

**01-2648/2725**

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IN THE UNITED STATES COURT OF APPEALS  
FOR THE SIXTH CIRCUIT

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**THE TAUBMAN COMPANY,**

*Plaintiff-Appellee*

v.

**WEBFEATS, a Texas Company, and HENRY MISHKOFF, an individual,**  
*Defendants-Appellants.*

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**Brief of *Amici Curiae***

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## I. Introduction and Statement of Facts

This case, and a growing number of similar cases across the country and indeed around the world, involves a conflict between trademark laws and the fundamental First Amendment right to criticize companies on the Internet.

Ironically, the critic in this case began as a company fan. Appellant-defendant Henry Mishkoff (hereinafter “Mishkoff”) created a “fan” web site to support a new mall, “The Shops at Willow Bend,” opening in Plano, Texas near his home.

Appellee-plaintiff The Taubman Company LP (hereinafter “Taubman”) is the owner and developer of the mall. (R. 40 Memorandum opinion & order, pg. 2) Taubman did not appreciate Mishkoff’s fan web site, at [www.shopsatwillowbend.com](http://www.shopsatwillowbend.com), and sued him in the Eastern District of Michigan for trademark infringement, unfair competition, and violation of the Anti-Cybersquatting Protection Act (or “ACPA”). (R. 1 Complaint, pp. 3-4) Predictably, the lawsuit changed Mishkoff’s opinion of the mall owner, so he established five additional Web addresses (or domain names) where he could criticize Taubman’s abusive litigation, at [www.taubmansucks.com](http://www.taubmansucks.com), [www.willowbendsucks.com](http://www.willowbendsucks.com), [www.willowbendmallsucks.com](http://www.willowbendmallsucks.com), [www.shopsatwillbendsucks.com](http://www.shopsatwillbendsucks.com), and [www.theshopsatwillowbendsucks.com](http://www.theshopsatwillowbendsucks.com) (hereinafter “the ‘sucks’ domain names” or “the gripe site”). (R. 40 Memorandum opinion & order, pg. 3)

The district court granted Taubman’s request for a preliminary injunction against Mishkoff’s continued publication of the fan web site and use of the web address at [www.shopsatwillowbend.com](http://www.shopsatwillowbend.com). (R. 7 Order granting Preliminary Injunction) Before Mishkoff learned of this injunction, he used his “sucks” domain names to publish a personal, chronological account of the litigation, which he was defending pro se.<sup>1</sup> This gripe site included relevant correspondence and court documents, and unequivocally expressed Mishkoff’s critical views of Taubman and its litigation tactics. No prospective mall customer could confuse Mishkoff’s gripe site with the mall’s official home page. The site was completely non-commercial, and contained no advertisements, solicitations, or links to commercial web sites. (R. 53 CDs attached to motion to supplement the record) Yet when Taubman learned of Mishkoff’s gripe site, it promptly moved to expand the initial preliminary injunction to ban it as well.

Ignoring the First Amendment protection of criticism, and the non-commercial and unconfusing nature of Mishkoff’s gripe site, the district court granted Taubman’s motion. Committing clear error, the district court enjoined Mishkoff’s use of the “sucks” domain names and ordered him to remove his gripe site. (R. 40 Memorandum opinion & order) “Using websites that incorporate Plaintiff’s mark to disparage Plaintiff would likely be an unfair commercial use

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<sup>1</sup> Mishkoff published the same web content at each of his “sucks” domain names.



within the scope of the Lanham Act’s protections,” explained the court. (R. 40 Memorandum opinion & order, pg. 14) Under that sweeping rationale, any online criticism of a trademark holder could be enjoined as trademark infringement simply because it uses a trademark to name the target of criticism.<sup>2</sup> The preliminary injunction is an unconstitutional prior restraint of speech at the core of what the First Amendment protects – non-commercial critical commentary about a company and the legal process. It is particularly troubling that the district court injunction silenced criticism not only of Taubman, but of the court’s own rulings. In fact, in extending its original injunction, the district court absurdly required Mishkoff to refrain from publishing on the Internet any of the content hosted at the “sucks” domain names – which includes the court’s own earlier injunction, along with other documents of public record. Trademark laws do not support such a result, and the First Amendment cannot allow it. *Amici* write to urge this Court to vacate the preliminary injunction, and to inform the Court of the broader significance of this case as part of a dangerous trend to use trademark laws to suppress protected criticism on the Internet.

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<sup>2</sup> Rather than applying the relevant factors to determine whether Mishkoff’s gripe site might infringe Taubman’s trademarks, discussed *infra* at Section IV, the district court instead relied solely on the “safe distance” doctrine to support its injunction. *Amici* concur with Appellant’s argument regarding the misapplication of that doctrine to this case. See Brief of Defendants-Appellants, pp. 52-55.

