fair Use?

The next two factors assess whether an imposter has a legitimate use of the domain name. Factor three evaluates whether the imposter has used the domain name for any bona fide uses of commerce.¹¹⁹ Because Twitter is still developing as a social network site, companies have been exploring different ways to use Twitter to offer goods and services.¹²⁰ Although the 140-character limit on posts could make it difficult for imposters to use the site in connection with bona fide commercial uses, users have found ways around the limit by posting links to websites outside of Twitter.com.¹²¹

The circuit courts are split on whether the linking of a commercial website would qualify as "offering of any goods or services."¹²² In the United States Court of

¹¹⁹ 15 U.S.C. § 1125(d)(1)(B)(i)(III).

¹²⁰ See Miller, *supra* note 4 ("Companies like Starbucks, Whole Foods and Dell can see what their customers are thinking as they use a product, and the companies can adapt their marketing accordingly"); see also Kimberly Palmer, *Tweeting Their Way into Your Wallet*, U.S. NEWS & WORLD REP. (Oct. 19, 2009), <http://www.usnews.com/money/blogs/alpha-consumer/2009/10/19/tweeting-their-way-into-your-wallet>.

Tony Hsieh, head of Zappos.com, says he thinks Tweeting does, ultimately, improve the company's sales. 'In the long run, yes. We don't think of Twitter as marketing channel, though. We look at it as a way of improving our relationship and connection with our customers,' he says. It seems to be working—he has almost 1.5 million followers. At the very least, those followers must be aware of the online shoe company.

Id.

¹²¹ Johnson, *supra* 6, at 32 (stating that users, in addition to posting text messages, can post website links to longer articles, discussions, posts, videos and almost anything that has a URL address attached to it).

¹²² See, e.g., Utah Lighthouse Ministry v. Found. for Apologetic Info. & Res., 527 F.3d 1045, 1052 (10th Cir. 2008) (holding that hyper-linking to a website that sells goods did not constitute a commercial use); People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359, 366 (4th Cir. 2001) (holding that a website which links to thirty commercial websites was itself commercial); Taubman Co. v. Webfeats, 319 F.3d 770, 775 (6th Cir. 2003) (concluding that a site was commercial because it contained hyperlinks to two commercial websites, even though the links were "extremely minimal"); Bosley Med. Inst. v. Kremer, 403 F.3d 672, 676–77 (9th Cir. 1999) (holding that a sequence of links to advertising was too remote to be commercial use); see also OBH, Inc. v. Spotlight Magazine, Inc., 86 F. Supp. 2d 176, 183 (W.D.N.Y. 2000) (holding that the defendant's website was used in connection with goods or services because the site contained hyperlinks to other local news sources and a site owned by the defendants that advertised local apartments). The court went on to say:

Prospective users of plaintiffs' services who mistakenly access defendants' web site may fail to continue to search for plaintiffs' web site due to confusion or frustration. Such users, who are presumably looking for the news services provided by the plaintiffs on their web site, may instead opt to select one of the several other news-related hyperlinks contained in defendants' web site. These news-related hyperlinks will directly link the user to other news-related web sites that are in direct competition with plaintiffs in providing news-related services

Appeals for the Ninth Circuit case, *Bosley Medical Institute v. Kremer*, the defendant used a hyperlink to another website that contained advertisements for the plaintiff's competitors.¹²³ The court held that such a use was not in connection with the sale of goods or services because the link was too "roundabout" and attenuated.¹²⁴

The United States Court of Appeals for the Fourth Circuit, however, in its decision of *People for the Ethical Treatment of Animals ["PETA"] v. Doughney*, stated that for the defendant to use PETA's mark "in connection with" goods or services he would only have to connect his infringing domain name to others' goods and services.¹²⁵ The court stated that in addition to preventing internet users from reaching the true website, the defendant's website linked to more than thirty commercial websites.¹²⁶ These facts were enough for the court to conclude that defendant's use of PETA's mark was in connection with the sale of goods and services.¹²⁷

As hinted to above, legitimate companies are able to use Twitter in connection with bona fide uses of commerce. In 2009, Dell reported that it had generated \$6.5 million in sales through Twitter.¹²⁸ Based on the aforementioned case law, however, where a lawsuit is filed will determine whether an imposter using the trademark of another as a Twitter screen name has done so in connection with the bona fide offering of any goods or services by hyper-linking to websites outside of Twitter.

