"I See What You’re Saying": Trademarked Terms and Symbols as Protected Consumer Commentary in Consumer Opinion Websites

Leslie C. Rochat*

I. INTRODUCTION

In the summer of 1999, Melinda Riddle frantically searched the Internet, looking for information about how to contact individuals ranked high within the corporate structure of U-Haul. An unsympathetic local franchisee had lost Ms. Riddle’s reservation for a moving van, and she wished to vent her frustration to a corporate representative in the hope of finding a solution to the problem. The company’s official website did not provide the desired phone numbers. However, the Internet search did turn up a wealth of information about the company and its practices—all via websites posted by consumers who had suffered a fate similar to that of Ms. Riddle. One site, calling itself the “U-Hell Web Site,” detailed, along with horror stories of flaming vans, missing reservations, and unsympathetic customer service representatives, the story of U-Haul’s attempted lawsuit against the site for its unauthorized use of the U-Haul logo and name.¹


* J.D. Candidate 2001, Seattle University School of Law; B.A., University of Colorado. Special thanks to Julie Kellogg, Patrick Santel, Robert Cumbow, Ross Farr, Todd Wyatt, and all the members of the Seattle University Law Review for their incredible work and valuable input. Thanks also to Melinda Riddle, whose unfortunate incident with U-Haul led to the idea for this Comment, and Dave Seaver, for being a friend and mentor. Finally, I would like to thank my family and Josh Boyd for their love and support.
The Internet, with its ease of accessibility and wealth of information, has become a modern symbol of the classical "marketplace of ideas." On the World Wide Web, ideas may be posted, perused, and panned by anyone who has a modem. This access to information is causing increasing worry on Wall Street and Madison Avenue as corporations watch their trademarks appear, without permission, on the home pages of thousands of computer users. Because the Internet is so accessible, individual websites can disseminate information, accurate or otherwise, to anyone interested in learning about the goods and services associated with a particular trademark. On the Internet, trademarks act as visual shorthand, instantly signifying a particular good or service. Additionally, the association of the trademark with information posted on a website creates a relationship between the company and the commentary in the mind of the viewer. Over the last decade, trademark owners have become increasingly outraged by the uncontrolled use of their marks and have started to take legal action against individuals who choose to use their marks without permission.

The initial scuffle between individuals and trademark owners broke out over the use and registration of Internet domain names. Companies tend to select domain names that incorporate their trademarks in an attempt to increase the chance that a consumer looking for information about their goods or services will find an official, authorized, corporate sponsored web page. A person looking for the website of IBM, for example, would expect to reach it by typing in the address "www.ibm.com." This domain name corresponds to the site's numeric address, allowing a user to locate the site without knowing its

---

2. The concept of the marketplace of ideas is rooted in the works of two philosophers, John Milton and Alexander Meiklejohn. The former is credited with founding the idea that no one person has a legitimate claim to the absolute truth, therefore, the pursuit of such truth requires that all perspectives be made available to the public. See JOHN MILTON, Areopagitica, in 2 COMPLETE PROSE WORKS OF JOHN MILTON 483, 561 (1959) ("And though all the winds of doctrine were let loose to play upon the earth, so Truth be in the field, we do injuriously, by licensing and prohibiting, to misdoubt her strength. Let her and falsehood grapple; who ever knew Truth put to the worse, in a free and open encounter."). Meiklejohn argues that free expression is essential to the enhancement of self-governance, but takes a less expansive position on free speech in comparison to Milton. See ALEXANDER MEIKLEJOHN, FREE SPEECH AND ITS RELATION TO SELF GOVERNMENT 25 (1948) ("What is essential is not that everyone shall speak, but that everything worth saying shall be said."). The contemporary understanding of the marketplace of ideas contains elements espoused by both philosophers—Milton's belief that all perspectives on an idea are necessary in order to discover the truth regarding that idea, and Meiklejohn's assertion that everything worth saying must be said.
numeric address.³ The assumption that a corporation will always use a trademarked name for its domain name is not always correct, however. Because Network Solutions Incorporated, the company originally responsible for the registration of domain names, did not require proof of authorization before allowing the registration of names including trademarked terms, such domain names became a point of contention almost immediately. “Cybersquatters” registered domain names that incorporated famous trademarks. These individuals hoped to force the trademark owner to pay significant amounts of money in exchange for the right to use the domain name.⁴ As corporations began to fight this practice, they became increasingly aware of the ease with which unauthorized individuals could incorporate trademarks, not only into a domain name, but into a website as well. Trademark owners began to feel threatened by this unauthorized use and rallied around trademark laws in search of relief.⁵

As trademark owners sought to control the use of their famous marks on the Internet, websites run by fans of television shows and movies quickly became targets of corporate “cease and desist” letters. In 1996, attorneys for Viacom, the parent company of Paramount Television, requested that Star Trek fans remove all copyrighted material from their websites.⁶ In a similar fashion, the FOX Network, concerned about the growing popularity of unauthorized websites for its television shows The Simpsons, Millennium, and The X-Files, started fighting with the owners of such sites over the use of logos, footage, and even the names of these shows—a battle that rages to this day.⁷ FOX, like many trademark owners, insists the issue is creative control, citing “fan” sites that have disseminated, among other things, inaccu-

³. Domain names are beneficial to users for two reasons. First, the words employed in the domain name are often easier to recall and far more intuitive than the corresponding numeric, or IP, address. For example, the web address for Seattle University School of Law is <http://www.law.seattleu.edu>. This domain name corresponds to the site’s IP address, which is 206.81.198.77. Second, while the IP address for a site can change for any number of reasons—if the site changes servers, for example—the domain name remains constant.

⁴. One of the most famous cybersquatters, Dennis Toeppen, registered thousands of domain names and extorted exorbitant amounts of money from trademark owners. He was successfully sued by Panavision and forced to pay for his misdeeds. See Panavision Int’l v. Toeppen, 141 F.3d 1316 (9th Cir. 1998).

⁵. See generally Deborah Shapley, Corporate Web Police Hunt Down E-Pirates, N.Y. TIMES, May 19, 1997, at D5. As the unauthorized use of trademarked and copyrighted material increases on the Internet, corporations have started to contract with firms specializing in tracking down such use. Firms such as Dayton, Ohio based Marketwatch “help [a corporation] detect potential infringement, dilution, tarnishment, and gerericide of trademarks” by notifying the corporation of any unauthorized use. Id.

⁶. See L.A. Lorek, ‘Cease and Desist,’ Firms Warning Private Webmasters, FL. SUN-SENTINEL, Aug. 31, 1997, at 4F.

⁷. See id.
rate information about its shows and digitally engineered nude photos of *X-Files* star Gillian Anderson. These corporate crackdowns on fan sites highlight the tension between corporations and individuals; corporations are used to enjoying a great deal of control over the depiction of their goods or services, while individual website owners are accustomed to having the liberty to post any information they choose. As a result of the actions by FOX and Viacom, angered fans have fought back, creating additional sites to chronicle their outrage.