## II. The Democratizing Features of the Internet Present Unique Opportunities for Consumers to Voice Their Complaints About Companies.

The Internet has been described as a "vast democratic for[um]," *Reno v. ACLU*, 521 U.S. 844, 868 (1997), which gives average users an unprecedented ability to join a worldwide discussion and debate on a range of subjects "as diverse as human thought." *Id.* at 852. The Internet is a relatively new and powerful medium in which anyone "can become a town crier with a voice that resonates farther than it could from any soapbox." *Id.* at 870. It should come as no surprise that disgruntled consumers, who previously had limited avenues for communicating with other consumers, have used this worldwide platform to voice their complaints about companies, products, and services to a much larger audience. The resulting "cyber-gripe" web sites are one of the many positive examples of the equalizing and empowering nature of the Internet. See generally, Note, Oscar S. Cisneros, *Bally Total Fitness Holding Corp. v. Faber*, 15 Berkeley Tech. L. J. 229 (2000); Note, Rebecca S. Sorgen, *Trademark Confronts Free Speech on the Information Superhighway: "CyberGrippers" Face a Constitutional Collision*, 22 Loy. L.A. Ent. L. Rev. 115 (2001). Like other innovative forms of speech on the Internet, cyber-gripe sites have raised "novel and complex legal issues and ha[ve] challenged existing legal doctrine." *Doe v. 2TheMart.Com, Inc.*, 140 F. Supp. 1088, 1091 (W.D. Wash. 2001). Though the Internet should not be immune to trademark laws,

such laws should not be used to silence this new form of criticism and other protected online speech. See generally, Sorgen, 22 Loy. L.A. Ent. L. Rev. 115; Note, Keith Blackman, *The Uniform Domain Name Dispute Resolution Policy: A Cheaper Way to Hijack Domain Names and Suppress Critics*, 15 Harv. J.L. & Tech. 211, 246-55 (Fall 2001); Marcelo Halpern & Ajay K. Mehrotra, *From International Treaties to Internet Norms: The Evolution of International Trademark Disputes in the Internet Age*, 21 U. Pa. J. Int'l Econ. L. 523, 558-59 (2000).

III. This Case is Part of a Disturbing Trend in Which Corporations Use Trademark Laws to Silence Their Online Critics.

A. The Use of Trademarks in Internet Domain Names

The potential for conflict between trademark laws and Internet speech is rooted in the Internet's global, centralized naming and addressing system for individual web sites around the world. Every web site on the Internet has a virtual address which consists of a unique Internet Protocol (IP) number. Because IP numbers are "hard to remember and hard to type," the Internet also relies on user-friendly "domain names," which consist of textual strings. A. Michael Froomkin, *ICANN's Uniform Dispute Resolution Policy – Cause and (Partial) Cures*, [www.law.miami.edu/%7Efroomkin/articles/udrp.pdf](http://www.law.miami.edu/%7Efroomkin/articles/udrp.pdf) at 7. Whenever a web user accesses a web site by its popular domain name address (e.g.,

<http://www.aclu.org>), an elaborate Domain Name System resolves the domain name to the proper IP address (e.g., <http://207.188.212.150>). The Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for assigning domain names on a first-come, first-served basis to anyone who pays the necessary fee.

*Id.*

As commentators have noted, “there is a global clash between geographically bounded trademarks and the limitless reach of the Internet.” Halpern & Mehrotra, 21 U. Pa. J. Int’l Econ. L. at 523. Traditional trademark law allows for multiple, concurrent uses of the same name by different people in the same business in different places, or by different businesses in the same place. Froomkin at 6. But “trademark law assumptions about the local and sectoral use of trademarks work badly on the Internet generally because content in one location can be visible anywhere.” *Id.* at 5. While trademark law can tolerate multiple users of the same mark, the Internet’s domain name system “enforces a greater degree of uniqueness.” *Id.* at 6-7. Thus, as the web grew in the 1990s, companies began to view domain names as important identifiers. “[I]t was only a small leap to the conclusion that trademarks might or should imply rights to corresponding domain names.” *Id.* at 11. The trademark lobby thus began a race to control and expand the rules for protecting the use of their trademarks in both domain names and in web page content on the Internet.

