

# Trademark

A trademark is a word, phrase, symbol or other indicator that identifies the source or sponsorship of goods or services. If an individual, business, or other organization uses a trademark to sell or promote its goods or services, then it can gain the right to use the trademark and to exclude others from using the trademark in connection with similar goods or services. Owners of famous trademarks, like "Windows," "McDonald's," or "Google," may also stop others from using them in connection with dissimilar goods or services. Trademark law is a branch of intellectual property law that is governed by both federal and state laws. By far the most important trademark law is the federal Lanham Act; because state laws generally follow the Lanham Act, this guide focuses on it exclusively.

A basic understanding of trademark law is important to your online activities for two reasons. First, as a provider of goods or services (e.g., online publishing, educating the public, news reporting), you may want to use trademarks to identify your work to the consuming public. In that case, you'll want to understand how to protect your legal rights, so that others do not unfairly take advantage of your reputation and the positive association you've built up between your trademark(s) and your work. Second, you should understand how you can properly make use of someone else's trademark for purposes of news reporting, commentary, criticism, and like activities. This overview page and the more detailed sections that follow will help you get a grip on both of these important aspects of trademark law.

Common examples of trademarks include "Yahoo!" in its characteristic red font, YouTube's slogan "Broadcast Yourself," and the venerable "New York Times."



Many trademarks use a stylized font or a particular combination of a logo and a product or business name, but a trademark can be as simple as a word in plain text, like "iPod," or a domain name, like "gmail.com," so long as the trademark owner uses it to identify its products or services. The crucial element is that the word, phrase, symbol, or design element act as **a source-identifier for goods or services**. If you want more information about what qualifies as a trademark, consult the section on What Trademark Covers.

To acquire rights in or "ownership" of a trademark, you simply need to use the trademark in commerce in connection with your goods or services. You do not obtain trademark rights through use in commerce, however, if your use is confusingly similar to someone else's prior use of the trademark. You may choose to register your trademark, but **you are not required to do so** in order to bring a lawsuit to protect it. Registering a federal trademark puts others on notice that you are using the mark, which may discourage them from adopting a similar trademark or business name in the future. It also helps you make out your case if you ever file a lawsuit to vindicate your trademark rights. Registration is fairly expensive, however, and you will want to consider whether the benefits of registration justify the expense. If you are interested in obtaining trademark rights, registering a trademark, or protecting your rights once established, see the Trademark Ownership page. In addition, we provide specific information about choosing a name for your website, blog, or organization in the section on Trademark Law and Naming Your Business.

The primary goal of trademark law is to **protect consumers from confusion about the source or sponsorship of goods and services**. It does this by allowing a trademark owner to prevent others from tricking consumers into buying a product or service they mistakenly believe comes from the trademark owner. Stated differently, the law helps consumers identify with accuracy the products and services that they want to buy and protects them from deceptive market practices. To see how this works, imagine a consumer - Sally. If Sally buys a computer that is labeled with the distinctive Dell logo, she can be pretty sure that the computer was made by Dell Inc. and nobody else. She can take Dell's reputation into account without worrying that a knockoff company is making shoddy computers and selling them with the Dell logo on them; trademark law prohibits this kind of confusing commercial activity, and it gives Dell the right to sue for trademark infringement if someone does so. In recent years, Congress has expanded the scope of trademark law to encompass harms other than consumer confusion, including dilution and cybersquatting, that we discuss below.

Federal trademark law protects against three distinct unlawful activities:

- **Trademark Infringement:** Trademark infringement happens when you use a trademark owner's trademark or a similar mark in a way that is likely to confuse the public into believing that the trademark owner is the source or sponsor of your products or services. This is the most common type of trademark claim, and it effectuates trademark's primary purpose of avoiding consumer confusion. See [What Trademark Covers](#) for details.
- **Trademark Dilution:** Trademark dilution happens when you use a trademark owner's *famous* trademark in a way that is likely to weaken its capacity to identify the trademark owner's goods or services or to tarnish the wholesomeness of the mark. The trademark owner need not show that you created consumer confusion, and dilution may occur even if your goods or services are completely different from the trademark owner's. Because of dilution law, it's probably not a good idea to call a blog "Kodak News" or "McDonald's Blog," unless it is actually about Kodak or McDonald's (in which case you should read [Using the Trademarks of Others](#) carefully). For details on trademark dilution, see [What Trademark Covers](#).
- **Cybersquatting:** Cybersquatting happens when you register, use, or sell a domain name with a bad faith intent to profit from someone else's trademark. Congress passed the Anticybersquatting Consumer Protection Act in 1999 to stop speculators from buying up multiple domain names and selling them at exorbitant prices to the legitimate owners of the associated trademarks. If your use of a trademark owner's trademark in a domain name does not fit this stereotypical model, you should be able to avoid cybersquatting liability. For details, see the [Cybersquatting](#) section.

Although trademark law provides trademark owners with a powerful tool for protecting the integrity of their trademarks, the law does not permit them to silence legitimate reporting, commentary, criticism, and artistic expression. As one court put it: "Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view." [L.L. Bean, Inc. v. Drake Publishers, Inc.](#), 811 F.2d 26, 29 (1st Cir. 1987). Because of the important role that trademarks play in our cultural vocabulary, "much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark." [The New Kids on the Block v. News America Publ'g](#), 971 F.2d 302, 306 (9th Cir. 1992).

The good news for citizen media creators is that the courts have therefore consistently protected the public's right to use the trademarks of others in order to engage in criticism, commentary, news reporting and other forms of noncommercial expression. This point is of special importance not only to journalistic sites, but also to gripe sites that focus criticism on particular companies and often use the companies' trademarks in their domain names. While the law is solicitous of your rights of free expression, the legal doctrines in this area are complicated. For this reason, it may be difficult to understand just how the law protects your use of a trademark in a particular act of reporting, commentary, criticism, and the like. If you want to make use of another's trademark in the course of these kinds of activities, you should consult the section on [Using the Trademarks of Others](#).

