

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

THE COCA-COLA COMPANY, *et al.*,)
)
 Plaintiffs-Appellees,)
)
 v.) No. 02-2894
)
 WILLIAM PURDY,)
)
 Defendant-Appellant.)

**BRIEF FOR PUBLIC CITIZEN
AS AMICUS CURIAE URGING AFFIRMANCE**

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STATEMENT

Defendant William Purdy is an opponent of abortion who believes that it will advance his cause to expose as many people as possible to graphic pictures of aborted fetuses. Hoping to bring these photographs to the attention of a broader audience, Purdy registered several domain names using plaintiffs' trademarks, such as drinkcoke.org, mymcdonalds.com, and washingtonpostsays.com. These pages were then linked to the abortionismurder.org website, including pictures of aborted fetuses, exhortations to oppose the legal right to have abortions, pleas for financial donations to the anti-abortion cause, and a grid of anti-abortion internet links.

Purdy has been unabashed about his purpose:

William Purdy sought to convince his intended audience that unborn children should not be destroyed and sought to do so by purchasing Internet domain names which would direct his target audience to pictures of aborted and dismembered unborn children in order to disclose the nature and effects of abortion.

<http://www.politechbot.com/p-04382.html>.¹

Purdy selected these plaintiffs because of the editorial position of the Washington Post, and because he believes that the other plaintiffs fund organizations like Planned Parenthood that favor abortion.

¹This statement is not in the appellate record, but was made by Purdy's lawyer while the appeal was pending.

With one exception, when plaintiffs first challenged Purdy's websites, the sites had no content even arguably related to the activities of the companies whose trademarks were in the domain names. The exception is that, for a period of time, Purdy used two of the domain names – my-washingtonpost.com and drinkcoke.org – to display a bogus front page of the Washington Post's washingtonpost.com website, onto which was superimposed a fictitious article, entitled "The Washington Post proclaims 'Abortion is Murder,'" as well as copies of Coca-Cola's trademarks, several anti-abortion photographs, and other content, including links to an anti-abortion fundraising site.

In early July, plaintiffs contacted Purdy to complain about his use of their trademarks to promote his anti-abortion views; Purdy responded by registering several additional domain names using the plaintiffs' trademarks. He also telephoned the Post's attorneys and told them that he would expand his use of the Post's trademarks unless the Post published an article by him on the editorial page of its newspaper. Record Entry Number ("REN") 4, ¶40. Purdy's son also emailed to the Post's counsel an altered version of the washingtonpost.com front page, into which a headline had been inserted, "The Washington Post Should Declare that "Abortion is Murder,'" followed by a slightly larger headline urging the Post to announce the abandonment of its editorial support for abortion rights. *Id.* ¶¶42-43. The record does

not reflect that this version was ever placed online.

In further response to plaintiffs' litigation threats, Purdy registered several additional domain names, using not only the plaintiffs' names, but the names or acronyms of several non-profit organizations that support abortion rights, including the ACLU, the National Organization for Women, and Planned Parenthood. Purdy pointed these domain names to anti-abortion material, located not only at the abortionismurder site, but also at abortioncams.org and babybutcher.org. On July 16, Purdy explained to the Politechbot mailing list that he was deliberately using those organizations' names because he detested their positions on abortion, because he knew that they would not like the websites, and because he wanted to test their commitment to free speech. <http://www.politechbot.com/p-03764.html> (REN9, Exh.53).

At the same time, Purdy added a paragraph at the top of the websites connected to several domain names using plaintiffs' trademarks that explained, in language that was almost identical with respect to each company, that the website was not sponsored by the company in question but rather had been mounted to criticize the company because it supported abortions. Just below introductory material, each website displayed the same graphic photographs and other anti-abortion content that had previously been there – material completely unrelated to the companies whose trademarks were used in the domain names.

On July 18, 2002, plaintiffs filed suit along with a motion for emergency relief, arguing that Purdy was using their trademarks in Internet domain names that were likely both to dilute their famous trademarks, and to cause confusion about whether plaintiffs were sponsoring Purdy's websites. Plaintiffs argued that any domain name that incorporates a famous trademark, regardless of whether generic words are added to the trademark, necessarily creates a likelihood of confusion and dilutes their marks, and hence is actionable under the trademark laws. Plaintiffs also argued that Purdy's use of the infringing domain names to disseminate fundraising appeals for the anti-abortion cause was inherently commercial in nature, and that cybersquatting is inherently commercial and so warrants coverage by the trademark laws. Accordingly, plaintiffs sought a preliminary injunction both requiring Purdy to turn all of his trademarked domain names over to the plaintiffs, and barring him from registering any further names using plaintiffs' trademarks. Purdy argued in response that his domain names represented speech in opposition to the support provided by plaintiffs to women's right to choose abortions, and that the First Amendment therefore forbade the issuance of a preliminary injunction.

