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## SPACE PIRATES, HITCHHIKERS, GUIDES, AND THE PUBLIC INTEREST: TRANSFORMATIONAL TRADEMARK LAW IN CYBERSPACE\*

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“I aim to misbehave”<sup>1</sup>

### ABSTRACT

*Modern trademark law has come of age. Like copyright and patent, it not only has a metaphysic of its own, but it also has the capacity to take goods and services out of the commons. The*

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1. As spoken by the space pirate, Captain Malcolm Reynolds, in *SERENITY* (Universal Pictures & Barry Mendel Productions 2005). Cf. DOUGLAS ADAMS, *THE ULTIMATE HITCHHIKER'S GUIDE* 243 (Wings Books ed. 1996) (characterizing the space traveler's guide, *The Hitchhiker's Guide to the Galaxy*, as having a “compendious and occasionally accurate glossary”). “Pirates” are discussed *infra* Part III.A; two glossaries are appended to this Article at 909-18.

*tendency of modern trademark law to diminish, waste, or spoil the commons is nowhere more apparent than in cyberspace. My prior analytic, descriptive, and doctrinal articles asserted the leading cases either overprotect or underprotect marks in space, and both extremes are wrong. The cases reach the wrong results at the critical margin because they neither define cyberspace nor distinguish the mark-type conflicts typically occurring among the characteristic users there. This normative article specifies a recognizably trademark-style solution to mark-type conflicts in an objective cyberspace. The solution is to add a transforming factor appropriate to the new environment: the "nature and place of use." This new factor is specified for rule-based application. It extends trademark-like protection to invisible, attenuated, and expropriating users, including such uses by way of addresses, magnets, markers, roadblocks, and detours in cyberspace, requiring a reasonable technological accommodation as a flexible remedy in favor of the mark proprietor. The remedy preserves the public interest in a robust cyberspace. It permits the value-added indexer to map cyberspace and to sell advertising to pay for the resulting hitchhiker's guide. The new factor avoids extremes, leaves trademark law transformed but undamaged, and provides a principled, practical, and predictable way to distinguish space pirates from guides, disarming the one while supporting the other.*

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## INTRODUCTION

This Article asserts there is a systemic problem with invisible, attenuated, and expropriating users in cyberspace.<sup>2</sup> It claims the leading cases are not only in conflict, but wrongly decided and likely either to diminish the value of cyberspace or disfigure the law itself. One line of cases diminishes the value of cyberspace by overprotecting to the point of retarding navigation in space. Another and opposite line of cases diminishes cyberspace by underprotecting

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2. That is, uses of a designation by an actor that include a trademarked term of another and which serve as an invisible or attenuated address or magnet to draw users to the actor rather than to the other (a “marker”), or which operate as a roadblock or detour effectively expropriating and preventing the other from employing its own marks (a “spoiler”). Such invisible, attenuated, or expropriating addresses, magnets, roadblocks, and detours function as markers or spoilers rather than, or in addition to, serving “as” a mark on the Internet or elsewhere in cyberspace. An example of an invisible and attenuated use would be an embedded tag or other marker within a Web site, ordinarily invisible to a user, but which is designed to reach a search engine, such as Google, to draw traffic to a site of someone other than the mark proprietor. Another example would be a keyword marker based on a trademarked expression that triggers targeted advertising for goods or services offered by a competitor of the mark proprietor. An example of an expropriating use would be the preemptive registration of another’s mark in an address, a vanity phone number, or a vanity domain name. See Appendix B, Cyberspace Glossary (explaining “attenuated, invisible, and expropriating” uses, and other terms used in this Article).

to the point of reducing cyberspace to an outlaw zone. Together, these cases diminish or spoil cyberspace and disfigure trademark-related law by contorting “initial interest” confusion when overregulating and by distorting a “use” requirement when underregulating.

Part I of this Article describes the current problems with markers and spoilers in cyberspace. Part II analyzes and reframes the existing materials using recognizable principles of trademark-related law and discerns an objective pattern by which the materials can be factored to derive a generalized solution: a new factor, the “nature and place of use,” for trademark-related problems in cyberspace. Part III extends the analysis by designing a more complete and normative solution. This solution distinguishes pirates from guides; takes into account the public interest in a limited remedy for invisible, attenuated, and expropriating uses; and expands the “nature and place of use” into a more robust and rule-specific form. There are two cooperating features to the solution: one is the liability factor (nature and place of use) and the other is a limited and flexible remedy. The fully specified solution combines the two. The final resolution is at once a more careful application of preexisting trademark-related laws and norms, and a normatively designed transformation of ordinary principles in the public interest. Appendix A concisely reprints the fully specified factor that is developed at length in Parts II and III of this Article (propositions 5 & 6 set forth the remedy and liability elements). Appendix B contains a glossary of cyberspace terms used in this Article.

Two prior articles present independent and extended support for certain background propositions. A doctrinally oriented article claims the leading cases are, in fact, in conflict,<sup>3</sup> and a descriptive and analytically oriented article claims it is possible to resolve the conflict in those cases by defining an objective cyberspace and accounting for the typical conflicts that occur among the characteristic users there.<sup>4</sup> This Article is normatively oriented. It fully specifies the previously suggested solution by factoring the prior material into shape for legal analysis and by proposing a series of normatively designed choices among alternatives. This Article will condense, especially in Part I, so much of the prior work as is necessary to develop the claims made in this Article.<sup>5</sup> The reader who is already familiar with the two prior

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3. Thomas C. Folsom, *Missing the Mark in Cyberspace: Misapplying Trademark Law to Invisible and Attenuated Uses*, 33 RUTGERS COMP. & TECH. L.J. 137 (2007).

4. Thomas C. Folsom, *Defining Cyberspace (Finding Real Virtue in the Place of Virtual Reality)*, 9 TUL. J. TECH. & INTELL. PROP. 75 (2007).

5. This seems regrettable though unavoidable apart from reprinting all three together as a book-length feature. The reader might even welcome the ability to treat the three as a serial, with each chapter at a more manageable length than if combined into one. Major quotations from, and repetition of, major themes of the prior articles



articles and with the stakes involved with legal interventions in an objective cyberspace may move immediately to Part II of this Article. Finally, the reader should notice that this Article advances the argument of the prior articles but does not exhaust the topic. This Article aims to set forth a fully specified factor in some detail and to thereby formulate a concrete and comprehensive solution to the previously identified problem, but it does not have room to address economic concerns or to completely resolve the differing views of various commentators on some of the underlying doctrinal issues. Part III.E of this Article identifies those other concerns and issues that must await further development in subsequent articles.

## I. DESCRIBING THE PROBLEM

Trademark law has come of age as an intellectual property discipline. There are two reasons for this observation, one minor, the other major. First, like copyright and patent, modern trademark law has attained a metaphysic of its own.<sup>6</sup> More importantly, modern trademark law has become everyone's business because of its power to reorder entire sectors of the economy if misapplied by judges or other juridical agents.<sup>7</sup> Just like copyright and patent, modern trademark law has the power to diminish or spoil the commons.<sup>8</sup>

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are footnoted, but there are practical limitations, and some signature phrases of my own are not credited. Cf. RICHARD A. POSNER, *THE LITTLE BOOK OF PLAGIARISM*, 64-65 (2007) (exonerating, perhaps, some self-plagiarism in the interest of developing, refining, and expanding the reach of somewhat novel ideas). It would seem a self-citing author might err by over- or under-punctiliousness, and it is hoped this Article finds the middle way.

6. It is famously observed that copyrights and patents "approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle [sic] and refined, and, sometimes, almost evanescent." *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4,901). If trademark is in any sense a species of intellectual property like copyrights and patents, then it should be expected to carry at least a trace of its own metaphysic. Quite apart from its tort-like approach to recognizing a "protectable interest that prohibits likelihood of confusion," but that does not constitute a property right in the abstract, and because of the nuance in distinguishing dilution from remote product sponsorship trademark infringement; unprotectable product features; colors or overall look and feel (or brand-aesthetic features) from protected marks; and even in applying the likelihood of confusion analysis itself, trademark must finally be welcomed to the world of metaphysics—with its own categories of nominal or notional properties of intangible things, their essences and accidents, and the subtle and evanescent distinctions among them. See *infra* Part I.B for some of the metaphysics of marks in space. See *generally* Folsom, *supra* note 3, at 147-68 (concentrating on those aspects of trademark metaphysics that most directly impinge on cyberspace).

7. The competing trends towards either too much or too little patent and copyright, and the danger to the public domain and to innovation (problems with the

The problem of marks in space is perhaps the most obvious demonstration of modern trademark law's growing pains. Trademarks in cyberspace are no longer completely "open,"<sup>9</sup> and the commonplace occurrence of invisible, attenuated, and expropriating users is unbalancing the law's response to predatory behavior in space. Without some level of sensible legal regulation, private

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"commons") are well-known. *See, e.g.*, LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* xvii (2002) ("[Y]ou can believe in copyright without believing copyright should be perpetual. You can believe in patents without believing that everything under the sun should be patented. You can believe in these tools to inspire innovation without believing these tools should become so bloated as to destroy the opportunity for innovation . . . I believe in this balance.").