Recently, corporate trademark owners’ increasing concern about the Internet portrayal of their goods and services has created a movement against what one search engine has dubbed “consumer opinion websites.” These sites, such as the “U-Hell” website, are generally posted by individuals who feel they have been mistreated by a company and have not been given sufficient recourse elsewhere. Sites criticizing the practices and products of K-Mart, Gateway, and Intel have been contacted by lawyers representing the trademark owners and asked to remove all trademarked names or logos from the sites. Although many simply remove the trademarked material, or the entire site, out of a fear of legal action, some web users are starting to resist. According to Esther Dyson, chairwoman of the Electronic Frontier Foundation,

> The real issue here seems to be that [the trademark owners] feel uncomfortable not having control over what they don’t own, and seeing it linked to what they do own. But they are going to have to get used to it. The difference is that in the past other people’s comments about them were not as visible or persistent.”

As individuals begin to square off against corporations by refusing to remove or alter critical websites, the legal rights of both parties will have to be more clearly defined.

---


10. Yahoo! has given them this name, and a list of such sites can be viewed at <http://dir.yahoo.com/Business_and_Economy/Consumer_Advocacy_and_Information/Consumer_Opinion/Individual_Companies>. Corporations have increasingly referred to these sites by the less flattering term “rogue sites.” Lorek, *supra* note 6. There are currently over 120 such sites accessible via Yahoo! alone. See <http://dir.yahoo.com/Business_and_Economy/Consumer_Advocacy_and_Information/Consumer_Opinion/Individual_Companies>.


12. *Id.*

13. *Id.*
II. ARTICLE SCOPE

Although all of the aforementioned actions on the part of trademark owners raise significant legal issues, this Comment is primarily concerned with the increasing frequency with which trademark owners challenge the rights of individuals to post consumer opinion websites. These sites, though seldom favorable to the trademark owner, present a type of information that often interests consumers—unsolicited, unsponsored opinions regarding a good or service. Prior to the advent of the Internet, such criticism was not nearly as accessible or as prevalent. Now, however, search engines will often pull up not only the official website for a particular good, service, or corporation, but also one or more corresponding consumer opinion sites as well. Thus, when searching for "Wal-Mart," an individual is presented with a list of several websites containing that term, including both the official website and the unauthorized site entitled "Wal-Mart Sucks."¹⁴

While companies fear the effects that this proximity of message will have on future consumers, American legal culture should not encourage the growing corporate drive to wipe such sites from the Internet. When a search pulls up both corporate-sponsored websites and consumer opinion websites, the Internet serves as a marketplace of ideas because the individual performing the search has access to a full dialog regarding the subject of his or her search, as opposed to just a single statement. This dialog benefits the potential consumer, and it may also provide corporations with valuable feedback, resulting in policy and marketing modifications that would not otherwise occur.

In this uncertain legal climate where many intellectual property issues remain unresolved, individual website owners fear that corporations have the power to wreak financial and reputational ruin upon those who cross them.¹⁵ An examination of the trademark laws, however, justifies neither this fear nor the increasing boldness of trademark owners in demanding that trademarks be pulled from a consumer opinion website. Consumers engaging in commentary must have access to trademarked terms and symbols in order to specify the subject of their commentary; trademarks are designed to symbolize a good or service, and the exploitation of this symbolic function should not be reserved for trademark owners alone.

Although there are a wide array of unresolved trademark issues with regard to the Internet, this Comment will not address disputes involving anything beyond the visible content of an individual's web-


¹⁵. See Lorek, supra note 6.
site. Domain name and meta-tag issues, though often referenced in order to demonstrate trends in analysis, are not the subjects of this inquiry. Rather, this Comment will focus on the triumvirate of claims most frequently asserted against individual web masters in the battle over the propriety of consumer commentary: trademark infringement, unfair competition, and trademark dilution. A recent court decision, Bally Total Fitness v. Faber, provides an example of the analysis a court should engage in when considering whether or not a consumer opinion website violates the rights of a trademark owner. Section III of this Comment will describe this analysis in an overview of Bally. Section IV will discuss the Lanham Act's "use in commerce" requirement, scrutinizing recent approaches to this inquiry and illustrating how a broad interpretation of "use in commerce" and the tendency of courts to treat trademarks as property harms an individual's ability to engage in a dialog about products and services. Finally, section V will demonstrate why consumer opinion websites, even if held to be subject to suit, should not be enjoined from using trademarks. An examination of the statutory requirements demonstrates that such sites do not constitute infringement, dilution, or unfair competition.

III. ONE THAT GOT IT RIGHT: BALLY TOTAL FITNESS V. FABER

In the days before the Internet, consumers unhappy with a company's goods or services had little recourse; they could either complain to the customer service department of the company, the Better Business Bureau, or their next door neighbors. Without much warning to the business community, the World Wide Web changed this dynamic. There is an old adage that advises businesses to keep their customers happy because, while a contented customer will tell just one person how pleased he was with a company, an unhappy customer will tell at least seven others how miserable his experience was. The sudden accessibility and pervasiveness of the Internet has modified the scope of this adage because those forced to suffer at the hands of poor

20. While technology changes rapidly, the law adapts to this growth at a much slower pace. This Comment stresses a position that the author believes the courts should take with regard to consumer opinion websites. However, it does not address the larger question of whether the courts are the proper body to decide this issue in the first place. One could argue that this entire debate is more appropriately resolved by the legislature, however, because it is the judicial realm that is currently being asked to address the propriety of trademark usage on the Internet, this Comment restricts its focus to the judicial application of trademark law.
customer service no longer have to confine their misery to the closest seven people—the Internet has given consumers a potential audience of millions. The ease with which a disgruntled consumer can use a company's trademarked material on a personal website has since vindicated many people; however, trademark owners are growing increasingly aware of the power of the negative press they receive on the Internet.

Due to many a website owner's lack of legal knowledge, a corporate "cease and desist" letter often has the intended effect of coercing an individual to take down a challenged website. These letters instill in a website owner the fear of losing vast sums of money, a job, or anonymity.\(^{21}\) To date, there are very few cases exploring the legal issues raised by consumer opinion websites because so few of these disputes reach the point of litigation. Recently, however, a California district court had the opportunity to determine the legal implications of a corporate challenge to a consumer's use of trademarked terms. The court ultimately held such use does not constitute trademark infringement, dilution, or unfair competition. This case is significant because it provides an excellent model for how these disputes should be resolved in the future. The *Bally* decision recognizes and reiterates the proper scope of trademark protection while respecting the value of consumer commentary.

In the summer of 1998, Bally Total Fitness Holding Corporation brought an action for trademark infringement, dilution, and unfair competition against Andrew Faber, the purveyor of a website dedicated to displaying complaints about Bally health clubs.\(^{22}\) Faber's site displayed, along with numerous complaints about the fitness club chain, Bally's stylized "B" logo with the word "sucks" boldly printed across it.\(^{23}\) It also included the disclaimer "Bally Total Fitness Complaints! Un-Authorized!"\(^{24}\) The "Bally Sucks" site was one of many that could be accessed via Faber's registered domain name. Also accessible was a mail order pornography site entitled "Images of Men," an informational website providing news about the gay community, a website featuring photographs of flowers and landscapes, and a website advertising Faber's web design services.\(^{25}\) Bally's origi-

---


23. *Id.*

24. *Id.*

25. *Id.* Each auxiliary site was gathered under the general domain name "www.compupix.com." The URL addresses for each site is as follows: Bally Sucks (visited Aug. 21, 2000) <http://www.compupix.com/ballysucks>; Images of Men (visited Aug. 21, 2000) <http://www.
nal request for a temporary restraining order against Faber, filed April 22, 1998, contained an allegation that Faber’s “Images of Men” site contained a direct link to the “Bally Sucks” page.26 In his reply, Faber stated that the link had been removed, and the court subsequently denied Bally’s request.27 Bally then filed a motion for summary judgment on its three claims in an attempt to enjoin Faber from using its name or logo anywhere on his page.28 The court denied Bally’s motion on October 20, 1998, ordering instead that Faber bring his own motion for summary judgment.29 The court granted Faber’s motion on December 21, 1998.