On July 23, 2002, the district court granted plaintiffs' preliminary injunction motion in substantial part. It found that each of Purdy's original nine trademarked domain names were identical or confusingly similar to plaintiffs' trademarks, Order

at 3 ¶ 7, and that Purdy had registered them with a bad faith intent to profit by using plaintiffs' names for the "personal gain of promoting [Purdy's] messages, generating publicity, and raising money for supported causes." *Id.* 3 ¶ 8. Accordingly, the Court ordered Purdy to stop using the listed domain names, ¶ 10, and to transfer the ownership of those names to plaintiffs. ¶ 14. Moreover, she noted Purdy's expressed intention to register many new domain names that incorporated plaintiffs' marks. ¶ 9. However, in an apparent bow to Purdy's First Amendment right to use the Internet to communicate material critical of plaintiffs, the Court forbade Purdy only from using any other domain name that (1) "incorporates, and is identical to or confusingly similar to plaintiffs' marks," **and** (2) does not contain, within the domain name itself, language that would "alert the unwary Internet user to the protest or critical commentary nature of the attached website." *Id.* ¶ 11.²

²The nine domain names at issue on this appeal are drinkcoke.org, mycoca-cola.com, mymcdonalds.com, mypepsi.org, pepsisays.com, my-washingtonpost.com, washingtonpostsays.com, washingtonpost.cc, and washingtonpost.ws. As plaintiffs discuss, Br. 6-9, the district court has entered further orders against Purdy, based on various forms of misconduct, including apparent attempts to intercept email to the Post's staff based on the deliberately deceptive use of domain names to support email addresses. Purdy has not appealed from those orders, and they are not before this Court.

ARGUMENT

1. The Preliminary Injunction Must Pass First Amendment Scrutiny.

An injunction obtained by a private party constitutes government action by a court, subject to scrutiny under the First Amendment. *Organization for a Better Austin v. Keefe*, 402 US 415, 418 (1971); *see also Procter & Gamble Co. v. Bankers Trust Co.*, 78 F3d 219, 224-225 (CA6 1996). Unlike copyright cases where fair use is largely co-extensive with the First Amendment, *Harper & Row Publishers v. Nation Enterprises*, 471 US 539, 560 (1985), in trademark cases, First Amendment considerations routinely receive separate discussion, although they also inform statutory interpretation. Even if a trademark has been used in a commercial context, courts are required to construe the trademark laws narrowly to avoid impinging on First Amendment rights. *Cliffs Notes v. Bantam Doubleday*, 886 F2d 490, 494 (CA2 1989). Here, although Purdy's inclusion of fundraising appeals in his websites makes them sufficiently commercial to warrant coverage by the anti-infringement provisions of the Lanham Act, his underlying speech is basically non-commercial, and appeals for donations in support of non-commercial speech does not remove them from the full protection of the First Amendment. *Schaumburg v. Citizens for a Better Environment*, 444 U.S. 620, 628-632 (1980). Nor is speech rendered commercial, and

hence less protected by the First Amendment, merely because attacks on commercial enterprises may hurt their business. *Organization for a Better Austin, supra*.

Moreover, First Amendment interests are weighed as a factor in deciding whether a trademark violation should be found. *Anheuser-Busch v. Balducci Publications*, 28 F3d 769, 776 (CA8 1994). Injunctions must be narrowly crafted to comply with the general rule against prior restraints of speech. *Id.* at 778; *Consumers' Union v. General Signal Corp.*, 724 F2d 1044, 1053 (CA2 1983); *Better Business Bureau v. Medical Directors*, 681 F2d 397, 404-405 (CA5 1982). "Restrictions imposed on deceptive commercial speech can be no broader than reasonably necessary to prevent the deception." *FTC v. Brown & Williamson Tobacco Corp.*, 778 F2d 35, 43-44 (CA5 1985), *citing In re RMJ*, 455 U.S. 191, 203 (1982); *see also Castrol v. Pennzoil*, 987 F2d 939, 949 (CA3 1993).

First Amendment considerations also affect the standard of review. The normal standard of review of a preliminary injunction is for abuse of discretion, although errors of law are reviewed de novo. However, because First Amendment rights are at stake in this case, any factual findings about the nature of the speech are subject to "an independent examination of the whole record in order to make sure that the [injunction] does not constitute a forbidden intrusion on the field of free expression." *Bose Corp. v. Consumers Union*, 466 US 485, 499 (1984); *Hurley v. Irish-American*

Gay Group, 515 US 557, 567 (1995). *Accord FAIR v. Nebraska Dep't Soc. Serv.*, 113 F3d 1409, 1411 (CA8 1997).

