

**THE DARK SIDE OF THE DOT COM—  
PROTECTING TRADEMARK USE IN THE POST  
DOMAIN PATHS OF URLS: *INTERACTIVE  
PRODUCTS CORPORATION V. A2Z MOBILE OFFICE  
SOLUTIONS*, 326 F.3D 687 (6TH CIR. 2003)**

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I. INTRODUCTION

A basic purpose of trademark law is to prevent customer confusion between products or services of a same or similar nature.<sup>1</sup> With the explosive growth of the Internet over the last decade, courts have struggled to keep up with issues involving trademark protection on the Internet. These cases have largely been solved by applying legal theories used prior to the Internet,<sup>2</sup> resulting in the protection of trademarks in domain names,<sup>3</sup> use of trademarks as “metatags,”<sup>4</sup> and use of trademarks on web pages.<sup>5</sup> Although the use of trademarks in a non-trademark way<sup>6</sup> is permitted under

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<sup>1</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995) (stating “In principle, trademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s cost of shopping and making purchasing decisions’ . . . for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product . . . . It is the source—distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes.” (citations omitted)).

<sup>2</sup> Roger E. Schechter & John R. Thomas, *Intellectual Property: The Law of Copyrights, Patents and Trademarks* 788 (West 2003).

<sup>3</sup> *E.g. PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 255 (6th Cir. 2003).

<sup>4</sup> *E.g. Brookfield Commun., Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036 (9th Cir. 1999) (finding that the use of a trademark as a metatag unduly influenced search engine results and was an infringing use). “Metatags” are lines of computer code invisible to the viewer that can affect search engines such that the results move a particular web page to a higher position on the list, making it more likely that a potential customer will see that web page and use it. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 800 n. 2 (9th Cir. 2002).

<sup>5</sup> *Playboy Enters., Inc. v. Universal Tel-A-Talk, Inc.*, 1998 U.S. Dist. Lexis 17282 at \*\*15-24 (E.D. Pa. Nov. 3, 1998).

<sup>6</sup> When alleging infringement or confusion of source “it is clear that a plaintiff must show that it has actually used the designation at issue *as a trademark*, and that the defendant has also used the same or a similar designation *as a trademark* . . . . In other words, the plaintiff must establish a likelihood that the defendant’s designation will be confused with the plaintiff’s trademark, such that consumers are

the Lanham Act,<sup>7</sup> the language chosen by the Sixth Circuit in *Interactive Products Corp. v. a2z Mobile Office Solutions* seemingly creates a bright line limit to the protection of trademarks on the Internet.<sup>8</sup>

When the court in *Interactive Products Corporation* (“IPC”) refused to protect the trademark “Lap Traveler” held by Interactive Products Corporation, it refused to apply the eight factor test articulated by the Second Circuit in a prior trademark case, *Polaroid Corp. v. Polaroid Electronics Corp.*<sup>9</sup> Instead, the IPC Court found that the “dark side” of the web page address, the part after the “.com,” “[does] not typically signify [the] source” of a product or sponsor.<sup>10</sup> Thus, using a trademark in this part of a complete web page address, or Uniform Resource Locator (URL),<sup>11</sup> cannot be infringing and courts need not address this particular use in the context of the *Polaroid* factor analysis.<sup>12</sup> While the IPC decision left open the theoretical possibility for finding infringement, the language chosen by the court strongly suggests that it would never find infringement.<sup>13</sup>

This Note argues that the Sixth Circuit failed to correctly apply prior case law and common technical knowledge. This failure and misinterpretation led to the erroneous conclusion that using a trademark in the post domain path<sup>14</sup> of a URL can never indicate the source of content on

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mistakenly led to believe that the defendant’s goods are produced or sponsored by the plaintiff.” *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prod.*, 134 F.3d 749, 753-54 (6th Cir. 1998) (citations omitted).

<sup>7</sup> The Lanham Act imposes liability on “[a]ny person who, on or in connection with any goods or services . . . uses in commerce . . . any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin . . . of his or her goods, services, or commercial activities.” 15 U.S.C. § 1125(a)(1)(A) (2000).

<sup>8</sup> 326 F.3d 687, 698 (6th Cir. 2003) (hereinafter *IPC 2*).

<sup>9</sup> 287 F.2d 492, 495 (2d Cir. 1961) (espousing an eight-factor likelihood of confusion test used, with minor variations, by most courts to determine if the use of a trademark is likely to confuse consumers as to the source of a product); *See infra* note 39 for further explanation of the *Polaroid* test.

<sup>10</sup> *IPC 2*, 326 F.3d at 698.

<sup>11</sup> Every specific web page on the Internet is identified by its unique URL, which includes three parts: (a) the transfer protocol required to access the file (e.g., “http” (“Hypertext Transfer Protocol”) for files created in HTML, or “ftp” (“File Transfer Protocol”) for documents created using more traditional word processing formats, etc.); (b) the domain name; and most important (c) the path on the host computer to a particular directory and page. Rick Stout, *The World Wide Web Complete Reference* 192-96 (McGraw Hill 1996); *see also Natl. A-1 Advert. v. Network Solutions, Inc.*, 121 F. Supp. 2d 156, 174 (D.N.H. 2000); *Chatam Intl., Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 553 (S.D. Ohio 2001). For example, the URL “http://www.exte.com/products/ibmcomputers.html” includes the protocol necessary to access the site (“http://”) and the domain name or location of the host computer on the World Wide Web (“www.exte.com”). The section “/products” refers to a particular directory on that computer and, finally, “/ibmcomputers.html” refers to a particular file and web page in that directory.

<sup>12</sup> *IPC 2*, 326 F.3d at 698.

<sup>13</sup> *Id.* (stating “[I]t is unlikely that the presence of another’s trademark in a post-domain path of a URL would ever violate trademark law.” (emphasis added)).

<sup>14</sup> The post domain path of a URL consists of everything after the top level domain (“TLD”), which

the web page. Section II of this Note provides the general factual and legal background behind the *IPC* decision and addresses the technology at issue in *IPC*. Section III discusses the court's failure to address prior case law opposing its holding, the erroneous factual and technological conclusions reached by the court, and offers some possible solutions to the issues raised. Section IV concludes by summarizing the arguments.

## II. BACKGROUND

The Sixth Circuit's ruling in *IPC* is the first federal appeals court ruling directly on the use of trademarks in the post-domain path of URLs. With the number of available domain names shrinking as people and companies register their names and products, the facts and circumstances in *IPC* are likely to become more common.<sup>15</sup> This section details the facts of the *IPC* case, the procedural history of the case leading up to the Sixth Circuit's decision, and the reasoning of the Sixth Circuit's decision in *IPC*.

### A. *The Facts Leading to the Dark Side of IPC*

Mark Comeaux ("Comeaux") and Douglas Mayer ("Mayer") co-founded Interactive Products Corporation ("IPC") in 1994.<sup>16</sup> Together they developed and sold a portable computer stand called the "Lap Traveler."<sup>17</sup> IPC registered Lap Traveler as a federal trademark.<sup>18</sup> Between 1996 and 1998 the Defendant, a2z Mobile Office Solutions ("a2z"), a computer accessories retailer, sold the Lap Traveler product on one of its web pages.<sup>19</sup> In 1998, Comeaux and Mayer had a falling out and sought dissolution of IPC in Ohio state courts.<sup>20</sup> By December 1998, there was a settlement agreement whereby Comeaux would buy out Mayer for \$33,000 with IPC retaining the exclusive right to use the Lap Traveler or model designations.<sup>21</sup> The agreement allowed Mayer to sell products similar or identical to the Lap Traveler, claim that Mayer was co-inventor of the Lap

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is normally a ".com," ".org," or ".net" among others. For further explanation of the technology and terms see *supra* note 11 and *infra* note 64.

<sup>15</sup> See *infra* n. 108 (explaining how the number of viable addresses on the Internet is shrinking).