Finally, if you host user-generated content, such as user comments, you'll want to consider whether trademark law will hold you responsible for materials posted on your website or blog by your users. Unfortunately, the protection provided by the "safe harbors" of the Digital Millennium Copyright Act and section 230 of the Communications Decency Act generally do not protect you from trademark claims. For details, see [Trademark: User-Generated Content](#).

This guide is not a full treatment of trademark law, but it does provide what we hope is a good understanding of how to deal with the legal issues surrounding trademarks. In the sections that follow, we lay out further specifics about the principles described above.

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## Trademark Ownership

It is easy to become the owner of a trademark. You simply need to **use the trademark in commerce in connection with a good or service**. Most citizen media creators will probably use a trademark in connection with a service -- the service of providing online publishing or creating an interactive online community or the like. Once you've gotten this far, you "own" the trademark in the sense that you have the right to use it in commerce with the specific good or service in question and to exclude others from doing so, as long as your use is not confusingly similar to or dilutive of another individual's or company's prior use of the trademark. For that reason, it is critically important that you do an effective search of existing trademarks *before* you adopt one in connection with your online services. Please see our section on searching for the trademarks of others for details. For more information on how to acquire trademark rights, see Sarah Bird's excellent post, Trademark Basics: Be First in Your Market, Be Distinctive, and Don't Confuse the Consumer.

You may also choose to register your trademark, but you are **not required** to do so in order to bring a lawsuit to protect it against infringement or dilution. Registering a federal trademark puts the country (and possibly the world) on notice that you are using a certain mark, and also provides additional protections. However, this process is fairly long (usually taking a year or more) and potentially expensive (the fees start at \$275). It is also possible to register a trademark with your state, which is likely to be cheaper and easier but is probably not the best option for online activities, which by definition have a national and international scope. However, if you would like to find out more about your state's registration process, you can contact your state authority responsible for trademark matters.

## Registration

### Benefits of Registration

As noted above, federal trademark registration is not required for you to protect your trademark. However, registration provides some advantages. Specifically, registering a trademark with the U.S. Patent and Trademark Office (USPTO) provides the following benefits:

1. a public record of the trademark claim, which puts others on notice;
2. presumptive proof of trademark ownership and exclusive right to use the trademark throughout the U.S. (if you sue to protect the trademark, this will help you make your case);
3. the use of U.S. registration as a basis for obtaining registration in foreign countries; and

4. the ability to file a suit related to the trademark in a federal court, and if the defendant is found to have "willfully" infringed your trademark, you may recover your attorney fees and up to three times your actual damages.

Because federal registration is expensive, you'll want to weigh these benefits against the out-of-pocket costs of obtaining registration.

## **How to Register**

You can apply for federal trademark registration online. The USPTO estimates that filling out the form should take about 15-20 minutes. A federal application must contain at least four things, in addition to the filing fee: your name, your address, a clear drawing of the mark (which can be automatically generated from text if you do not have a logo), and at least one category of goods or services in which the mark is or will be used. Alternatively, you can file a much more detailed application and receive a discount on the filing fee. You can choose more than one product, service, or industry for your trademark, but you must pay the filing fee for each one. The USPTO has predefined categories of products and services that they strongly suggest you use, but you can also type in something else if your product or service does not fit in its categories. You may want to consider filing for more than one category. If your business is not clearly confined to one area, doing so would give you flexibility to expand into new products or services in the future. On the other hand, aside from the added filing fees, the downside to doing so is that you are more likely to conflict with someone else who is using the mark or a similar one in another field or industry. Furthermore, if you do expand in the future, you can apply for a new registration at that time (unless someone else has already registered the mark in that area in the meantime). If this process sounds too complicated for you, you can hire an attorney to do it. Trademark registration is usually fairly straightforward for attorneys who specialize in it, so it is relatively inexpensive.

After you file the registration forms with the USPTO, within about 3-6 months a USPTO attorney will examine and research your application. There are several categories of marks that the USPTO will refuse to register, including "immoral, deceptive, or scandalous" marks (such as those including foul language), those that disparage or falsely imply a connection to other people (the Washington Redskins are in danger of losing their trademark registration over this), and marks that are confusingly similar to others that are already registered. The USPTO attorney may contact you to resolve any issues in your application. If the USPTO approves your application, it will publish your trademark in its Official Gazette, and anyone who is already using the mark may oppose the registration. If no one opposes within thirty days, the USPTO will register your mark. All told, the process can easily take 1-2 years, but once it is approved your rights date back to the day you filed your application.

For additional details on registering a trademark, see the Chilling Effects [FAQ on Trademark](#).

## Trademark Notice

You can choose to include a trademark notice next to your trademark, but you are not required to do so in order to protect the mark. Trademark notice indicates to others that you claim ownership of the trademark in connection with the good or service in question, warning them against possible infringement. Any time you believe you have a rightful claim to a mark you may designate the mark with a <sup>TM</sup> (for goods) or <sup>SM</sup> (for services). You do not have to register the mark to use these notices. In addition, if you choose to seek registration of a trademark, you can use these notices during the registration process. If you obtain federal registration, you will probably want to use the more powerful ® notice, which can *only* be used after a successful registration with the USPTO. Even then, you can only use the ® notice in connection with the goods or services listed in your registration application.