2. Internet Domain Names May Use Trademarks for Sites That Speak About the Trademark Holder, So Long as the Site Is Not Confusing About Source.

The fundamental flaw in plaintiffs' argument that a domain name incorporating a trademark necessarily fosters confusion about the source of the underlying website is that it fails to consider carefully the role played by domain names in identifying websites for Internet users. Courts that have analyzed the role of domain names have properly ruled that trademark law does not bar the use of trademarked domain names that accurately portray the content of the underlying website, so long as the site owner takes sufficient steps to dispel any confusion about source. To understand why this is so, it is first necessary to consider the wide-ranging nature of information available on the Internet, the kind of information that Internet users may be seeking on the Internet, how they use domain names to find such information, and, concomitantly, how website hosts use domain names to call their sites to the attention of users who are looking for the information that the hosts wish to communicate.

Plaintiffs assume that anybody who uses their trademarks as an Internet search term must necessarily be looking for plaintiffs, as the owners of the trademarks. Certainly, for example, some Internet users who search the Internet using the term

“McDonalds” may want to find the website of the company that owns McDonalds. However, the user may instead be looking for information **about** McDonalds or its products, without caring whether the information comes from the trademark holder. Indeed, the user might prefer information from a different and hopefully more impartial source. The user might also be looking for historical information; or the user might have a grievance about the trademarked item, and want information about other similar grievances. For example, McDonalds’ customer might be concerned about the health effects of its fatty food or about burns caused by hot coffee, and might try to find out whether others have had similar problems, whether there are lawsuits pending on such issues, or whether any private organization is trying to find non-litigation solutions to the same problem (*e.g.*, lobbying for a law, seeking an administrative order, or conducting a boycott).

The rules that are developed regarding the various uses of trademarks on the Internet must take into account all of these potential objectives of Internet users. Thus, the goal, in trying to prevent customer confusion about source, is to create rules that do not impair the ability of Internet users in general to find the information that they are seeking about the trademarked item.

For example, an unauthorized history of the Washington Post could be entitled “The Washington Post” without violating that company’s trademark, *see Rogers v.*

Grimaldi, 875 F2d 994, 1000 (CA2 1989), just as the subject and title cards in a library card catalog could use “The Washington Post.” The author card, however, could not use that phrase. *See Reno v. ACLU*, 521 US 844, 853 (1997) (analogizing to a library).

Similarly, although, the domain name may in many cases be the name of the website’s owner, in other cases, the domain name reflects the title or subject of the site. So, for example, a user who wants information about apples might go to www.apples.com and find information about apples, even though Apple is also a well-known trade name. *Cf. Cello Holdings v. Lawrence-Dahl Companies*, 89 FSupp2d 464 (SDNY 2000) (defendant sought domain names of several different musical instruments for purpose of selling names to persons with interest in creating sites about such items; court rejected cybersquatting claim by company holding trademark in word “cello”). Because a domain name can denote a title, a subject, or an author, the rules governing the use of trademarks on the Internet must allow for multiple uses of a single phrase.

If the Internet were no more than a place for businesses to advertise their services, Coca-Cola would have a better reason to assume that any person who entered one of its trademarks as a domain name must be trying to find Coke’s own website. Although the business community has plunged into the Internet, and although the

perception that the Internet is a key means of reaching customers has surely driven the growth of the Web over the past several years, commerce remains a distinct minority online. Kelly, “The Web Runs on Love Not Greed,” Wall Street Journal, January 3, 2002 (estimating that commercial websites comprise less than one-third of Web’s content). Indeed, a recent report from the Markle Foundation found that the predominant public perception of the Internet is that it is a library, not a shopping mall – that is, primarily a source of information, not a place to buy products. <http://www.markle.org/news/AccountabilityChapter1.pdf>, at 20-25.). Consequently, one cannot assume that any person who searches the Web for sites whose domain name includes “Washington Post” must necessarily be searching for the official website of the Washington Post newspaper, and no evidence was introduced below to suggest that such is the case.

Plaintiffs rely on cases holding that businesses have used trademarked domain names in ways that infringed the trademark rights of other businesses, Br. 11, 14, 17-18, but those cases have little bearing here. The real issue in most such cases was which of two companies was entitled to use a particular name to promote its own business on-line. Typical of such cases – and typical of the problems that such cases present – is *Brookfield Communications v. West Coast Entertainment*, 174 F3d 1036, 1044-1045 (CA9 1999).