8. *See* Thomas C. Folsom, *Truth in Intellectual Property Revisited: Embracing eBay at the Edge*, 2 AKRON INTELL. PROP. J. 69, 78-79 (2008).

[The] orthodox and commonly recited benefits of trademark law include its protection of consumers against likelihood of confusion, incentives for mark proprietors to deliver consistent product quality, and a concomitant reduction in consumer search costs. The usually reckoned costs of trademark law include barriers to entry in mark-dominated industries and a tendency to inefficiently allocate funds away from basic research and product development (or away from reduced prices and/or increased returns to shareholders) and towards wasteful, non-value-adding advertising and promotion.

*Id.* With the advent of heavy-handed trademark intervention in cyberspace, it is now much more apparent than ever before that trademark law also includes another kind of cost, more typically considered an externality-like consequence of patent and copyright: the potential for diminution or spoilage of the commons. It is a claim of this Article that overprotection of marks in space diminishes the commons, and that underprotection of marks in space permits spoilage of the commons. It is in these senses that trademark has now come of age as an intellectual property discipline.

9. By "open," it is meant "open for taking and use." When prior registration of an Internet domain name that contains a trademarked term preempts the mark proprietor from using its mark as the same vanity domain name, the mark is no longer open to its own proprietor, short of litigation or other dispute resolution proceedings. Intellectual property in patents and copyright is frequently characterized as "nonrivalrous" in the sense that a second user does not diminish a prior user (these are also characterized as "nonexcludable" and as exemplifying a pressing dilemma of "public goods"). Trademark is, of course, rivalrous in the sense that a junior user of a senior user's mark will lessen the value of the mark. But an as yet insufficiently remarked upon feature of trademarks in cyberspace is that an expropriator may, in fact, significantly control the use (or nonuse) of a trademarked expression on the Internet or within the telephone system simply by first taking a vanity address that contains a trademarked term, thereby excluding the mark proprietor from its own mark in the identical address form. There is no readily apparent analog to this "banking" of already-existing marks in ordinary U.S. trademark law in ordinary space. Indeed, since even the banking of *unused* expressions in ordinary space is discouraged, there is, a fortiori, little or no prospect for rent-seeking activity in respect of making a U.S. market in ordinary space for marks that are *already* in use or registered by others. The casual expropriating of marks in space is a striking contrast in the nature of trademark problems in cyberspace compared to the more ordinary problems trademark law is asked to resolve in ordinary space.

safeguards (or “fences”) alone cannot provide sufficient shelter to persons who are interested in conducting business (or pleasure) or engaging in leisure activity in cyberspace, nor can they well protect the greater public interest in a robust and navigable cyberspace.<sup>10</sup>

When the law too clumsily intervenes to regulate conduct in space, however, it gyrates between the twin faults of casually destroying the foundational values of cyberspace by removing too much freedom, or thoughtlessly disfiguring itself in its attempt to preserve some ill-defined measure of freedom in space. The foundational values of cyberspace not only support personal enjoyment and access to information, but also enable valuable commercial uses. There is a public interest in a robust, accessible, navigable, and trustworthy cyberspace where augmented agents can find and access active (or “live”) information and safely enter into transactions, both commercial and noncommercial. At the same time, there is a public interest in not distorting the law with special doctrines, exceptions, and oddities for cyberspace that can be expected to creep back into ordinary space and distort the “ordinary” principles of trademark law.<sup>11</sup> Neither should it be necessary to await a new statutory solution for each and every particular or new technological offense, as the common law ought to be able to adapt to the changes in a disciplined way, evaluating allegedly offending conduct, and regulating it (or not) in accordance with transformed but recognizable principles and techniques. The law cannot well

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10. “Fences” in this context refers to the idea of self-help, especially when it is posited that there is little or no need for strong-form legal regulation in space because proprietors can protect their own property, other rights, or activities by effectively controlling access. See LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* 122-23 (1999) (describing Harold Smith Reeves, *Property in Cyberspace*, 63 U. CHI. L. REV. 761 (1996), and summarizing: “[I]t sometimes makes sense to shift the burden of protection to citizens rather than the state. . . . [S]ince the intent of the [cyberspace] ‘owner’ is so crucial here [because it is so ‘hard for the law to distinguish’ between legitimate and illegitimate uses of cyberspace], and since the fences of cyberspace can be made to reflect that intent cheaply, it is best to put all the incentives on the owner to define access as he wishes.”). *But cf.* WILLIAM GIBSON, *BURNING CHROME* 196 (1986) (describing a fictionalized account of something like fence cutting by “cybernetic second-story men”: “The elapsed-time figure in the corner of the monitor read 07:24:05. The burn had taken a little under eight minutes.”). This Article claims a mix of fences and legal regulation is a sensible response, and more importantly, it claims that sensible legal regulation ought to support, rather than inadvertently destroy, the foundational values of cyberspace. This Article specifies those values for rule-based application.

11. See generally Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1697 (1999) (explaining “doctrinal creep” in trademark law: “[W]e sometimes seem to be making trademark law for the extreme case, but we then apply that law to a large number of run-of-the-mill trademarks.”).

afford to be playing constant catch-up, always several steps behind and never quite in step with the times and the technology.<sup>12</sup>

This Article proposes a transformational approach. It does not simply “make up” new law, in equal parts bad poetry and ersatz policy. Instead, it is voluntarily constrained to take existing law as it is, or as it might fairly be characterized; to apply analytical approaches as they are commonly understood within trademark law itself; and to accept historical and cultural norms as they are developing in plain view—fashioning from these a recognizably trademark law-based approach that judges can apply, lawyers can figure out, and the public can understand. This Article is, therefore, one more example of modern moral realism,<sup>13</sup> not presented as abstract theory, but actually applied to solve a difficult problem in the law, indeed, one that is among the most difficult in current trademark law.<sup>14</sup>

### A. *Cyberspace*

This Article asserts that in an objective cyberspace, invisible, attenuated, or expropriating markers might be used as an address, magnet, and/or mark<sup>15</sup> (or as roadblock or detour), and might be so

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12. See Karl Lewellyn, *Some Realism About Realism—Responding to Dean Pound*, 44 HARV. L. REV. 1222, 1223 (1931) (“[Some folk of modest ideals] suspect, with law moving slowly and the life around them moving fast, that some law may have gotten out of joint with life.”); cf. WILLIAM SHAKESPEARE, *HAMLET* act I, sc. V, ll. 189-90 (“The time is out of joint; O cursed spite, That ever I was born to set it right!”) (W.J. Craig ed., Oxford University Press 1912) (1609).

13. See Thomas C. Folsom, *The Restatement of the Obvious or What’s Right Got to Do with it? Reflections on a Business Ethic for our Times*, 16 REGENT U. L. REV. 301, 347-49 (2004) (setting forth, in list form, a moral and normative approach to law).

14. PETER B. MAGGS & ROGER E. SCHECHTER, *TRADEMARK AND UNFAIR COMPETITION LAW, CASES AND COMMENTS* 3 (6th ed. 2002) (“Perhaps no issue dominated trademark law at the turn of the millennium more than the question of how to protect trademark owners from misuse of their marks and symbols in cyberspace. The problem spawned legislative solutions, alternative dispute resolution mechanisms, and the predictable body of judicial case law.”). This Article asserts the problem has, thus far, resisted any satisfactory solution despite the “spawn” unleashed upon it.

15. This way of framing the issue is itself valuable. Some persons employ expressions in space “as” marks. These are easy (or at least “easier”) cases for treatment under ordinary principles of trademark law, as developed in ordinary space. The harder cases are those involving markers or spoilers employed as addresses, magnets, roadblocks, or detours in cyberspace instead of, or in addition to, “as” a mark. Unless the law is prepared to conclude that no such activities can be regulated by trademark law, the very real problem for trademark law is determining when, how, and on what basis to regulate invisible, attenuated, and expropriating users in cyberspace. See Folsom, *supra* note 3, at 232-33 (cataloging commentators who support, or tend to support that view); *infra* notes 72-92 and accompanying text (summarizing holdings in leading cases that tend to support that view). This Article

used by surfers and mappers, spoofers and trappers, spoilers and arbitrageurs, shills and advertisers, shoppers, consumers and competitors, and sometimes by a single person simultaneously in more than one category or sequentially moving from one category to another, as well as by a mark's proprietor. Such individuals may be invited or uninvited, value-adding or free-riding, predatory or harmless. The dramatically different search strategies and the varying public interest attaching to each category add another level of difficulty to the problem of resolving mark-type disputes in cyberspace. These terms are not haphazardly created, but are directly reflective of more than a decade's worth of manifest legal experience in and with cyberspace.<sup>16</sup>

### 1. Current Confusion about Cyberspace

All the leading cases involving invisible, attenuated, and expropriating uses of trademarked expressions as addresses, magnets, roadblocks, or detours take place on the Internet or the phone system and invoke the legal process to resolve them. It might be expected in response to the resulting lawsuits that the law would concern itself about this so-called "cyberspace," and it has, to some extent. The law has, indeed, defined the Internet.<sup>17</sup> But curiously,

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concentrates on the harder problem: the principled regulation of invisible, attenuated, or expropriating users of expressions deployed in cyberspace "as" addresses, magnets, roadblocks, or detours. This Article generally passes over the easier cases, as visible and direct users of designations "as" marks in cyberspace can probably be handled without too much strain, and does not explicitly deal with those issues.