## B. The Use of Trademark Remedies Against Parody and Gripe Sites.

Corporations now have an expanded, formidable arsenal with which to protect their trademarks on the Internet: traditional trademark infringement remedies under the Lanham Act, the Federal Trademark Dilution Act (FTDA) (passed in 1995), the Anticybersquatting Consumer Protection Act (ACPA) (passed in 1999), and ICANN's Uniform Domain Name Dispute Resolution Policy. See 15 U.S.C. §§ 1114, 1125(a), (c), (d); ICANN, Uniform Domain Name Dispute Resolution Policy (approved Oct. 24, 1999) (hereinafter "Uniform Policy"), at <http://www.icann.org/dndr/udrp/policy.htm>. In principle, where the mark used is not identical to plaintiff's trademark, trademark holders seeking to recover under any remedy other than dilution must prove that defendant's use of the mark is either "likely to confuse" consumers or is "confusingly similar." See 15 U.S.C. §§ 1114(1)(a); 1125(a)(1)(A); 1125(d)(1)(A)(ii); Uniform Policy. In addition, plaintiffs may not recover where defendant is engaged in good faith noncommercial or fair use of the mark. Yet despite the limitations within the remedies themselves, there are a growing number of cases in which trademark owners have tried to use these remedies to stifle legitimate criticism and speech protected by the First Amendment. See generally, Blackman, 15 Harv. J.L. & Tech. at 246-55; Sorgen, 22 Loy. L.S. Ent. L. Rev. 115; Halpern & Mehrotra, 21 U. Pa. J. Int'l Econ. L. 523. Though this

case involves only some of these remedies, an overview of recent decisions will help to contextualize the fundamental speech issues presented in the current case.

In *PETA v. Doughney*, 263 F.3d at 366 (4<sup>th</sup> Cir. 2001), the People for the Ethical Treatment of Animals successfully sued a web site at <http://www.peta.org> that claimed it was for “People Eating Tasty Animals.” The content of the site was a parody of the PETA organization. Considering only the URL and not the content on the site, the Fourth Circuit held defendants liable for infringement and dilution because the URL might cause confusion by web users expecting to find the actual PETA organization’s web site at that address. The court’s flawed reasoning wrongly assumes that Internet users could be confused by a URL alone. In fact the user would never be confused once the content on the site is actually accessed, which happens nearly simultaneously with the entry of the URL into a browser. Cases more consistent with traditional trademark theories have imposed liability only where both the URL and the content on the site is confusing. See, e.g., *Planned Parenthood Federation of America, Inc. v. Bucci*, 1997 WL 133313 (S.D.N.Y.), *aff’d mem.*, 152 F.3d 920 (2d Cir. 1998); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J.), *aff’d mem.*, 159 F.3d 1351 (3d Cir. 1998); *OBH v. Spotlight Magazine*, 86 F. Supp. 2d 176 (W.D.N.Y. 2000). Though some trademark holders have sued using infringement and dilution theories where neither the URL nor the content is confusing, courts have correctly ruled for defendants in

these cases. See, e.g., *Bally Total Fitness v. Faber*, 29 F. Supp. 2d 1161, 1164, 1165 n.3 (C.D. Cal. 1998) (ruling for defendants because use of the terms “Bally Sucks” on a web site was unlikely to cause confusion); *Ford v. 2600*, 177 F. Supp. 2d 661 (E.D. Mich. 2001) (ruling for defendant because “www.fuckgeneralmotors.com” unlikely to meet the standards for infringement or dilution).

In addition to direct infringement and dilution remedies, trademark owners may now sue under the Anticybersquatting Consumer Protection Act (ACPA). ACPA imposes liability where plaintiff can prove a bad faith intent to profit from the registration, traffic, or use of a domain name that is identical or confusingly similar to a distinctive trademark, or is identical, confusingly similar to, or dilutive of a famous mark. See 15 U.S.C. § 1125(d). ACPA was passed to stop persons who register well-known trademarks specifically for the purpose of selling these domain names for a profit. In the vast majority of these cases, cyber-squatters place no content on the web sites whose domain names they register. ACPA was intended to provide courts "with a preferable alternative to stretching federal dilution law when dealing with cybersquatting cases." *Sporty's Farm v. Sportsman's Market*, 202 F.3d 489, 497 (2d Cir. 2000). Yet trademark holders have also used this remedy to attempt to suppress parody and criticism. See *Lucent Technologies v. LucentSucks.com*, 95 F. Supp. 2d 528, 535 (E.D. Va. 2000) (dismissing suit

because of plaintiffs' failure to comply with due diligence requirement of ACPA, but noting that web site is probably a protected parody); see also *Lucent Technologies v. Johnson*, 2000 WL 1604055, 3-4 (C.D. Cal. 2000) (court denied motion to dismiss based on fair use when same plaintiffs sued again in another district).

Trademark holders have yet another remedy available to prevent the use of a trademark in domain names: the Uniform Domain Name Dispute Resolution Policy implemented by ICANN. The Uniform Policy is incorporated into all registration agreements with approved domain name registrants. The Policy "sets forth the terms and conditions in connection with a dispute between [the registrant] and any party other than [the registrar] over the registration and use of an Internet name registered by [the registrant]." Uniform Policy at <http://www.icann.org/dndr/udrp/policy.htm>. The Policy requires all domain name registrants to submit to a mandatory administrative proceeding upon a complaint by a trademark owner. If the trademark owner prevails in the proceeding, ICANN transfers the disputed domain name to the trademark owner. See generally, Dale M. Cendali, "Legal Developments in Trademark Law and the Internet," in *Fifth Annual Internet Law Institute*, Vol. 1 (2000) (citing Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*, Nov. 9, 2000 at



<http://dcc.syr.edu/roughjustice.htm>). The Uniform Policy is now arguably the most oft-used remedy regarding use of trademarks in domain names.