<sup>16</sup> *IPC* 2, 326 F.3d at 692.

<sup>17</sup> *Id.* at 693.

<sup>18</sup> *Id.*

<sup>19</sup> The URL address where the Lap Traveler and Mobile Desk were sold was "[http://www.]a2zsolutions.com/desks/floor/laptraveler/dkfl-lt.htm." *Id.* (emphasis added).

<sup>20</sup> *IPC* 2, 326 F.3d at 693.

<sup>21</sup> *Id.*

Traveler, and to also engage in unrestricted free competition between the former business partners.<sup>22</sup>

At the same time that Mayer and Comeaux's relationship dissolved, IPC and a2z's relationship was also strained.<sup>23</sup> In January 1999, Comeaux terminated all business relationships between IPC and a2z.<sup>24</sup> IPC also asked a2z to remove references to the Lap Traveler from a2z's website.<sup>25</sup>

After Mayer and Comeaux parted ways, Mayer started a second company, Mobile Office Enterprises ("MOE"), which developed and sold a similar stand called "The Mobile Desk."<sup>26</sup> Shortly thereafter a2z began advertising and selling Mayer's The Mobile Desk instead of the Lap Traveler.<sup>27</sup> However, a2z did not change its URL and posted the following announcement based on a copy of the agreement between Mayer and Comeaux stating:

Important Announcement about the Lap Traveler Product. The original Lap Traveler was co-developed by Doug Mayer and his ex-partner. They have split. a2z carries the redesigned and improved product – The Mobile Desk.<sup>28</sup>

In August 1999, Comeaux performed several web searches on the Internet using "laptraveler" and "lap traveler" as the keywords on various search engines.<sup>29</sup> These searches consistently produced results including a2z's portable-computer-stand web page as one of the highest results.<sup>30</sup>

### *B. Procedural History of IPC: The Road to the Dark Side*

Based on the results from these searches Comeaux and IPC filed suit against a2z and others in September, 1999.<sup>31</sup> The complaint asserted *inter alia*, that a2z's use of the trademark "The Lap Traveler" violated the Lanham Act, specifically the use constituted infringement under 15 U.S.C. § 1114(1) and false designation of origin under 15 U.S.C. § 1125.<sup>32</sup> After

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<sup>22</sup> *Id.* at 692-93.

<sup>23</sup> *Id.* at 693.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *Interactive Prods. Corp. v. a2z Mobile Off. Solutions*, 195 F. Supp. 2d 1024, 1034 (S.D. Ohio

discovery ended, a2z moved for and was granted summary judgment on all counts.<sup>33</sup> Summary judgment was awarded on grounds that the use of the Lap Traveler trademark in the post domain path of the URL did not signify the source of the product.<sup>34</sup> Additionally, the district court also stated that applying the *Polaroid* eight factor analysis resulted in a finding that consumers would not likely be confused by the alleged infringing use.<sup>35</sup> IPC appealed only the infringement and false designation of origin claims.<sup>36</sup>

### C. The Sixth Circuit's Decision to Stay on the Dark Side in IPC

Affirming the lower court's ultimate ruling, the Sixth Circuit found there was no need to address the likelihood of confusion because the post-domain path of a URL does not "typically signify source."<sup>37</sup> As a result, the court found it "unlikely" that the use of a trademark in the post domain path of a URL would ever indicate the source of the product.<sup>38</sup> The Sixth Circuit notes that to reach the typical *Polaroid* eight factor analysis for likelihood of confusion, the trademark must be used in a source identifying manner or else "trademark infringement and false designation of origin laws do not apply."<sup>39</sup> Therefore, the lower court erred in applying the *Polaroid* eight factors to the allegedly infringing use.<sup>40</sup> The court in *IPC* relied principally on *Patmont Motor Werks v. Gateway Marine*, holding that the use of a

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2003) (hereinafter *IPC 1*), *aff'd*, 326 F.3d 687 (6th Cir. 2003).

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *IPC 2*, 326 F.3d at 690.

<sup>37</sup> *Id.* at 698.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at 695. Most courts consider a *Polaroid* eight factor analysis, or a slight variation, when determining if a likelihood of confusion exists. Schechter & Thomas, *supra* n. 2, at 640. The *Polaroid* factors are (i) the strength of the plaintiff's trademark; (ii) the degree of similarity between the parties' marks; (iii) the proximity of the products; (iv) the likelihood that the plaintiff will "bridge the gap" between the products; (v) the existence of actual confusion; (vi) the defendant's good faith; (vii) the quality of the defendant's product; and (viii) the sophistication of the consumers. 287 F.2d at 495. In the Sixth Circuit Court of Appeals, a principal case listing the eight factors a court should consider is *Frisch's Restaurant Inc. v. Elby's Big Boy of Stuebenville Inc.*, 670 F.2d 642 (6th Cir. 1982). The *Frisch's* factors are (i) the strength of the senior mark; (ii) relatedness of the goods and services; (iii) the similarity of the marks; (iv) evidence of actual confusion; (v) the marketing channels used; (vi) likely degree of purchaser care; (vii) the intent of the defendant in selecting the mark; and (viii) the likelihood of expansion of the product lines. *Id.* at 648. "These factors are not exhaustive and courts may consider some or none of them, or expand upon them." *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756 at \*85 (E.D. Mich. Nov. 19, 2003). The Sixth Circuit has also cautioned that "[e]ach case presents its own complex set of circumstances and not all of these factors may be particularly helpful in any given case." *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991).

<sup>40</sup> *IPC 2*, 326 F.3d at 698.

trademark in the post domain path of a URL can not be infringing.<sup>41</sup> The *IPC* Court echoed the *Patmont* ruling finding that since “[t]he post domain path merely shows how the website’s data is organized within the host computer’s files,” it is not acting as a source identifying trademark and its use is not infringing.<sup>42</sup>

### III. ANALYSIS

Over the last twenty years, trademark law has developed in response to the rapid growth and exploitation of the Internet by businesses and consumers. This relatively new and growing area requires courts to pay careful attention to the facts of each case and the technology used by the parties attempting to obtain protection of trademarks.<sup>43</sup> Based on its understanding, or lack of understanding, of the facts, the court in *IPC* erred in concluding that trademarks in the post domain path of a URL can never signify source.<sup>44</sup> This section discusses how the court’s analysis in *IPC* misapplies or ignores previous case law to reach its conclusion. Next, this section discusses how the court in *IPC* erred in relying on a single footnote from one case to assist in justifying its analysis, failing to properly consider all the facts and technology issues present in *IPC*.<sup>45</sup> Finally, this section discusses possible solutions to the problems raised in this Note. Through these failures, the court in *IPC* has created poor precedent which has the potential to open whole new areas of trademark “infringement” on the Internet by companies seeking to profit from the goodwill established by the original owners of trademarks.

#### A. *The Light Fades on the Dark Side: The IPC Court’s Failure to Consider Past Case Law*

A basic premise of liability under the Lanham Act<sup>46</sup> is that a

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<sup>41</sup> *Id.* at 697; *Patmont Motor Werks v. Gateway Marine*, 1997 U.S. Dist. LEXIS 20877 at \*13, n. 6 (N.D. Cal. December 17, 1997) (holding that as a matter of law the use of a trademark in the post domain path of a URL does not suggest sponsorship or endorsement).

<sup>42</sup> *IPC 2*, 326 F.3d at 696-97.

<sup>43</sup> *PACCAR*, 319 F.3d at 250 (holding that each case must be addressed on its facts).

<sup>44</sup> *IPC 2*, 326 F.3d at 698.