In reaching its decision to grant Faber’s motion for summary judgment, the court refused to engage in the increasingly popular broad approach to trademark dilution and unfair competition analysis, which tends to view trademarks as discreet property apart from the goods and services that they symbolize. The court instead applied a much narrower view of the rights granted to trademark owners, ultimately concluding Faber’s use of Bally’s marks was permissible.

Judge Pregerson began scrutinizing Bally’s trademark infringement claim by determining whether the parties had related goods, a necessary first step in determining whether or not Faber’s use of the trademarked terms created a likelihood of consumer confusion.30 In the Ninth Circuit, an eight-factor test is used to evaluate whether a likelihood of confusion exists. Under this test, a court must examine the following: (1) the strength of the mark, (2) the proximity of the goods, (3) the similarity of the marks, (4) any evidence of actual confusion, (5) the marketing channels used by both parties, (6) the degree of care likely to be used by the consumer, (7) the intent of the parties, and (8) the likelihood of expansion of the product lines.31 This test, however, applies only to “goods which, although not identical, are related in the minds of consumers.”32 This rule protects the owner of


27. Id.
28. Id.
29. Id.
30. Id. at 1163.
31. These specific factors come from AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979). “The factors courts use to determine likelihood of confusion vary among the circuits in detail and emphasis, but are generally similar.” Robert M. Newbury, Trademark Infringement Primer, in UNDERSTANDING BASIC TRADEMARK LAW at 720 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 596, 1999).
a mark against others using the mark in such a way as to imply a connection, sponsorship, affiliation or common origin between the trademark owner’s good and another product.33 Although Bally asserted its health club industry and Faber’s site were “related goods” because both used the Internet as a source to communicate with current and potential Bally members, the court found otherwise.34 The judge determined that the mere fact that both parties advertise on the Internet did not make the goods sufficiently related.35 Additionally, because Faber’s site asserted it was unauthorized and also contained the words “Bally Sucks,” Judge Pregerson concluded that “no reasonable consumer comparing Bally’s official website with Faber’s site would assume Faber’s site to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.”36

Although the court found the parties did not have related goods, it continued its analysis. It held that even if the two goods were related, under the facts of the case, traditional trademark analysis did not demonstrate that Faber’s use created a likelihood of confusion among consumers.37 Employing the Ninth Circuit’s eight-factor test, the court determined the “Bally Sucks” logo was not at all similar to the original Bally logo; the former had the word “Sucks” scrawled across the Bally logo, while the latter did not.38 Also, the judge determined that individuals searching for the official site would be skilled enough to know that Faber’s site was not affiliated with the Bally corporation.39 The court also found there was little cause to believe either party would expand its products or services into the relevant market of the other.40

Once it finished weighing the likelihood of confusion factors, the court examined Bally’s trademark dilution claim. To establish a viable dilution claim, a trademark owner must demonstrate that another is making commercial use of the established mark in interstate commerce and that the use causes dilution by lessening the capacity of the

1352, 1363 (9th Cir. 1985)). Although some circuits do not treat this as a necessary first step, most include it in their analysis when determining whether an unauthorized use of a mark will cause consumer confusion.

33. Id. at 1163.
34. Id.
35. Id.
36. Id. at 1163-64
37. Id.
38. Id. at 1164.
39. Id. at 1165.
40. Id. at 1166.
owner's mark to identify and distinguish goods and services. Bally argued that because both the "Bally Sucks" and "Images of Men" sites were accessible via the same domain name, Faber diluted the Bally mark by associating it with pornography. The court disagreed that any such tarnishment had occurred, holding that Faber's "Bally sucks" site did not constitute commercial use for purposes of the Lanham Act. "[T]he dilution statute will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not part of a commercial transaction." The court noted that Faber was not using the Bally mark to sell or promote his web design services and refused to validate Bally's assertion that any unauthorized use of another's mark on the Internet constitutes per se commercial use.

The courts have held that trademark owners may not quash unauthorized use of the mark by a person expressing a point of view. This is so even if the opinion may come in the form of a commercial setting... If the antidilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.

Judge Pregerson determined that even if Faber had engaged in commercial use of Bally's trademarks, no dilution by tarnishment occurred as a result. Faber used Bally's marks in the context of consumer commentary, expressing his opinion that Bally engaged in practices he found distasteful and unsatisfactory. The court held that Faber needed to have use of the marks in order to identify the source of the goods or services about which he was complaining. In order for Bally's assertion of tarnishment to be valid, the scope of the dilution statute would have to be broadened.

Including linked sites as grounds for finding commercial use or dilution would extend the statute far beyond its intended purpose of protecting trademark owners from uses that have the

41. Id.
42. Id.
43. Id. at 1167.
44. Id. at 1166.
45. Id. at 1167.
46. Id.
47. Id.
48. Id.
effect of lessening . . . the capacity of a famous mark to identify and distinguish good or services.\textsuperscript{49}

The court ultimately granted Faber’s motion for summary judgment, determining there was no viable claim for infringement or dilution. Because Bally relied on those two claims to establish its cause of action for unfair competition, the court ruled for Faber on that claim as well.\textsuperscript{50} In conclusion, the court noted “[t]he explosion of the Internet is not without its growing pains. It is an efficient means for businesses to disseminate information, but it also affords critics of those businesses an equally efficient means of disseminating critical commentary.”\textsuperscript{51} The court refused to apply the broad standards desired by Bally, striking an appropriate balance between the rights of a trademark owner and the rights of an individual to engage in discourse about a company’s goods and services.

\textbf{IV. CURRENT TRENDS IN “USE IN COMMERCE” ANALYSIS}

Trademark protection, unlike patent or copyright protection, is not expressly recognized in the Constitution.\textsuperscript{52} Originally rebuffed by the courts for its attempt to derive trademark protection from the constitutional acknowledgement of patent and copyright law, Congress ultimately succeeded in enacting trademark legislation under its Commerce Clause authority. This statutory source for trademark protection is commonly referred to as the Lanham Act.\textsuperscript{53} As a result of its Commerce Clause roots, federal trademark law has several commerce-based requirements. For example, a valid mark must be used in commerce as a prerequisite for registration in the Primary Register. Additionally, an infringing mark must be used in commerce before a trademark owner may bring an infringement action under federal law.

Although the \textit{Bally} court’s discussion of the Lanham Act’s use in commerce requirement is sound, the confusion surrounding its application to the Internet warrants a deeper investigation of this provision.