Factor four assesses whether the imposter has any defenses for using another's trademark.¹²⁹ A House Report on the ACPA states that the "use of a domain name for purposes of comparative advertising, comment, criticism, parody, news reporting, etc. even where done for profit, would not alone satisfy the bad-faith intent requirement" under the statute.¹³⁰ As the majority of Twitter accounts are currently used for comment or criticism, an imposter might be able to offer several defenses. If the Fourth Circuit's logic from *PETA* is followed, however, then merely registering an imposter Twitter account and preventing users from accessing the real trademark owner's Twitter account is enough to qualify as commercial making the argument much more difficult that the domain name's use is for comment or criticism.¹³¹ It would appear that the assessment of these two factors depends largely on which circuit the trademark owner's case is in.

over the Internet. Thus, defendants' action in appropriating plaintiff's mark has a connection to plaintiff's distribution of its services.

Id.

¹²³ *Bosley*, 403 F.3d at 672.

¹²⁴ *Id.*

¹²⁵ *People for the Ethical Treatment of Animals*, 263 F.3d at 365.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ See Jenna Wortham & Nick Bilton, *Big Web Attack on Twitter is Third Assault This Year*, N.Y. TIMES, Dec. 19, 2009, at B3.

¹²⁹ 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (2006).

¹³⁰ H.R. REP. NO. 106-410, at 11 (1999).

¹³¹ See *People for the Ethical Treatment of Animals*, 263 F.3d at 365.

3. Whether the Imposter Has Intent to Divert Customers Either for Commercial Gain or to Tarnish or Disparage the Mark or Offers to Transfer, Sell, or Assign the Domain Name for Financial Gain?

The fifth factor assesses whether the imposter intends to divert customers away from the true trademark owner for commercial gain.¹³² As applied to Twitter, this factor weighs against an imposter and in favor of a finding of bad-faith intent to profit. Although intent is rarely proven directly, it typically is inferred from circumstantial evidence.¹³³ When the ACPA was first interpreted, the circuit courts were in agreement that the most common method of locating an unknown domain name was simply to type in the company name or logo with the suffix “.com.”¹³⁴ Since then, however, courts have observed that consumers are becoming more “internet-savvy.”¹³⁵ For example, the Ninth Circuit has stated:

An internet user interested in purchasing, or gaining information about Nissan automobiles, would be likely to enter nissan.com. When the item on that website was computers, the auto-seeking consumer would realize in one hot second that she was in wrong place and either guess again or resort to a search engine to locate Nissan Motor’s site. A consumer might initially be incorrect about the website, but Nissan Computer would not capitalize on the misdirected consumer. However, once nissan.com offered links to auto-related websites, then the auto-seeking consumer might logically be expected to follow those links to obtain information about automobiles. Nissan Computer financially benefitted because it received money for every click.¹³⁶

Under this logic, the mere usage of the mark XYZ in Company A’s Twitter account would not satisfy the fifth factor as an intent to divert customers from Company B’s online location. Merely possessing the domain name is not enough, as the Eleventh Circuit stated in *Southern Grouts v. 3M Co.*¹³⁷ *Southern Grouts* established the need for evidence of intent of diversion in acquiring or maintaining the domain name.¹³⁸

¹³² 15 U.S.C. § 1125(d)(1)(B)(i)(V).

The person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site.

Id.

¹³³ *Audi AG v. Bob D’Amato*, 469 F.3d 534, 549 (6th Cir. 2006) (quoting *Int’l Bancorp, LLC v. Societe Des Bains De Mer Et Du Cercle Des Etrangers A Monaco*, 192 F. Supp. 2d 467, 486 (E.D.Va. 2002) (“As intent is rarely discernible directly, it must typically be inferred from pertinent facts and circumstances.”)).

¹³⁴ *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1132 (D. Co. 2000) (“As stated by the Second Circuit in *Sporty’s*, the most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com.”).

¹³⁵ See *Nissan Motor Co. v. Nissan Computer Corp.*, No. 99-12980, 2007 U.S. Dist. LEXIS 90487, at *46 (C.D. Cal. Sept. 21, 2007).