<sup>45</sup> *Id.*

<sup>46</sup> The Lanham Act, 15 U.S.C. § 1125(a), “covers trademark infringement as well as a host of other deceptive practices” that includes false designation of origin. *Johnson v. Jones*, 149 F.3d 494, 502 (6th Cir. 1998). False designation of origin claims have two elements: “(1) the false designation must have a substantial economic effect on interstate commerce; and (2) the false designation must create a

defendant's use of a plaintiff's trademark is likely to cause confusion among consumers regarding the "origin of goods," not the origin of the specific factory, warehouse, or web page where the goods are made, stored, or sold, respectively.<sup>47</sup> Thus, when the court in *IPC* failed to analyze a2z's use of the trademark "The Lap Traveler" under a typical *Polaroid* analysis, the *IPC* Court principally relied on the minimal analysis given by the *Patmont* court.<sup>48</sup> By holding that a2z's use of the trademarks in a URL does not signify source, it failed to properly analyze all previous case law on the subject.<sup>49</sup> Typically, the Sixth Circuit does not bar claims of initial interest confusion on the Internet.<sup>50</sup> Under the initial interest confusion doctrine,<sup>51</sup> a customer is lured into a store or to look at a web page which displays familiar trademarks. However, the customer soon learns that the products

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likelihood of confusion" that is analyzed under factors similar to those in *Polaroid* for an infringement action. *Id.* The factors for determining likelihood of confusion for a false designation of origin claim under 15 U.S.C. § 1125(a) are identical to those for a trademark infringement claim under 15 U.S.C. § 1114. Compare *id.* at 502-03 with *Daddy's Junky Music Stores v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 280 (6th Cir. 1997).

<sup>47</sup> See *infra* nn. 93-98 and accompanying text (discussing why courts should look at the "origin of goods"). In its analysis, the *IPC* Court focuses on identifying the sponsorship of a web page and not the products sold on a web page. *IPC* 2, 326 F.3d at 697-98. The *Patmont* Court's analysis also seemingly focused on the sponsorship of the web page instead of the product. 1997 U.S. Dist Lexis 20877 at \*13, n. 6. The *IPC* Court apparently mistakenly relies on the commentary in the Restatement (Third) of Unfair Competition which states that the likelihood of confusion rule:

applies to all forms of confusion [of sponsorship], including the false belief that the [prior user] of the mark has formally certified the goods as meeting particular standards . . . the false belief that the [producer or distributor] is affiliated with [the prior user] . . . or the false belief that the [producer or distributor] has [obtained] the approval of the [prior user] in manufacturing or marketing the goods.

*Restatement (Third) of Unfair Competition* § 20 cmt. d (1995).

<sup>48</sup> *IPC* 2, 326 F.3d at 698; see *infra* pt. III.A.1. for a detailed discussion of *Patmont*.

<sup>49</sup> *IPC* 2, 326 F.3d at 698.

<sup>50</sup> *PACCAR*, 319 F.3d at 253.

<sup>51</sup> Initial interest confusion is a theory of trademark infringement that occurs when a customer becomes confused as to the source of a product before a sale is made. Yelena Dunaevsky, Student Author, *Don't Confuse Metatags With Initial Interest Confusion*, 29 Fordham Urb. L.J. 1349, 1363 (2002). Under this theory the consumer will discover his initial confusion about the source of a product before a sale, but instead of correcting his mistake and purchasing the product he initially wanted, the customer will proceed to purchase the secondary product he initially mistook for the original. Most courts agree that when a vendor intentionally diverts consumer attention from his competitor by using the competitor's trademark, or something that may be confused for the competitor's trademark, the vendor benefits unjustly from the competitor's goodwill and can be accused of trademark infringement under the Lanham Act. "In the context of the Internet, 'the concern is that potential consumers of one website (website 1) will be diverted and distracted to a competing website (website 2).'" *Id.* The harm comes from the fact that potential consumers may believe that website 2 is associated with website 1 and will be too lazy to resume their search for website 1. Alternatively, if they do not believe that there is any association between websites 1 and 2, they may still choose to remain on website 2 because its information may simply be appealing enough for them to abandon their initial search. In either situation, the result is the diversion of potential consumers from their original search. See *generally id.* (footnotes omitted).

being sold are not of the brand names he thought were advertised. As a result, the customer may or may not purchase the items he now knows are not the name brands he originally intended to buy.<sup>52</sup> Under this doctrine, as it pertains to this case, the only confusion that matters is if the consumer sees the trademark Lap Traveler in the post domain path of the URL for the web page and then thinks the goods on that web page are associated with the maker of the Lap Traveler. The decision in *IPC* limits the reach of the initial interest confusion doctrine in the Sixth Circuit by refusing to apply it to the post domain paths of a URL.<sup>53</sup>

The principle question that a court seeks to answer in an infringement action is whether there is a likelihood of confusion between two source identifying marks.<sup>54</sup> In failing to reach this question where the marks are identical,<sup>55</sup> used by a company in competition with the trademark holder,<sup>56</sup> and the product sold is of similar design and purpose as the original trademark product,<sup>57</sup> the *IPC* Court erred by considering only two cases where neither case supported its decision with hard facts.

As the court in *IPC* noted, the issue before it was an issue of first impression among the federal appellate courts.<sup>58</sup> This section discusses the *Patmont* ruling, as well as other trademark cases the *IPC* Court should have utilized in order to provide a context in which to apply its final decision. Its failure to consider other cases and its acceptance of the opinion of the *Patmont* Court that trademarks in post domain paths do not signify source without citing further support weakens the rationale behind its holding.<sup>59</sup>

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<sup>52</sup> The theory behind the initial interest confusion doctrine is similar to a “bait and switch” scam where the customer sees a potentially high quality item with a familiar trademark on it, decides to purchase the item, but actually purchases a low quality “knockoff” or fake item that he did not originally intend to buy. *Id.*

<sup>53</sup> *IPC 2*, 326 F.3d at 698.

<sup>54</sup> Although the interstate commerce effect is necessary, a “likelihood of confusion is the essence of an unfair competition claim” under the Lanham Act. *Johnson*, 149 F.3d at 502.

<sup>55</sup> *IPC 2*, 326 F.3d at 695, n. 5 (finding that there is no “meaningful” difference between Lap Traveler and laptraveler); *Pub. Serv. Co. v. Nexus Energy Software, Inc.*, 36 F. Supp. 2d 436, 444 (D. Mass. 1999) (finding “Energy Place” and “energyplace” to be virtually identical).

<sup>56</sup> *IPC 2*, 326 F.3d at 692.

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*

<sup>59</sup> *Id.* at 698.

### 1. The Beginnings of the Dark Side: The *IPC* Court's Inappropriate Reliance on *Patmont*

The central issue the *IPC* Court<sup>60</sup> purported to address is “whether a consumer is likely to *notice* [the Plaintiff’s trademark] in the post domain path and then think that the [Defendant’s product] may be produced by the same company . . . that makes the [Plaintiff’s Product].”<sup>61</sup> The only case the court employed to address and analyze this issue prior to *IPC* was *Patmont*, where a California district court held that the post domain path of a URL does not signify the source of a web page or web site.<sup>62</sup> The *Patmont* Court reached the conclusion that the post domain path of a URL does not signify source in a footnote. However, independent of its analysis of the facts before it, the court did note that the plaintiff failed to establish facts that might cause it to reconsider the ultimate decision.<sup>63</sup>

The *Patmont* Court decided the issue on these two facts: post domain paths show how a website’s data is organized within the host computer files,<sup>64</sup> and that “[n]othing in the post[ ]domain path of a URL indicates a *website’s* source of origin.”<sup>65</sup> While the court was correct in stating that the post domain path normally does not indicate the source of a web site,<sup>66</sup> the

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<sup>60</sup> It is interesting to note that the main case the Sixth Circuit relied on in *IPC* in assessing whether the post domain path signified source, uses a test, “nominative fair use,” in its final decision that the Sixth Circuit explicitly rejected barely two months earlier in Feb. 2003. *PACCAR*, 319 F.3d at 257.

<sup>61</sup> *IPC* 2, 326 F.3d at 696 (emphasis added).