In order for a claim to fall under the purview of the Lanham Act, an individual must use a mark in commerce without the permission of

\textsuperscript{49} Id. at 1168.
\textsuperscript{50} Id.
\textsuperscript{51} Id.
\textsuperscript{52} ROCHELLE COOPER DREYFUSS \& ROBERTA ROSENTHAL KWALL, INTELLECTUAL PROPERTY: CASES AND MATERIALS ON TRADEMARK, COPYRIGHT AND PATENT LAW 6-7 (1996). Copyright and patent protection are derived from Article 1, Section 8 of the Constitution, which provides that Congress has the power to “promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” U.S. CONST. art. 1, § 8.
\textsuperscript{53} DREYFUSS \& KWALL, supra note 52, at 6-7.
the registrant. Infringement, for example, requires the mark to be used in commerce "in connection with the sale, distribution, or advertising of any goods or services."\textsuperscript{54} Unfair competition has a similar requirement: use in commerce that is likely to cause confusion as to the affiliation, connection or association of the user, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.\textsuperscript{55} Dilution arguably requires an even greater degree of commercial involvement than does infringement or unfair competition. The statute defines dilution as "commercial use in commerce" that causes dilution of the distinctive quality of a mark.\textsuperscript{56} Although some courts have defined the "use in commerce" and "commercial use in commerce" standards very broadly in Internet cases, such decisions could have dangerous repercussions on free speech. When dealing with consumer opinion websites, courts should follow the lead of the \textit{Bally} decision and hold that such sites do not constitute commercial use for purposes of the Lanham Act.

\textbf{A. Broad Decisions}

Some courts have articulated a very low threshold for meeting the necessary "use in commerce" requirement when dealing with unauthorized trademark use on the Internet. Two recent decisions outline such minimal requirements for Lanham Act application, that under their analysis almost any website would be subject to scrutiny under trademark law.

In \textit{Planned Parenthood Federation of America, Inc. v Bucci}, Planned Parenthood sued Bucci for Lanham Act violations allegedly resulting from his website, "www.plannedparenthood.com."\textsuperscript{57} Bucci, host of "Catholic Radio," a daily program broadcast in Syracuse, New York, established the site in order to reach individuals searching for Planned Parenthood's website. Bucci's site, which proclaimed "Welcome to the PLANNED PARENTHOOD HOME PAGE" across the top, also displayed an image of a book entitled \textit{The Cost of Abortion}, by Lawrence Roberge.\textsuperscript{58} The site contained links that allowed the viewer to read the forward and afterward of the book, Mr. Roberge's resume, and quotations from individuals endorsing \textit{The Cost of Abortion}.\textsuperscript{59} Only after scanning this information would the visitor

\begin{itemize}
\item \textsuperscript{54} 15 U.S.C. § 1114(1)(a).
\item \textsuperscript{55} 15 U.S.C. § 1125(a)(1)(A).
\item \textsuperscript{56} 15 U.S.C. § 1125(c)(1).
\item \textsuperscript{57} Planned Parenthood Fed'n of Am., Inc. v Bucci, 1997 WL 133313 (S.D.N.Y. 1997).
\item \textsuperscript{58} \textit{Id.} at *1.
\item \textsuperscript{59} \textit{Id.} at *2.
\end{itemize}
understand that the book is strongly opposed to abortion. In addition to information about the book and the author, the site also informed viewers of Mr. Roberge's availability for speaking engagements and interviews.

The court began its analysis by noting that for Planned Parenthood to bring suit under the Lanham Act, Bucci must have used its trademark to engage in some sort of commercial use. The court first determined that the "use in commerce" requirement for Lanham Act liability is merely a jurisdictional predicate, and therefore is "broad and has sweeping reach."62

The court found that Bucci was subject to suit for several reasons. First, by using the plaintiff's name in his domain name, Bucci affected the plaintiff's ability to offer services. "Thus, even assuming arguendo, that defendant's activities are not in interstate commerce for Lanham Act purposes, the effect of the activities on plaintiff's interstate commerce activities would place defendant within the reach of the Lanham Act."63 Second, the court held "the nature of the Internet indicates that establishing a typical home page on the Internet, for access to all users, would satisfy the Lanham Act's 'in commerce' requirement."64

The court next examined each claim of Planned Parenthood's cause of action and found sufficient use in commerce under all sections. Looking first at Planned Parenthood's infringement claim, the court found that Bucci's site was "in connection with the distribution or advertising of goods or services."65 By endorsing The Cost of Abortion, the court held that Bucci was advertising within the scope of the act, even though he did not actively sell the book or profit from any sales made as a result of his endorsement. Additionally, the court held that Bucci's web page was part of Catholic Radio's effort to educate Catholics about the anti-abortion movement. Thus, because Bucci often solicited funds for Catholic Radio (although not on the "Planned Parenthood" site), the court found a sufficient advertising connection between Catholic Radio and Bucci. Finally, the court held that Bucci's use of the plaintiff's mark was "in connection with the distribution of goods and services because it [was] likely to prevent some Internet users from reaching plaintiff's own Internet site."66 The court

60. Id.
61. Id.
63. Id.
64. Id.
65. Id.
66. Id.
used this same commercial use analysis to evaluate the plaintiff’s unfair competition claim, effectively holding that the actions of an individual are not independent of, and must be considered in conjunction with, that individual’s website.

The court also found the requisite commercial use under Planned Parenthood’s dilution claim, which requires a “commercial use in commerce” of another’s mark. The court held that because Bucci engaged in the promotion of The Cost of Abortion, he could be characterized as a nonprofit political activist soliciting funds for his activities. Neither trademark infringement nor dilution contains a personal profit requirement. For this reason, the court held that a defendant need not derive monetary gain from the use of another’s mark to engage in a commercial use in commerce.67 Because other courts had found that fundraising activities may bring a defendant’s activities within the scope of the Lanham Act, the court concluded Bucci’s fundraising for Catholic Radio constituted commercial activity sufficient to place any of his actions under the scrutiny of the Act.68

In addition, the court concluded that Bucci’s use was commercial because of its effect on Planned Parenthood’s ability to offer goods and services.69 The court held that not only did Bucci’s use of the trademark provide Internet users with competing and directly opposing information, but the use of the plaintiff’s mark also actually prevented users from reaching the plaintiff’s service message.70

Planned Parenthood’s extremely low use in commerce threshold was lowered even further in a subsequent decision by a New Jersey district court. In December 1997, Brodsky, a member of The Outreach Judaism Organization, posted a website located at “www.jewsforjesus.org” in an attempt to reach individuals searching for information about the plaintiff organization, Jews for Jesus.71 Jews for Jesus is an international nonprofit outreach ministry that teaches that Jesus is the “messiah of Israel and the Savior of the World.”72 Brodsky’s website, in contrast, articulated a mission statement completely contrary to that of Jews for Jesus. He designed the site to prevent individuals from learning about or accessing Jews for Jesus.73 In addition to vocalizing beliefs opposite to those of the plaintiff, the site

---

67. Id. at *5.
68. Id. at *6.
69. Id.
70. Id.
72. Id. at 288.
73. Id. at 290-91.
contained a hyperlink to the Outreach Judaism Organization, which offered audiotapes and books for sale. 74

Jews for Jesus alleged that Brodsky’s site satisfied any use in commerce requirement and was therefore subject to suit under the Lanham Act. 75 Brodsky denied this, arguing he was exempt from a dilution suit because his speech was noncommercial in nature. 76 “The exception for non-commercial use of a famous mark is intended to prevent courts from enjoining constitutionally protected speech. That is, the exclusion encompasses conduct such as parodies and consumer product reviews.” 77 The court acknowledged that noncommercial speech is not actionable under the Lanham Act, but it refused to hold that Brodsky’s site was sufficiently noncommercial to qualify for protection. 78