16. These definitions are not wholly arbitrary nor are these categories casually constructed. Instead, they reflect patterns abstracted from case data and common experience on the Internet and in cyberspace. *See infra* Part I.B (presenting pattern cases).

17. *See Stomp, Inc. v. NeatO L.L.C.*, 61 F. Supp. 2d 1074, 1075 n.1 (C.D. Cal. 1999).

Although familiarity with the Internet is common, a brief explanation is appropriate for the understanding of this case. The Internet is a giant world-wide network which connects innumerable smaller groups of linked computer networks, and is thus described as a "network of networks." It had its beginnings in 1969 when the United States military established the ARPAnet, a high speed, nation-wide network of military mainframe computers, and has since expanded into the largely private network that exists today.

*Id.* (citing *ACLU v. Reno*, 929 F. Supp. 824 (E.D. Pa. 1996), *aff'd*, 521 U.S. 844 (1997)). *See generally* MARGARET JANE RADIN, JOHN A. ROTHCHILD, R. ANTHONY REESE & GREGORY M. SILVERMAN, *INTERNET COMMERCE: THE EMERGING LEGAL FRAMEWORK* 1276 (2d ed. 2006) (defining "Internet": "The global network of computer networks that communicate using the TCP/IP protocol [transmission control protocol/Internet protocol]. The Internet consists of physical connections among computers throughout

cyberspace itself “is not commonly defined in the law.”<sup>18</sup> It is variously and uncommonly defined—if it is defined at all—and takes on several potential meanings, each of which tends to obscure rather than clarify the tangible things and actual relationships involved.<sup>19</sup>

Sometimes the word “cyberspace” is used “as if it were the same as the Internet or the networked computers that get to the Internet or the resources found there.”<sup>20</sup> That is, cyberspace is used as if it were nothing more than the Internet. This usage cannot overcome the limitation that the Internet has no ethical nature, but it “is whatever we decide to make it.”<sup>21</sup> It also cannot overcome its limitation to one particular embodiment of a gateway technology—the Internet—to the exclusion of the matrix into which the gateway leads. It obscures rather than illuminates what characteristically happens within the matrix and why any of those activities might matter to the law and might be enhanced by a proper application of the law rather than degraded by the opposite application. In addition, this usage entirely misses other gateway technologies such as the phone system,<sup>22</sup> is likely to miss Wi-Fi,<sup>23</sup> and can be predicted

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the world and a set of protocols that allows those computers to communicate with one another.”).

18. Folsom, *supra* note 4, at 95.

19. *See id.* at 95-96.

20. *Id.* at 95.

21. RADIN ET AL., *supra* note 17, at 25 (characterizing an argument made in LESSIG, *supra* note 10, at 6).

22. The phone system, like the Internet, is an embodied switched network for moving information traffic. *See* Interview by Dan Josefsson with William Gibson, Author (Nov. 23, 1994), <http://www.josefsson.net/gibson> [hereinafter Gibson Interview] (“Well, you know, I think in a very real sense cyberspace is the place where a long distance telephone call takes place. Actually it’s the place where any telephone call takes place . . . and we take that very much for granted. Otherwise, I would say that when people use the Internet, that’s when they’re most obviously navigating in cyberspace.”). Gibson is credited with coining the term “cyberspace.” *See, e.g.*, 3 OXFORD ENGLISH DICTIONARY ADDITIONS SERIES 107 (John Simpson ed., 1997) [hereinafter OED]; Folsom, *supra* note 4, at 95 nn.45 & 46 (connecting the OED attribution to Gibson in his article, *Burning Chrome*, published in *Omni* magazine in July 1982, and in his book, *Neuromancer*, published in 1984).

23. “Wi-Fi” (from “wireless fidelity”) is a likely candidate for inclusion in cyberspace as another switched network for moving information traffic. The term is not just a certification mark of the Wi-Fi Alliance. *See* Wi-Fi Alliance Home Page, <http://www.wi-fi.org> (last visited April 25, 2008). Wi-Fi comprises a robustly distributed, fault-tolerant, “mesh”-networking infrastructure that allows for quick negotiation of new connections with devices enabled to connect. *See* Benjamin D. Kern, *Whacking, Joyriding and War-Driving: Roaming Use of Wi-Fi and the Law*, 21 SANTA CLARA COMPUTER & HIGH TECH L.J. 101, 103-04 (2004); *see also* Folsom, *supra* note 4, at 84 n.21.

to miss the “grid” or the “singularity” or whatever else (if anything at all) might come next.<sup>24</sup>

“Sometimes ‘cyberspace’ is used as if it represents the imagination, or a shared imagination, a virtual ‘reality’ so separate from ‘real’ or ‘ordinary’ reality as to be an independent ‘place’ in some allegorical sense of the word.”<sup>25</sup> That is, cyberspace is used as if it were nothing but a hallucination, consensual in nature, but otherwise lacking objective reality.<sup>26</sup> This usage perhaps captures some of the romance of cyberspace or the panache of more general semiotic deconstruction, but it at once signifies everything vague and nothing at all. This is a usage which, though poetical, is too unreliable for intelligible legal work.<sup>27</sup> This poetry unfortunately tends to obscure rather than illuminate the fact that “cyberspace” actually is an objective place in which, by augmentation, a person

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24. The “grid” is sometimes used to signify the next iteration of the Internet and “was coined in the mid-1990s to denote a (then) proposed distributed computing infrastructure for advanced science and engineering.” Ian Foster & Carl Kesselman, *Concepts and Architecture*, in *THE GRID: BLUEPRINT FOR A NEW COMPUTING INFRASTRUCTURE* 37, 44-46 (Ian Foster & Carl Kesselman eds., 2d ed. 2004) (defining the grid and examining the evolution of grid technologies). The “singularity” is an expression used in RAY KURZWEIL, *THE SINGULARITY IS NEAR: WHEN HUMANS TRANSCEND BIOLOGY* 7 (2005) (explaining singularity as “a future period during which the pace of technological change will be so rapid, its impact so deep, that human life will be irreversibly transformed”). The factors proposed in this Article are adaptable to whatever comes next.

25. Folsom, *supra* note 4, at 95 (citing Gibson Interview, *supra* note 22). Certainly William Gibson has famously used the expression this way. WILLIAM GIBSON, *NEUROMANCER* 69 (1984) (“Cyberspace. [1] A consensual hallucination experienced daily by billions of legitimate operators, in every nation . . . [2] a graphic representation of data abstracted from the banks of every computer in the human system. [3] Unthinkable complexity. [4] Lines of light ranged in the nonspace of the mind, clusters and constellations of data.”). This is a useful construct for many purposes, but to distinguish the concept of “consensual hallucination” in Gibson’s special sense (in which it serves as a graphic representation of non-graphic data) from the concept of an objective cyberspace as used in this Article, it may be helpful to reserve the expression “the metaverse” to signify the notion of the consensual hallucination. See NEAL STEPHENSON, *SNOW CRASH* 20-24 (1992) (“The goggles throw a light, smoky haze across his eyes and reflect a distorted wide-angle view of a brilliantly lit boulevard that stretches off into an infinite blackness. This boulevard does not really exist; it is a computer rendered view of an imaginary place . . . . So Hiro’s not actually here [in ordinary space] at all. He’s in a computer-generated universe that his computer is drawing onto his goggles and pumping into his earphones. In the lingo, this imaginary place is known as the Metaverse.”).

26. STEPHENSON, *supra* note 25, at 469-70 (recounting that he created the word “Metaverse” when he “decided that existing words (such as ‘virtual reality’) were simply too awkward to use,” and acknowledging an independent creation of certain related words (“avatar”), together with a software implementation of a virtual reality system called “Habitat” by F. Randall Farmer and Chip Morningstar).

27. See *supra* text accompanying note 15.

can perceive sights and sounds, and in which real agents conduct real transactions.<sup>28</sup> This usage obscures rather than reveals that there are persistent traces in an objective environment, in which there are tangible and augmented communications and actions.<sup>29</sup>

"Sometimes the word 'cyberspace' is used to signify both the Internet and some virtual reality or 'place' experienced there."<sup>30</sup> In a usage that is very productive in some contexts, the word "cyberspace" actually is meant to signify a number of discrete "cyberplaces" within which like-minded persons might congregate or consort on the Internet.<sup>31</sup> This composite usage combines aspects of the two prior usages and begins to broaden each of them in a way that is conducive to problem solving.<sup>32</sup> But it is still overly limiting and obscurantist because it hides rather than reveals the commonality of the broader cyberspace within which these "places" reside.<sup>33</sup>

Occasionally, "cyberspace" has to do with navigation, which is, after all, the linguistic root of the term.<sup>34</sup> "And from time to time, 'cyberspace' is used with reference to legal consequences that might follow from regulating it (or not regulating it)."<sup>35</sup> Frequently, this leads to attempts to optimize the law so that it might facilitate "eCommerce," extraterritorial applications of jurisdiction or choice of law, or some other issue approached in isolation from any organizing

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28. The voice at the other end of a phone line is no hallucination. The resulting conversation is not imaginary. The same can be said of transactions on the Internet, especially the ones that involve the active viewing of two dimensional images, the active reading of text, and interactive participation with other agents that leave an objective trace and conclude business. Folsom, *supra* note 4, at 90-91.

