

A ruse by any other name: Normalizing trademark infringement by domain name sabotage

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Recently, a prominent long-established property tax law firm, O’Keefe Lyons & Hynes, LLC, of Chicago filed a suit for trademark infringement in Chicago federal court against O’Keefe Law Firm, Ltd. of LaGrange.¹ Reprising its illustrious history, the elder firm argues in its complaint that “the term ‘O’Keefe’ is the most distinctive term in [its] name.” Most interestingly, both firms emphasize their expertise in property tax law and both firms have an actual natural-person “O’Keefe” connection; this is not simply an obvious instance of one competitor selecting a trademark/trade name for the sole purpose of creating confusion in the minds of consumers.

This is an interesting case on several levels, reminiscent of the long string of trademark battles between McDonald’s Corporation and would-be knock-off restaurant chains, pre-existing McDonalds and even dentists.² The collision of trademarks and the definition of “consumer confusion” are not new subjects.

But those are not the subjects of this article. Rather, the most interesting aspect to me is the increasingly familiar role of domain names in orchestrating that collision and confusion.

Here’s a little experiment you can try at home: take a known trademark, the more famous the better, and go to any of the scores of domain name registrars; plug in that trademark in the form of a request for a domain name. Combine it with any of the most common top-level domains [TLDs], like .org, .com, .edu, .net, etc. An interesting thing happens, with one [hilarious] exception.

For example, I went to one of those domain name registrars, GoDaddy, and “requested” the “ford.com” domain name.

I was immediately informed that “Sorry, ford.com is taken.” No surprise there. But not to worry, GoDaddy wants to help. So it suggests (“Selected just for you”) NINETEEN alternative domain names using “ford”, including ford.design, ford.site, ford.com, ford.loan, ford.racing, fords.solutions, and even ford.lawyer, perhaps anticipating that anyone who tries to cop a domain name at Ford Motor Company’s expense will need a lawyer. But if you are thinking of being that lawyer and somebody beats you to that domain name, GoDaddy suggests you go for ford.attorney instead.

Hmm. What if the trademark is not a common family name or not even a real word like “Ford”, I wondered. Well, what could be more famous and less family or real than “Xerox”? So this time I proposed to “request” the “xerox.com” domain name. Nope, no luck; GoDaddy informed me that “Sorry, xerox.com is taken.” But as before, GoDaddy was eager to help anyhow, and this time the offerings were truly surprising. GoDaddy again “Selected just for you” another 19 domain names, including xerox.review, xerox.trade, xeroxpro.com, xeroxprinter.us, xeroxprinters.us, xeroxcolor.us, xeroxprinter.org and xeroxprinters.org. Frankly, this assortment shocked and amazed me; whatever matrix GoDaddy is using to propose alternative domain names clearly recognized the connection between the “Xerox” name and that company’s principal line of business. Heaping helpings of consumer confusion are on tap and ready for delivery for as little as \$1.99. I can’t make this stuff up.

I repeated this experiment several times, using other famous trademarks like

“Hershey” and “Goodyear”. Same result every time.

So then I wondered whether domain name registrars would be as willing to offer 19 or 20 alternatives to their OWN marks. When I “requested” the “GoDaddy.com” domain name, I was duly advised by GoDaddy that “Sorry, godaddy.com is taken.” But this time, there were no suggested alternatives, just “we did not find anything with these search terms.” Either GoDaddy has already registered every possible domain name combination using “godaddy” [a potential universe of hundreds, if not millions], or it just isn’t all that keen on confusing its own customers.

For what it’s worth, I tried the “ford.com” experiment on another domain name purveyor, NetworkSolutions, and discovered that it is a relative piker, numerically, in proposing alternative “ford” domain names: it only suggested TEN alternatives. However, its proposed alternatives were still interesting in the context of trademark infringement: it advised me that “usedford.org,” “myusedford.com” and “my-ford-online.com” were still available for purchase. This suggested to me that the matrix used by NetworkSolutions to propose alternative domain names, like that used by GoDaddy, seemed to recognize the connection between the “Ford” name and that company’s principal line of business. Interestingly, none of the alternative available domain names suggested by either of these domain name purveyors was identical to the alternative available domain names suggested by the other. At this point, then, I had a grand total of twenty-nine suggested choices for purchasing a “ford” domain name. Since there are many

other domain name purveyors, I may have dozens if not hundreds more suggested choices available for purchase.