The court’s extremely broad reading of the use in commerce requirement yielded several justifications for its ultimate decision that “www.jewsforjesus.org” was a commercial site. The court first noted that although Brodsky’s site did not directly solicit funds from its visitors, the Outreach Judaism Organization site, accessible via a hyper-text link, did solicit funds through the sale of merchandise. 79 Thus, because Brodsky’s website contained a link to a site that was commercial in nature, the court held the commercial use requirement for the dilution action had been met. Additionally, the court stated “the conduct of the Defendant also constitutes a commercial use of the Mark and the Name of the Plaintiff Organization, because it is designed to harm the Plaintiff Organization commercially by disparaging it and preventing the Plaintiff Organization from exploiting the Mark and the Name of the Plaintiff Organization.” 80 This logic is arguably circular: commercial use for the purposes of dilution exists when a defendant engages in actions that would constitute dilution if the com-

74. Id. at 291.
75. This court only engaged in commercial use analysis under the dilution statute. The court did not engage in any “use in commerce” analysis for the infringement or unfair competition claims brought by the plaintiff.
76. Jews for Jesus, 993 F. Supp. at 307. 28 U.S.C. § 1125(c)4 states: The following shall not be actionable under this section:  
   (A) Fair use of a famous mark by another person in comparative advertising or promotion to identify the competing goods or services of the owner of a famous mark.  
   (B) Noncommercial use of a mark.  
   (C) All forms of news reporting and news commentary.
78. Id. at 308.
79. Id.
80. Id.
mercial use requirement was satisfied. Such an argument jostles uncomfortably with the policy that "[t]he non-commercial use of a domain name that impedes a trademark owner's use of that domain name does not constitute dilution because such use is excluded from Section 1125(c)." The court recognized and restated this policy but did not apply it. Instead, the court moved in an antithetical direction, holding Brodsky's use to be commercial in nature because it impeded Planned Parenthood's ability to use the mark.

Both Planned Parenthood and Jews for Jesus espouse a very broad definition of use in commerce, arguably inspired more by a desire to punish defendants engaging in unsavory tactics than by clear legal reasoning. In order to reach the desired outcome, each court refused to distinguish the actions of the individual from the trademark use in question. For example, although neither Bucci nor Brodsky solicited donations via their websites, the courts found commercial use because each man was personally affiliated with a group that solicited donations or sold products and, in the case of Jews for Jesus, because the defendant's website had a link to a commercial site. Additionally, the courts noted that both sites could dissuade individuals from using the services provided by each plaintiff, thereby having a commercial impact.

The ramifications of decisions like Planned Parenthood and Jews for Jesus are extreme in the context of the Internet. Using the logic of these cases, any individual who posts a link to a for-profit site on his home page engages in sufficient commercial use to be liable under the Lanham Act for any unauthorized logo or trademarked name displayed on his page. Additionally, if Planned Parenthood is used as a model, anyone affiliated with a group that raises funds, whether or not there is a link to the group on the disputed site, will be liable for Lanham Act claims if the individual posts a trademark on his web page without the permission of the owner. Finally, consumer opinion websites, which by their nature criticize company practices and therefore may dissuade others from using the goods or services of a trademark owner, will always be found to be sufficiently commercial for purposes of the statute. The ultimate effect of such a broad definition of commercial use is to chill commercial speech by rendering all consumer opinion websites subject to suit under the Lanham Act.

81. Id. at 307 (citing Lockheed Martin Corp. v. Network Solutions, Inc., 985 F. Supp. 949, 959 (C.D. Cal. 1997)).
B. The Modern Tendency to See Trademarks as Property

Trademarks are, in their original and traditional sense, merely a way to help a consumer affiliate a good or service with a particular producer or provider. For example, trademark protection does not adhere to the word “Dell” in an of itself; rather, the law protects the relationship between the mark and the good that the computer company provides. Those who violate the Lanham Act do not do so merely by using the product name or slogan of another. They do so by confusing consumers as to the source of a good or by lessening the capacity of a mark to identify a good.

The increasingly broad definition of use in commerce, exemplified by Planned Parenthood and Jews for Jesus, illustrates a modern tendency to treat trademarks as though they are “assets with their own intrinsic value, rather than a means to an end.”82 This trend does not necessarily further the underlying goal of trademark protection, which is to enable the public to identify a particular product as coming from a particular source.83

According to Professor Mark Lemley, “vesting trademarks with the mantle of property . . . defeats the purpose of linking trademarks to goods in the first place”84 because it does not further the underlying policy goal of trademark law and may actually result in increased consumer confusion.85 Lemley notes this trend is comprised of three parts: courts making law in response to extreme cases of trademark use by nonowners, courts treating brands as things owned in their own right, and the tendency to be “insensitive to free speech concerns in cases where trademark owners seek to restrict noncompetitive uses of the trademark.”86

Society pays for the increasing power of trademark owners through increasing restrictions on freedom of expression. In a time where trademarks themselves “form an important part of the public dialog on economic and social issues,”87 modern trademark owners have been allowed to prohibit the unauthorized use of their marks to an extent never before possible. Companies increasingly bring suit,

83. Id. at 1695.
84. Id. at 1698-99.
85. Id. at 1695. The desired end result is not an increase in trademarks, but rather a clear connection between a product and a trademark. According to Professor Lemley, we might be better off with fewer brands “clamoring for our scarce attention” and less of the artificial product differentiation that exists in a world where a variety of trademarks represent very similar products. Id.
86. Id. at 1697.
87. Id. at 1711.
not to remedy trademark violations in the traditional sense discussed above, but rather to prevent others from using a mark to discuss, satirize, or criticize the trademark owner. 88 Professor Lemley notes that "even where these cases do not succeed, the fact that they are regularly filed and litigated to judgment may have a chilling effect on speech that happens to involve trademarks." 89 Because consumer opinion websites regularly use a trademarked name or term to symbolize the product or company subject to criticism, treating trademarks as property would open all such sites to liability.

The solution to this problem is to strike a balance between the rights of trademark owners and the rights of the general public. The courts can do so by employing a "principled and vigorous" application of traditional trademark law, not by creating new legal rules and principles. 90 Thus, use in commerce, the gatekeeper of trademark law, should not be expanded to encompass the entirety of the World Wide Web. The rejection of the standards for commercial use enunciated in Planned Parenthood and Jews for Jesus is imperative if the consumer dialog regarding products and services is to survive on the Internet or in any other forum.

C. A More Realistic Approach to "Use in Commerce": A Narrow View

The Bally decision, on the narrow end of the use in commerce spectrum, is superior to the more expansive standard because, while it allows for trademark protection, the protection afforded is not at the expense of public dialog. The Bally court determined that Faber's site was not a commercial use of Bally's mark because he was not using the trademark to sell his services as a web designer or identify his goods in commerce. Rather, the site was "akin to an on-line resume." 91 Ignoring the per se use in commerce argument outlined in Planned Parenthood and urged by Jews for Jesus, the Bally court refused to find that simple Internet use, without anything more, satisfies the Lanham Act requirements. This conception of trademark rights is more clearly discussed in the case of L.L. Bean, Inc. v. Drake Publishers. 92 An examination of this court's detailed analysis demonstrates why a higher threshold is more appropriate for determining whether or not a defendant has used another's mark in commerce.