Brookfield arose from a dispute between two companies about which of them had been the first to use the mark “moviebuff” to describe their rival services of providing searchable internet databases about movies available on videocassette. Brookfield sought a TRO against West Coast, claiming that it was the prior user even though West Coast had been first to register the domain name “moviebuff.com.” The district court denied the motion but treated its ruling as the denial of a preliminary injunction.

Brookfield appealed, and the parties’ briefs were devoted almost exclusively to substantive trademark issues, which was not surprising since the issue between the parties was which of them was entitled to the trademark “moviebuff.” The court decided that it was the plaintiff and not the defendant that had first right to the trademark, *id.* 1053 and consequently decided that the plaintiff was entitled to the preliminary injunction that had been denied below. *Id.* 1061. However, because the appeal had arisen from a TRO proceeding, there was no evidence discussed in the briefs of either party about the nature of the Internet, the significance of domain names, or inferences that Internet viewers draw about the sponsorship of websites having particular domain names. Although the court made various statements about the nature of the Internet in its opinion (which has been frequently cited since then), the court’s pronouncements on that issue were not based on evidence and did not bear

on the main issue between the parties – that is, control of the mark.

Another sort of domain name case that has been widely litigated is between a company that wanted to use its trademark for its domain name and an individual who registered the name first, not because he wanted to use it for a website related to the name, but because he foresaw that the trademark owner might want the domain name for itself and might be willing to pay for it. In those cases, the courts must choose between a company with a longstanding connection to the trademark and somebody who had no legitimate interest in the mark, but wanted to be paid for thinking ahead.

For example, in *Virtual Works, Inc. v. Volkswagen of America*, 238 F3d 264 (CA4 2001), Virtual Works, Inc. (“VWI”) registered the name “vw.net” with the hope of eventually selling it to Volkswagen. *Id.* at 266-267, 269, 270. When the auto manufacturer asked for the name, VWI responded that unless Volkswagen bought the name immediately, the name would be put up for auction to the highest bidder; VWI gave Volkswagen twenty-four hours to respond. The court decided that this was a classic cybersquatting case, but warned of the limited nature of its holding: “The fact that a domain resembles a famous trademark . . . hardly in and of itself establishes bad faith. Moreover, domain names that are abbreviations of a company’s formal name are quite common. To view the use of such names as tantamount to bad faith would chill Internet entrepreneurship with the prospect of endless litigation.” *Id.* at 269.

On the other hand, when the defendant has a legitimate interest in the domain name, the plaintiff will not automatically on a claim of likelihood of confusion. Two recent appellate decisions illustrate this approach. Most recently, in *Taubman v. Mishkoff*, 2003 WL 255720 (CA6 Feb 7, 2003), the court reversed injunctions that had been issued against the maintenance of a non-commercial “fan site” about a shopping mall (www.shopsatwillowbend.com), and a non-commercial gripe site complaining about the trademark suit against the first site (www.taubmansucks.com). The court of appeals explained that, because defendant had placed a prominent disclaimer along with a hyperlink to the official shopping mall site, and because there was no possibility of any confusion about whether either website was the official site for The Shops at Willow Bend, there was no violation of the Lanham Act. As Judge Suhrheinrich wrote, Mishkoff was entitled to scream about the mall and the resulting litigation from the rooftops:

“Essentially, this is what he has done in his domain name. The rooftops of our past have evolved into the internet domain names of our present. We find that the domain name is a type of public expression, no different in scope than a billboard or a pulpit, and Mishkoff has a First Amendment right to express his opinion about Taubman, and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.

Id. *7.

The Seventh Circuit reached a similar result in the commercial context in *Ty v.*

Prettyman, 306 F3d 509 (CA7 2002). The decision overturned an injunction issued against an unauthorized reseller of Beanie babies who used the name bargainbeanies.com for a website on which she marketed Beanie baby products. Because *Prettyman* was entitled under trademark law to tell the consuming public that her website was one to which they could come to find Beanie babies, Judge Posner held that trademark law could not be used to deprive *Prettyman* of the right to truthfully identify the content of her website by placing the trademark “Beanie” in her domain name.