## Maintaining Your Trademark Rights

According to Chilling Effects "Trademark rights can last indefinitely if the trademark owner continues to use the mark to identify goods or services. . . The term of a federal trademark registration is 10 years, with 10-year renewal terms. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit setting forth certain information to keep the registration alive. If no affidavit is filed, the registration is canceled." In addition to renewing your registration (should you choose to register), you need to take some additional steps to make sure that you do not lose your trademark rights:

- Periodically check whether another individual or company is using your trademark in a way that confuses its goods or services with yours. If you see something like this, you should probably send a cease-and-desist letter and contemplate filing a lawsuit. Otherwise, a court might later determine that you have abandoned your trademark. We know that this may be objectionable to some, but it is one of the costs of asserting trademark rights. Remember that nothing requires you to acquire or enforce trademark rights in the first place.
- Try to use the mark continuously. If you stop, keep a record of how you intend to use the mark in the future. Otherwise, a court might determine that you have abandoned it.
- Discourage others from using your trademark as an ordinary verb or noun, or it might become generic. For example, if consumers referred to xeroxing documents instead of photocopying them, blowing their noses with kleenex instead of facial tissues, and googling things instead of using a search engine, at some point Xerox, Kleenex, and Google would lose the ability to prevent others from using those

terms to describe their own products or services. This in fact happened to aspirin (formerly a trademark of Bayer), cellophane (formerly held by DuPont), and escalator (created by the Otis Elevator Company), among many other words that we now take for granted. The basic test is whether consumers generally understand a word as referring to the products or services of one company or individual (e.g., Xerox with a capital "X") or as including all makers of a certain product or service (e.g., Canon and HP make a xerox machine with a lowercase "x"). Admittedly, it is not easy to control the public's diction, but you can start yourself by only using the term in its trademark sense.

## What Trademark Covers

**Trademark** law applies to the use of words, phrases, symbols, slogans and other "marks" to identify the source or sponsorship of goods or services. The Lanham Act, which is the federal statute that covers trademark law, makes it unlawful for you to use a trademark in a manner that confuses consumers about the source or sponsorship of goods or services. Creating this kind of consumer confusion is called **trademark infringement**. Trademark law's primary purpose is to protect consumers from confusion in making purchasing decisions, and it does not protect against confusion generally. If you use a trademark in a way that does not create consumer confusion, you cannot be held liable for trademark infringement.

But, in 1996, Congress expanded federal trademark law so that it now covers some uses of trademarks that do not create consumer confusion. The federal dilution statute, found at 15 U.S.C. § 1125(c), gives the owner of a "famous" trademark the ability to bring a federal lawsuit against someone for **trademark dilution**. Trademark dilution occurs when someone other than the rightful owner of a famous mark uses it in a manner that diminishes its power to identify the trademark owner's goods or services **regardless of consumer confusion about source or sponsorship**. The dilution statute does not apply to noncommercial uses of a famous trademark, such as for news reporting, criticism, commentary, and parody.

The following sections go into greater detail to explain what kinds of things can serve as a trademark, and what activities qualify as trademark infringement and trademark dilution.

## What Is A Trademark?

A "trademark" is an intellectual property right in a particular "mark" used to identify the source or sponsor of a good or service. (Don't be intimidated by the word "mark" -- it is just a generic term for the various things that can qualify as a trademark, which we are about to describe.) A number of things can serve as a trademark (from Chilling Effects):

- names (such as company names, product names);
- domain names, if they label a product or service;
- images;
- symbols;
- logos;
- slogans or phrases;
- colors;
- product design; and
- product packaging (known as "trade dress").

Other types of trademarks are possible -- the key element is that the word, phrase, symbol, or design element act as a **source-identifier for goods or services**. You can think of it as very similar, if not identical, to the concept of branding. A trademark right is **limited**. It only applies to those goods or services actually identified with the trademark. A valid trademark entitles the trademark owner to stop others from selling similar goods or services using the trademark or confusingly similar trademarks; it does not entitle a

trademark owner to completely lock up a word, phrase, or image and remove it from society's common vocabulary.

Common examples of trademarks include the word "Kodak" for cameras and the familiar Apple logo for computers, music-downloading services, iPhones (another trademark), and iPods (yet another). Other examples include the Nike "swoosh" for sneakers, the "golden arches" for fast food, the Starbucks mermaid for coffee, and slogans like "There are some things money can't buy -- for everything else there's MasterCard" and "Priceless" for credit-card services. A good example of trade dress is the the particular shape of a Coca-Cola glass soda bottle. On the Internet, trademark protection may apply to domain names, websites names, website logos, and the "total image" of a website, among other things. Again, the essential ingredient for trademark protection is that the name, phrase, symbol, or whatever serve to identify the source of a good or service. Some common Internet trademarks include the word "gmail" and domain "gmail.com" for email services, the domain "nytimes.com" for online news, the name "TechCrunch" for electronic publishing services, and the name "eBay" and its familiar logo for online auction services. In addition, website operators can protect the overall "look" of their websites as trade dress, if they can establish that consumers uniquely associate that "look" with their goods or services.

Not all words, phrases, symbols, and the like can serve as a trademark, however. The primary requirement for a valid trademark is that the mark be **distinctive**. For details on what kinds of words and phrases qualify as distinctive, see [Naming Your Business: Choosing A Name Capable of Trademark Protection](#). Although the discussion focuses on names, the same points apply to other types of trademarks like symbols, words, and slogans.

For more information on registering and acquiring ownership of a trademark, please see the [Trademark Ownership](#) section.

## Trademark Infringement and Dilution

Trademark law gives trademark owners the ability to bring a lawsuit for **trademark infringement** and **trademark dilution**. These two distinct legal claims are discussed below. Trademark law also creates a legal claim for cybersquatting, which is discussed separately in the [Cybersquatting](#) section of this guide.