---

88. Id. at 1712.
89. Id. at 1713.
90. See id.
91. Bally, 29 F. Supp. 2d at 1167.
High Society Magazine, a monthly “erotic entertainment” magazine owned by Drake Publishers, published a two page article entitled L.L. Beam’s Back-to-School Sex Catalog, a parody of L.L. Bean’s decidedly less risqué mail order business.\textsuperscript{93} The article displayed a depiction of the L.L. Bean logo “and featured pictures of nude models in sexually explicit positions using ‘products’ that were described in a crudely humorous fashion.”\textsuperscript{94} Not at all amused by the magazine’s use of its logo, L.L. Bean sued for, among other things, trademark infringement, unfair competition, and trademark dilution.\textsuperscript{95} While a Maine district court granted L.L. Bean summary judgment on the dilution claim, the court of appeals refused to do so, finding that the magazine’s use of the plaintiff’s logo did not constitute commercial use and therefore did not constitute dilution.\textsuperscript{96}

The court noted that the antidilution statute can be invoked to regulate commercial speech, which the Supreme Court has defined as “expression related solely to the economic interests of the speaker and its audience.”\textsuperscript{97} The court properly noted, however, that any regulation of speech involves a First Amendment consideration that is not easily dismissed. While the “Constitution tolerates an incidental impact on rights of expression of commercial actors in order to prevent a defendant from unauthorizedly merchandising his products with another’s trademark,” the Constitution is offended when the antidilution statute is invoked as a basis for “enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression.”\textsuperscript{98} The court held Drake Publishers’ use of the L.L. Bean logo did not meet the threshold definition of commercial speech. Additionally, the court found that the magazine’s actions fell into a category that is traditionally recognized as beyond the scope of com-

\textsuperscript{93} Id. at 27.

\textsuperscript{94} Id.

\textsuperscript{95} Id. The plaintiff’s dilution claim was brought under a state statute, as the Federal Trademark Dilution Act had not yet been enacted. The court’s analysis is useful nonetheless, because it thoroughly discusses the appropriate balance between a trademark owner’s rights and those rights protected by the First Amendment. The scope of the Maine antidilution statute had yet to be clearly defined at the time of this appeal, thus, such a discussion was necessary in order to determine whether the district court’s injunction offended First Amendment rights. Id.

\textsuperscript{96} The district court allowed the trademark infringement and unfair competition claims to continue on to trial, noting that there were factual issues regarding consumer confusion that should be resolved by a jury. The district court found that L.L. Bean had sufficiently established its dilution claim, however, because the article tarnished the goodwill and reputation associated with its trademark. The defendant appealed from this summary judgment. Id. at 27.

\textsuperscript{97} Id. at 32 (citing Central Hudson Gas & Elec. v. Public Serv. Comm’n, 447 U.S. 557, 561 (1980)).

\textsuperscript{98} Id.
mercial use and is protected by the First Amendment—parody. The court mentioned other categories of speech that are considered non-commercial in nature, outside the purview of trademark protection, and protected by the First Amendment: editorial speech and artistic expression.

Trademark protection prohibits only injurious, unauthorized commercial use of a mark by another; these 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." The court explicitly noted trademarks are not property in the traditional sense of the word, but are only words or symbols that communicate the origin of a commercial product. Thus, trademark owners do not have sufficient interests in those words or symbols to justify an expansive prohibition on the use of trademarked terms by others.

The court's analysis leads to an important conclusion: a failure to distinguish in any meaningful way between commercial and noncommercial use could give a trademark owner the right to prohibit the use of his mark in any context it deems offensive or negative, thereby diluting the force of the First Amendment's guarantee of protection for otherwise allowable expression.

By refusing to minimize the threshold of the commercial use requirement, the court of appeals determined that Drake Publishers' magazine article did not constitute commercial use of the trademark. Although the magazine was, in itself, an article in commerce, the mark was not used to identify or promote goods or services to consumers. It did nothing more than identify L.L. Bean as the source of its parody. "The reading of [the statute] advanced by the district court would improperly expand the scope of the antidilution statute far beyond the frontiers of commerce and deep into the realm of expression."

This standard is narrower than that articulated by Planned Parenthood and Jesus for Jesus, and it therefore properly grants deference to the First Amendment when considering the scope of a trademark owner's rights. This view still allows a trademark owner significant recourse against those who use its mark without permission, but only if that use is related "solely to the economic interests of the speaker

---

99. Id. at 33.
100. Id.
101. Id. at 29.
102. Id.
103. Id.
104. Id. at 33.
105. Id.
and its audience."\textsuperscript{106} Thus, consumer opinion websites, in which an individual has no economic interest, fall outside the scope of the Lanham Act.

V. THE CAUSES OF ACTION: INFRINGEMENT, UNFAIR COMPETITION AND DILUTION

Although the \textit{Bally} court properly determined that Faber's use of Bally's mark was not a commercial use, in an attempt to provide others with direction on the issues, the court discussed each claim brought by Bally, ultimately finding each without merit. The \textit{Bally} court's decision to evaluate the plaintiff's infringement, unfair competition, and dilution claims, despite its conclusion that Faber's use was noncommercial, was an important analytical step; the judge's reasoning demonstrates that regardless of whether consumer opinion websites constitute commercial use, the trademark laws are, nonetheless, still not designed to prohibit the type of speech these sites disseminate. The court engaged in a less expansive approach to trademark law, refusing to increase the protection afforded to trademark owners at the expense of the free speech rights of others.

A. \textit{Trademark Infringement, Unfair Competition, and the Likelihood of Confusion Test}

The Lanham Act provides that when an individual uses the mark of another in commerce "in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive," the owner of the mark may sue for infringement.\textsuperscript{107} Thus, the key points of inquiry are whether the plaintiff has a valid protectable mark and whether the defendant's use of the mark creates a likelihood of confusion.\textsuperscript{108} Generally, it is not difficult for a trademark owner to demonstrate that it has a protectable mark; registration of such a mark on the Principal Register is prima facie evidence of the owner's exclusive right to the mark.\textsuperscript{109}

\textsuperscript{106} \textit{Id.} at 32.
\textsuperscript{107} 15 U.S.C. § 1114(a).
\textsuperscript{109} \textit{Id.} Other ways to prove a protectable mark include demonstrating that the owner's mark is arbitrary, suggestive, or descriptive with a secondary meaning. Arbitrary marks are words that have no ties to the goods or services they represent, such as Lucent Technologies or Apple Computers. \textit{Id.} at 2. Suggestive marks imply some characteristic or quality of the good or services, but some imagination is needed to determine the types of goods or services. \textit{Id.}
Unfair competition analysis is often performed in tandem with trademark infringement analysis because both require the plaintiff to demonstrate that the defendant's use of the trademark creates a likelihood of consumer confusion. Unfair competition results when a person uses a trademark in commerce in such a way that it is likely to "cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person." Because both unfair competition and infringement require a similar analysis, this discussion will consider the causes of action together in order to demonstrate that consumer opinion websites do not create a likelihood of consumer confusion.