Further explication of this line of analysis is provided by *Strick Corp. v. Strickland*, 162 FSupp2d 372 (EDPa 2001), where a manufacturer of transportation equipment that owned several trademarks involving “Strick” sued a computer consultant who had registered “strick.com” for his business, using his long-standing nickname of “Strick.” The court found no likelihood of confusion because, once an Internet user reached the defendant’s website, it was clear that the Strick company was not the sponsor of the strick.com site. The court explained that the claim of likely confusion rested on the doctrine of “initial interest confusion,” namely, the concern that an Internet user might be misled into coming to the junior user’s site, and then either decide to buy goods from the junior user, or, at least, lose interest in looking harder for the trademark holder. *Id.* 377. However, the court refused to find a

trademark violation based on that concept in the Internet context:

[A]ny initial confusion that arises from Defendant's use of his strick.com domain site, specifically, that consumers will realize that they are at the wrong site and will go to an Internet search engine to find the right one, is not enough to be legally significant. . . . It is clear that Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded, or unnerved, when, after taking a stab at what they think is the most likely domain name for particular website [they] guess wrong and bring up another's webpage. [Going on to reject plaintiff's dilution claim:] It is clear that nothing in trademark law requires that title to domain names that incorporate trademarks or portions of trademarks be provided to trademark holders. To hold otherwise would create an immediate and indefinite monopoly to all famous mark holders on the Internet, by which they could lay claim to all .com domain names which are arguably "the same" as their mark. The Court may not create such property rights-in-gross as a matter of dilution law. . . . Trademark law does not support such a monopoly.

Id. at 377, 380 (quotation marks and citations omitted).

See also The Network Network v. CBS, 54 USPQ2d 1150, 1155 (CDCal 2000) ("there is a difference between inadvertently landing on a website and being confused").³

Similar principles have been applied where the reason for registering a domain name including a trademark was to comment on the trademark holder. A number of

³This Court has never addressed the doctrine of initial interest confusion. Because that doctrine is in tension with a longstanding rule that merely temporary confusion is not actionable, *Duluth News Trib. v. Mesabi Pub. Co.*, 84 F3d 1093, 1098-1099 (CA8 1996), *citing Astra Pharm Prod. v. Beckman Instruments*, 718 F2d 1201, 1207-1208 (CA1 1983); *Woodsmith Pub. Co. v. Meredith Corp.*, 904 F2d 1244, 1246 n3 (CA8 1990), the Court should hesitate to decide whether to adopt the doctrine in a case that does not require such a decision.

these cases involve “sucks” domain names, which include some comment in the names themselves. Every court decision involving a critical website using a “sucks” internet address has been decided in favor the defendant. *Lucent Technologies v. LucentSucks.com*, 95 FSupp2d 528, 535 (EDVa 2000); *Bally Total Fitness Holding Corp. v. Faber*, 29 FSupp2d 1161, 1165 and n3 (CDCal 1998). See also *Ford Motor Co. v. 2600 Enterprises*, 177 FSupp2d 661, 664 (EDMich 2001). But a court also found no likelihood of confusion in *Northland Ins. Co. v. Blaylock*, 115 FSupp2d 1108 (DMinn 2000), where a consumer registered “northlandinsurance.com” for a website that attacked an insurance company of that name. The fact that the website obviously was not confusing was sufficient to defeat the “initial interest confusion” argument. Similarly, in *Taubman v. Mishkoff*, *supra*, the Sixth Circuit allowed a shopping mall’s neighbor to use “shopsatwillowbend.com” for a noncommercial website about that mall.

Although several courts have granted relief against commentary sites whose domain names were identical to the trademark of the complaining mark holder, the websites at issue there were deliberately confusing and admittedly were intended to keep Internet users from reaching the mark holder’s website. *E.g., Jews for Jesus v. Brodsky*, 993 FSupp 282 (DNJ), *aff’d mem.*, 159 F3d 1351 (CA3 1998) (site was deliberately designed to lure doubting Jews to see pro-Jewish material); *Planned*

Parenthood v. Bucci, 42 USPQ2d 1430 (SDNY 1997), *aff'd mem.*, 152 F3d 920 (CA2 1998) (site was deliberately designed to appear to be home page of Planned Parenthood, so as to draw viewers to buy an anti-abortion book). Although plaintiffs cite a passage in Professor McCarthy's book which cites four cases supporting the proposition that a gripe site may not use a domain name to confuse web users into thinking they are reaching the official website, Br. 26, most of those cases involved websites that were deliberately designed to mislead viewers, and one involved a cybersquatter who had originally apparently registered the name for the purpose of extorting payment from the trademark owner, using content that he knew would horrify the trademark owner as a way of extorting a payment.⁴

Plaintiffs may cite decisions by arbitrators in proceedings before the World Intellectual Property Organization to support the proposition that the Internet community supposedly treats domain names as reflecting only source and not subject.