<sup>62</sup> 1997 U.S. Dist. LEXIS 20877 at \*13, n. 6. The *IPC* Court also notes that a second case, *PACCAR*, cites *Patmont* without further analysis. *IPC* 2, 326 F.3d at 696.

<sup>63</sup> 1997 U.S. Dist. LEXIS 20877 at \*13, n. 6.

<sup>64</sup> *Id.* There is a critical distinction between domain names and URLs. A domain name is only one component of a URL. Stout, *supra* n. 11 at 192-94. Normally files on the Internet are organized under directories which become part of the post domain path of a URL. *Id.* A domain name *only* describes a specific entity, such as a server or system, commonly referred to as a web site or “home page” connected to the Internet. *Id.* However, a domain name does not refer to a specific web page or any content on that page as does the post domain path of a URL. *Id.* at 195-96. The Federal Circuit recently distinguished a web site from a web page stating:

Every web page is identified by a unique Uniform Resource Locator (URL). Web pages are stored on ‘web sites’ [which are] locations on the World Wide Web comprising one or more computers, known as servers. Every web site has a home page, which is identified by a URL and is the first document users see when they first connect to the web site. Also associated with each web site is a domain name, usually part of the URL.

*Resonate Inc. v. Alteon Websystems, Inc.*, 338 F.3d 1360, 1361-62 (Fed. Cir. 2003). See *supra* n. 11 for further discussion and examples of URLs.

<sup>65</sup> 1997 U.S. Dist. LEXIS 20877 at \*13, n. 6 (relying on the same two facts cited by the *IPC* court) (emphasis added).

<sup>66</sup> Even the URLs for “home pages” of websites have a post domain path. “Web servers automatically provide a [post domain path for all URL’s entered into] a browser” if the user does not provide one. The most common name is index.html and since this “is the default name, organizations almost always name their home pages index.html . . . [t]his way you don’t have to know” the post

*Patmont* Court failed to address the issue of whether or not the use of a trademark in the post domain path can help identify the source of goods for sale on a web page.<sup>67</sup> Thus, when the *IPC* Court principally relied on the ruling and logic of *Patmont* any erroneous conclusions reached by the *Patmont* Court were also used by the *IPC* Court in reaching a similar conclusion.

Interestingly, the *Patmont* ruling conflicted with another ruling handed down just two months earlier in the same District Court. In *Playboy Enterprises v. Calvin Designer Label*,<sup>68</sup> the court filed an injunction prohibiting the use of Playboy Enterprise's Inc. ("PEI") trademark:

as Defendants' domain name, *directory name*, or other such computer address, as the name of Defendants' Web site service, in buried code or metatags on their home page or Web pages, or *in connection with the retrieval of data or information* or on other goods or services, or in connection with the advertising or promotion of their goods, services or [W]eb sites.<sup>69</sup>

The *Calvin* Court issued this injunction two months before the *Patmont* ruling, even though the only infringing use in *Calvin* was in the domain name portion of the URL.<sup>70</sup> By relying only one decision from a court with conflicting rulings issued within months of each other the *IPC* Court failed to properly consider all case law discussing this issue.<sup>71</sup>

## 2. First Light on the Dark Side: Questioning the Holdings in *Patmont* and *IPC*

*Patmont* and *Calvin* were not the only cases involving alleged confusion and infringement based, at least in part, on use of trademarks in post domain paths of URLs. In *Universal Tel-A-Talk*, a dispute arose over defendant's use of PEI's trademark "PLAYBOY" and other logos used on the web page and in the post domain path of defendant's URL.<sup>72</sup> This court found the use of the trademarks in the web page and post domain path of the URL constituted an infringing use, likely to confuse consumers as to the

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domain path of the URL to access the home page of a business or organization. Stout, *supra* n. 11, at 195-96.

<sup>67</sup> 1997 U.S. Dist. LEXIS 20877 at \*13, n. 6.

<sup>68</sup> 985 F. Supp. 1220 (S.D. Cal. 1997).

<sup>69</sup> *Id.* at 1221 (emphasis added).

<sup>70</sup> *Id.*

<sup>71</sup> *Patmont*, 1997 U.S. Dist. Lexis 20877 at \*13, n. 6; *Calvin*, 985 F. Supp. at 1220.

<sup>72</sup> 1998 U.S. Dist. Lexis 17282, at \*14. (The URL in question in *Universal Tel-A-Talk* was [http://www.adult\\_sex.com/playboy/members](http://www.adult_sex.com/playboy/members)).

source and sponsor of the website.<sup>73</sup> Specifically, it found that the defendant's use was "an effort to capitalize on [Playboy's] established reputation," and constituted infringement of plaintiff's trademark.<sup>74</sup> Although not explicitly stating that the use of the mark PLAYBOY in the post domain path was infringing, the *Universal Tel-A-Talk* Court specifically notes that the infringing mark was identical to the plaintiff's mark and enjoined the defendant's from:

using in any manner the PLAYBOY trademarks or any term or terms likely to cause confusion therewith as defendant's domain name, *directory, or other such computer address*, as the name of their Web site service, on their home page, on computer diskettes or in connection with the retrieval of data or information or on other goods or services, or in connection with the advertising or promotion thereof.<sup>75</sup>

A similar injunction was issued in *Pepper's Fine Foods, Inc. v. Pepper's Butcher Shop & Deli*.<sup>76</sup> As in *Universal Tel-A-Talk*, the court in *Pepper's Fine Foods* did not reach the explicit conclusion that the use of a trademark in the post domain path could be confusing as to source. However the court enjoined the defendants from:

directly or indirectly using Plaintiff's Marks, or any other confusingly similar mark or colorable imitation, in any manner or for any reasons, as a corporate name, [I]nternet domain, web page, uniform resource location ("URL"), fictitious name filing, trademark or service mark on supplies, printed matter, [or] electronic media.<sup>77</sup>

Another California district court case dealing with the use of a trademark in the post domain path was *Bally Total Fitness Holding Corp. v. Faber*.<sup>78</sup> In *Faber*, the defendant operated a web page under the URL "www.compupix.com/ballysucks," where he placed complaints about Bally's health club business.<sup>79</sup> The court found this use to be a non-trademark use because "[n]o reasonable consumer comparing Bally's

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<sup>73</sup> The court specifically notes that the use of the trademark in the post domain path is identical to the plaintiff's mark. *Id.* at \*\*14, 22-23.

<sup>74</sup> *Id.* at \*15.

<sup>75</sup> *Id.* at \*\*14, 22-23 (emphasis added). The wording in *Universal Tel-A-Talk* is similar to that in *Calvin*, suggesting that the court in *Universal*, simply followed *Calvin*'s lead.

<sup>76</sup> 2002 U.S. Dist. Lexis 25925 at \*\*3-4 (M.D. Fla. Nov. 1, 2002).

<sup>77</sup> *Id.* (emphasis added).

<sup>78</sup> 29 F. Supp. 2d 1161, 1162-64 (C.D. Cal. 1998).