¹³⁶ *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1019 (9th Cir. 2004).

¹³⁷ *S. Grouts & Mortars v. 3m Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009).

¹³⁸ *Id.*

Thus, this factor tends to be very fact specific and would depend on the imposter's conduct and what could be discerned during the discovery period. For example, in *Omega S.A. v. Omega Engineering*, the court stated that:

[D]efendants' registration and use of domain names containing generic terms exactly describing plaintiff's principal product and its chief function but not descriptive of any product sold by defendants or offered at the offending websites constitutes strong evidence of defendants' intent to divert customers from plaintiff's online location by creating a likelihood of confusion.¹³⁹

Again, the imposter's conduct and what the imposter uses the Twitter account for would determine which party this factor would favor in litigation.

The sixth factor tests whether there has been direct evidence of bad-faith intent to profit by selling the domain name.¹⁴⁰ Twitter imposters have attempted this type of cybersquatting. As discussed in the background, Cedar Fair LP received an offer by a marketing consultant to transfer control of a Twitter account that used Cedar Fair LP's trademark "Cedar Point" in exchange for season passes to the amusement park.¹⁴¹ This is exactly the type of behavior the ACPA attempts to prevent because the imposter is profiting off of using another's trademark in a domain name.¹⁴² The ACPA should therefore be amended to include Twitter domain names.

*4. Whether the Imposter Registers Multiple Domain Names Which are Identical or Confusingly Similar to Marks of Another and The Extent to Which the Mark Incorporated in the Imposter's Domain Name Is or Is Not Distinctive and Famous?*¹⁴³

The eighth factor assesses whether an imposter is specifically trying to profit off of another's trademark by registering multiple domain names containing that

¹³⁹ *Omega S.A. v. Omega Eng'g*, 228 F. Supp. 2d 112, 135 (D. Conn. 2002).

¹⁴⁰ 15 U.S.C. § 1125(d)(1)(B)(i)(VI) (2006).

The person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct.

Id.

¹⁴¹ See Needleman, *supra* note 35, at B2.

¹⁴² S. REP. NO. 106-140, at 5-7 (1999).

Cybersquatters target distinctive marks for a variety of reasons. Some register well-known brand names as Internet domain names in order to extract payment from the rightful owners of the marks, which find their trademarks "locked up" and are forced to pay for the right to engage in electronic commerce under their own brand name.

Id.

¹⁴³ Factor VII of Section 1125(d) is left out of this analysis because it relates to falsifying contact information when registering domain names with registrars. As of the date of publication one need only provide a full name, email, desired password, and desired username to Twitter in order to set up an account and receive the corresponding post-domain path. See *It's Your Turn—Join Twitter*, TWITTER, <http://twitter.com/signup> (last visited June 9, 2011).

trademark.¹⁴⁴ As some companies have taken preventative measures to insure this situation does not occur, this factor is applicable to a potential Twitter imposter.¹⁴⁵ As evidenced by American Airlines, users have the ability to register multiple Twitter accounts all containing various marks. This example demonstrates that Twitter users have the ability to violate this factor by registering as many Twitter accounts as they want containing trademarks that belong to others.

Factor nine deals with whether the trademark used in the imposter's domain name is distinctive or famous.¹⁴⁶ Referring to the hypothetical, if XYZ was determined by a court to be famous then this factor would weigh in favor of Company A. This factor is very fact specific and depends on the trademark at issue. Furthermore, this factor incorporates the topic of dilution, which is beyond the scope of this comment.

C. Current Case Law Dealing With Twitter Imposters

As Twitter imposters are becoming more and more prevalent, trademark owners are filing lawsuits to seek relief under sections of the Lanham Act.¹⁴⁷

1. New York City Triathlon, LLC v. NYC Triathlon Club, Inc.

In the United States District Court for the Southern District of New York, The New York City Triathlon, LLC ("plaintiff") filed a motion for preliminary injunction citing claims of both trademark infringement under § 43(a) of the Lanham Act and cybersquatting under § 43(d) of the Lanham Act (ACPA).¹⁴⁸ NYC Triathlon Club ("defendant") was using several names including "NYC Triathlon Club," "NYC Tri Club," and "New York City Triathlon Club" in both domain names as well as on social networking sites, including Twitter, that plaintiff thought were confusingly similar to its marks, NEW YORK CITY TRIATHLON, NYC TRIATHLON, and NYC TRI.¹⁴⁹

The court's discussion included analysis of both §§ 43(a) and 43(d) of the Lanham Act.¹⁵⁰ In regard to the § 43(a) analysis, the court held that plaintiff's

¹⁴⁴ 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

The person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties.