The constitutional problems inherent in the Uniform Policy itself, and in its application by arbitration panels, are already well-documented.<sup>3</sup> Because the trial court's flawed reasoning in this case mirrors the flawed reasoning of many Uniform Policy decisions regarding cyber-gripe sites, *amici* summarizes some of those decisions here. In *ADT Services AG v. ADT Sucks.com*, WIPO Case No. D2001-0213 (4/23/01), the panel ruled for the complainant, reasoning that "the addition of the sucks [to the domain name] does nothing to deflect the impact of the mark on the Internet user." *Id.* It further found that "[t]he addition of the suffix 'sucks' is a crude attempt to tarnish the mark," and assumed that non-English speakers in particular might be confused into believing that the URL is sponsored by the trademark holder. *Id.* Ignoring the First Amendment's protection for criticism entirely, the panel then found bad faith by noting the respondent's registration of other "sucks" sites, and by his "attempt to embarrass the owners of internationally

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<sup>3</sup> See, e.g., Cendali; David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 Santa Clara Computer & High Tech. L.J. 35 (Dec. 2001); Halpern and Mehrotra, 21 U. Pa. J. Int'l Econ. L. at 558-59; A. Michael Froomkin, *Wrong Turn In Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 Duke L.J. 17 (2000); Froomkin, at <http://www.law.miami.edu/%7Efroomkin/articles/udrp.pdf>; Blackman, 15 Harv. J.L. & Tech. 211.

known marks.” *Id.* In *Vivendi Universal v. Mr. Jay Davis Sallen*, WIPO Case No. D2001-1121 (11/7/01), the respondent had registered *vivendiuniversalsucks.com*. Although the purpose of the site was “the free expression criticism of Complainant’s business practices,” *id.*, the panel followed the ADT panel’s reasoning on the confusion issue, and found bad faith from the simple fact that the respondent had “deliberately chose[n] to register a domain name which incorporated” the complainant’s mark. *Id.* Neither complainant had provided any evidence that consumers were actually confused.<sup>4</sup> These and other Uniform Policy rulings represent a dangerous trend both because the outcomes are

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<sup>4</sup> See also *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO Case No. D2000-0477 (7/20/2000) (ruling for complainant and finding confusion despite use of “sucks” in URL and despite content merely critical of Wal-Mart’s litigation); *Wal-Mart Stores v. Rich MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662 (9/19/2000) (ruling for complainant against *wal-martsucks.com* and holding that a domain name is “identical or confusingly similar” to a trademark “when the domain name includes the trademark ... regardless of the other terms in the domain name.”); but see *Wal-Mart Stores v. wallmartcanadasucks.com*, WIPO No. D2000-1104 (11/23/2000) (ruling that “I do not see how a domain name including ‘sucks’ ever can be confusingly similar to a trademark to which ‘sucks’ is appended”); *Compusa Management Company v. Customized Computer Training*, Nat’l Arbitration Forum Case No. FA0006000095082 (8/17/2000) (ruling for respondent because “[n]o one could confuse ‘Compusa’ with ‘StopCompusa’ and ‘BanCompusa’”); *McLane Company v. Fred Craig*, WIPO Case No. D2000-1455 (1/11/2001) (ruling for respondent because confusion over “*mclanenortheastsucks.com*” is unlikely and user would never be confused once content of site is viewed); *Lockheed Martin Corp. v. Dan Parisi*, WIPO Case No. D2001-1015 (ruling for respondent because “*lookheedsucks.com*” cannot be confusing).

inconsistent and arbitrary, and because many of the arbitration panels have issued rulings directly contrary to First Amendment rights. Though these decisions should not bind federal courts, a rejection of their reasoning by this Court may help to curb future abuses.<sup>5</sup>

Though there have been a number of federal district court and Uniform Policy rulings regarding parody and gripe web sites, no federal appellate court has yet reviewed a case involving registration of a domain name that incorporates a disparaging term such as “sucks” along with a trademark. For the reasons discussed below, *amici* urge the court to reverse the district court injunction against Mishkoff’s gripe site and to protect the First Amendment right to criticize companies on the Internet.