### Trademark Infringement

An owner of a valid trademark may sue an individual or company for trademark infringement when that individual or company uses an identical or confusingly similar mark in connection with goods or services. The [Lanham Act](#) contains two statutory provisions authorizing an infringement lawsuit. [15 U.S.C. § 1114](#) gives the owner of a registered trademark the right to sue for infringement of that trademark. [15 U.S.C. § 1125\(a\)](#) gives the owner of an unregistered trademark the right to sue for infringement of that trademark. For details on how trademark ownership arises via registration and otherwise, see [Trademark Ownership](#). A trademark owner that wins a trademark infringement lawsuit can recover money [damages](#) and get an [injunction](#) barring the [defendant](#) from continuing its infringement. A court may also force a losing defendant to pay the trademark owner's attorneys' fees under "exceptional circumstances" -- basically, when the court determines that the defendant willfully or intentionally infringed the trademark.

The key to an infringement claim is a **likelihood of confusion** between the defendant's use of a mark and the trademark owner's use of its trademark. While different courts use slightly different standards to make this comparison, the factors most commonly used to determine the likelihood of confusion are as follows:

- the strength of the [plaintiff's](#) mark;
- the similarity of the plaintiff's and the defendant's goods or services;
- the similarity of the trademark used by the plaintiff and the trademark used by the defendant;
- the marketing channels used for their respective goods or services;
- the degree of care likely exercised by the purchaser of their respective goods or services;
- the defendant's intent in selecting the trademark;
- the likelihood of expansion of their respective product or service lines; and
- evidence of actual confusion.

The more similar the marks used, the more likely that consumers will be confused. In addition, confusion tends to arise when the plaintiff's and the defendant's goods or services are similar and they use similar marketing channels. The rationale is that, if the parties' goods or services are dissimilar, the ordinary consumer will not be confused about whether the goods or services come from the same source. For example, given the existence of Pepsi brand soda, someone selling soft drinks under a slightly different brand name, such as "Pipsi" or "Peps," would almost certainly lose a trademark infringement lawsuit. On the other hand, a company selling pet grooming services under the "Pipsi" or "Peps" brand name would be more likely to successfully defend against an infringement suit because ordinary consumers would probably not assume that Pepsi had moved into the pet grooming business. Needless to say, this example is a simplification of what you might see in a real case. The multi-factor test can result in complex line drawing, and it is often difficult to tell whether a certain use of a trademark will or will not infringe a trademark owner's rights. This is one of the primary reasons why trademark lawsuits are expensive to defend.

When it comes to online publishing, there are a few points to remember. First, a plaintiff cannot win an infringement lawsuit without proving that the defendant used a confusingly similar mark **in connection with the sale, offering for sale, distribution, or advertising of any goods or services**. If you operate a purely noncommercial website (i.e., you do not sell any goods or services, and you don't host advertising or solicit donations in connection with your services), then you may be able to defeat a lawsuit without even getting to the likelihood of confusion question. We discuss this issue and other possible defenses to an infringement lawsuit in the [Using the Trademarks of Others](#) section.

Second, even if you do sell advertising or solicit donations, you primarily need to worry only about trademarks used by businesses or individuals doing work that is similar to yours. Before adopting a trademark (whether a domain name, a title for your blog, a logo, or whatever), you should look around at other websites doing work similar to yours to see if they are using the same or similar trademark. When you consider whether something is "work similar to yours," take a broad view. This could be anything from a journalism site, a blog, some kind of interactive web service, something tech-y with a heavy online presence, etc. Keep in mind that there is little certainty in this area, and you will just have to do your best in making the call. **There is one important caveat. As discussed below, owners of famous trademarks can protect their trademarks with a dilution claim, even if there is no likelihood of confusion.** So you may want to avoid using famous trademarks altogether.

Third, if you use a trademark owner's trademark in the process of criticizing, commenting, or reporting on the trademark owner, its activities, or its goods or services, you will have a good argument that no reasonable consumer would be confused into thinking that the trademark owner is the source or sponsor of your work. Take news reporting, it stretches credulity to imagine that consumers get confused about source or sponsorship when the *New York Times* reports on Wal-Mart's most recent earnings release or Ford's new hybrid car. The lack of confusion should be even more clear when it comes to criticism. For example, in [Lamparello v. Falwell](#), 420 F.3d 309 (4th Cir. 2005), the United States Court of Appeals held that there was no likelihood of confusion between a website criticizing the religious and social views of Reverend Jerry Falwell and the Reverend's own services, even when the website made use of the domain name "www.fallwell.com." The court noted, in relevant part: "After even a quick glance at the content of the website at [www.fallwell.com](#), no one seeking Reverend Falwell's guidance would be misled by the domain name-www.fallwell.com-into believing Reverend Falwell authorized the content of that website. No one would believe that Reverend Falwell sponsored a site criticizing himself, his positions, and his interpretations of the Bible."

### **Trademark Dilution**

An owner of a famous trademark may sue an individual or company for trademark dilution when that company or individual uses its trademark in connection with goods or services in a way that is likely to dilute it. See [15 U.S.C. § 1125\(c\)](#). A trademark owner that wins a trademark dilution lawsuit can get an injunction barring the defendant from continuing its dilution, and in rare circumstances it can obtain money damages and attorneys' fees. To make out its case, the trademark owner need not show that the defendant's use of its trademark causes a likelihood of consumer confusion. The parties to the lawsuit need not be in competition, and the goods or services in question need not be similar. Importantly, the trademark in question must be "famous," which means pretty much what it sounds like. If an ordinary person would recognize a trademark as a household name, then it probably qualifies as famous.