Id.

¹⁴⁵ See Needleman, *supra* note 35, at 32.

¹⁴⁶ 15 U.S.C. § 1125(d)(1)(B)(i)(IX) ("The extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).").

¹⁴⁷ See, e.g., *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 346 (S.D.N.Y. 2010); Verified Counterclaim at 5, *Black Sheep Television, Ltd. v. The Town of Islip*, No. 10-04326 (E.D.N.Y. Dec. 3, 2010), 2010 WL 4970766.

¹⁴⁸ *New York City Triathlon*, 704 F. Supp. 2d at 313.

¹⁴⁹ *Id.* at 311.

¹⁵⁰ *Id.* at 313, 323.

marks were descriptive, but protectable, as they had acquired secondary meaning, due to many years of use.¹⁵¹ The court further held that defendant's use of its marks was likely to create a likelihood of confusion with plaintiff's marks.¹⁵² In regard to the § 43(d) analysis, the court held that plaintiff's marks were distinctive, the infringing domain names complained of were identical or confusingly similar to plaintiff's marks, and the defendant had a bad faith intent to profit from the mark.¹⁵³

The court ordered defendants to "immediately refrain from using infringing marks on its site and all other web pages within its control, such as, but not limited to, its Facebook, Twitter, and LinkedIn pages."¹⁵⁴ Defendant argued that it would not totally deactivate its Twitter account because it did not wish to lose control of the "nyctriclub" screen name.¹⁵⁵ The court did not agree with defendant's argument and stated that defendant must remove "any reference to 'nyctriclub' or any of Plaintiff's marks or anything similar from all websites, social networking sites and other forms of electronic media."¹⁵⁶

The issue here is whether the quoted line of the court order includes deactivating defendant's Twitter screen names. With a holding that defendant has infringed on plaintiff's marks under § 43(a), the defendant would have to take down any reference to plaintiff's marks that appear on its Twitter page. For example, if the defendant had the mark in the banner at the top of the page or if the defendant used the mark as background wallpaper for its Twitter page, it would have to remove those marks to comply with the court's order.

The *New York City Triathlon* holding departs from precedent regarding post-domain paths and trademark infringement. In *Interactive Products Corp. v. a2z Mobile Office Solutions, Inc.*, the Sixth Circuit stated that "[I]t is unlikely that the presence of another's trademark in a post-domain path of a URL would ever violate trademark law."¹⁵⁷ This rule was upheld by the Sixth Circuit in 2010 in *Nagler v. Garcia*, when the court stated that the usage of plaintiff's mark in defendant's post-domain path "cannot support a claim for trademark infringement."¹⁵⁸ While this rule was established in the Sixth Circuit, the Southern District of New York adopted it in *Knight-McConnell v. Cummins* and specifically cited to the *Interactive Products* decision.¹⁵⁹ Based on this precedent in the Southern District of New York, the court in *NYC Triathlon Club* did not have the legal authority to order NYC Triathlon Club to deactivate its Twitter accounts based solely on the appearance of plaintiff's mark in its screen name/post-domain path.

This only leaves the court with authority under the ACPA to order the defendant to deactivate its Twitter account. Section 43(d) only applies to domain names, which is limited to what is in between "www" and the top-level domain names

¹⁵¹ *Id.* at 314–16.

¹⁵² *Id.* at 320–21.

¹⁵³ *Id.* at 324–25.

¹⁵⁴ *Id.* at 346.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 698 (6th Cir. 2003).

¹⁵⁸ *Nagler v. Garcia*, 370 Fed. App'x 678, 680 (6th Cir. 2010).

¹⁵⁹ *Knight-McConnell v. Cummins*, 03 Civ. 5035, 2004 U.S. Dist. LEXIS 14746, at *8 (S.D.N.Y. July 29, 2004).

and purposefully excluded both screen names and post-domain paths.¹⁶⁰ The court has appeared to lump the Twitter post-domain paths/screen names in with the traditional trademark infringement and cybersquatting that directly contradicts present case law.