#### IV. Mishkoff’s “Sucks” Domain Names and Gripe Site Do Not Infringe Taubman’s Trademarks or Violate ACPA.

##### A. Mishkoff’s Use of Taubman’s Marks is Clearly Non-Commercial.

The district court improperly enjoined Mishkoff for trademark infringement with no proof that he had used Taubman’s marks “in commerce,...in connection with the sale, offering for sale, distribution or advertising of any goods or services.”

15 U.S.C. § 1114(1)(a).<sup>6</sup> Mishkoff’s gripe site is wholly non-commercial. Nothing

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<sup>5</sup> See generally, Sorkin, 18 Santa Clara Computer & High Tech. L.J. 35 (2001).

<sup>6</sup> A claim of unfair competition requires the “essentially identical showing” of use of

is sold or offered for sale, the site contains no advertising, and readers are not solicited for funds.<sup>7</sup> Mishkoff has never profited from the site in any way, and appears to maintain it at his own personal expense. (R. 53 CDs attached to motion to supplement the record) Not surprisingly, then, Taubman itself never even alleged facts to support a finding that Mishkoff had used its marks on his gripe site for commercial purposes. Clearly, Mishkoff is not a commercial competitor of Taubman's, but a critic using the most convenient and powerful medium available to him. The only content on his site is criticism of Taubman, and legal documents about the current dispute. Mishkoff has merely used Taubman's marks to identify the target of his criticism and to accurately describe the contents of his web site.

Unable to identify any traditional commercial use, the district court instead reasoned that the fan site and the gripe site "as a whole" established that Mishkoff "may be trying to inflict some type of economic harm unto plaintiff." (R. 40 Memorandum order & opinion, pg. 13; emphasis added) The district court's holding was based solely "on the *assumption* that Defendants are trying to inflict

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the marks "in commerce," "in connection with any goods or services." *Ford*, 177 F. Supp. 2d at 665; 15 U.S.C. §1125(a).

<sup>7</sup> During the spring of 2001, Mishkoff's fan web site contained an advertisement for his girlfriend's T-shirt business, which he posted as a personal favor. When Taubman objected to this advertisement, in August 2001, Mishkoff promptly removed it. No advertisement has ever been published on Mishkoff's gripe site. (R. 53 CDs attached to motion to supplement the record)

economic harm on the Plaintiff” by “disparaging” its trademarks. (R. 40 Memorandum order & opinion, pp. 14-15; emphasis added) But consumer commentary does not become “commercial,” and thus liable as infringement, solely because it may convince other consumers not to patronize the company.

The district court mistakenly relies upon *Planned Parenthood Federation of America v. Bucci* to support its assertion that “[u]sing websites that incorporate Plaintiff’s mark to disparage Plaintiff would likely be an unfair commercial use within the scope of the Lanham Act’s protection.” (R. 40 Memorandum order & opinion, pg. 14) Planned Parenthood, a family planning organization offering information on abortion, sought to preliminarily enjoin defendant’s use of the domain name “www.PlannedParenthood.com.” The defendant had used the web site to advertise the sale of an anti-abortion book, promote speaking engagements by the book’s author, and solicit funds to support abortion protest activities. The defendant’s web page was prefaced with the prominent greeting “Welcome to the PLANNED PARENTHOOD HOME PAGE!”, and he admitted using the Planned Parenthood mark to reach Internet users who thought they would be getting information from the plaintiff. See *Planned Parenthood*, 1997 WL 133313 at 1-2. Based on these facts, the court held that defendant’s use of the Planned Parenthood trademark was a competing, commercial use. See *id.* at 4. The facts are easily distinguishable from Mishkoff’s use of Taubman’s marks. Mishkoff’s personal,

non-commercial gripe site does not compete in any way with Taubman's mall, and Mishkoff has no intent to confuse readers into believing that his site is sponsored by Taubman. Instead, Mishkoff's domain names and the contents of his site make it clear to any reasonable web user that he believes that Taubman "sucks."

In addition, Mishkoff's gripe site is not transformed into a commercial site simply because some web users may find it when searching for information about Taubman's mall, even if Mishkoff's site slows or dissuades users from accessing web sites hosted by Taubman. As one court put it, "where, as here, the unauthorized use in no way competes with the mark owner's offering of goods or services, the 'in connection with goods or services' requirement is not satisfied simply because a prospective user of the Internet may face some difficulty in finding the home page he is seeking." *Ford*, 177 F. Supp. 2d at 665 (distinguishing *Planned Parenthood* and finding that defendant's use of the domain name "Fuckgeneralmotors.com", which provided no content other than a hyperlink to the "ford.com" web site, did not dilute or infringe upon Ford's trademarks). In fact, there are many good reasons why web users should be able to find Mishkoff's gripe site when searching for information about Taubman's mall. "The average Internet user may want to receive all the information available" on a company, and "will be unable to locate sites containing outside commentary unless those sites include [the plaintiff's] marks." *Bally*, 29 F. Supp. 2d. at 1165 (finding that

defendant's web site "Bally sucks" did not infringe or dilute Bally's mark by hosting critical consumer commentary).