There are two distinct types of dilution, **blurring** and **tarnishment**. Blurring refers to the loss of uniqueness of a trademark because of an association with goods or services other than those of the



trademark owner. When Congress passed the statute, it indicated that the law would apply to the sale or advertisement of goods like hypothetical "Kodak Pianos," "Buick Aspirin," and "Dupont Shoes." Note that blurring can occur even if no reasonable consumer would believe that Kodak had started making pianos or that Buick had started making aspirin. Blurring is an extremely expansive concept -- it could encompass almost any unauthorized use of a famous trademark, so long as the defendant used the mark to identify its own goods or services, rather than to engage in commentary, criticism, news reporting, and like activities. Tarnishment occurs when the defendant's use of the famous trademark harms its image in the minds of consumers, such as by associating it with immoral or scandalous goods or services. For example, the lingerie seller Victoria's Secret sued a sex shop called "Victor's Little Secret" for tarnishing its famous trademark.

Because of the potential breadth of trademark dilution, Congress wanted to ensure that trademark owners could not use the law to silence speech protected by the First Amendment. To this end, Congress created specific exceptions to the dilution statute for the following uses of a trademark:

- any fair use of a famous mark in connection with comparative advertising or parody, criticism, or commentary upon the famous mark owner or the goods or services of the famous mark owner;
- all forms of news reporting and news commentary; and
- any noncommercial use of a mark. See [15 U.S.C. § 1125\(c\)\(3\)](#)

These exclusions provide a good deal of protection for citizen media creators, but the courts have yet to provide exact or consistent meanings for many of these terms, such as "fair use", "news reporting," and "noncommercial use." In the most favorable cases, courts have determined that the dilution law does not apply to **any speech that does more than propose a commercial transaction**. See, e.g., [Mattel Inc. v. MCA Records](#), 296 F.2d 894, 906-07 (9th Cir. 2002); [Mattel Inc. v. Walking Mountain Prods.](#), 353 F.3d 792, 812 (9th Cir. 2003); [Smith v. Wal-Mart Stores](#), No. 1:06-cv-526-TCB, slip op., at 81-83 (N.D. Ga. Mar. 20, 2008). Under this view, you could not be held liable for using a famous mark in nearly all forms of criticism, commentary, parody, and news reporting. But not all courts have embraced this view. We take up these issues and other defenses to trademark infringement and dilution in the [Using the Trademarks of Others](#) section.

## Using the Trademarks of Others

An important question for bloggers, citizen media creators, and other online publishers is whether trademark law limits their ability to engage in reporting, commentary, criticism, and other forms of political, social, and artistic expression. There is a threat, should trademark law become too robust, that companies and other trademark holders might use it to silence commentary, criticism, and unfavorable reporting. Such a "right to control language" would offend the First Amendment and seriously undermine the quality of public debate on issues of fundamental importance. The **good news** is that courts have consistently protected the public's right to use the trademarks of others in order to engage in criticism, commentary, news reporting and other forms of noncommercial expression. As long as what you're doing is *really* commentary, criticism, or reporting (etc.), and not a surreptitious attempt to sell goods or services, or to deceptively attract customers or readers you otherwise would not have had, you should be able to defeat a trademark claim brought against you. The **bad news** is that the law relating to this intersection of trademark law and free expression is complex and confusing. Neither Congress nor the courts have developed a simple and clear rule that protects your rights to use the trademarks of others for free speech purposes; instead they've developed a complex array of defenses to trademark claims that even lawyers find difficult to untangle. This makes it hard for a defendant to get a trademark lawsuit dismissed quickly with little expense, and it leaves bloggers and citizen media creators vulnerable to intimidation through the unscrupulous use of cease-and-desist letters. (The ideas here are based on William McGeeveran's excellent article, [Four Free Speech Goals for Trademark Law](#).)

The following sections briefly explain the legal protections available to you and apply them to some of the common situations you might face in the course of your online activities.

## How Trademark Law Protects Your Right to Free Expression

As discussed in detail in [What Trademark Covers](#), the main purpose of trademark law is to avoid consumer confusion, and the fundamental question in any [trademark infringement](#) lawsuit is whether the defendant's use of a trademark creates a likelihood of confusion between the defendant's goods or services and the [plaintiff's](#). Therefore, an obvious first line of defense in any trademark infringement lawsuit is that there is **no likelihood of confusion**. As a general matter, if you are reporting on, commenting on, or criticizing a trademark owner, most ordinary consumers will not be confused about whether the company or organization is the source or sponsor of your work. You can reduce the likelihood of confusion further by avoiding a website design that looks like the trademark owner's site or resembles its product packaging, and you should never festoon your website with a company's logo (but isolated use when relevant to a discussion is OK). You might also place a disclaimer on your site saying that you are not affiliated with the company in question and providing a link to its official site, but this usually isn't necessary unless you operate a gripe site or fan site focusing on the trademark owner. (If you are just writing a post about Company X, there is no need provide a disclaimer just because you use the words "Company X.")

If someone threatens you with a lawsuit or sues you for [trademark dilution](#), then a lack of consumer confusion will not help you. Here, one obvious line of defense is to argue that there is **no likelihood of dilution**. [Federal](#) and state dilution law protects a trademark owner against the whittling away of the distinctiveness of its famous trademark by association **with other goods or services**; it does not give a trademark owner the right to shut down all unflattering speech about it. If you do not associate a famous trademark with your own goods or services, then there can be no dilution (or at least that's how your argument goes). A court might agree that, by definition, using a trademark for purely expressive purposes (e.g., criticism, commentary, reporting, parody) is not a use in connection with a good or service and thus cannot cause dilution. Your argument on this point is especially strong if you do not host advertisements on your website and do not link to other websites selling goods or services (especially to your own commercial websites). But you might win this point even if you sell advertising, so long as you use the trademark in criticism, commentary, reporting, or other purely expressive activities, and not in advertising or other promotion of your site. This argument overlaps with one of the defenses discussed below -- **noncommercial use**.

