



TIP SHEET™

an informational newsletter on intellectual property matters

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Pirates of the Internet: Infringer Tides



BY RYAN LOBATO
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Policing intellectual property on the World Wide Web can seem like a daunting task. Infringers pirate copyrighted material and pillage trademark rights across the Internet. The establishment of new virtual territories creates perilous waters for intellectual property holders to navigate. With a few simple tips and tools, however, intellectual property owners can either sink or blockade the most likely online infringements.

One common concern for trademark owners is a practice known as “cybersquatting.” Cybersquatting is the bad faith registration of a domain name in order to profit from the goodwill associated with the trademark of another. The seminal example of cybersquatting involved the registration of the domain Panavision.com. Due to the bad faith registration of a cybersquatter, users visiting the Panavision.com domain encountered aerial images of Pana, Illinois, rather than the motion picture equipment goods of Panavision, Inc. The wrongful owner of Panavision.com was in the business of attempting to sell domains, including Panavision.com, to the rightful owners of the underlying trademarks for exorbitant sums, often with success. Panavision, Inc. refused to comply with the owner’s demands. A court determined that the defendant owner’s use was unlawful and awarded the domain to Panavision, Inc. The Anti-cybersquatting Consumer Protection Act, 15 U.S.C. §1125(d), was subsequently enacted to provide trademark owners with a statutory means to stop cybersquatters. Statutory damage awards for cybersquatting can be as high as \$100,000 per infringing domain.

A Google search can help identify potential cybersquatting domains. To search for a potential cybersquatting domain, simply type the words InUrl:trademark (replacing the word ‘trademark’ with your term of concern) in the Google search bar. This search will return all domain names with the ‘trademark’ term in the address. This search may be repeated with common misspellings of the term of concern to identify “typosquatters,” or cybersquatting domains that are confusingly similar to the mark of concern. Once identified, the Web pages must be evaluated to determine if a good faith use is being made or if the Web page exists primarily to siphon Internet traffic from the website of the true owner of the underlying trademark.

A no-cost Google Alert can be set up which will run any desired InUrl:trademark searches on a periodic basis. Should a new potentially infringing domain name appear, Google Alert will send the account holder an e-mail alerting the account holder of the new reference. The Google Alert process can be useful to identify and stop new infringements before the would-

be infringer invests appreciable time or effort in the domain. An early response may further suggest to the would-be infringer that the particular trademark is heavily policed and may encourage the would-be infringer to transfer the domain and forego any use of the trademark.

Copyright infringement is another area of concern, both as to images and text. For images, digital watermarks are useful to (1) provide notice of copyright protection, and (2) discourage unauthorized uses. A reverse image search utility may be employed to identify infringing uses of protected images. While not comprehensive, such reverse image searching websites allow users to search a catalog of images and identify exact copies of the same image. Presently, the free tool TinEye.com is the industry leader for reverse images searches and indexes over a billion images.

With respect to copyright protected text, Google searches of a particular phrase in quotation marks return exact matches. By searching a particular lyric or a uniquely phrased sentence from prose or ad copy, exact copies of the text can be readily identified. Once identified, the potentially infringing unauthorized use must be analyzed for fair use. If fair use does not apply,

statutory means exist to force the website host to take down the copyright infringing use.

Finally, the relevant Internet authorities are creating a new general top level domain (gTLD). gTLDs are the final portions of Internet domain names, such as .com, .net, .gov, and .edu. The new gTLD is .xxx. The .xxx gTLD will be industry specific and used solely for pornographic goods and services. The relevant authority is currently accepting pre-reservations of domain names. Through the pre-reservation process, trademark owners who wish to prevent cybersquatting at the .xxx can notify the relevant authority that the trademark owner has an interest in the name. When

the “sunrise” period begins, priority registration will be given to parties who have historically provided pornography-related goods or services. Following the priority registration by members in the industry, non-industry parties who have pre-registered will be notified and may be allowed to pay a one-time fee to permanently disable the domain of concern. A fee of \$200 to \$300 is expected to block registrations of a name for an initial 10-year period. Following the “sunrise” period and the open registration for the .xxx gTLD, standard domain name resolution protocols will apply.

While the above information may help some intellectual property owners navigating the World Wide Web, there are additional paths, mechanisms and strategies for identifying and avoiding the online intellectual property shoal waters. The Intellectual Property practice group at McAfee & Taft has many years at the helm avoiding, deterring and defending online infringements. If you have any questions or concerns about your intellectual property policing program, or would like to discuss any of these matters further, please feel free to contact us at your earliest convenience.



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