A discussion regarding consumer confusion often begins with the determination of whether or not the plaintiff and the defendant have related goods. If the goods are not sufficiently related, then there is little likelihood that the defendant's use will create consumer confusion. Related goods are those products or services that a reasonable consumer would think come from the same source or would assume to be "affiliated with, connected with, or sponsored by the trademark owner." As mentioned previously, the Bally court properly determined that Faber's website was not related to Bally in the mind of the average reasonable consumer. Although the court mentioned Faber's computer design skills were not related to the health club industry, the true deciding factor was that no consumer would assume Faber's criticism of Bally was authorized or endorsed by the plaintiff. Applying this analysis to consumer opinion websites in general, those that are obviously not sponsored by the trademark owner, use vernacular such as "sucks" to describe a good or service, or carry the disclaimer that they are "unauthorized" do not have the appearance of being related to the goods or services that they criticize.

Descriptive marks identify a "characteristic quality, purpose or some other aspect of a product" and are not generally protectable "unless consumers associate it with a single source, which is called a secondary meaning." Id.


11. The Bally court treated this determination as a gatekeeper element—if relatedness was not established, then the evaluation under the Sleekcraft factors was not necessary. Other courts treat this inquiry as one of the factors for determining whether a likelihood of confusion exists.


13. Bally, 29 F. Supp. 2d at 1163 (citing 3 J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:6 at 24-13 (1997)). Courts have found the following to be related goods: Shirts and pants, Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352 (9th Cir. 1985); Beer and whiskey, Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149 (9th Cir. 1963); Locks and flashlights, Yale Elec. Corp. v. Robertson, 26 F.2d 972 (2d Cir. 1928).
Because many courts do not explicitly inquire whether or not the plaintiff and the defendant have related goods, it was a good analytical decision for the Bally court to examine all eight additional likelihood of confusion factors. These eight factors, though slightly different in each circuit, are generally consistent. An examination of these factors demonstrates that most consumer opinion websites do not create a likelihood of confusion for the purposes of the Lanham Act.

Recently, a court held that when examining the unauthorized use of trademarks on the Internet, not all of the eight factors are equally relevant in determining whether a likelihood of consumer confusion exists. "Some factors are much more important than others, and the relative importance of each individual factor will be case specific."\(^{114}\) Brookfield Communications, Inc. v. West Coast Entertainment noted that the test is pliant and that some factors will weigh more heavily than others.\(^{115}\) "We must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach."\(^{116}\) Thus, when examining whether or not a consumer opinion website causes a likelihood of confusion, some factors may not be relevant to the inquiry.

The first factor, the strength of the plaintiff's trademark, often weighs in favor of the plaintiff. If the plaintiff has registered the mark, spent considerable money and effort to advertise the mark, or has used the mark consistently over time, a court will generally find that the plaintiff has demonstrated a strong connection to the mark.

In the case of consumer opinion websites, the similarity between the marks used by the plaintiff and the defendant is a more contentious matter than the first factor. The Brookfield court noted that this is generally the case for all infringement and unfair competition disputes, stating that "the similarity of the marks will always be an important factor."\(^{117}\) When creating a consumer opinion website, defendants often mimic the plaintiff's mark as closely as possible in an attempt to make clear the subject of their criticism. This similarity is not automatically fatal to the defendant, however. For example, the Bally court determined that although the Faber site prominently displayed the plaintiff's stylized "B" logo, Faber's superimposing of the word "sucks" over the top diminished any similarity.\(^{118}\) Other opinion websites have engaged in a practice similar to Faber's (i.e. scrawling

114. Brookfield, 174 F.3d at 1054.
115. See id.
116. Id.
117. Id. at 1054.
118. Bally, 29 F. Supp. 2d at 1163.
the word "sucks" or its equivalent across the logo), thereby illustrating that the site is in no way a product of the trademark owner.

The Brookfield court noted that "looks aren't everything" when attempting to discern a likelihood of confusion, therefore, it is also important to consider the sound and meaning of the marks.119 In most cases, the consumer website will have a logo that looks somewhat similar to the plaintiff's, but the meaning will be very different because the website's criticism of the plaintiff is readily apparent. If the mark is too similar and the criticism too subtle, however, a court may find that there is sufficient similarity between the two to cause confusion. Thus, if the mark is not altered in some way, either facially or contextually, this factor may be decided in favor of the plaintiff. "The more similar the marks in terms of appearance, sound or meaning, the greater the likelihood of confusion."120

The existence of evidence of actual consumer confusion is unlikely when consumer opinion websites are at issue. In the Bally case, the plaintiff did not seek to enter any such evidence, stating that "consumer confusion is patently obvious in this case because [of] the strength of the Bally marks, combined with the obvious similarities in appearance and proximity of the marks."121 The court determined that because Faber included a disclaimer that the website was an unauthorized criticism of Bally, the reasonably prudent user would not mistake Faber's site for the official Bally website.122 Brookfield noted, however, that this factor should not be dispositive, because actual confusion is very difficult for a plaintiff to prove, therefore "difficulties in gathering evidence of actual confusion make its absence generally unnoteworthy."123

It is important to distinguish cases such as Planned Parenthood and Jews for Jesus from those involving consumer opinion websites because, in Planned Parenthood and Jews for Jesus, the defendants actually intended to confuse consumers and make them think that they had found the plaintiffs' websites. Thus, evidence that Bucci placed a banner across the top of the page that stated "WELCOME TO THE PLANNED PARENTHOOD WEBSITE" would strongly support an implication of actual confusion.

When both parties to a trademark infringement suit use the Internet as a marketing and advertising tool, the courts have recognized this as significant in increasing a likelihood of consumer confu-

119. Brookfield, 174 F.3d at 1054.
120. Id.
121. Bally, 29 F. Supp. 2d at 1164.
122. Id.
123. Brookfield, 174 F.3d at 1050.
sion. According to the Brookfield court, "In the Internet context, in particular, entering a website takes little effort—usually one click from a linked site or a search engine's list; thus, web surfers are more likely to be confused as to the ownership of a website than traditional patrons of a brick-and-mortar store."

As computer users grow savvier, however, this reasoning becomes less convincing. Although the marketing channels used by both Bally and Faber included the Internet, this did not convince the court that there would be an increase in consumer confusion regarding the origin of Faber's site. This is because consumer opinion websites do not tend to lead the viewer to believe the trademark owner is the sponsor of the site. Generally, it is clear when a trademark owner does not sponsor a site criticizing its goods or services. Many such sites tell personal horror stories about the company from a first-person account, and most employ an angry, sarcastic tone.

The next factor, the degree of care likely to be exercised by the average consumer, must take into account the average computer user's increasing familiarity with Internet search tools. Courts should note that although search engines may pull up sites belonging to both trademark owners and unaffiliated individuals when an individual initiates a search for a trademark owner's site, individual computer users are increasingly used to sifting through large volumes of information in order to find what they are looking for. In the Bally case, the plaintiff asserted "prospective users of the plaintiff's services who mistakenly access defendant's website may fail to continue to search for plaintiff's own home page, due to anger, frustration or the belief that the plaintiff's home page does not exist." The court found this argument unpersuasive, noting that Faber used the Bally mark in the context of consumer criticism rather than in the domain name and clearly stated that his site was unauthorized.