⁴ In *PETA v. Doughney*, 263 F3d 359 (CA4 2001), Doughney created a parody site for the non-existent group "People Eating Tasty Animals," <http://mtd.com/tasty/>, which consisted of links to furriers, butchers, animal testers, and other merchants and trade groups that People for Ethical Treatment of Animals found abhorrent. The evidence cited by the court showed that Doughney's purpose was to extort a payment from PETA to give up the domain name, not to parody PETA's work. The three cases involving confusing websites are *Planned Parenthood* and *Jews for Jesus*, cited *supra*, and *OBH v. Spotlight Magazine*, 86 FSupp2d 176 (WDNY 2000), where a commercial competitor of a newspaper created a website that mimicked the script and style of the newspaper's site, purported to be a parody site, and then linked to the competitor's own apartment advertising service.

But even in these proceedings, which are notoriously favorable to trademark owners, many arbitrators uphold domain names the use trademarks for sites commenting on the trademark owner, whether negatively, *Bosley Medical Institute v. Kremer*, http://arbiter.wipo.int/domains/decisions/html/2000/d2000_1647.html; *Mayo Found. v. Briese*, <http://www.arbforum.com/domains/decisions/96765.htm>; *Ahmanson Land Co. v. Curtis*, <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0859.html>, or positively in the form of a “fan” site. *Springsteen v. Bugar*, <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html>. In *Springsteen*, the panel stated, “Users fully expect domain names incorporating the names of well known figures in any walk of life to exist independently of any connection with the figure themselves, but having been placed there by admirers or critics as the case may be.”

One important difference between early domain name cases, and more recent cases where a true gripe site has used the trademark to denominate a website about the trademark holder, is that technology has progressed enormously since the first cybersquatting cases in the mid-1990's. In the Internet's early days, the main way to find a company's website was to “name-guess,” by entering the trademarked name into a web browser, followed by a top-level domain such as .com or .org. More recently, however, the technology and effectiveness of search engines has improved

so markedly that Internet users who name-guess and reach a site other than what they wanted will simply guess again or visit a search engine to find what they really want. *Strick*, 162 FSupp2d at 377. David Bernstein, a prominent trademark enforcement lawyer, recently admitted that "99 times out of 100, consumers are able to find the site they are looking for." Loomis, *Domain Name Disputes Decline as Internet Matures*, <http://www.law.com/jsp/article.jsp?id=1044059430652>. And, according to a report prepared for use in the *Taubman* case by Syracuse University Professor Milton Mueller, a leading authority on the domain name system, name-guessing has been displaced by search engines even as the **first** choice for finding an unknown website. <http://dcc.syr.edu/miscarticles/mishkoff.pdf>.

Accordingly, mere use of a trademark in the domain name for a website that is devoted to a discussion of the trademark holder is not a sufficient basis for a finding of likelihood of confusion; the evidence must also show a genuine likelihood of confusion about who is sponsoring the website itself. As discussed below, however, the preliminary injunction was proper because Purdy's websites were not "about" plaintiffs.

3. Because Purdy Was Not Using Plaintiffs' Trademarks to Entitle a Website About Plaintiffs, the Preliminary Injunction Was Not an Abuse of Discretion.

The preliminary injunction in this case was not an abuse of discretion because Purdy did not use the domain names to comment, favorably or negatively, on the companies whose trademarks he was using. To the contrary, he used those names to attract attention to a completely different subject – his views about abortion. Although the First Amendment protects his right to campaign against abortion, it scarcely protects his right to piggyback on plaintiffs' trademarks to attract attention to his views on that subject. His use of the marks for that purpose was likely both to cause confusion about who was sponsoring the websites in question, and to improperly associate plaintiffs with the graphic photographs that many Internet viewers would likely find extremely offensive. Hence, he was liable for infringement.

Purdy's violation was compounded when, after receiving cease and desist letters from the various plaintiffs, he posted a bogus home page for the Washington Post, which, in addition to various articles appearing on the actual home page, included a headline stating, "The Washington Post proclaims 'Abortion is Murder.'" Alongside that article, he placed Coca-Cola's trademarks and fetus photographs of the sort that anti-abortion campaigners are wont to use. Accordingly, it was not just the domain names but the content of the websites themselves that made it appear that the

Washington Post and the Coca-Cola company were espousing Purdy's anti-abortion views. Purdy's displeasure with plaintiffs' views on this important public issue scarcely gave him license to use their trademarks to make it appear that they agreed with him about it.

Purdy apparently defends these materials on the theory that they represent protected parody. However, these pages did not parody the Post and Coke; they represent Purdy's wishful thinking about the position those companies should take on the abortion issue. When coupled with the use of domain names that consist of unadorned iterations of plaintiffs' own trademarks, these webpages unmistakably conveyed the impression that the Washington Post and Coca-Cola companies endorse Purdy's views.