In sum, the preliminary injunction is invalid because Mishkoff was engaged in purely non-commercial criticism of Taubman. If the negative impact of that criticism were to transform it into a commercial use under the Lanham Act, then all companies would be immune to any consumer complaints.

B. Mishkoff's Domain Names and Gripe Site Cannot Be Confused with Sites Sponsored by Taubman.

The district court also failed to find that Mishkoff's use of Taubman's marks was likely to confuse or deceive the buying public. 15 U.S.C. §1114. "Likelihood of confusion is synonymous with a probability of confusion, which is more than a possibility of confusion." *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1122 (D. Minn. 2000) (citing *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 543 (5<sup>th</sup> Cir. 1998)). The Sixth Circuit considers eight factors in determining whether such a likelihood exists: 1) the strength of the plaintiff's mark; 2) the relatedness of the goods in question; 3) the similarity of the marks; 4) evidence of actual confusion; 5) the marketing channels used; 6) the degree of purchaser care; 7) the defendant's intent in selecting the mark; and 8) the likelihood of expansion of product lines.<sup>8</sup> See *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family*

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<sup>8</sup> Unfair competition claims are decided using the same likelihood of confusion

*Music Center*, 109 F.3d 275, 280 (6<sup>th</sup> Cir. 1997); see also *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2<sup>nd</sup> Cir. 1961). None of these factors supports the district court injunction in this case.

Even assuming that Taubman's marks are strong enough to warrant trademark protection and satisfy the first factor, the second factor strongly cuts against Taubman. "Related goods are those goods which, though not identical, are related in the minds of consumers.... The modern rule protects any product or service which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner." *Bally*, 29 F. Supp. 2d at 1163 (internal citations omitted). When discussing a web site dedicated to complaints about the plaintiff's health clubs, the court in *Bally* easily found that "[n]obody comparing Bally's official web site with [defendant]'s site would assume [defendant]'s site 'to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.'" *Id.* at 1163-4. Like Bally's official site and the "Bally Sucks" web site, the parties' sites in this case "have fundamentally different purposes. [Taubman]'s site is a commercial advertisement. [Mishkoff]'s site is a consumer commentary.

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factors. *Chatam International Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 554-55 (E.D. Pa. 2001) (quoting *A & H Sportswear v. Victoria's Secret Stores*, 237 F.3d 198, 210 (3d Cir. 2000) ("We measure federal trademark infringement, 15 U.S.C. § 1114, and federal unfair competition, 15 U.S.C. § 1125(a)(1)(A), by identical



Having such different purposes demonstrates that these sites are not proximately competitive,” i.e., are not related goods or services. *Id.* at 1164.

As for the third factor, similarity of the marks, the trademarks “Taubman” and “The Shops at Willow Bend” are clearly dissimilar to and distinguishable from Mishkoff’s use of the marks in his domain names, such as “www.taubmansuckscom” or “www.theshopsatwillowbendsucks.com”. Although the “sucks” domain names contain the trademarks, the addition of the word “sucks” radically changes the message being communicated. “ShopsatWillowBendSucks” is clearly not an identifier for Taubman’s mall, but rather an unambiguous statement of negative opinion about it. As Mishkoff points out in the introduction to his site, the accepted slang definition of “to suck” is “to be objectionable or inadequate,” and “[t]his, of course, is the sense in which I’m using the term.” (R. 53 CDs attached to motion to supplement the record) The *Bally* court noted that “[s]ucks’ has entered the vernacular as a word loaded with criticism.” *Bally* at 1164. No reasonably prudent Internet user would believe that “TaubmanSucks” is similar to Taubman. *Id.* at n. 2.

Even if a web user believed initially that Mishkoff’s gripe site could be sponsored by Taubman, which is unlikely, this “initial interest confusion” also fails to support the injunction. Initial interest confusion is “a brand of consumer standards”)).

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confusion...which permits a finding of a likelihood of confusion although the consumer is only initially confused and quickly becomes aware of the source's actual identity," *Northland*, 115 F. Supp. 2d at 1119. In the context of the Internet, any initial confusion is de minimus because "Internet surfers are inured to the false starts and excursions awaiting them in this evolving medium." *Chatam*, 157 F. Supp. 2d at 559. Web users know they will reach the wrong site on occasion, and such a mistake is easily cured with the press of a button, which is why there "is a difference between inadvertently landing on a website and being confused." *Id.* at 559 (citing *The Network Network v. CBS, Inc.*, 54 U.S.P.Q. 2d 1150, 1155 (C.D. Cal. 2000)); see also *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001) ("any confusion that a consumer may have when reaching defendant's web site is not legally cognizable"); *Ford*, 177 F. Supp. 2d at 666 (quoting *Strick* at 379-80 ("[a]ny inconvenience to an Internet user searching for Plaintiff's web site is trivial.")). In addition, since Taubman and Mishkoff are not competitors, any initial interest confusion that might be suffered by visitors to Mishkoff's gripe site does not have the same "bait and switch" consequence that the doctrine seeks to prevent. See *Chatam*, 157 F. Supp. 2d at 558 (citing McCarthy on Trademark and Unfair Competition, § 23:6 (4<sup>th</sup> ed. 2000)). Therefore,