Now, back to our O’Keefe litigants. The plaintiff in that suit uses a domain identified as “okeefe-law.com” while the defendant employs “okeefelawfirm.com”. Although less than 40 miles apart, it is unlikely the Chicago firm would have discovered its smaller LaGrange counterpart except for the fact that *one of its customers* detected “okeefelawfirm.com” during its web search and blew the whistle. While there is no telling how that suit will wind up, it is clear that the accelerating drift toward online merchandising and shopping are having an effect on the world of trademarks. Indeed, the O’Keefe case reminds us (or at least, me) that the worlds of trademarks and domain names are in fact (and are increasingly) joined at the hip; the practical distinction between them is, in my opinion, vaporizing. Thirty minutes of evening television will expose you to ubiquitous commercials for “MyPillow.com” and “Hotels.com” and a host of other dot-com enterprises. Already there are federally registered trademarks ending in “.com.”³

Yet while trademarks are heavily regulated, domain names are not. In fact they are increasingly unregulated. First, the original cop on the beat has resigned: in October of 2016, the U.S. Government formally relinquished its role as the entity which oversees the process of assigning domain names and IP addresses. In 1998, at the dawn of the internet as we now know it, the U.S. Government created and chartered the Internet Corporation for Assigned Names and Numbers (ICANN) to serve this function; ICANN relied on the services of a horde of volunteers to perform functions such as avoiding duplicative domain names and assigning which companies or countries were entitled to which domains. Now that every nation of the world, and some nation wannabes occupy the internet, the consensus (by no means unanimous) was that it no longer made sense for the U.S. to own that role. Intense negotiations over a period of years among nations and large internet entities like Google resulted in the U.S.

Government divesting its control over ICANN last year, ICANN is now governed by a gaggle of what one publication described as “academics, technical experts, private industry and government representatives, public interest advocates and individual users around the world.”⁴

In addition, starting in 2009, hundreds of new TLDs were authorized; a process is now in place by which even more can be added.⁵ No longer limited to the “big three” domains [.org, .com, .net] and a relative handful of less-familiar TLDs, a limitless number of new possibilities for consumer confusion have been made possible by the use of .pro, .law, .cheap, .law, .lawyer, and even .porn. Auto manufacturers can choose from .ford [uh oh], .jaguar, .chrysler and so on. Nations and cities have their own TLDs, like .CA (Canada), .UK (Great Britain) and .Istanbul. There is a regular smorgasbord of choices. Theoretically, you could try to slap “Ford” or “Hershey” or “Chrysler” or you-name-it trademark to the left of the dot in every one of these TLDs.

If I had more confidence in the process for policing infringement by domain names, I might not be as concerned as I am. Unfortunately, my personal experience with ICANN, admittedly before it gained its independence last year, compels me to conclude that the elaborate dispute resolution process adopted by ICANN is a sham. I intend to discuss my experience with that process in a later piece, but suffice to say the obvious: a body established by players whose only means of support is the sale and distribution of domain names will do everything possible to encourage the sale and distribution of domain names; every other consideration is subordinate to that end. Do not expect the makers of Coors, Budweiser and Heineken to effectively discourage the sale and distribution of beer. One should expect even less regard by domain name purveyors for the niceties of trademark protections, particularly now that ICANN is a hydra-headed conglomeration of interests.

Now, before you suggest otherwise, I am well aware of the Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125(d)(1), *et seq.* It does address

this issue, and does so pretty well, at least within the confines of the United States; I have even managed to use it effectively on behalf of a couple of my own clients. However, the sheer volume of available new TLDs and the geographic range of potential new avenues for consumer confusion suggest to me that efforts to protect one’s marks is beginning to resemble a global and punishingly exhaustive game of “whack a mole.” Indeed, at least some holders of famous marks are obviously not bothering to pursue every such instance of infringement or dilution.

The inevitable conclusion, in my view, is that trademarks are losing their vitality in proportion to which consumer confusion is being promoted and sold for profit by practically unregulated domain name registrars around the globe. The attorney advising a client with valuable trademarks and service marks is compelled to counsel her or his client that, in addition to defending its marks aggressively before the USPTO and, in the case of state trademarks, the affected state’s courts, it needs to gobble up as many competing domain name combinations as it rationally can (you simply cannot anticipate every variant possible), in order to protect its internet flank. Further, it needs to routinely monitor the web to see what mischief the inventive minds of domain name registrars have come up with. ■

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1. *O’Keefe Lyons & Hynes LLC v. O’Keefe Law Firm Ltd.*, No. 1:17-cv-05375.

2. See, e.g., *McDonald’s Corp v. McBagels, Inc.*, 649 F. Supp. 1268, 1 U.S.P.Q.2d 1761 (S.D.N.Y. 1986); *McDonald’s Corp. v. Druck & Gener, DDS, P.C.*, 814 F.Supp. 1127 (N.D. NY 1993); and for a hilarious take on a legendary Illinois case on point, see “*Small Fry Wins McDonald’s War – Farm Town Ronald McDonald Leaves Rival With Fallen Arches*”, Seattle Times, August 16, 1996.

3. e.g., Hotels.com, Serial No. 86248660; Registration No. 4655689

4. *The Independent US*, October 1, 2016

5. “New Top-Level Domain Names to be Allowed” *Ruder Ware - Legal Updates*; Derek L. Preston, March 3, 2009 [<http://www.ruderware.com/legal-updates/new-top-level-domain-names-be-allowed>]