Nor were Purdy's violations ameliorated when, in response to plaintiffs' demand letters, he attempted to wrap himself in the flag of free speech by placing an introduction on each website which, in a dense paragraph in relatively small print, stated that the website was not sponsored by the company in question but rather was intended to criticize their views on abortion. First, notwithstanding this introductory material, the bulk of each home page remained Purdy's anti-abortion photographs and anti-abortion material; the disclaimers were the **only** parts of the page that related to the trademark holders, and hence are really being offered as a figleaf to conceal the

true subject of the websites, which is Purdy's campaign against abortion. Thus, the district court was clearly correct in concluding that the pages were not a campaign about what the Post, McDonalds, and other companies say about the abortion controversy. Therefore, the use of plaintiffs' trademarks cannot be justified on the free speech theory of such cases as *Taubman v. Mishkoff* and *Northland Insurance v. Blaylock*, *supra* pages 14, 17, because the webpages are not "about" the trademark holders. Similarly, it cannot be argued that the trademarks are being accurately used as the title or subject cards for the webpages, as in cases like *Rogers v. Grimaldi*, 875 F2d 994, 1000 (CA2 1989)

Second, the token disclaimers were too small to convey immediately and unmistakably that the pages were not sponsored by the trademark holders, and thus they did not dispel any misimpression created by the domain names. Moreover, plaintiffs are entitled to be concerned that many Internet viewers, upon visiting Prudy's websites, will be so offended by the graphic photographs contained there that they will not pause to consider the textual matter, but will immediately leave the page without ever recognizing that plaintiffs are **not** responsible for posting this material. Recognizing that, despite the proper use of trademarks to denote the subject of a website, Internet users may be temporarily confused when they reach a website that is not sponsored by the trademark holder, *Northland* and *Taubman* reconcile the

emerging doctrine of initial interest confusion with the demands of the First Amendment by requiring a very prominent disclaimer that immediately brings to the attention of the viewer the fact that the website is not the trademark holder's own. Where, by contrast, a website is not clear, or even intentionally creates confusion to draw the viewer into content irrelevant or hostile to the trademark holder, the courts have not hesitated to find a trademark violation, as in *Planned Parenthood* or *Jews for Jesus*, *supra* pages 17-18.

Indeed, Purdy's statements during the course of this case tend to suggest that his intent was to misuse plaintiffs' trademarks for his own ends. His public statements made clear that he was punishing the plaintiff companies for their pro-choice positions, as did his threats to the companies that he would continue to use their trademarks and would increase the levels of his registration of domain names using their trademarks unless they changed their positions to ones that he supported. So, too, Purdy's telephone call to the Post's lawyers, demanding that they provide him with space on the editorial page of the print edition of the newspaper as a condition of giving up the domain names, revealed that his purpose for using the trademarks was to call the public's attention to his views on abortion and not to use the Internet to express his views about the plaintiffs. Purdy's history of cybersquatting is further established not only by the fact that this Court has previously affirmed a

cybersquatting judgment against him, *Purdy v. Burlington Northern*, 21 FedAppx 518 (CA8 2001), but by the registration of trademarks from several different companies to post a common set of materials about abortion. This pattern of behavior therefore confirms that his purpose for using the domain names was to comment on abortion, not about plaintiffs or their views on abortion. This is not the typical form of cybersquatting, which usually seeks to extort a payment of money, but it is cybersquatting nonetheless.

Finally, a number of courts have dealt with cybersquatters who, after they were challenged over their improper domain names, attempted to wrap themselves in the First Amendment by creating websites attacking the plaintiff companies. When the timing of such speech suggest that it was only “cooked up” after the fact for the purpose of justifying cybersquatting, the courts have not hesitated to apply standard trademark law to find a violation. *Gallo Winery v. Spider Webs Ltd*, 286 F3d 270, 272, 276 (CA5 2002); *Shields v. Zuccarini*, 254 F3d 476, 485-486 (CA3 2001). In sum, the injunction against Purdy’s use of the nine names was not an abuse of discretion.

The portion of the injunction that is directed at Purdy’s future use of other domain names presents a closer question, because, as a general matter, the owner of a website about a company should be allowed to put the company’s name in the

domain name without including negative words proclaiming the site to be critical. Here, plaintiffs presented evidence that the specific domain names that Purdy had registered, using generic words in tandem with the trademarks, were misleading. For example, the prefix “my” is commonly used for a special kind of homepage that can be established through an official relationship with a company, and the domain name “drinkcoke” strongly implied an exhortation to associate with the company and has no relationship to Purdy’s anti-abortion content. REN3.