29. *Id.*

30. *Id.* at 95-96 (citing *Stomp, Inc. v. NeatO, L.L.C.*, 61 F. Supp. 2d 1074, 1075 n.1 (C.D. Cal. 1999)).

31. This very useful concept is illustrated to good effect by Professor Lessig, who uses it to draw distinctions among various "places" or "cyberplaces" within cyberspace. See, e.g., LESSIG, *supra* note 10, at 82-83 (describing a number of "cyberplaces," each providing a different experience, and each exhibiting a different level of regulation to its participants: "[C]yberspace is not a place; it is many places. Its places don't have one nature; the places of cyberspace have many different 'natures.' These natures are not given, they are made.").

32. See *id.*, *passim* (repeating the admonition that "we" must make choices in cyberspace and supporting those admonitions with the strong claim that there are competing values in play among different user groups and that there is no necessity that any one value set should prevail in the absence of a choice made by someone).

33. Folsom, *supra* note 4, at 100-01.

34. *Id.* at 96 & n.48 (explaining the root coinage "cyber-netics," and tracing this sense of the expression to the voyage of Theseus against the Minotaur (and back) by aid of his steersman (the cyber-naut), and the Athenian feast of Cybernesia in honor of the feat).

35. *Id.* at 96 & n.49.



principle or genuine policy.<sup>36</sup> This is at least an instrumental, albeit somewhat circular, usage, but it too has its limitations.<sup>37</sup> It too does not open up the question in a way that demonstrates what, if any, tangible things or real relationships are involved in “cyberspace” that might be worth legal incentives or disincentives.<sup>38</sup>

## 2. Defining an Objective Cyberspace and its Characteristic Values

In the prior articles, an objective cyberspace is defined as “an embodied switched network for moving information traffic, further characterized by varying degrees of access, navigation, information-activity, augmentation (and trust).”<sup>39</sup> The first of these defining elements—an “embodied switched network for moving information traffic”—can be called a “gateway” technology.<sup>40</sup> The second of these defining elements—“varying degrees of access, navigation, information-activity, augmentation (and trust)” —can be called the foundational or characteristic “activity set.”<sup>41</sup> Hence, an objective

36. *Id.*

37. *See id.* at 100-01 (proposing a “nonarbitrary, common sense” definition of cyberspace that avoids the competing and extreme claims of both “cyber-romanticism” and “technological realism”).

38. *See id.*

39. *Id.* at 80; Folsom, *supra* note 3, at 140 n.5. This Article will not attempt to establish again what was established in the prior articles concerning cyberspace, but will instead provide a condensation so that this Article may proceed more directly to the newly specified factor without rehashing all of the previous demonstrations in detail.

40. Folsom, *supra* note 4, at 80. A cyberspace gateway is “embodied,” which distinguishes it from unfixed impressions (it is not merely a “network of friends”); it is “switched,” which emphasizes its technological roots in a timing and routing system (it is not merely a highway system, but is more like a railroad); it is a “network” that has nodes and pathways (more than a point to point, but a multi-point connected system); and it is for moving information traffic (it is, ultimately, not a railroad despite some similarities). *Id.* at 83, 85 & n.22. Cyberspace gateway technologies include (most obviously) the Internet and the phone system, probably include Wi-Fi, and will likely include others. *Id.* at 84 & n.21.

41. *See id.* at 80, 84-92. The characteristic or foundational cyberspace activity set includes degrees of “access” so that a user may jack into cyberspace, thereby becoming both an addressable address and a participant, simultaneously an active subject and a findable object; “navigation” from point to point and back again among the live locations in cyberspace; “information-activity,” which is not merely the prospect of information, but information that is immediately acted upon or immediately accessible and available for action; “augmentation,” which is not simply an enhancement in a user’s powers and abilities, but the creation of an augmented presence (e.g., a phone call, for example, is neither imaginary nor a consensual hallucination, but is characterized by the augmented presence of a real and audible voice far removed from the speaker’s physical presence); and “trust” in the identity and contents of cyberspace itself. *Id.* at 84-92.

cyberspace is, in shorthand, defined as (1) a gateway technology (2) “further characterized by varying degrees” of the foundational activity set.<sup>42</sup> It may equivalently be defined as a specified architecture (the gateway technology) plus its characteristic functions or values (its activity set).<sup>43</sup> Current gateways include “the Internet and the phone system.”<sup>44</sup>

The gateways constitute the technologies or architectures of cyberspace.<sup>45</sup> But the foundational activity set describes any architecture’s characteristic function or value to the people who use it, thereby constituting the basis for defining a public interest.<sup>46</sup> This captures the notion that cyberspace is not simply “the Internet” or a “phone system”—mere technology that has no inherent nature or value at all—but is a dynamic activity set, or a matrix, that admits of

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42. Folsom, *supra* note 3, at 141 n.9; *see also* Folsom, *supra* note 4, at 84-92.

43. Folsom, *supra* note 3, at 141-42; *see also* Folsom, *supra* note 4, at 77 n.2.

44. Folsom, *supra* note 3, at 141 n.8; *see also* Folsom, *supra* note 4, at 85.

45. Folsom, *supra* note 3, at 141; *see also* Folsom, *supra* note 4, at 85.

46. Folsom, *supra* note 4, at 84-87, 93-94. This may not be so inconsistent with Professor Lessig’s famous dictum that “cyberspace has no nature” as may first appear. *See id.* at 85; Lawrence Lessig, *The Law of the Horse: What Cyberlaw Might Teach*, 113 HARV. L. REV. 501, 506 (1999). Designed architecture *does* have a nature; indeed, it is designed and specified precisely to have a nature. Its resulting constraints are the boundaries that define what the architecture is. Because the architecture does have a nature, code may be written to achieve the specifications set for the code within the architecture in which it will (so it is hoped) run. Perhaps the key to resolving any apparent inconsistency between the claims of this Article and those of Professor Lessig lies in the fact that we both recognize that *someone* has a choice to make. If architecture is specified and if code is written, then someone (presumably) designed the architecture, determined a specification, and wrote the code. The observation that the architecture might be respecified or that the code might be rewritten does not seem to establish that either architecture or code has no “nature.” But Professor Lessig may be asserting only that there is nothing intrinsic to cyberspace itself that dictates the choices concerning the matters he chooses to discuss, mainly those having to do with the “regulability” of cyberspace and its consequences for associated privacy, liberty, property, and other interests. Such concerns are of an order different than those discussed in this Article. Hence, there are differences, but perhaps no inconsistencies between the approach of this Article and the approach that Professor Lessig has championed. *See generally* LESSIG, *supra* note 10, at 6 (“Code is never found; it is only ever made, and only ever made by us.”); *id.* at 24 (claiming cyberspace has no nature, but becomes what we make of it and referring to its malleable amenability to regulation: “If there is any place where nature has no rule, it is in cyberspace”). This Article and the prior articles all claim there is an objective cyberspace which has a distinctive activity set. It is, therefore, something that can be fixed as an object of thought and can, therefore, afford a baseline against which to measure regulation: some regulations enhance and other regulations retard this objective cyberspace and its characteristic activity set. If someone wants to design, or to discuss, another cyberspace with other values than these, they are at liberty to do so. In the meantime, the approach of this Article and the prior articles permits juridical actors to engage in meaningful conduct, right now, and to better regulate the objective cyberspace that is evident, both for now and for the future.

degrees.<sup>47</sup> In addition, some activities on the Internet or elsewhere in cyberspace are merely transposed transactions from ordinary space and may not need any particular legal response at all.<sup>48</sup> Yet other transactions in cyberspace may invoke much more substantially the foundational cyberspace activity set in ways that exemplify distinctive cyberspace values, and also might require at least some explicit accommodation, recognition, or even encouragement, help, or support from the legal system.<sup>49</sup> It would be nice if the legal system were able to distinguish the important from the unimportant aspects of technology.<sup>50</sup> The importance of cyberspace, if any, comes from the new relationships and activities it enables, not from any new technological use it happens to embody.<sup>51</sup>

This objective definition of cyberspace illuminates what is happening and why it matters. It also reveals what we are not talking about as well as what we are. The network and the activity set that make up the matrix does not include a network of friends, does not include the sewer system, and does not include the interstate highway system or any billboards next to it.<sup>52</sup> If a near-cousin is needed, the time-switched railroad grid is one of the closest non-cyberspace analogs to a gateway technology.

The distinctive cyberspace activity set affords a way of distinguishing important from unimportant events within the matrix and of prioritizing the significance of those that are important. The distinctive cyberspace activity set does not deeply implicate transactions that are not in cyberspace at all, or even those that are merely transposed from ordinary space.<sup>53</sup> It does, however, include invisible, attenuated, or expropriating users of expressions in space that function as addresses or magnets to draw traffic (markers) or

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47. Folsom, *supra* note 4, at 84-87.