In addition to these general arguments against infringement and dilution, there are a host of other **free expression defenses** to a trademark claim. This is where the legal terrain gets complicated and the terminology gets a bit arcane. If the explanations below make your eyes glaze over, feel free to skip down to the next section, [Some Free Expression Uses of Trademarks](#), where we explain how these defenses work in practical situations. The important free expression defenses are as follows:

- **Descriptive Fair Use:** Found at [15 U.S.C. § 1115\(b\)\(4\)](#), the descriptive fair use defense protects your ability to use ordinary words to describe your own goods or services, even if those words happen to be part of someone's trademark. It also protects the use of your own name in connection with your business or other activities. In [KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.](#), 543 U.S. 111 (2004), the U.S. Supreme Court made clear that this defense applies to bar [liability](#) even if some consumer confusion results. Examples of descriptive fair use include using the term "sweet-tart" to describe a cranberry drink despite a candy company's "SweetTarts" trademark for candy; and using the domain name [samadamsformayor.com](#) despite a beer company's "Sam Adams" trademark for beer (see our [database entry](#)). In another interesting [case from our legal threats database](#), Andrew Oh-Willeke of the [Wash Park Prophet](#) blog used the expression "Mr. Trademark" to make fun of a man who files a lot of questionable trademark lawsuits. A few days later, the vice-president of a trademark search firm called "Mr. Trademark ®" wrote Oh-Willeke to complain about the blog's use of his company's trademark. Mr. Oh-Willeke correctly stood his ground, arguing that he was not using the words "Mr. Trademark" to sell goods or services, but to describe an individual unrelated to Mr. Trademark ®. Because Oh-Willeke was not referring to his own goods or services but to a third party, this case presents a slight variation on the usual case of descriptive fair use, but the underlying reason for prohibiting liability still applies.
- **Nominative Fair Use:** The nominative fair use defense protects your ability to use a trademark to refer to a trademark owner or its goods or services for purposes of reporting, commentary, criticism, and parody, as well as for comparative advertising. Courts impose three requirements on defendants who want to take advantage of the nominative fair use defense: (1) the trademark

owner, product, or service in question must not be readily identifiable without use of the trademark; (2) the defendant must use only as much of the mark as is necessary to identify the trademark owner, product, or service; and (3) the defendant must do nothing that would suggest sponsorship or endorsement by the trademark owner. This defense works against trademark infringement lawsuits. The federal dilution statute, found at 15 U.S.C. § 1125(c)(3)(A), also makes nominative fair use a complete defense to trademark dilution claims. Some examples of nominative fair use include a newspaper's use of the "New Kids on the Block" trademark to create and report on polls asking readers questions about the musical group's popularity; another newspaper's use of the trademark "Boston Marathon" in order to report on the sporting event; and a photographer's use of "Barbie" dolls in parody photographs that criticized Mattel's famous toy and the values she represents. Another example from our database is law blogger Eric Turkewitz's use of the Avis and Hertz logos in a blog post about a lawsuit involving these two companies. (Note, however, that there is some question about whether using a logo, rather than just a textual reference, would qualify as a fair use under the three-part test outlined above.)

- **News Reporting and News Commentary:** The news reporting and news commentary defense, found at 15 U.S.C. § 1125(c)(3)(B), is a complete defense to a trademark *dilution* claim. The law is not clear on what exactly qualifies as news reporting and news commentary, but one court has applied this defense to stop a dilution claim against a blogger who wrote critical commentary about a company that resells items on eBay. See BidZirk, LLC v. Smith, 2007 WL 3119445 (D.S.C. Oct. 22, 2007). There is no explicit news reporting defense to trademark *infringement* claims, but courts are likely to protect the use of a trademark in news reporting and commentary based on the nominative fair use defense and because there is no likelihood of confusion.
- **Noncommercial Use:** There are two types of noncommercial use defenses: one for trademark infringement and one for trademark dilution.
  - If someone sues you for **trademark infringement**, you can defend yourself by arguing that you did not use the trademark **"in connection with a good or service."** Unfortunately, different courts have widely different views about what qualifies as "use in connection with a good or service" on the Internet. Some courts have found that simply registering a domain and diverting consumers away from another website may constitute "use in connection with a good or service." Other courts have rejected this view, but found that hosting advertisements or linking to commercial websites is sufficient to create "use in connection with a good or service." For example, in Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005), the court held that a gripe site that hosted no advertising, did not directly link to any commercial websites, and was devoted to critical commentary was not "a use in connection with a good or service." It therefore dismissed the plaintiff's trademark infringement lawsuit against the gripe site operator. In another case, Taubman v. Webfeats, 319 F.3d 770 (6th Cir. 2003), the defendant ran a number of websites relating to a shopping mall coming to his area. On one site, he included a link to his girlfriend's shirt business, and the court held that this was sufficient for the website and its domain name to be a "use in connection with a good or service." On another site, with the domain name "taubmansucks.com," the defendant included no commercial links, and the court concluded that this website and its domain name were "purely an exhibition of Free Speech" and not a "use in connection with a good or service."
  - If someone sues you for **trademark dilution**, you can argue that your use of the famous trademark was "noncommercial." Congress created this defense, found at 15 U.S.C. § 1125(c)(3)(C), out of concern that dilution claims would impinge on the First Amendment rights of critics and commentators. Following Congress's lead, the courts have interpreted this defense broadly, holding that the term "noncommercial" applies to **any speech that does more than propose a commercial transaction**. It is easier to show that your use of a trademark fits into this category than to show that it was not "in connection with a good or service." Under this test, if you use a trademark owner's famous trademark to report on, comment on, or criticize the trademark owner or its goods or services, your use is likely "noncommercial," even if you host advertising or link to commercial sites. This defense would also likely protect you if you used a trademark owner's famous mark in a parody or other work of political or artistic expression. Note, however, that some early cases took a more restrictive view, and found that some gripe sites were "commercial"

because of advertising and links to commercial websites. While most recent cases have moved away from this view, the precise state of the law in this area is uncertain.