However, other domain names that Purdy might register in the future, using the trademark with other words, might not be confusing, and might accurately portray the website’s content without being misleading in any way, even if they do not contain express words of criticism. Given Purdy’s interest in abortion, for example, if Purdy wanted to create a website about McDonalds’ support for abortion, surely he should be able to use the domain name McDonaldsSupportsAbortion.com, despite the fact that such language is not expressly critical as required by the exception to the preliminary injunction. Or, if Purdy were to conduct a taste test between Pepsi and Coke, and wanted to describe those results on a website, even with no mention of abortion, the domain name Pepsi-v-Coke.com would be a fair description of his content and would not be confusing. In short, the district court’s injunction seems overbroad.

However, the district court was confronted by a case involving a true cybersquatter, who had used plaintiffs' trademarks not to mount websites about them, but at best to retaliate against the plaintiffs for their views on an important public issue, and at worst to try to coerce them into changing their views and even into giving defendant free space in the Post newspaper in which to express his views. When challenged, Purdy announced that plaintiffs could not stop him from using their trademarks because he was going to register many more domain names using those marks (which, after the issuance of the injunction, he proceeded to do). And despite the fact that Purdy claimed that he was going to use these additional names for the purpose of expressing his criticisms of the plaintiffs, at the time the preliminary injunction was issued, those sites consisted of the original anti-abortion material coupled with a short passage at the front criticizing each of the plaintiffs for their support of abortion. In sum, it appeared that Purdy was going to continue to use plaintiffs' trademarks in a misleading fashion to draw readers to his anti-abortion campaign material, and that it was his intention to "push the envelope" by making minor changes in the domain names to find out what he could get away with.

Rather than forcing plaintiffs to litigate each possible new domain name individually, the judge ordered that, if Purdy registered any other domain name that **both** "incorporates **and** is identical or confusingly similar" to seven specifically

identified trademarks (emphasis added), the domain name itself, through the use of words expressing hostility to plaintiffs, would have to make clear that Purdy's material was not sponsored by plaintiffs. In the unusual circumstances presented, the issuance of such a preliminary injunction was not an abuse of discretion. And because the preliminary injunction can be upheld based on the unusual facts of this case, the Court need not decide whether, as a general rule, any domain name using a trademark **must** contain critical words to be lawful.

Since the injunction was issued, Purdy has registered such names as WashingtonPostChristian.com, WashingtonPostAborts.com, and similar names using the name of the Washington Post. Although all of these names violate part of the first prong of paragraph 11 of the preliminary injunction, by incorporating a protected trademark, and although they presumably violate the second prong of paragraph 11 by not including words of criticism within the domain names, it remains to be decided in a future appeal whether they are "confusingly similar" to plaintiff Washington Post's trademarks. However, no appeal is currently pending pertaining to those domain names.

At the same time, one may well wonder whether there is any genuine risk that these domain names will lead Internet viewers to examine any of Purdy's websites. In this regard, it is important to remember that the **reason** why trademark owners

claim to be worried about the use of domain names containing their trademarks is that members of the public may come looking for them on the Internet by typing particular combinations of letters into the “location” window of their web browsers. It is difficult to imagine what member of the public who is looking for a website sponsored by the Washington Post is going to type the letters “WashingtonPostAborts.com” into her web browser. Moreover, courts are no longer willing to assume, as they did during the early days of the Internet, that Internet users are so unsophisticated in the ways of the Web that they will fail to appreciate small differences in domain names. *Entrepreneur Media v. Smith*, 279 F3d 1135, 1147 (CA9 2002) (discounting confusing impact of internet domain name because “in the Internet context, consumers are aware that domain names for different Web sites are often quite similar, . . . and that very small differences matter”).

The rules against cybersquatting arose because knowledgeable Internet specialists had registered thousands of trademarks, or common misspellings of trademarks, as domain names before the trademark owners had appreciated the potential utility of the Internet and picked their own domain names. Such cybersquatting posed a genuine threat to the companies’ ability to use the Internet to reach their customers. The names hypothesized above scarcely pose a genuine likelihood of confusion for the plaintiffs, and would, indeed, seem to be a fair use of

their trademarks to describe plaintiffs' position on an issue of national importance. Should Purdy bring such names to the attention of the district court with a proposed nonconfusing website, he might well make a strong case for modification of the injunction, in light of the underlying principles of trademark law and against the backdrop of the First Amendment in deciding whether to make the injunction final regarding those names. *See Gallo Winery, supra*, 286F3d at 230.

CONCLUSION

The preliminary injunction should be affirmed.

Respectfully submitted,

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February 14, 2003