<sup>79</sup> *Id.* (finding that since there is no possibility of confusion as to source, plaintiff's claims fail as a matter of law).

official web site with Faber's" web page would assume that Faber's page was sponsored, came from, or was connected or affiliated with the trademark owner.<sup>80</sup> It is important to note that the *Faber* Court did not address whether the use in the post domain path was sufficient without the word "sucks" to potentially confuse consumers as to source.<sup>81</sup> This case is an example of a non-trademark use that is not actionable under the Lanham Act as opposed to the use of a trademark that is actionable under the Lanham Act by the trademark holder.<sup>82</sup>

If the *IPC* Court had employed cases like *Universal Tel-A-Talk* and *Pepper's Fine Foods* in its analysis, it is likely that the court in *IPC* would have been forced, at a minimum, to distinguish these cases instead of relying heavily on the short analysis provided by *Patmont* and the *IPC* District Court's ruling.<sup>83</sup> *Universal Tel-A-Talk* and *Pepper's Fine Foods* are two cases that represent the greater number of cases that choose to enjoin all use of trademarks in the URL.<sup>84</sup>

Although the *Universal Tel-A-Talk* Court did not base its decision to enjoin the use of the trademark solely on the trademark's use in the post domain path of the URL, the court's injunction specifically covers all actions that it found to be infringing uses.<sup>85</sup> In contrast to *Universal Tel-A-Talk*, the *Pepper's Fine Foods* decision prohibits the defendants from using the disputed trademark in *any* manner in *any* URL even though this issue may not have been litigated.<sup>86</sup>

Another California case sheds doubt on the brief analysis provided in *Patmont* and *IPC*. In July 2002, the district court in *Metro Publishing, Inc. v. Surfmet, Inc.*, found that defendant's SURFMETRO mark was likely to cause confusion with plaintiff's use of the METRO and METROACTIVE

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<sup>80</sup> *Id.* at 1163-64.

<sup>81</sup> *Id.* at 1164 (finding that the attachment of the word sucks is not a minor change).

<sup>82</sup> 15 U.S.C. § 1125(a); *Compare Faber*, 29 F. Supp. 2d 1161 with *Daddy's Junky Music Stores*, 109 F.3d at 280.

<sup>83</sup> *IPC 2*, 326 F.3d at 697-98; *IPC 1*, 195 F. Supp. 2d at 1030-31 (citing *Patmont* as the only case directly addressing this issue).

<sup>84</sup> See generally *Metro Publg., Inc. v. Surfmet, Inc.*, 2002 U.S. Dist. LEXIS 26232 (N.D. Cal. July 3, 2002); 66 U.S.P.Q.2D (BNA) 1134 (N.D. Cal. 2002), *aff'd*, 2003 U.S. App. Lexis 1553 (9th Cir. Jan. 21, 2003) (affirming the district court without discussion). However, courts can choose to specifically enjoin use in only domain names. See e.g. *Scan Design of Fla., Inc. v. Scan Design Furniture, Inc.*, 2001 U.S. Dist. Lexis 7945 at \*20 (S.D. Fla. May 18, 2001).

<sup>85</sup> Instead the court based its ruling of infringement on that fact that the defendants were actually using the trademark in the text of the web page, using other logos held by PEI, and the intent of the defendants was clearly to deceive customers. *Universal Tel-A-Talk*, 1998 U.S. Dist. LEXIS 17282 at \*14.

<sup>86</sup> The court's opinion has very few details about the actual case, therefore it is difficult to tell if the parties litigated the post domain path issue or if the court simply enjoined use of the trademark *sua sponte*. *Pepper's Fine Foods*, 2002 U.S. Dist. LEXIS 25925 at \*\*3-4.

as marks.<sup>87</sup> The *Metro* Court stated in its injunction that the defendant could not use the “METRO mark as part of its domain names—‘metrosurf.com’ and ‘surfmetro.com’—[as] those domain names’ corresponding URL addresses and any other domain name or URL address are confusingly similar to the METRO or METROACTIVE marks.”<sup>88</sup> When the Ninth Circuit affirmed the injunction finding no abuse of discretion by the trial court, the court implicitly held that post domain paths of a URL address can signify source.<sup>89</sup> Therefore, in affirming *Metro*, the Ninth Circuit Court of Appeals seemingly overrules the *Patmont* holding principally relied on by the *IPC* Court.<sup>90</sup> *Universal Tel-A-Talk*, *Pepper’s Fine Food*, *Metro* and others<sup>91</sup> indicate that the use of trademarks in the post-domain path of a URL could identify the source of products or sponsorship of a web page. The *IPC* Court’s failure to distinguish the facts of *IPC* from these cases weakens the analysis provided by the court; it refused to find that the use of a trademark in the post domain path of a URL could be infringing.

### 3. The Light Fades on the Dark Side: The *IPC* Court’s Perplexing Confusion in its Decision

Previous Internet trademark decisions by the Sixth Circuit state that “[t]he touchstone of liability under [the Lanham Act] § 1114<sup>92</sup> is whether the defendant’s use of the disputed mark is likely to cause confusion among consumers regarding *the origin of the goods offered by the parties*”<sup>93</sup> and that the “[u]se of a trademark in such a way as to confuse, mislead, or deceive persons as to the manufacturer, producer or source of origin of the *product* is prohibited by [the Lanham Act] 15 U.S.C. § 1125.”<sup>94</sup> In its analysis, the *IPC* Court seems to focus on identifying the source of a web

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<sup>87</sup> 2002 U.S. Dist. LEXIS 26232 at \*\*27-28.

<sup>88</sup> *Id.* at \*30.

<sup>89</sup> *Metro Publg., Inc. v. Surfmet, Inc.*, 2003 U.S. App. LEXIS 1553 (9th Cir. Cal. Jan. 21, 2003) (stating that abuse of discretion occurs only if the district court based its decision on either an erroneous legal standard or clearly erroneous factual findings).

<sup>90</sup> *Id.*

<sup>91</sup> See e.g. *Howard Johnson Intl., Inc. v. Craven Props. Ltd.*, 2002 U.S. Dist. LEXIS 19744 (M.D. Fla. June 12, 2002).

<sup>92</sup> Likelihood of confusion analysis for violations of § 1114 and § 1125 are identical. See *supra* note 46 and accompanying text for further discussion.

<sup>93</sup> *Daddy’s Junky Music Stores*, 109 F.3d at 280 (stating also that “when determining whether a likelihood of confusion exists, a court must examine and weigh” the *Polaroid* eight factors) (emphasis added).

<sup>94</sup> *Dolphin Seafoods, Inc. v. Zartic, Inc.*, 1983 U.S. Dist LEXIS 11132 at \*25 (N.D. Ohio Dec. 5, 1983) (citing *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405 (6th Cir. 1963)).

page and not the products sold on the web pages.<sup>95</sup> Considering the *IPC* Court closely followed the *Patmont* ruling, which misidentified the proper question for analysis, it is not surprising that the *IPC* Court also failed to identify the proper question to be addressed.<sup>96</sup>

In *ETW Corp. v. Jireh Publishing, Inc.*, the Sixth Circuit noted that not every use of a protectable trademark qualifies for protection, rather it must be proven that the trademark identifies one source of goods and distinguishes it from another source, even if consumers do not know the exact source of the goods.<sup>97</sup> In *Dastar Corp. v Twentieth Century Fox Film Corp.*, the Supreme Court defined “origin of goods” within the meaning of the Lanham Act to “refer to the producer of tangible goods that are offered for sale.”<sup>98</sup>

The *IPC* Court discusses the differences between a trademark use in a domain name and in the post-domain path of a URL.<sup>99</sup> However, it addresses the wrong question in trying to determine if there could ever be a likelihood of confusion as to the source of the *web page* based on the use of a trademark in the post domain path of a URL.<sup>100</sup> Under *Dastar*,<sup>101</sup> the more appropriate question for *IPC*’s false designation of origin claim is whether there is a likelihood of confusion as to the source of origin of the *goods or services* being offered on that web page.<sup>102</sup> In fact, the Sixth Circuit Court of Appeals stated this proposition two months earlier in *Taubman Co. v. Webfeats*.<sup>103</sup> In *Taubman*, the Sixth Circuit stated that under the Lanham Act “the only important question is whether there is a likelihood of confusion *between the parties’ goods or services* . . . it is irrelevant whether customers would be confused as to the origin of the web sites” or web

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<sup>95</sup> *IPC 2*, 326 F.3d 696-98; *Patmont*, 1997 U.S. Dist LEXIS 20877 at \*13, n.6.

<sup>96</sup> *IPC 2*, 326 F.3d at 696-98.

<sup>97</sup> 332 F.3d 915, 921 (6th Cir. 2003).