- **First Amendment Defenses:** Courts have recognized a number of additional "First Amendment" defenses in particular situations. For example, in Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989), the Second Circuit Court of Appeals held that a filmmaker could use Ginger Rogers' trademark (her name) in the title of a film called "Ginger and Fred," even though the film was not primarily about Rogers. The court indicated that trademark law should be applied to artistic works "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." The specific details of these defenses is beyond the scope of this guide; the point to keep in mind is that courts may act to protect your right of free expression even if what you are doing doesn't fit nicely into one of the categories above.

## Some Free Expression Uses of Trademarks

So how does all this apply in the real world? This section gives some guidance on how the free expression defenses may apply to your activities.

### News Reporting

Trademark law does not let a trademark owner exert its trademark rights to stop news reporting about it or its products or services. You see proof of this everyday on the front pages of newspapers, the homepages of news websites, and countless blogs. Mainstream reporters and non-traditional journalists routinely report on earnings announcements, job lay-offs, and accounting scandals without worrying that they are infringing or diluting the trademarks of the companies and organizations they report on. There are several legal bases for this result: there is no risk of confusion between the news source and the trademark owner; nominative fair use protects this use of the trademark owner's mark; and the federal dilution statute expressly exempts "news reporting and news commentary" from a dilution claim. See 15 U.S.C. § 1125(c)(3)(B). As noted above, one court has held that a blogger's critical commentary on a company qualified as "news reporting and news commentary." See BidZirk, LLC v. Smith, 2007 WL 3119445 (D.S.C. Oct. 22, 2007). This is just one case, however, and it remains to be seen how the courts will define "news reporting and news commentary" in the face of different kinds of new media that blur the distinction between reporter and consumer of news.

There is a wrinkle. It is a common practice for bloggers to use the **logo** of a company when they post about it. For example, TechCrunch often does. Although the practice is widespread, it is beginning to draw fire from trademark owners. As noted above, late last year a representative of Avis requested that law blogger Eric Turkewitz cease-and-desist from using its logo in a post about a lawsuit involving the company (see Turkewitz's post). The law is not entirely clear on this point. The nominative fair use defense may not apply because using the logo is not strictly necessary for describing the trademark owner or its products or services. Nevertheless, courts would probably find that use of a logo in the process of news reporting is not likely to confuse consumers. Without confusion, there is no trademark infringement. And, as noted above, there is a categorical exemption from dilution claims for news reporting. So, it looks like using logos for illustration and visual stimulation during news reporting is OK. The one possible weakness is that the logo is not necessarily relevant to the substance of the news reporting, so a court might view its use as outside the news reporting function. Still, confusion and dilution seem highly unlikely in this context.

### Commentary and Criticism

Trademark law does not permit a trademark owner to use its trademark rights to silence commentary and criticism. As with news reporting, courts recognize the important First Amendment values at stake and usually deny efforts by trademark owners to encroach on legitimate commentary and criticism. There are

several legal bases for this result: there is no risk of confusion between the commentator and the trademark owner, and nominative fair use may protect this use of the trademark owner's mark. Additionally, courts are likely to find that your use of a trademark in commentary or criticism is "not in connection with a good or service" and "noncommercial" (the argument is especially strong for the latter category). But note that some courts may find your use of a trademark for criticism and commentary to be commercial if you host advertising or link to commercial websites. In any event, to defeat a trademark dilution claim, you do not even need to show that your use is noncommercial. The federal dilution statute creates a categorical exemption for "**criticizing . . . or commenting upon the famous mark owner or the goods or services of the famous mark owner.**" 15 U.S.C. § 1125(c)(3)(A)(ii).

The issue of **logos** comes up with commentary and criticism as well. As with news reporting, using a logo to illustrate or liven up criticism or commentary is probably OK from a trademark perspective. See above for details.

## **Domain Names**

Using someone else's trademark in your domain name is a risky proposition because courts do not necessarily extend the same protections to domain names as they do to commentary, criticism, and news reporting. Early on in the development of Internet law, many cases held that websites could not use a company or organization's trademark in a confusingly similar domain name, even if the website accessible under that domain name criticized the trademark owner, and its content made clear that it was not sponsored by or affiliated with the trademark owner. The reasoning was that a critic has no free speech right to confuse Internet users into thinking that they are entering someone else's website in order to expose them to a critical message.

However, there is a new trend in the cases towards allowing "grippers" and other critics to use domain names that are nearly identical to the trademark owner's trademark, so long as the underlying website does not confuse Internet users into thinking it is affiliated with the trademark owner and it does not engage in commercial activity. For example, in Falwell v. Lamparello, 420 F.3d 309 (4th Cir. 2005), the Fourth Circuit Court of Appeals denied a trademark infringement claim based on the defendant's use of the domain name "fallwell.com" in connection with a website criticizing the social and religious views of the Reverend Jerry Falwell. The court held that it "must look not only to the allegedly infringing domain name, but also to the underlying content of the website" and concluded that, when viewed in this context, the defendant's use of the domain name created no likelihood of confusion. In TMI Inc. v. Maxwell, 368 F.3d 433 (5th Cir. 2004), the Fifth Circuit Court of Appeals denied a trademark dilution claim based on the defendant's use of a developer's trademarked name in her gripe site's domain name. The court determined that the defendant's site was noncommercial because it was dedicated to critical consumer commentary and did not host advertising or links to commercial sites. The court did not treat the domain name as separate from the underlying website, and so it dismissed the entire dilution claim.