[d]issimilarity of goods and services resolves the initial interest confusion question. A trademark violation based upon initial interest confusion involves the junior user [of the mark] capitalizing on the senior user's goodwill. The

senior user's customers, at least tangentially in the market for the junior user's services, accidentally access the infringing site while in search of information on the senior user's products. Thus, relatedness of products is an important component in the analysis."

*Id.* at 558-59 (quoting *Network Network*, 54 U.S.P.Q. 2d at 1157-58).

Given the discussion above, it is also not surprising that Taubman was unable to offer any evidence of actual confusion, another factor weighing against the injunction. In fact, "[r]egistering domain names in the form of [company name]sucks.com to provide a forum for critical commentary is not uncommon," which makes such domain names even less likely to confuse web users. *Lucent*, 95 F. Supp. at n.9.

The intent of the defendant factor also cuts against Taubman. Mishkoff chose the "sucks.com" domain names to identify his web sites as hosting content critical of the plaintiff, without any intent to profit from that use. And, "[w]hile defendant may intend to use the domain names here to attract Internet users interested in plaintiff's business, this does not equate with an attempt to pass off any type of commercial services or goods as being those of plaintiff." *Northland*, 115 F. Supp. 2d at 1121. Because Mishkoff's gripe site is non-commercial, none of the remaining factors supports a finding of likely confusion. To sensibly apply them, there must be competing, related products or services. Mishkoff is not a shopping mall developer, while Taubman "does not claim to be known as a

manufacturer of vacuum cleaners or suction pumps...or a test laboratory for beverage straws, or a porn star, a black hole, or any other sort of entity that people are likely to associate with sucking.” *Vivendi Universal v. Mr. Jay Davis Sallen*, WIPO Case No. D2001-1121 (11/7/01). Customer confusion between a gripe site and a site sponsored by the critic’s target is wholly improbable.

No other federal court has yet to find a “sucks.com” domain name or web site likely to be confused with the trademark criticized. See *Lucent*, 95 F. Supp. 2d 528; *Bally*, 29 F. Supp. 2d 1161, *Ford*, 177 F. Supp. 2d 661; but see discussion of cases resolved under ICANN’s Uniform Policy, *supra* at Section III.B. Findings of trademark liability have instead generally been limited to cases where the domain name in question was identical to the plaintiff’s mark. See *Planned Parenthood*, 1997 WL 1333313, *PETA*, 263 F. 3d 359; and *Jews for Jesus*, 993 F. Supp. 282. At least one court has found lack of confusion even when the domain name and the mark were identical. See *Northland*, 115 F. Supp. 2d 1108.

C. Mishkoff’s Use of Taubman’s Marks Is a Fair Use.

The district court injunction is also in error because Mishkoff is clearly making a fair use of Taubman’s marks, which is expressly protected by the Lanham Act. 15 U.S.C. 1115(b)(4). Mishkoff is “exercising his right to publish critical commentary about” the plaintiff, and “he cannot do this without making reference to” the plaintiff. *Bally*, 29 F. Supp. 2d at 1165. That is why “[a]n individual who

wishes to engage in consumer commentary must have the full range of marks that the trademark owner has to identify the trademark owner as the object of criticism.” *Id.* at n.4; see also *Lucent*, 95 F. Supp. 2d at 535-36 (“A successful showing that lucentucks.com is effective parody and/or a cite (sic) for critical commentary would seriously undermine the requisite elements for the causes of action at issue in this case”).

The fact that fair uses “frequently are designed to, and actually may, hinder the mark owner’s commercial success,” does not affect their protected status. *Ford*, 177 F. Supp. 2d at 664. “In the offline context, consider a graffiti vandal painting ‘Fuck General Motors’ on a sign at Ford headquarters. While some other law may (or should) provide a remedy, it would be a stretch to conclude that trademark law had been violated,” *id.* at n.3, even if the vandal’s insult convinced some consumers to avoid Ford products. In fact, consumer criticism is a protected fair use precisely because it promotes vigorous public debate and discussion about the shortcomings of commercial products and services.