<sup>98</sup> 539 U.S. 23, 123 S. Ct. 2041, 2049 (2003). “The essence of a trademark is a designation in the form of a distinguishing name, symbol or device which is used to identify a person’s goods and distinguish them from the goods of another.” *ETW Corp.*, 332 F.3d at 921.

<sup>99</sup> *IPC 2*, 326 F.3d at 696-98.

<sup>100</sup> *Id.* The court does address the product aspect of the confusion as to source, but seemingly only as an afterthought after fully discussing the likelihood of confusion as to source of the web page without analyzing the possibility of a confusion as of source of the product. *Id.* at 698 (stating “the presence of “laptraveler” in the post-domain path of a2z’s portable-computer-stand web page is [not] likely to cause consumer confusion regarding the source of the web page or the source of the Mobile Desk”).

<sup>101</sup> 123 S. Ct. at 2049.

<sup>102</sup> Ironically, the Sixth Circuit stated this in the first paragraph of its analysis but failed to follow its own guideline later. *IPC 2*, 326 F.3d at 694 (stating “*IPC* must show that the presence of its trademark in the post-domain path of a2z’s portable-computer-stand web page is likely to cause confusion among consumers regarding *the origin of the goods offered by the parties*” (emphasis added)).

<sup>103</sup> 319 F.3d 770 (6th Cir. 2003).

pages.<sup>104</sup> The *IPC* Court's failure to analyze the proper question and to follow its own precedent calls into question the rationale provided by the court to justify its holding.

*B. The Failure to Address the Facts and Technology of the Dark Side in IPC*

The *IPC* Court fails to address, or errs in the analysis of, the factual and technology issues raised by *IPC*. It provides no evidence to support its analysis of typical online consumers and fails to fully identify and understand the role of the post domain path in a URL. It also fails to address the disclaimer placed on the web page and the possible effects this had on a likelihood of confusion claim under the initial interest confusion doctrine.

1. Failing to Properly Understand How Online Consumers May View the Dark Side

Web sites and pages are used by many companies to provide product information and sell products online.<sup>105</sup> Individuals use the Internet to send messages, locate information, and purchase goods.<sup>106</sup> The *IPC* Court stated that Internet users "will often begin by guessing the domain name" by typing a company or product name directly into an Internet browser.<sup>107</sup> However, as other courts have noted, "[m]ore often, users do not know the exact address and must rely on 'search engines' available on the Web to search for key words and phrases associated" with the desired web page, at least when accessing the web page for the first time.<sup>108</sup>

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<sup>104</sup> *Id.* at 776.

<sup>105</sup> *Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 493 (2d Cir. 2000); *Morrison & Foerster, LLP v. Wick*, 94 F. Supp. 2d 1125, 1126 (D. Colo. 2000).

<sup>106</sup> See Kiersten Conner-Sax & Ed Krol, *The Whole Internet, The Next Generation: A Completely New Edition of the First—and Best—User's Guide to the Internet* Chs. 3-5 (O'Reilly & Assocs. 1999).

<sup>107</sup> 326 F.3d at 691.

<sup>108</sup> *Lockheed Martin Corp. v. Network Solutions*, 985 F. Supp. 949, 952 (C.D. Cal. 1997); See also *Reno v. ACLU*, 521 U.S. 844, 852 (1997) (stating that often users do not know the exact address and must rely on search engines available on the Web to search for key words and phrases associated with the desired Web site). Users generally explore a given Web page, or move to another, by clicking a computer 'mouse' on one of the page's icons or links. Domain names have been compared to "a street address [that] tells people where they can find a particular home or business." *Chatam Intl.*, 157 F. Supp. 2d at 553. However the exponential growth of the Internet has begun to severely limit the number of possible useful domain names and this analogy may not be as useful as it once was, especially as the number of web pages on the Internet continues to grow. See generally Kevin J. Heller, Student Author, *The Young Cybersquatter's Handbook: A Comparative Analysis of the ICANN Dispute*, 2 Cardozo

The use of a search engine results in a “shotgun” approach that will find all web pages on the Internet containing the particular word or phrase a user is searching for.<sup>109</sup> The use of these engines to find web sites and web pages associated with a specific company or product becomes even more likely where the address of a web page is not easily deduced or known, such as when there are several companies trying to use the same trademark, such as “acme” or “delta.”<sup>110</sup> The current state of search engine technology and the number of web pages on the Internet often results in a list of hundreds of web pages through which the user must sort in order to find what he or she is looking for.<sup>111</sup> Companies strongly prefer that their trademarks be used as little as possible by others on the Internet so that search engine results give concise and usable results, given the possibility of a prolific number of results from the use of a search engine.<sup>112</sup>

The *IPC* Court failed to adequately address the use of a search engine by consumers in its analysis.<sup>113</sup> This is surprising because in the technology section of the opinion, the court specifically addresses how search engines

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Online J. Confl. Resol. 2 (2001) (stating that:

More domain names are being registered, and there are more registrars to do it than ever before. In fact, the Internet may be running out of space. In the most popular top level domain, <.com>, it seems that almost every recognizable word has been claimed. Whereas trademark law permits multiple parties to use the same mark for different classes of goods and services; the current organization of the Internet permits only one use of a domain name, regardless of the goods or services offered. That is, although two or more businesses can own the trademark “Acme,” only one business can operate on the Internet with the domain name “acme.com.” Such a limitation conflicts with trademark principles and hinders the use [of] the Internet by businesses.

(footnotes omitted)).

Thus, a web site encompasses all the web pages that begin with a particular domain name, just as the cite name or zip code encompasses all the street addresses within its boundaries. Therefore a more apt analogy may be that the domain name is similar to a city’s name or zip code on a letter’s address, and the post domain path is more similar to the street address representing the location of the specific information (i.e. the home or business) the user wishes to access (i.e. send the letter to). However, several courts do not seem to understand these distinctions or they confuse the terms web site and web page. *E.g. Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 266 (4th Cir. 2001) (stating “[a] domain name tells users where they can find a particular *web page*, much like a street address tells people where they can find a particular home or business.” (emphasis added)). However, a domain name merely indicates the web site’s name, and does not indicate the location of a web page. Stout, *supra* n. 11, at 192-94. The proliferation of the “country” TLD’s will likely do little to alleviate this problem as the companies with the established trademark and domain names are quickly rushing in to register their names in other countries and generic TLD’s to prevent others from obtaining them.

<sup>109</sup> See Kiersten Conner-Sax & Ed Krol, *supra* n. 106, at 412-20.

<sup>110</sup> See *IPC* 2, 326 F.3d 687; *Lockheed Martin*, 985 F. Supp. at 952 (finding that an easily deduced address is directly related to the company or product being searched for). For example, to find the web site of the IBM Corporation, a person may deduce that the web site, or home page, is www.ibm.com. But if a user were to look for Delta Carpets and deduce that the home page is at www.delta.com, they might be surprised when the browser displays the home page of Delta Airlines.

<sup>111</sup> *Sporty’s Farm*, 202 F.3d at 493.

<sup>112</sup> *Id.*

<sup>113</sup> *IPC* 2, 326 F.3d at 694-98.

are used.<sup>114</sup> The basis for the initial complaint by IPC claimed that searches for IPC's trademark, Lap Traveler, on several engines, resulted in listing a2z's web page as a potential positive hit.<sup>115</sup> Still in a footnote, the court does acknowledge the results from the use of search engines, but states that no evidence was presented by IPC as to why the search engines gave the erroneous results.<sup>116</sup> The court may be correct in stating that users are more likely to know the domain name, than a complete URL.<sup>117</sup> However, it provides no support for its implicit proposition that users are more likely to enter the domain name rather than use a search engine to locate the desired web page. Yet, researchers investigating techniques used to search the Internet have learned that when people do not know where the information sought is located they are likely to either use a search engine or browse the Internet.<sup>118</sup>

Therefore, when the *IPC* Court refused to find trademark use in the post domain path of a URL to be infringing, the court rejected any initial interest confusion claim IPC could have brought. The only basis to hold a2z liable for the use of IPC's trademark is under the initial interest confusion doctrine; given that a customer making a purchase on a2z's allegedly infringing web page would know that the product was not IPC's Lap Traveler.