48. *Id.* at 93.

49. *Id.* at 93-94.

50. *Id.* at 114-15.

51. *Id.* at 119.

52. The billboard analogy from *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999), is a particularly inapt metaphor. It is not only wrong, but exactly wrong. Folsom, *supra* note 4, at 110 n.90; see also *id.* at 110-12 (observing that a billboard luring travelers off an interstate highway might well result in a legitimate finding of preclusion-style initial interest confusion in ordinary space, but that the ability to easily back-click out of a mistaken, but noticeably wrong location in cyberspace presents the opposite situation).

53. See Folsom, *supra* note 4, at 93, 106-07 (suggesting that some persons in cyberspace are just trying to buy a shirt from, say, L.L. Bean and are acting very like an ordinary purchaser in ordinary space, simply using their augmented presence in cyberspace as they would use their ordinary presence in ordinary space).

that function as roadblocks or detours to prevent or hinder traffic (spoilers).<sup>54</sup>

These markers and spoilers matter to the extent they either aid or harm the cyberspace activity set. Those that aid or support might be considered good.<sup>55</sup> Those that harm or waste might be considered bad in relation to the foundational activity set that characterizes cyberspace.<sup>56</sup> The harmful or wasteful uses are those that effectively deny access by hindering navigation, making information-activity less efficient, taking advantage of the augmented presences in cyberspace, and destroying the trust necessary for augmented agents to engage in commercial or noncommercial transactions.

This definition of an objective cyberspace further illuminates the interested parties. Invited or uninvited, value-adding or free-riding, predatory or harmless, the surfers and mappers, spoofer and trappers, spoilers and arbitrageurs, shills and advertisers, shoppers, customers, competitors and mark proprietors meet in an objective cyberspace.<sup>57</sup> Trademark-related law enters the picture when one or

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54. *Id.* at 115-17 (identifying the key use as “indexing, cataloging and mapping by placing or exploiting invisible or attenuated magnets or marks in space as an aid to a surfer’s enjoyment of access, navigation, information-gathering, and augmentation”—the creation of a “hitchhiker’s guide to cyberspace”—and observing that these are precisely the points at which cyberspace begins to differ from ordinary space; that these activities directly implicate the foundational cyberspace characteristics of access, navigation, information-activity, augmentation, and trust; and that they do so to a high degree).

55. There is no more than a hypothetical or contingent teleology here. *If* the characteristic cyberspace activity set proposed herein and in my prior articles is something desirable (as an “end”), *then* those things that further the activity set (as “means” for supporting or attaining it) are “good” for it. The law itself might do some good for cyberspace if the law, other things being equal and there being authority to do so, supported the good of the cyberspace activity set.

56. *See supra* note 55 (denoting a hypothetical good, and implying the “bad” as its opposite). There is no deontological claim being made herein about any intrinsic nature or essence of technology itself, *see* LESSIG, *supra* note 10, at 24 (warning against the tendency to ascribe an intrinsic value to technology), but rather the provisional moral claim made herein is grounded in the functional uses made of the technology by the human persons who design it, use it, and presumably “like” or “desire” it for some reason. There appears to be no coherent competing claim particularly relevant to trademark-related disputes in cyberspace, but if anyone has such a claim, it would be interesting to evaluate it. In the meantime, this Article advances the modest moral and normative propositions that purposeful law is more likely to attain its purpose than non-purposeful law and that a good purpose is better than its opposite. Compare the two proverbs “if you don’t know where you are going, you are sure to get there” with the notion that “if you know your target and aim at it, you have a better chance of hitting it than otherwise.” *See* ARISTOTLE, *NICOMACHEAN ETHICS*, bk. I, ch. ii (Terence Irwin trans., 1985).

57. These typical users are revealed in the reported cases and are also evident to those who have visited cyberspace. *See* Folsom, *supra* note 4, at 104-07 (describing typical users).

more of these parties places markers or obtains spoilers that include trademarked expressions of another person, either supporting or harming cyberspace, and when mappers in particular use targeted advertising triggered by keywords that include trademarked expressions to pay for value-added mapping services.<sup>58</sup> These definitions, and the vocabulary they enable, permit the law explicitly to consider the nature of cyberspace, what is happening there, and who is interested in the outcome. They permit the law to intelligibly distinguish helpful cyberspace users from harmful cyberspace users.<sup>59</sup>

Importantly, this definition and its associated vocabulary provide a way to articulate more succinctly the public interest in a robust and freely navigable cyberspace.<sup>60</sup> These definitions also permit a juridical agent to notice that there is no unitary interest or presence in space and that a single person may simultaneously or sequentially pass from one interest to another during a single session in cyberspace.<sup>61</sup> Significantly, a person or agent might act as surfer, shopper, or consumer simultaneously or sequentially, and it would seem there is no reliable evidence—direct, survey, indirect, or circumstantial—that could account for the dramatically varied and changing search strategies or activities of the hypothetical ordinary user of cyberspace, much less their different levels of expertise or

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58. Uses such as these are more difficult to resolve by routine application of ordinary trademark law's likelihood of confusion factors than are the easier cases in which an expression containing a trademark is employed in cyberspace more nearly as it might be employed anywhere else; and these uses also comprise the leading cases in cyberspace. See Folsom, *supra* note 3, at 179-81, 213-19 (describing typical conflicts in cyberspace); *infra* text accompanying notes 63-109 (discussing representative cases).

59. Not to put too fine a point on it, this allows the law to distinguish "good" from "bad" even if only hypothetically, relatively, and contingently. See *supra* notes 55-56 (making the breathtakingly modest observations that sometimes a contingent "good" might be named and that, other things being equal, good is better than bad).

60. See Folsom, *supra* note 4, at 114-21 (arguing that creating a vocabulary will aid a surfer's enjoyment); Folsom, *supra* note 8, at 103-04 (asserting trademark intervention in cyberspace, while not without costs, can benefit the commons); Folsom, *supra* note 3, at 140-41 (asserting a public interest that can be derived from the characteristic activity set itself: if there is a desired architecture for cyberspace and if there is a desirable activity set, then it would, other things being equal, be in the public interest to regulate with the grain rather than against the grain).

61. Folsom, *supra* note 4, at 102 (observing that the same person might be acting in the capacity of surfer, spoofer, arbitrageur, consumer, or some other role either simultaneously or sequentially in various sessions in cyberspace, or even in the same session).

familiarity with cyberspace, or even their level of attention, awareness, or concentration at any given moment.<sup>62</sup>

### B. *What Happens There*

This Article has already summarized what cyberspace is, and what might be good for it.<sup>63</sup> It is now time to focus on the more important trademark-related things that happen there and to describe how the leading cases impact them. This Article asserts the leading mark-related cases in cyberspace are those involving invisible, attenuated, or expropriating markers or spoilers and which: (a) implicate the ability of a value-added mapper or guide to produce an index (a directory) to cyberspace and to sell targeted advertising to pay for the index; (b) affect the ability of a user to freely and reliably access and navigate within cyberspace; or (c) harm the characteristic values of cyberspace. As an analytical matter, the leading cases are demonstrably in conflict with one another and with ordinary principles of trademark law.<sup>64</sup> At one extreme is a line of cases that overprotects marks in space upon a radical misapplication of initial interest confusion.<sup>65</sup> At the opposite extreme is a second line of cases that underprotects marks in space upon a radical

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62. Imagine the survey instrument and its question: "if you use the Internet, and if you think about such things, would you think of yourself as (a) a surfer, (b) an information aggregator, (c) a shopper, (d) all of the above, (e) none of the above, or (f) a combination of some of the above." Or: "if you characterize yourself in relation to the Internet, would you characterize yourself as (a) an expert, (b) a person non-expert but familiar, (c) neither an expert nor a person familiar with cyberspace, but one who is always careful and 'on-guard' when on the Internet, (d) some combination of the above, at least some of the time, or (e) none of the above, ever." One would wonder what to make of any survey results. An advantage of the approach of this Article is that it permits more or less real-time "polling" of the participants involved. The poll will answer the question at the point in time that matters, and in respect of the participants who count. See *infra* note 229 (explaining the "polling" concept). There is, of course, still room for surveys in ordinary space where the actors and their capacities and intentions are, or might be, somewhat more fixed.

63. See Folsom, *supra* note 4, at 84-87.

64. Folsom, *supra* note 3, at 225-27. This Article will not attempt to demonstrate again what was demonstrated in the prior articles concerning the conflicts in the cases, but will instead provide a condensation so that this Article may proceed more directly to the newly specified factor without rehashing all of the previous arguments in detail.