2. *Black Sheep Television, Ltd. v. Town of Islip*

In 2010, in the United States District Court for the Eastern District of New York, Black Sheep Television, Ltd. (“Black Sheep”) filed a complaint against the Town of Islip (“Islip”).¹⁶¹ Islip answered with a counterclaim including claims of both trademark infringement under § 43(a) of the Lanham Act and cybersquatting under § 43(d) of the Lanham Act (ACPA).¹⁶² This case involved several of Islip’s airport marks allegedly being infringed.¹⁶³ Specifically, Black Sheep reserved @FlyLIMA, @IslipAirport, @MacArthurAirprt; and @ISPAirport as Twitter addresses.¹⁶⁴ Islip filed a complaint through Twitter’s internal trademark infringement complaint mechanism, to which Twitter responded by removing only one of the four imposter accounts.¹⁶⁵

On December 6, 2010, the Eastern District of New York granted Islip a preliminary injunction, which included the following language:

Pursuant to Rule 65(a) of the Federal Rules of Civil Procedure, Plaintiff and all agents, representatives or assigns thereof . . . are hereby enjoined from any use of the DOMAIN NAMES and the Twitter Accounts during the pendency of this action. These domain names and Twitter Accounts shall remain in the ownership, custody, and control of the Town of Islip throughout the pendency of this litigation.¹⁶⁶

The court provided further reasoning explaining its authority to transfer control of the Twitter accounts over to Islip.¹⁶⁷

In Islip’s Memorandum of Law filed in support of its preliminary injunction request, Islip only raised the issues of trademark infringement and cybersquatting.¹⁶⁸ Islip then concluded by stating, “[T]he Court should grant a preliminary injunction in favor of the Town and *order the transfer of the* disputed

¹⁶⁰ See *infra* Part II.A.

¹⁶¹ Complaint, Black Sheep Television, Ltd. v. Town of Islip, No. 10-04926 (E.D.N.Y. Oct. 26, 2010).

¹⁶² Verified Counterclaim at 21–25, Black Sheep Television, Ltd. v. The Town of Islip, No. 10-04326 (E.D.N.Y. Dec. 3, 2010), 2010 WL 4970766.

¹⁶³ *Id.* at 2, 6–10.

¹⁶⁴ *Id.* at 12.

¹⁶⁵ *Id.*

¹⁶⁶ Black Sheep Television, Ltd. v. Town of Islip, No. 10-04926, 2010 WL 4961669, at *2 (E.D.N.Y. Dec. 6, 2010) (order granting preliminary injunction).

¹⁶⁷ *Id.*

¹⁶⁸ Reply Memorandum of Law of Defendant/Counterclaim-Plaintiff the Town of Islip at 4–14, Black Sheep Television, Ltd. v. Town of Islip, 10-CV-04926 (E.D.N.Y. Nov. 29, 2010).

domain names and *[T]witter accounts to the Town [emphasis added]*.¹⁶⁹ Based on the same analysis as *New York City Triathlon*, the court does not have authority to transfer the disputed Twitter accounts because, under both §§ 43(a) and 43(d), Black Sheep is not committing any violation of the Lanham Act by registering Twitter screen names containing Islip's protected trademarks.¹⁷⁰

It appears that while the courts are arriving at the correct result—transfer or prevention of imposter Twitter accounts to the trademarks' owners—the reasoning for doing so is legally flawed.

III. PROPOSAL

The ACPA must be amended so that the relevant law can evolve to include screen names and corresponding post-domain paths for social networking and similar websites.¹⁷¹ Currently, there is no remedy for the cybersquatting type behavior seen on social networking sites like Twitter.¹⁷² While Twitter experimented with verified accounts—and subsequently stopped—that is not enough to ensure adequate protection for trademark owners' intellectual property rights on social networking sites.¹⁷³ Having Twitter self police its own site does not guarantee companies' protection of their trademarks on other social networking sites.

A. Minor Amendments to the ACPA Would Protect Cybersquatting on Twitter

A statutory amendment is the most efficient means of obtaining uniform protection of trademarks contained within post-domain paths issued by Twitter and other social network websites.