## 2. Affects of the Dark Side: Failure to Understand the Role of a Post Domain Path in a URL

The *IPC* Court failed to understand the multiple functions that post domain paths serve.<sup>119</sup> Just as trademarks serve more than one function,<sup>120</sup> the post domain path of a URL can tell how data is organized on a web server and provide information about the content of those sites.<sup>121</sup> Recent

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<sup>114</sup> *Id.* at 691-92.

<sup>115</sup> *Id.* at 693. The President of IPC began the suit based on the results obtained when he performed these searches. *Id.* at 698, n. 7.

<sup>116</sup> *Id.*

<sup>117</sup> *See id.* at 697.

<sup>118</sup> Browsing is defined as the searching of the Internet by following links from one page to the next until the desired information is found. Chris Olston and Ed Chi, *Scent Trails: Integrating Browsing and Searching on the Web*, <http://www2.parc.com/istl/projects/uir/pubs/items/UIR-2003-03-Chi-ACMTCHI-ScentTrails.pdf> (accessed December 5, 2003) (proposing a way to integrate search engines and browsing). The Palo Alto Research Center has several other projects involving research on the web in progress which are viewable at <http://www2.parc.com/istl/projects/uir/publications/index.html>.

<sup>119</sup> *See Stout, supra* n. 11, at 194-98.

<sup>120</sup> *See Schechter & Thomas, supra* n. 2, at 546-49.

<sup>121</sup> *Stout, supra* n. 11, at 194-98.

decisions by the Sixth Circuit have held that a domain name can signify the source of a web site<sup>122</sup> and no two organizations can have the same domain name in combination with the top level domain.<sup>123</sup> As noted earlier, domain names have been compared to “a street address [that] tells people where they can find a particular home or business.”<sup>124</sup> Thus, the fictional URL address “http://www.exte.com/ibmcomputers.html” could be a web page selling computers and it is likely that potential consumers would think that the computers were made by IBM.

Consumers do not need to know the true source of a product; consumers are only required to know that the products being purchased come from a specific “albeit anonymous, source.”<sup>125</sup> To determine if there is a likelihood of confusion between two trademarks, courts normally apply the *Polaroid* eight factor test to determine if the alleged infringing trademark identifies the source of the infringers’ products.<sup>126</sup> However, the *IPC* Court did not reach this analysis because it determined that the defendant’s use of the trademark did not identify the source of the web page.<sup>127</sup>

Given that the available number of domain names is constantly shrinking, it makes sense for companies to start using the post domain paths as an indication of source.<sup>128</sup> This is especially true after *Dastar*, which defined the “origin of goods” to be the producer of tangible goods,<sup>129</sup> which includes distributor companies using the trademark, as a2z did in the post domain path of the URL.<sup>130</sup>

IPC’s previous business arrangement with a2z, to sell the Lap Traveler, in all probability established a2z as a distributor of this type of product.<sup>131</sup> As result, a2z built a solid customer base for the Lap Traveler.<sup>132</sup>

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<sup>122</sup> *PACCAR*, 319 F.3d at 250.

<sup>123</sup> *Chatam Intl.*, 157 F. Supp. 2d at 553. *See also supra* n. 108 (discussing domain names).

<sup>124</sup> *Virtual Works*, 238 F.3d at 266. *See supra* n. 64 for a description of the functions of domain names.

<sup>125</sup> *E.g. Comerica Inc. v. Fifth Third Bankcorp*, 282 F. Supp. 2d 557, 563 n. 6 (E.D. Mich. 2003) (stating “[t]rademarks are intended to designate a single, albeit an anonymous source”) (quoting *Key West Fragrance & Cosmetic Factory, Inc. v. The Memmen Co.*, 216 U.S.P.Q. 168, 170 (Trademark Tr. & App. Bd. 1982)).

<sup>126</sup> In the context of the Internet this is normally done under the initial interest confusion test. *See supra* nn. 51-52 for further discussion of the initial interest confusion doctrine.

<sup>127</sup> *IPC 2*, 326 F.3d at 697-98.

<sup>128</sup> *See supra* note 108 for discussion of how the number of domain names is shrinking.

<sup>129</sup> 123 S. Ct. at 2049.

<sup>130</sup> *IPC 2*, 326 F.3d at 693.

<sup>131</sup> *Id.*

<sup>132</sup> Although the complaint centered around IPC’s president searching the Internet and finding the allegedly infringing web page and URL, there was also hearsay evidence, not admitted, that at least two

Immediately after the falling out between Comeaux and Mayer, a2z began selling a competing product of the same or similar design and function called, the Mobile Desk.<sup>133</sup>

Some first time customers seeking the Lap Traveler would likely use a search engine to search for the desired product and see the URL “a2zsolutions.com/desks/floor/laptraveler/dkfl-lt.html” in the results list.<sup>134</sup> Under *Dastar* and *Polaroid* all that is required for there to be a likelihood of confusion as to source under the initial interest confusion doctrine, is that a user seeing this URL and the goods offered on the web page for sale, experience confusion as to who is the actual source of the “tangible good for purchase.”<sup>135</sup> Given that IPC is the sole owner of the Lap Traveler trademark, a2z’s selling of a different product, similar to IPC’s product, should be enough to cause confusion among reasonable consumers as to the source of the producer of the tangible goods offered on a2z’s web page, not the sponsors of the website. Consider another example involving this situation, specifically a vendor that advertises COCA-COLA™ but only stocks a generic brand. On a hot day, a thirsty customer may enter intending to buy a COCA-COLA™ product. Upon realizing that the vendor only has the generic brand, the customer may leave and no infringement occurs under initial interest confusion. However, if that customer decides it is too far to walk to the next store selling COCA-COLA™ and he purchases the generic brand, then COCA-COLA™ company will have a claim for infringement against the vendor under initial interest confusion because COCA-COLA™ lost a sale and profits to the vendor selling a generic cola product. In the same manner, if a potential IPC customer sees the Lap Traveler trademark, visits a2z’s web page, buys the Mobile Desk, knowing it is not the Lap Traveler, then IPC will have a claim against a2z for infringement under initial interest confusion.

In failing to recognize that the post domain path of a URL has the potential to signify the source of products on the web page, the *IPC* Court failed to properly analyze the effect the post domain path has on a likelihood of confusion claim under the Lanham Act.<sup>136</sup> Just as the domain name is important to signify the source of a web *site*, the post domain path of a URL can be just as important to signify *web page* source. Therefore the court in *IPC* erred in suggesting that the post domain path of a URL can

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potential customers of IPC were confused. However, IPC presented no further evidence of other customer confusion and the court found the lack of proof of customer confusion persuasive. *IPC 1*, 195 F. Supp. 2d at 1033 (finding that “unless we have been seriously misled about the size of the market for this kind of product, two customers hardly constitutes a significant portion” of the customer base).

<sup>133</sup> *IPC 2*, 326 F.3d at 692-93.

<sup>134</sup> *Id.* at 692.

<sup>135</sup> *Dastar*, 123 S. Ct. at 2049; see *Taubman Co.*, 319 F.3d at 776.

<sup>136</sup> *IPC 2*, 326 F.3d at 698.

never signify source.