65. *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999); Folsom, *supra* note 3, at 181-96 (selecting these two cases as representative and asserting that both *Netscape* and *Brookfield* "overprotect" marks in cyberspace compared to ordinary space by creating trademark liability in cyberspace greater than, and in conflict with, ordinary principles of trademark-related law). The overprotection stems from a radical misapplication of the "initial interest confusion" doctrine in cyberspace. *Id.*

misunderstanding of the threshold offending “use” necessary to any cognizable trademark-type injury.<sup>66</sup> Both extremes are wrong. They cannot coexist with one another, nor can they coexist with ordinary principles of trademark law. Between these two extremes, there are a number of middling cases that are not particularly satisfying.<sup>67</sup> Upon review, the cases do not reach the correct results, do not do so for the right reasons, and are not otherwise persuasive.<sup>68</sup> This is so despite the fact that the cases show obvious evidence of painstaking work by all the juridical agents involved, and also that their results are not entirely unexpected.<sup>69</sup> Despite all the effort, there is, in fact, a

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66. 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400 (2d Cir. 2005); Holiday Inns, Inc. v. 800 Reservation, Inc., 86 F.3d 619 (6th Cir. 1996); Folsom, *supra* note 3, at 196-213 (selecting these two cases as representative and asserting that both *1-800 Contacts* and *Holiday Inns* “underprotect” marks in cyberspace compared to ordinary space by refusing, in conflict with ordinary principles of trademark-related law, to find any basis upon which even to apply the law to allegedly offensive or clearly predatory mark-type activity in cyberspace). The underprotection stems from a radical misreading of the requirement that an offending user must “use” an expression “as” a mark in such a way as to cause a likelihood of confusion. Folsom, *supra* note 3, at 196-213.

67. *Playboy Enters. v. Welles*, 279 F.3d 796 (9th Cir. 2002); *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001); *Sporty’s Farm, L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489 (2d Cir. 2000), *cert. denied*, 530 U.S. 1262 (2000); *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998); Folsom, *supra* note 3, at 213-28 (selecting these cases and asserting that they, and dozens of others under the shadow of the over- and underprotection extremes are interesting but ultimately unsatisfying ad hoc solutions to trademark-type disputes involving invisible or attenuated conflicts in cyberspace). These cases are unsatisfying because they do not present a principled, practical, or predictable way of resolving invisible or attenuated uses of markers in cyberspace, apart from the happenstance of specialized statutes perhaps sufficient to handle stylized offenses based on the technology and mores du jour, but insufficient to deal with essentially identical offenses as technologies change or offending practices adjust. Folsom, *supra* note 3, at 213-27.

68. See Posting of mindse to The Academy, [http://theacademy.blogspot.com/2003\\_05\\_04\\_theacademy\\_archive.html#93864929](http://theacademy.blogspot.com/2003_05_04_theacademy_archive.html#93864929) (May 6, 2003, 7:50 EST) (recounting an interview with Howard Bashman, entitled *20 Questions for Howard Bashman*, in which Mr. Bashman characterizes a high quality opinion as one that reaches the correct result, for the right reason, and is persuasive and well written); see also Folsom, *supra* note 3, at 139 n.3.

69. See *MAGGS & SCHECHTER*, *supra* note 14 (one wonders if this is what they meant by the “predictable body of judicial case law”). In the midst of the competing claims of the “initial interest” proponents and their critics, it is an obvious fact that there is, of course, some sort of initial interest going on when an actor uses the goodwill of another somehow to influence or draw traffic to the actor’s location, goods, or services, and that there is some sort of law more or less on point. It is not surprising, therefore, that cases such as *Brookfield* and *Netscape* might find those concerns persuasive. Nor is it surprising that commentators should find something amiss.

systemic problem that drives the cases in the wrong directions and requires a new approach.<sup>70</sup> The same observations apply to the various commentaries on the cases: despite careful articles, well-written by highly capable scholars, there remains an unsettled void at the center of the analysis.<sup>71</sup> Despite all the work by so many juridical agents, the answer is not yet in place.

This Article is intended for the generalist as well as for those who are forced to judge these controversies or who are scholarly specialists in trademark or cyberspace law. Accordingly, this Article does not assume every reader is already familiar with the cases cited herein, or even that every expert will agree upon which cases are most fundamental or which principles of trademark-related law are firmly established. So this Article will name some cases and will identify some of the "ordinary" principles of trademark-related law most applicable to the problems of marks in space. Because the cases, legal principles, and conflicts among them will come up again later in this Article, it may be convenient to briefly summarize them.

To describe the conflicts among the leading cases, this Article samples representative cases. It asserts that one line of leading cases

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Likewise, despite the perhaps doubtful provenance and likely unintended consequences of a threshold "use as a mark" requirement, it is an obvious fact there is something odd about finding likelihood of confusion arising out of invisible, attenuated, or expropriating conduct. Such conduct does not seem to "use" the offending expression "as" a mark. There is some sort of authority on point and the proponents of the requirement have thereby found a tool, albeit somewhat overbroad and untested, to combat the excesses of initial interest confusion. It is not surprising, therefore, that cases such as *1-800 Contacts* and *Holiday Inns* might find such concerns persuasive.

While this Article proposes a better solution, rejecting both of the other approaches as extreme and also unnecessary, the proposal is presented without any intent to disdain the underlying factual insights and concerns that lead to the two extremes. Each of the extreme approaches was to have been expected, and each could have been predicted in advance. This is yet another example of the ability of cyberspace to throw a spotlight on a preexisting, but latent antimony, paradox, or ambiguity already embedded in ordinary principles of ordinary law. See LESSIG, *supra* note 10, at 22-23 (discussing "latent ambiguities").

70. See Folsom, *supra* note 3, at 139 ("When even the more influential cases dealing with marks in space are wrong—when they miss the mark in cyberspace—it is time for a reassessment.").

71. As a matter of methodology, moral realism (and this Article) begins with the data itself rather than with the various systems or theories imposed on the data by scholars. See *id.* at 237. In this context, it is driven by the combination, first, of observable and manifest features of cyberspace; next, the case law regulating markers in cyberspace; and finally, those existing principles of ordinary law from which such regulation is said to come. But while this Article begins with the data, it by no means ignores the contributions of other scholars. See *id.* at 232-33 (collecting some of the representative scholarly viewpoints); *infra* notes 242-44. Further work remains to be done to sort out the various viewpoints, but it must come in a subsequent article. See *infra* Part III.E (discussing what remains).



overprotects mark-type designations in space compared to what would have been expected under ordinary principles of trademark-related law in ordinary space, and another line of leading cases underprotects against the same standard. This Article also samples some in-between cases and asserts they, too, are worth reconsidering. The next few subsections more fully articulate these assertions.

### 1. Overprotection

Two cases represent overprotection. In *Brookfield*,<sup>72</sup> a vanity web address (domain name)<sup>73</sup> and hidden metatags<sup>74</sup> were used (or it was announced that they were about to be used)<sup>75</sup> by a junior user to draw traffic to its site at the apparent expense of a senior user who claimed trademark rights in the expressions incorporated within the domain name and in the metatags.<sup>76</sup> Each of these allegedly offending uses, both as an attenuated address within a domain name

72. *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999).

73. *Id.* at 1042, 1044-45 (explaining "domain names" and their usefulness). A domain name is an address that points to a location on the world wide web, readable by a web browser, and used to deposit a user at the site. *Id.* at 1044; see RADIN ET AL., *supra* note 17, at apps. A-B ("Computer Networking and The Internet" and "The Domain Name System"). The particular domain name at issue in *Brookfield* was *www.moviebuff.com* and the trademark at issue was "MovieBuff." *Brookfield*, 174 F.3d at 1042-43.

74. *Brookfield*, 174 F.3d at 1045 (explaining "metatags" and their uses). A metatag is a tag,

used in the code that constitutes a web page, that describes the contents of the page. The text of a metatag is not [ordinarily] displayed on the website visitor's computer monitor, but can be read by another computer across the network. For example, a search engine [a machine-generated directory, created by a computer software agent or "spider" that moves through the Internet and retrieves information, such as the Google search engine] may read a web page's metatags in determining whether that page is relevant to a search query that it is processing.

RADIN ET AL., *supra* note 17, at 1277; see *id.* at 80-81 (describing strategic "metatagging" and other techniques to influence search engines). The metatags at issue included instances of "moviebuff" embedded as tags within the HTML (hypertext markup language) code at the offending Web site. *Brookfield*, 174 F.3d at 1043.

75. The concept of an offending "use" in either of these contexts is a matter about which more will be said. See, e.g., *infra* note 143 (asserting the required offending conduct comprises "marketing" goods or services using a "designation" which causes a likelihood of confusion); *infra* note 149 (describing the four-way equivocation of "use"); *infra* notes 242-44 and accompanying text (sampling some of the scholarly opinions); see also Folsom, *supra* note 3, at 233-34 (collecting authorities); *id.* at 159-60 nn.89-93, 161-63 nn.96-105, 206-10 nn.287-303, 232 n.382 (discussing the issues raised in asserting an independent requirement that an offending party must "use" a designation "as" a mark, and concluding there is no such requirement).