¹⁶⁹ *Id.* at 14.

¹⁷⁰ *See infra* Part II.C.1.

¹⁷¹ *See* 15 U.S.C. § 1125(d) (2006). Since the Anticybersquatting Consumer Protection Act went into effect on January 1, 1999, there have been no amendments made to the Act.

¹⁷² Needleman, *supra* note 35, at 32.

While a 1999 law gave trademark owners the right to sue cybersquatters, it is unclear how the law would apply to false Twitter accounts. 'It's not covered by existing laws protecting against domain name abuse,' says Susan Weller, a trademark attorney in Washington, D.C., for Mintz, Levin, Cohn, Ferris, Glovsky and Popeo P.C.

Id.

¹⁷³ Mossberg & Swisher, *supra* note 22 (showing that the founders recognize the issue with authenticity). Evan Williams stated:

Because organizations' Twitter accounts are different than individual Twitter accounts, what's really important is authenticity. So a lot of companies, you want to know who is actually doing this. Is it someone in PR, is it the local Dunkin' Donuts franchisee? Who is behind this Twitter account? So maybe that's something we reveal. That's helpful to you, it's helpful for them, and it establishes more authenticity.

Id.

The current definition of “domain name” still contains the original language drafted more than ten years ago.¹⁷⁴ The intent behind this definition was to prevent cybersquatting in the early phases of commercial usage on the internet.¹⁷⁵

As the use of the internet changes, so should the law governing it. Congress should amend the definition of “domain name” to include post-domain paths to a limited extent. Courts, as seen in the *Interactive Products Corp. v. A2Z Mobile Office Solutions* decision, were quick to disqualify post-domain paths as having the capability of being source identifying—a necessary element for trademark law.¹⁷⁶ That particular part of a URL is becoming more and more prevalent in denoting source rather than organization of the website’s files on a host computer.¹⁷⁷

The amended definition of “domain name,” contained in 15 U.S.C. § 1127, should be as follows:

The term “domain name” means any alphanumeric designation *contained in between “http://” and any recognized top-level domain name (“.com,” “.net,” “.edu,” and “.org”)* which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet. *Furthermore, post-domain paths (http://www.XYZ.com/postdomainpath) are included in the definition of “domain name” so long as they are used to signify source rather than to merely show how the website’s data is organized within the host computer’s files.*¹⁷⁸

This amendment would ensure that when the post-domain path is used in a source-identifying role, such as <http://Twitter.com/XYZ>, the mark contained therein is protected under the ACPA. Furthermore, this definition would not protect post-domain paths when they are merely used to show the organization of the website’s files on their host computer.¹⁷⁹ The caveat in the last sentence of the definition would prevent extending trademark protection to those parts of the domain name that are not used as a trademark.¹⁸⁰

Under this proposed amendment, courts will carry the burden of determining whether a post-domain path is used to signify source or merely used as an organizational tool. Statutes are, however, often written with broad terms to account for the unanticipated and have left the courts the task of defining the boundaries of

¹⁷⁴ 15 U.S.C. § 1127.

¹⁷⁵ See S. REP. NO. 106-140, at 9 (1999).

¹⁷⁶ *Interactive Prods. Corp. v. A2Z Mobile Office Solutions, Inc.*, 326 F.3d 687, 696–97 (6th Cir. 2003) (holding that “[t]he post-domain path merely shows how the website’s data is organized within the host computer’s files”).

¹⁷⁷ See Needleman, *supra* note 35 (reporting that numerous companies are experience source identification issues related to the post-domain paths assigned to them by Twitter).

¹⁷⁸ See 15 U.S.C. § 1127. The proposed definition takes parts of the original “domain name” definition, which are not italicized. See also *Interactive Prods. Corp.* 326 F.3d at 696–97 (6th Cir. 2003). The last sentence of the definition used some of the language from this decision: “The post-domain path merely shows how the website’s data is organized within the host computer’s files.”

¹⁷⁹ See *Interactive Prods. Corp.*, 326 F.3d at 697.