D. ACPA Also Fails to Support the Injunction Against Mishkoff’s Gripe Site.

Although it is unclear whether the district court applied the Anti-Cybersquatting Protection Act (“ACPA”) when expanding its injunction to include the “sucks” domain names and gripe site, it is clear that the statute does not support

the injunction. Unlike traditional trademark remedies, ACPA does not require commercial use of the mark, but does require a finding of “bad faith intent to profit from [the plaintiff’s] mark” – an intent Mishkoff clearly lacks. 15 U.S.C. §1125(1)(A)(i). Mishkoff has not attempted to sell the “sucks” domains for a profit, and certainly does not fit the “‘classic’ cybersquatter profile, i.e., a person who registers multiple domain names and attempts to sell them for the highest price obtainable.” *Northland*, 115 F. Supp. 2d at 124. In addition, under ACPA, “fair use of the mark in a site accessible under the [disputed] domain name” is a factor demonstrating a lack of bad faith intent. 15 U.S.C. §1125(1)(B)(i)(IV). Uses that suggest a lack of bad faith include comment, criticism, and use of domain names that by their own terms signal such a use, e.g., by appending the term “sucks” to the trademark of the criticized party. See *Lucent*, 95 F. Supp. 2d at 535.

Furthermore, ACPA applies only if the domain names used by Mishkoff are “identical or confusingly similar” to Taubman’s marks. 15 U.S.C.

1125(d)(1)(A)(ii)(I). As discussed above, finding a likelihood of confusion between the mark “Taubman” and the domain name “www.taubmansucks.com” stretches the bounds of credulity. A finding under ACPA that they are “confusingly similar” clearly surpasses those bounds, for the same reasons.

V. The Preliminary Injunction Issued by the District Court is an Unconstitutional Prior Restraint.

Although First Amendment considerations inform the statutory analysis of any trademark claim, courts must also conduct an independent constitutional inquiry to ensure that trademark laws do not impinge on First Amendment rights. See *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 560 (1985). In this case, because Mishkoff used the Internet to engage in protected, non-commercial speech, the district court's preliminary injunction is an unconstitutional prior restraint. "Temporary restraining orders and permanent injunctions – i.e., court orders that actually forbid speech activities – are classic examples of prior restraints." *Alexander v. United States*, 509 U.S. 544, 550 (1993); see *New York Times Co. v. United States*, 403 U.S. 713 (1971); *Organization for a Better Austin v. Keefe*, 402 U.S. 415 (1971); *Near v. Minnesota*, 283 U.S. 697 (1931). They come to the court bearing a heavy presumption against their constitutionality. *Organization for a Better Austin*, 402 U.S. at 419; *Bantam Books, Inc. v. Sullivan*, 372 U.S. 58, 70 (1963). A plaintiff "carries a heavy burden of showing justification for the imposition of such a restraint." *Organization for a Better Austin*, 402 U.S. at 419. They are rarely upheld. See *New York Times Co.*, 403 U.S. 713 (Pentagon Papers case).

Consumer criticism and commentary has long been recognized as core protected speech. See *Bose Corp. v. Consumers Union*, 466 U.S. 485 (1984); *Semco v. Amcast*, 52 F.3d 108, 111-14 (6<sup>th</sup> Cir. 1995); *Porous Media Corp. v. Pall*

*Corp.*, 173 F.3d 1109, 1119-21 (8<sup>th</sup> Cir. 1999). As the Supreme Court has clearly stated, “No prior decisions support the claim that the interest of an individual in being free from public criticism of his business practices in pamphlets or leaflets warrants the use of the injunctive power of a court.” *Organization for a Better Austin*, 402 U.S. at 419; see also *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 32 (1<sup>st</sup> Cir. 1987) (finding magazine’s non-commercial parody to be “an editorial or artistic, rather than a commercial, use of the mark,” and holding that application of anti-dilution statute violated First Amendment).<sup>9</sup> That rule applies equally to the critical commentary on Mishkoff’s gripe site.

Finally, the prior restraint imposed by the district court’s injunction is particularly broad because it extends far beyond the domain names or specific uses of Taubman’s marks to enjoin publication of *all* speech on Mishkoff’s gripe site at *any* domain name on the Web. (R. 40 Memorandum opinion & order, pp. 15-16)

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<sup>9</sup> Similarly, Mishkoff’s use of the “sucks” domain names is analogous to the use of a trademark in the title of a creative work to describe the subject of that work, and is due the same protection. See *Twin Peaks Production v. Publications Int’l*, 996 F.2d 1266, 1379 (2<sup>nd</sup> Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2<sup>nd</sup> Cir. 1989).



There is simply no way to interpret trademark law or the First Amendment to sanction such a broad restraint on publication.

### CONCLUSION

For the reasons stated above, *amici* urge this Court to hold that Mishkoff's online criticism of Taubman is protected by the First Amendment, and to vacate the district court's preliminary injunction against Mishkoff's web site.

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