76. *Brookfield*, 174 F.3d at 1042-43.

and as an invisible magnet within the metatags, were held to constitute an independent act of trademark infringement based on initial interest confusion.<sup>77</sup> Assuming, arguendo, it is a part of the “ordinary principles” of trademark law at all, “initial interest confusion” attaches liability even though there is no likelihood of confusion at the point of sale.<sup>78</sup> It does so because some earlier offending use might “initially” have drawn a potential customer in the first place. According to one formulation of the reason for this theory, even though the offending party dispels the confusion at the point of sale, the prior conduct may nevertheless have *precluded* a sale by the mark proprietor.<sup>79</sup> After all, it is a common sense observation that the consumer is now ready to buy from the offending party, but would likely not have been absent the initial confusion, and that if the mark proprietor also loses the chance to compete for the transaction, then there would seem to be a “preclusion” basis for applying the doctrine. But if applied too quickly in cyberspace, and without proper regard to whether there actually are any preclusive

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77. *Id.* at 1066. In this Article, the distinctively coined labels (invisible, attenuated, or expropriating use; address, magnet, mark, roadblock, or detour; and the like) are added in the interest of deriving some order out of the chaos, and were not part of the language or discourse of the courts involved. *Cf.* JOHN WITTE, JR., RELIGION AND THE AMERICAN CONSTITUTIONAL EXPERIMENT 225 (2005) (referring to a certain line of decisions: “Even a sympathetic reader . . . is tempted to apply to [this line of cases] the definition that Oliver Wendell Holmes, Jr. once applied to the common law: ‘chaos with an index.’”). It is the task of this Article to superimpose an index, or at least a meaningful glossary, on the existing common law. It is a kind of Hitchhiker’s Guide to the law of cyberspace. *See* ADAMS, *supra* note 1 (praising even an inaccurate glossary as better than nothing).

78. As commonly understood, the notion of initial interest confusion is based on consumer preclusion: actionable harm to the proprietor of the mark occurs if, because of likely confusion prior to the point of sale, the proprietor “may be precluded from further consideration by the potential purchaser in reaching his or her buying decision.” Folsom, *supra* note 3, at 156 n.73 (quoting authorities). *Compare* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 cmt. d (1995) (Reporters Note) (giving a perhaps backhanded acknowledgment of the doctrine by faint allusion to it: “Several cases suggest that pre-sale confusion of source or association that is likely to harm the commercial interests of the trademark owner is actionable as an infringement even if the confusion is dispelled before the actual purchase.”), *with* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:6 (4th ed. 2006) (cataloging cases, including ones that apply a “preclusion” style of initial interest confusion). *But see* Lamparello v. Falwell, 420 F.3d 309, 316 (4th Cir. 2005) (declining to adopt the doctrine) (“[This court has] never adopted the initial interest confusion theory; rather, we have followed a very different mode of analysis, requiring courts to determine whether a likelihood of confusion exists by ‘examining the allegedly infringing use *in the context in which it is seen by the ordinary consumer.*’”).

79. Lamparello, 420 F.3d at 316; *see also* Folsom, *supra* note 3, at 155-57 (collecting cases, some of them attaching liability when the initial interest confusion “precludes” the consumer from considering the goods or services of the mark proprietor after the initial confusion is dispelled).

effects, this doctrine will impose liability on many if not all attenuated or invisible users of any trademarked term, hindering fair navigation and information gathering in space by many users who are not at all likely to be confused. Moreover, the doctrine requires some care in its application lest it distort trademark law's likelihood of confusion standard in ordinary space.<sup>80</sup>

A subsequent case extended the rationale of *Brookfield* from invisible and attenuated uses by competitors to such uses by value-adding mappers of cyberspace who were selling targeted advertising triggered by keywords.<sup>81</sup> In *Netscape*,<sup>82</sup> a resource provider had created a pre-identified list of certain key words for various goods and services that could serve as invisible or attenuated triggers for targeted advertising.<sup>83</sup> When it came to sex, the defendants had generated a list of some four hundred words, two of which (playboy and playmate) constituted trademarked expressions of Playboy Enterprises, Inc. (PEI).<sup>84</sup> When a user typed one of those marks into a search engine, the user would see a click-through banner advertisement paid for by competitors of PEI offering goods or services that might substitute for those offered by PEI.<sup>85</sup> The court held that this constituted a use suitable for trial on the question of likelihood of confusion, based on the doctrine of initial interest confusion.<sup>86</sup> The judges who wrote the majority and concurring decisions seemed uneasy about the result,<sup>87</sup> and the case is reported

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80. See *infra* note 142; see also Folsom, *supra* note 3, at 155-57 ("There are several other peculiarities in determining 'likelihood of confusion,' each of which makes sense in context but each of which can be taken dramatically out of context.").

81. *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004).

82. *Id.*

83. *Id.* at 1022-23.

84. *Id.* at 1023.

85. *Id.*

86. *Id.* at 1023-29; see also Folsom, *supra* note 3, at 191-96 (discussing the case).

87. Folsom, *supra* note 3, at 195 n.248, explained:

The [majority] opinion for the *Netscape* court suggested the dispute could be resolved by an accommodation between the mark proprietor and the search engine provider—perhaps some sort of disclaimer or other flag could be tagged to the resultant ads. *Netscape*, 354 F.3d at 1030 n.43 (majority's view that "[d]oing so might eliminate the likelihood of initial interest confusion that exists in this case"). The *Netscape* [majority] expected some further appellate resolution after trial, and the concurring opinion signaled that *Brookfield* might have to be revisited. . . . See *id.* at 1034 (Berzon, J., concurring) (based on the controlling rationale of *Brookfield*, "there could be [trademark infringement] even if the banner advertisements were clearly labeled"); *id.* at 1036 ("There will be time enough to address the continuing vitality of *Brookfield* should the labeled advertisement issue arise later. . . .

to have settled.<sup>88</sup> But because the decision remains on the books and represents a logical application of the *Brookfield* rule, *Netscape* jeopardizes any provider of targeted advertisements triggered by an invisible or attenuated use of another person's marks.<sup>89</sup> Because such advertisements might subsidize the production, maintenance, and improvement of high value directories that map the contents of cyberspace, any loss or impairment of the advertising revenue to the provider might threaten the continued availability and development of those directories.<sup>90</sup> It frankly puts Google, or at least one aspect or one version of its business model, in the legal crosshairs and, with it, such interest as the public might have in a "hitchhiker's guide" to cyberspace.<sup>91</sup>

## 2. Underprotection

Two cases represent underprotection of marks in space. In *1-800 Contacts*,<sup>92</sup> a third party was able to insert resources for generating external calls for popup advertising into an application program that was "voluntarily" downloaded by Internet users onto their own computers.<sup>93</sup> The allegedly offending application program afforded an opportunity for sponsored advertising. The popups were triggered upon keyed terms input by the user into the user's computer.<sup>94</sup> Even

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Should the question arise again, in this case or some other, this court needs to consider whether we want to continue to apply an insupportable rule.").

88. Jason Krause, *Google Targeted in Trademark Disputes: Rulings Should Help Define What is Protected in Internet Advertising*, A.B.A. J. E-REP., May 28, 2004, at 1 ("Netscape and Excite quickly settled for an undisclosed amount. 'My sense is that they had to settle or Netscape potentially risked putting a fundamental part of its business model at risk. This was a bet-the-company kind of risk,' says Allen J. Baden, a trademark attorney based in San Jose."); see also Folsom, *supra* note 3, at 194 n.247.

89. One such provider is Google, Inc., and the resource in question is Google's search engine. There are other competing providers and resources, and it might be supposed there may be others that arise in the future and against whom the legal regime might adversely tilt the playing field unless the legal regime is mindful of the consequences of getting initial interest wrong. In addition, there would seem to be a public interest in a robust and navigable cyberspace, and any legal regime should consider it. See Folsom, *supra* note 4, at 117 n.105; see also Folsom, *supra* note 3, at 195.

90. There is a public interest here that is underrepresented in the cases. In fact, there is little explicit consideration of the public interest in the leading cases at all, and yet, a renewed interest in the public interest seems invited by the U.S. Supreme Court, and perhaps not only in patent matters. See *eBay, Inc. v. MercExchange L.L.C.*, 547 U.S. 388, 392-93 (2006) (citing authorities involving copyright remedies); Folsom, *supra* note 8, at 100-01 (suggesting application of *eBay* to copyright and trademark remedies).

91. See Folsom, *supra* note 4, at 117 & n.105; Folsom, *supra* note 3, at 221 n. 343.

92. *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400 (2d Cir. 2005).

93. *Id.* at 404

94. *Id.* at 404-05.

though some of the keyed terms included trademarked expressions that were alleged to cause a likelihood of confusion, the court's conclusion was that this type of invisible or attenuated use of magnets in space did *not* constitute a "use" by the offending party of the expression "as" a trademark.<sup>95</sup> Because there cannot be any trademark infringement without a "use" by an offending party causing a likelihood of confusion, it followed that this particular kind of nonuse could not possibly raise any issue of trademark infringement.<sup>96</sup> The *1-800 Contacts* court went to some lengths to distinguish on technological (or perhaps semantic) grounds the kind of triggered advertising it exonerated as a "nonuse" from the kind of triggered advertising that constituted a "use" in *Netscape* (expressly reserving judgment whether the specific Netscape technology and delivery system as described might constitute a "use" in the Second and Ninth Circuits).<sup>97</sup> It still seems, however, that the logical basis of the underprotecting *1-800 Contacts* case must be at odds with the logical basis of the overprotecting *Netscape* case.<sup>98</sup>

Perhaps *1-800 Contacts* reached a better result than did *Netscape* because *1-800 Contacts* can at least be read as exonerating one particular type of targeted advertising.<sup>99</sup> But it did so for the wrong reason and at the cost of turning cyberspace into an outlaw zone for invisible or attenuated magnets, while incidentally

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95. *Id.* at 407-12.