The court found that one individual's site does not significantly add to the large volume of information that the average user must sift through when performing an Internet search. "Further, the average user may want to receive all the information available on Bally," thus, to prohibit the unauthorized use of trademarks anywhere on an individual's page would prohibit the individual from communicating his message to interested consumers. The Bally decision properly notes that Internet users are becoming increasingly adept at locating the type of information they

124. Id. at 1057.
125. Bally, 29 F. Supp. 2d at 1164.
126. Id.
127. Id.
desire; additionally, the court’s decision respects the value of consumer commentary in the marketplace.

In examining a website owner’s intent in selecting and using a trademark owner’s mark, courts scrutinizing consumer opinion websites must realize that although individuals intentionally employ trademarks in their commentary, “an individual who wishes to engage in consumer commentary must have the full range of marks that the trademark owner has to identify the trademark owner as the object of the criticism.” Thus, to prevent an individual from using any trademark would endanger First Amendment rights.

Many courts do not require an element of willfulness or malice when examining intent. Mere knowledge on the part of an individual that he has used the mark of another has been sufficient to weigh this element in a trademark owner’s favor. This factor is only relevant, however, to the extent it bears on the likelihood that consumers will be confused by the alleged infringer’s use of the mark. In the context of commentary, there is little cause to believe consumers will be confused. This situation may again be contrasted with Planned Parenthood or Jesus for Jesus—cases in which the defendants sought to prevent people from visiting the plaintiffs’ websites by intentionally creating the type of confusion prohibited by trademark law.

The Bally court concluded by examining the likelihood that Faber would expand his product lines into the same area as Bally and determining there was no such likelihood. This will be the case in most consumer commentary sites, as many do not even offer services, and those that do offer services do not generally offer goods and services in competition with those of the plaintiff. This factor is arguably of little relevance in the context of consumer opinion websites.

In determining whether or not consumer opinion websites constitute actionable infringement or unfair competition, courts applying the eight factor test should find Bally’s analysis persuasive and hold that such sites do not create a likelihood of consumer confusion. Because such sites are obviously not sponsored by the trademark owner, increasingly savvy Internet users will not be confused by them or think they represent the trademark owner in any official capacity.

### B. The Federal Trademark Dilution Act (FTDA)

Dilution differs from the previous causes of action in that it does not require the plaintiff to demonstrate that another’s use of its mark

---

128. Id. at 1164 n.4.
129. Id. at 1166.
130. Brookfield, 174 F.3d at 1059.
causes a likelihood of confusion. Rather, a plaintiff need only show that another's use of its mark lessens the capacity of the famous mark to identify its goods or services. Trademark owners attempting to enjoin consumer opinion websites from using their marks generally assert that dilution has occurred via tarnishment. The threat of tarnishment arises when a plaintiff's trademark is linked to products that are of shoddy or inferior quality, conjuring associations that clash with associations generated by the owner's lawful use of the mark.

Although this cause of action seems very expansive and likely to ensnare the owner of a consumer opinion website, the language of the statute provides a measure of relief. The FTDA explicitly protects unauthorized use of a trademark in certain circumstances: fair use of another's mark in advertising, the identification of competing goods or services, noncommercial use of goods or services, and all forms of news reporting and commentary. Currently, a majority of the decisions regarding dilution have been decided in favor of the plaintiff, however, courts should not automatically translate this trend into a standard that is prohibitive of consumer opinion websites. Rather, courts should address each case in a fact specific manner, keeping in mind the spirit of the statute and its desire to protect commentary and discourse.

In support of its dilution claim, Bally asserted that because of the proximity between Faber's "Bally Sucks" site and his "Images of Men" site, Faber's website tarnished Bally's product by associating its mark with pornography. The court did not agree with Bally's broadly drawn view of the dilution statute, stating that "if the court accepted this argument, it would be an impossible task to determine dilution on the Internet. Looking beyond the "Bally Sucks" site to other sites within the domain name or to other linked sites would, to an extent, include the Internet in its entirety." The court determined that the consumer commentary itself, regardless of what it was linked to, was valuable speech protected by the First Amendment. Although Bally cited several cases in which a defendant's use of a trademark was enjoined because of the mark's unauthorized association with unsavory connotations, the court refused to find these cases sufficiently analogous to the unauthorized use of trademarks on consumer opinion websites. For example, in

134. Bally, 29 F. Supp. 2d at 1167.
Coca-Cola v. Gemini Rising, the defendant produced a poster modifying the plaintiff’s well-known catchphrase “Enjoy Coca-Cola.” The poster read “Enjoy Cocaine” and employed the plaintiff’s trademarked script. The Bally court agreed with the Coca-Cola court’s conclusion that this was the type of unsavory association that trademark protection was designed to prevent. The court refused to acknowledge, however, that such an association existed in the present matter because Faber’s speech, while negative, employed Bally’s name and logo only as a means to identify the source of the goods and services about which it was complaining.

The Bally analysis properly notes the important symbolic function that trademarks serve in consumer opinion websites. Website owners employ logos, slogans, or names in combination with original commentary to express an opinion about a good or service. Though the composite result is often negative, it is not the type of trademark use enjoined by the FTDA. Congress’ express exception of commentary from the scope of the statute evidences a legislative recognition of its importance.

IV. CONCLUSION

In an age where the Internet is increasingly used as a method of discourse, the judicial trend of treating trademarks as discrete property will, if unchecked, have frightening ramifications for individuals who use the Internet to tell others their opinions regarding goods and services. Individuals must be able to use company names and logos in order to communicate opinions to others in terms that are widely understood. Without the tools of name and logo, commentary is rendered ineffective and meaningless because it is robbed of a context.

Although several court decisions have attempted to broaden the scope of trademark protection, this trend evidences the extent to which the judicial system is out of sync with modern technology. In the absence of legislative direction, courts are increasingly being called upon to determine the fate of a technology they are unfamiliar with, without considering the far-reaching implications of their decisions. Judges must remember that consumer opinions are not actionable under the trademark law, regardless of their form or pervasiveness. Courts should not expand trademark protection beyond its statutory scope simply because they are dealing with a new medium that has the potential to reach an audience greater than any other.

Trademarks are granted limited protection, and the law should not be interpreted so as to shield owners from any and all unwanted or unsolicited criticism. Consumer opinion websites do not fall under the purview of the Lanham Act for several reasons. Primarily, these sites do not constitute commercial use, and therefore, do not meet the threshold requirement for infringement, unfair competition, or dilution actions. Additionally, these sites do not pose a likelihood of consumer confusion when analyzed under the multifactor test present in each jurisdiction, nor do they constitute dilution by tarnishment of the trademark owner's product.

Courts must not strain the parameters of trademark infringement, unfair competition, and dilution actions simply to provide a remedy in a particular case. In their zeal to incriminate defendants who engage in unsavory Internet tactics, some courts are creating precedent that is wholly inappropriate for general Internet application. Future courts called on to render decisions regarding consumer opinion sites should model their analysis after the Bally court's decision and employ its far-sighted reasoning and narrower trademark protection. Although the Internet is a rapidly growing commercial entity, courts must not forget the important discursive function it serves. If courts continue to adhere to an expansive application of trademark law, the Internet will serve as little more than a marketplace, and not as a marketplace of ideas.