It is still not clear which view of the law will prevail. One way to help yourself avoid trademark liability is to include something in the domain name itself that makes it clear that you are criticizing or commenting on the trademark owner, such as a "sucks" designation. This brings the domain name back within the category of commentary and criticism and makes your First Amendment arguments more persuasive. For example, in Taubman v. Webfeats, 319 F.3d 770 (6th Cir. 2003), the court held that the defendant's use of the domain name "taubmansucks.com" was "purely an exhibition of Free Speech, and [federal trademark law] is not invoked." Similarly, in Bally Total Fitness Holding Corporation v. Faber, 29 F. Supp.2d 1161 (C.D. Cal. 1998), the court held that the defendant's use of "ballysucks" in a sub-domain for a website engaging in critical commentary did not constitute trademark infringement or dilution.

Domain name disputes often involve cybersquatting claims under the Anticybersquatting Consumer Protection Act. For details, see the Cybersquatting section.

## **Gripe Sites and Fan Sites**

The two sections immediately above outline most of the legal issues related to running a gripe site. Your use of a trademark owner's trademark in commentary and criticism on the website itself is largely protected because there is little likelihood of confusion, because use of the trademark may be nominative fair use, and because there is a statutory exemption from dilution claims for "criticizing . . . or commenting upon the famous mark owner or the goods or services of the famous mark owner." You can help your case by including

a prominent disclaimer on your website, making clear that your site is not "official" and providing a link to the trademark owner's site. Such disclaimers are not foolproof, but they go a long way towards reducing consumer confusion. Use of the trademark owner's mark in a domain name is more risky, but you may reduce this risk by including some critical remark like "sucks" in the domain itself. This may make it harder for you to gain the attention of Internet users trying to find the trademark owner's official website, but this may be the price you have to pay for more security from a trademark claim. In addition, if you refrain from hosting advertising and linking to commercial websites, including the websites of companies that compete with the trademark owner, your case is even better. Gripe site cases often involve cybersquatting claims, so you will want to look at the [Cybersquatting](#) section of this guide for additional information.

The legal issues surrounding fan sites are more uncertain. In some cases, you may be able to characterize the content of your fan site as "news reporting," if what you are doing is following the activities or new products and services of the trademark owner. In that case, all the protections for news reporting discussed above would apply. Also, you may have a case that your fan site's use of the trademark owner's trademark is a nominative fair use, so long as the appearance of your site does not create confusion about whether or not you are sponsored by or affiliated with the trademark owner. Again, a prominent disclaimer making clear that your site is not "official" and providing a link to the trademark owner's site may help your case, but is not necessarily foolproof. When registering a domain name, you may want to include some term that makes clear that you are running a fan site, such as a "fans," or you may want to avoid the trademark altogether. See the [Cybersquatting](#) section for additional details on domain names. As always, if you refrain from hosting advertisements and linking to commercial websites, you have a better chance of defending against a trademark lawsuit.

Fan sites often raise other legal issues, such as [copyright](#) infringement and [right of publicity](#) claims. For additional information, consult the [copyright section](#) and our forthcoming section on [rights of publicity and misappropriation](#).

## **Parody**

Courts generally recognize that parody is entitled to First Amendment protection in a trademark infringement lawsuit, and the federal dilution statute expressly exempts parody from dilution claims. See [15 U.S.C. § 1125\(c\)\(3\)\(A\)\(ii\)](#). In addition, a number of courts have held that parodies are "noncommercial" uses exempted by the federal dilution statute. However, simply labeling your work "parody" will not be enough to defeat an otherwise legitimate claim of trademark infringement or dilution. The courts take a relatively narrow view of what qualifies as a "successful" parody. A parody must walk the fine line between evoking the original (i.e., the trademark) and making clear that it is *not* the original (i.e., it is something new commenting on or criticizing the trademark owner). Moreover, the parody must be aimed at the trademark owner or its goods or services, not at an unrelated third party or issue. In the final analysis, if your parody confuses consumers, and they believe that the trademark owner is the source or sponsor of the parody, then you may be liable for infringement or dilution.

Putting your parody in a commercial context -- like using it in an advertisement or fake advertisement, or selling merchandise like coffee mugs or t-shirts emblazoned with the parody -- may make it harder for you to defend against a trademark lawsuit. But this is not necessarily the case. For example, in *MasterCard International Inc. v. Nader 2000 Primary Committee, Inc.*, 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004), the court upheld Ralph Nader's use of MasterCard trademarks in a parody political advertisement, finding that there was no likelihood of confusion and that his use of the marks were political speech and thus "noncommercial." In another case, *Mattel Inc. v. MCA Records*, 296 F.2d 894, 906-07 (9th Cir. 2002), the Ninth Circuit Court of Appeals held that the band Aqua's use of Mattel's "Barbie" trademark in the parodic song "Barbie Girl" was protected by the First Amendment and "noncommercial," even though the band sold the song for money. The court found that Aqua's parody successfully lampooned the Barbie image and commented humorously on the cultural values the doll represents, and therefore was protected by the First Amendment. Finally, in *Smith v. Wal-Mart*, 537 F. Supp.2d 1302 (N.D. Ga. 2008), the defendant created a series of parodies using Wal-Mart's logos and slogans, in which he likened the retail giant to Al-Qaeda and the Nazis. He not only posted these parodies on his websites, but sold CafePress t-shirts and other merchandise containing the designs. The court held that the defendant's designs were successful parodies of Wal-Mart's trademarks, that there was no likelihood of confusion between his websites or goods and Wal-Mart's, and that his use of the trademark was "noncommercial," even though he sold the designs to the public on t-shirts and other merchandise.