### 3. The Effect of the Disclaimer on the Dark Side

A final issue the *IPC* Court neglected to analyze is the effect of the disclaimer a2z posted on the page selling the Mobile Desk.<sup>137</sup> The disclaimer placed on the web page stated:

Important announcement about the Lap Traveler Product[.] The original Lap Traveler was co-developed by Doug Mayer [and] his ex-partner. They have split. a2z carries the redesigned and improved product-The Mobile Desk.<sup>138</sup>

The district court only analyzed the disclaimer issue under a literally false standard.<sup>139</sup> *IPC* correctly did not challenge the announcement as literally false; however, the statement was challenged as misleading.<sup>140</sup> The district court found that Mayer and his ex-partner, Comeaux, designed the Lap Traveler, they did split, and a2z did carry a redesigned product called The Mobile Desk.<sup>141</sup> Therefore, the statement posted on the web page was essentially true and not literally false. However, “[l]iability under [the Lanham Act] is not restricted solely to descriptions and representations that are literally false. Relief may be granted if the actions of the defendants create a false impression.”<sup>142</sup> As a result, if a company or person makes a true statement that creates a “false impression” using another’s trademark, they may be liable for infringement.

The *IPC* Court did not address this potential issue of a2z’s liability, because *IPC* did not make the argument that the announcement contributed to the search engine hits and might be actionable under an initial interest confusion analysis.<sup>143</sup> Two months prior to the *IPC* decision, in *PACCAR Inc. v. TeleScan Technologies, L.L.C.*, the Sixth Circuit Court of Appeals

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<sup>137</sup> *Id.* at 693.

<sup>138</sup> *IPC I*, 195 F. Supp. 2d at 1032. A literally false statement occurs when the statement made is not true. “When a statement in an advertisement is literally true and yet claimed to be misleading, the plaintiff is required to demonstrate that a substantial portion of the intended audience was either deceived or tended to be deceived by the advertisement.” *Id.* at 1033.

<sup>139</sup> *Id.* at 1032-33.

<sup>140</sup> *Id.* (finding the disclaimer is not literally false in any statement of fact); *Pizza Hut Inc. v. Papa John’s Intl. Inc.*, 227 F.3d 489, 497 (5th Cir. 2000) (holding mere puffery non-actionable under the Lanham act where puffery includes a “general claim of superiority over comparable products that is so vague that it can be understood as nothing more than [an] expression of opinion”).

<sup>141</sup> *IPC I*, 195 F. Supp. 2d at 1026-29.

<sup>142</sup> *Geisel v. Poynter Prods. Inc.*, 283 F. Supp. 261, 267 (S.D.N.Y. 1968).

<sup>143</sup> *J. K. Harris & Co., L.L.C. v. Kassel*, 253 F. Supp. 2d 1120 (N.D. Cal. 2003).

held that a disclaimer “does not remedy [the] confusion caused by the use of [a trademark] in [a] domain name.”<sup>144</sup> Approximately two weeks prior to the holding in *IPC*, the Northern District of California found that using a trademark in a non-trademark manner more than what is reasonably necessary, is actionable, and can be enjoined.<sup>145</sup> *IPC* could have argued that the disclaimer *used more than reasonably necessary* the trademark Lap Traveler. The post-domain path, by itself, will not cause a search engine to place a particular web page higher on the list of results from a search.<sup>146</sup> As a result, the only likely cause of the high ranking of a2z’s web page on the search engine, and the cause of all of the potential confusion resulting from these hits, was a2z’s “overuse” of *IPC*’s trademark in a2z’s disclaimer.<sup>147</sup>

*C. Bringing Light Back to the Dark Side: Possible Solutions to the IPC Dilemma*

The Sixth Circuit Court of Appeals opinion in *IPC* is likely to reopen the doors of infringement closed by the Lanham and Anti Cyber-squatting Acts.<sup>148</sup> *IPC* allows the use of trademarks to “organize” web sites in formats that can attract consumers away from the trademark owner’s site. Allowing web page operators and businesses to circumvent the Lanham and Anti Cyber-squatting Acts will result in a lack of ability of trademark holders to protect their interests; those operators and businesses that use the trademarks to “organize” their web pages will be able to advertise these web pages and potentially attract customers away from the trademark owners, in opposition to the principles of trademark law.<sup>149</sup> The example web page previously described “<http://www.exte.com/ibmcomputers.html>” is a legal use of the trademark IBM<sup>TM</sup> under the rule set forth in *IPC*, even if the company exte.com sells computers on that web page and attracts customers away from IBM<sup>TM</sup> with lower prices or other business tactics.

As companies increasingly turn to the Internet to sell their goods to the public, the resulting searches and advertisement of specific web pages will likely increase the frequency of the situation faced in *IPC*. A possible solution is to analyze all uses of trademarks anywhere in URLs under the *Polaroid* or similar test, so long as the use of the trademark at issue has the

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<sup>144</sup> 319 F.3d at 253.

<sup>145</sup> *J. K. Harris & Co.*, 253 F. Supp. 2d at 1128-30.

<sup>146</sup> *IPC* 2, 326 F.3d at 692 n. 3.

<sup>147</sup> *Id.* at 698 n. 6.

<sup>148</sup> The Lanham Act is codified as 15 U.S.C. §§ 1051-1126 and the Anti Cyber-squatting Act is codified principally as 15 U.S.C. § 1125(d).

<sup>149</sup> *Qualitex*, 514 U.S. at 163-64.

potential to suggest the source of goods on that web page.<sup>150</sup> Under the test courts might consider the length and placement of the trademark in the URL. Placement of a trademark in a long URL, such as the one in *IPC*, may have less likelihood of confusion than a shorter example of “http://www.exte.com/ibmcomputers.html,” where the trademark of IBM<sup>TM</sup> computers is prominently placed in the URL. Under this analysis, courts may find that the use of IBM<sup>TM</sup> is infringing because it is easier to see the IBM trademark than the Lap Traveler trademark. The IBM trademark is more likely to be noticed by the customer so that the customer is enticed to visit that web page and potentially buy the non-trademark product, creating a high likelihood of confusion under the initial interest confusion doctrine.

Also courts may wish to look at the placement of the trademark within the URL. Burying the trademark in the middle of a long URL may be less likely to confuse customers than placing it at the end or right after the .com, where it is easily seen and is more likely to be acted upon, creating a higher likelihood of confusion. A final factor that courts may want to consider is whether the alleged infringing use has been advertised because the advertisement or text may contain the complete URL which users can enter into their browsers, thus they will be expecting to see the trademark product, creating a higher likelihood of confusion, as above.<sup>151</sup>

#### IV. CONCLUSION

The Sixth Circuit erred by essentially forbidding all trademark infringement claims where the trademark is used in the post domain path of a URL. The *IPC* Court erred by ruling that essentially no use of a trademark in the post domain path of a URL can infringe, by not considering past case law and misunderstanding the facts and technology behind the case.

Although the court in *IPC* may have ultimately ruled that a2z’s use of Lap Traveler in the “dark side” was not infringing use, to create a bright line rule stating that all uses of trademarks in the post domain path of a

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<sup>150</sup> If the trademark is used in the post domain path of a URL where the web page identified does not act to compete or in any other way violate the provision of the Lanham Act, then this use should be allowed. *See generally Faber*, 29 F. Supp. 2d at 1162-64 (holding that using a trademark to criticize and not compete is a legal use).

<sup>151</sup> When an entity wants readers to access a particular page for information, the complete URL, including the post domain path, is normally given, instead of just the domain name and directions to follow several links to the correct web page. *E.g. Muscarello v. U.S.*, 524 U.S. 125, 144 n. 6 (1998) (asking readers to specifically reference the “http://us.imdb.com/M/search\_quotes?for=carry” and “http://www.geocities.com/Hollywood/8915/mashquotes.html” web pages); *Thompson v. Bell*, 315 F.3d 566, 602 (6th Cir. 2003) (Clay, J., dissenting) (referencing the specific web pages “http://www.emory.edu/AAPL/org.htm” and “http://www.abfp.com/brochure.html”).

URL “do not typically” signify source is not good precedent because the number of possible domain names is shrinking daily and the use of trademarks in the post domain paths of URLs may be the only option companies have to exploit their trademarks on the Internet.