¹⁸⁰ *Id.* (holding that ACPA protection is not available to post-domain paths when they merely serve to show how the website’s data is organized within the host computer’s files).

those terms.¹⁸¹ Traditional methods of assessing whether a trademark is used as identifying a source would be of little help in the post-domain context.¹⁸² The issue with post-domain paths is not how distinctive the mark is, but rather in what manner the mark is being used.¹⁸³ The *Interactive Products* decision would be a good starting point for courts. In the opinion, Judge Gibbons stated:

Typically, web pages containing post-domain paths are not reached by entering the full URL into a browser; instead, these secondary pages are usually reached via a link from the website's homepage, which does not contain a post-domain path. For example, a consumer wanting to purchase a Lap Traveler product would probably not enter "a2zsolutions.com/desks/floor/laptraveler/dkfl-lt.htm" into a browser. The consumer would more likely enter "LapTraveler.com," which would bring the consumer to IPC's website, which sells the Lap Traveler. If a consumer were generally looking for portable computer stand products, the consumer might look at a general retailer's website, such as a2zsolutions.com. If the consumer were to go to a2zsolutions.com, the consumer would find a link entitled "The Mobile Desk tm Computer Stand," which if double-clicked would bring the consumer to a2z's portable-computer-stand web page selling The Mobile Desk.¹⁸⁴

Based on this opinion, merely having a trademark in a post-domain path does not guarantee that the trademark is used as a source identifier.¹⁸⁵ The first indication that a trademark owner's post-domain path is used as a source identifier could be whether a consumer is reaching that page by entering in the domain path and the post-domain path. In context of our hypothetical Twitter account, @XYZ, the easiest way a consumer would get to that Twitter page would be to type in twitter.com/XYZ into their URL bar.

Lastly, though the definition of "domain name" is narrow, the Senate was forward-thinking enough to provide for the expansion of the term "domain name" to cover third and fourth level domain names should the need for such expansion arise.¹⁸⁶ This article's proposal should not be an issue for Congress as it is a mere

¹⁸¹ See 15 U.S.C. § 1125 (demonstrating that there are no factors in the Lanham Act to help guide the courts as to what "likely to cause confusion" entails); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (showing that courts commonly use the factors from this case in analyzing whether a mark is likely to cause confusion).

¹⁸² See *Two Pesos v. Taco Cabana*, 505 U.S. 763, 768 (1992) (stating that in order for a trademark to identify sources the mark must distinguish the product from others).

¹⁸³ See *Interactive Prods. Corp.*, 326 F.3d at 697 (explaining that the manner in which the mark is used, as an organizational indicator rather than as a source identifier, is what prevents a post-domain path from violating trademark law).

¹⁸⁴ *Id.* at 697.

¹⁸⁵ See *id.*

¹⁸⁶ S. REP. NO. 106-140, at 9 (1999).

This definition essentially covers the second-level domain names assigned by domain name registration authorities (i.e., the name located immediately to the left of the ".com," ".net," ".edu," and ".org" generic top level domains), but is technology neutral enough to accommodate names other than second-level

extension based on Congress' own rationale. Congress wanted the definition to be narrow, but included language that allowed the term to be "technology neutral" by allowing third and fourth level domain names should the registrars begin issuing third and fourth level domain names.¹⁸⁷ Congress recognized that a simple domain name was not going to be the only manner in which URL addresses could create issues for trademark owners.¹⁸⁸ This article's proposal follows Congress' rationale by allowing the ACPA to evolve to protect the way in which trademarks are currently being used in URLs, but at the same time keep the term confined enough not extend the Act's reach.

CONCLUSION

Currently, there is no remedy for trademark owners when imposters register user names—with corresponding post-domain paths—containing another's protected trademarks on social network websites. While Twitter temporarily experimented with its own verification process it currently does not help users of its site to distinguish the trademark owners' pages from the imposters. Current law discouraging such activity only applies to domain names.¹⁸⁹ With a minor change to the ACPA the law could be updated to fall in line with the ever-changing uses of the Internet. Amending the current definition of "domain name" under 15 U.S.C. § 1127 to include post-domain paths in certain instances would give trademark owners a legal remedy against imposters abusing the intellectual property rights of others within the realm of social network websites.

domains that are actually registered with domain name registration authorities, as may be the case should the Internet domain name registrars begin to issue third and fourth level domains.

Id.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ 15 U.S.C. § 1127 (2006).