96. *See id.* at 412; *see also* Folsom, *supra* note 3, at 196-200.

97. *1-800 Contacts*, 414 F.3d at 410-11. The court takes some pains to distinguish without endorsing various other views. *Id.* at 411 n.15 (citing *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1034-36 (9th Cir. 2004) (Berzon, J., concurring); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999)). The distinctions seem based on rather fine technological or semantical differences. First, metatags might be used for ranking purposes (a "use" in *Brookfield*), but there was no such ranking-style use here. *Id.* at 411. Second, there may be a difference between the use of a keyword to trigger an unidentified banner advertisement, which could be a "use" in *Netscape*, but there was no such unidentified advertisement-style use here. *Id.* Third, there may be a difference between the act of selling particular trigger words to specific sponsors (as in other cases) and simply selling random category placements as in *1-800 Contacts*. *Id.* at 411-12. As a result, perhaps the rationale is best explained by the court's ultimate challenge to the plaintiff. *Id.* at 412. It appeared to the court quite simply that the plaintiff was "unable to explain precisely how" the allegedly infringing user was using its mark. *Id.* But even that seems a bit understated—a fair inference from *1-800 Contacts* is that, in fact, no triggered pop-up advertisement could ever constitute "use" of the type the court is demanding. Folsom, *supra* note 3, at 99 n.258.

98. *See Rescuecom Corp. v. Google*, 456 F. Supp. 2d 393, 399-401 (N.D.N.Y. 2006) (reading *1-800 Contacts* as such and extending its rationale for the proposition that the keyword advertisements sold by Google do not constitute "use" sufficient to sustain a cause of action for trademark infringement); Folsom, *supra* note 3, at 199 n.258.

99. *See* Folsom, *supra* note 3, at 199.

permitting spoilage of the commons.<sup>100</sup> That cost may be better seen in the other representative underprotection case. *Holiday Inns*<sup>101</sup> is a good example of the sort of predatory conduct that underprotection is likely to immunize. "It was a 'trapping' case in which the offending party deliberately sought to [trap, and then] do business with[,] consumers who were clearly trying to reach the mark proprietor [but (predictably)] misdialed the [proprietor's] vanity [phone] number."<sup>102</sup> Like the *1-800 Contacts* decision, although predating it and having been determined independently of it, *Holiday Inns* also concluded that an attenuated use did not constitute "a 'use-for-trademark-purposes' that can cause any legally cognizable likelihood of confusion."<sup>103</sup>

### 3. Antimony, Paradox, and Conflict Within the Leading Cases

If, according to the overprotection cases, an attenuated or invisible use of a marker as an address or magnet in space is not only a "use" but is an offending use that necessarily, or almost always, causes initial interest confusion (at least if the magnet is any good, and if a court fails to consider whether there actually were any preclusive effects resulting from the use of the marker), then there can scarcely be an instance in which there is not an infringement every time a magnet draws or influences traffic.<sup>104</sup> An observer might not be too far wrong to interpret these cases as standing for something very like the proposition that every invisible or attenuated use of a marker in space is always a trademark violation, because such use always causes an initial-interest-style likelihood of confusion.

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100. *See id.* at 199-200.

101. *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996).

102. Folsom, *supra* note 3, at 200; *see also id.* at 620-22. The proprietor, Holiday Inns, had a vanity phone number, 1-800-HOLIDAY, that it massively advertised as a toll-free number for room reservations. Holiday Inns' vanity mnemonic mapped to the number 1-800-465-4329. *Holidays Inns, Inc.*, 86 F.3d at 620. The predatory user observed that a predictable group of consumers would misdial the number "0" (zero) for the letter "o" in "holiday" and so purchased a trapping number, 1-800-405-4329 (which mapped to 1-800-h[zero]oliday). *Id.* The predatory user sold or licensed the trapping number to a travel agent who, intercepting calls meant for Holiday Inns, offered to book the caller into a comparable hotel or into a Holiday Inns hotel, presumably diverting the one and taking a booking fee from Holiday Inns for the other. *Id.* Though the trial court ultimately had no problem in holding the predator liable, the court of appeals reversed, believing the offending conduct that caused a deliberate diversion of customers and also a likelihood of confusion nevertheless did not constitute a "use" of Holiday Inns' trademark in the eyes of the law and holding, therefore, that the law could provide no remedy. *Id.*

103. Folsom, *supra* note 3, at 200.

104. *See id.* at 194-95.

But if, according to the underprotection cases, an attenuated or invisible use of a marker in space is not even a legally cognizable “use,” then there can logically be no infringement by such uses—ever.<sup>105</sup> An observer might conclude these cases stand for the proposition that no (or pretty nearly no) invisible, attenuated, or expropriating use of a marker or spoiler in space can ever be a trademark violation, even if such use does cause a likelihood of confusion.

It might be that the overprotection and the underprotection lines of cases are both wrong, but as an analytical matter, they cannot both be right.<sup>106</sup> Perhaps there is a way to resolve the paradox or to show there is no true antimony between them.<sup>107</sup> But barring that, the modest conclusion is that these two lines of cases are at least in conflict with one another. In fact, this Article claims that both lines are wrong because each is also in conflict with ordinary principles of

105. See *id.* at 198-99.

106. Unless, that is, they can be realistically distinguished from one another, at least in part. See *supra* note 97 (describing the *1-800 Contacts* Court’s suggestions of ways to distinguish *1-800 Contacts* from *Brookfield* and from *Netscape*). Those suggestions seem weak in theory and difficult in practice, but regardless of the success in distinguishing *1-800 Contacts*, it appears clear that there is no reasonable way to distinguish *Holiday Inns* from *Brookfield* or *Netscape*—those cases seem wholly irreconcilable. See Folsom, *supra* note 3, at 225 n.358 (suggesting the futility of doing so); see also Uli Widmaier, *Use, Liability, and the Structure of Trademark Law*, 33 HOFSTRA L. REV. 603, 704 (2004) (applauding *Holiday Inns* as the better approach to the problem: cases like *Holiday Inns* have “stubbornly insisted upon proof of trademark use of the allegedly infringing mark by the defendants themselves. That is the correct viewpoint, and the doctrinal nail in the coffin of the *Brookfield* . . . aberration.”). Professor Widmaier’s view is incorrect on the merits, but he is on target in observing the opposite and contrary results that follow, according to the opposite views taken on the meaning of “use.” See, e.g., *infra* note 144 (asserting the conduct required of the offending actor is “marketing” goods or services); *infra* note 149 (describing the four-way equivocation of “use”); *infra* notes 242-44 and accompanying text (sampling some scholarly opinions); see also Folsom, *supra* note 3, at 232-33 (collecting authorities); *id.* at 159 nn.89-93, 161 nn.96-105, 206 nn.287-303, 222 n.347, 232 n.382 (discussing consequences and concluding there is no independent requirement that an offending actor “use” the offending designation “as” a mark).

107. A paradox is only an apparent contradiction, but an antinomy is a contradiction; a paradox can be resolved, but an antinomy cannot (if the rule against contradiction be maintained). An ambiguity in word usage might clear up either a paradox or an antinomy, once a verbal equivocation or amphiboly is made explicit. See OED, *supra* note 22, at “amphiboly” (distinguishing equivocation from amphiboly “though in popular use the two are confused”); cf. *id.* at “antinomy” (defining it as “a contradiction between conclusions which seem equally logical, reasonable or necessary” and as “intellectual contradictoriness” but then equating the term to “a paradox”); *id.* at “paradox” (defining it as an “apparently absurd or self-contradictory statement or proposition . . . which investigation, analysis, or explanation may nevertheless prove to be well-founded or true”).

trademark and related law.<sup>108</sup> Not only are they analytically wrong, their results seem almost perversely backwards because, as a normative matter, it is the pirate (in *Holiday Inns*) who gets a free pass while it is the resource provider (in *Netscape*) who is at risk of liability. If settled law really compels such results, then there is an additional reason to be concerned.<sup>109</sup>

#### 4. In-between or Ad Hoc Cases

Existing beneath the shadow, or penumbra, of these over- and underprotection cases are a number of others that seem more or less ad hoc, and destined to be counted rather than analyzed.<sup>110</sup> From the perspective of an objective cyberspace with characteristic values that are worth preserving, these cases raise a concern. There is within these cases a tacit admission that the problems are, by and large, left uncovered by "ordinary" principles of trademark or related common law and are able to be addressed, if at all, only because of specialized statutes, each within its own narrow compass.<sup>111</sup> If it should happen that any of these offenders had consulted with counsel, or had modified their conduct only slightly so as to move outside the strictures of the specific statutory proscriptions, then the courts would have had to determine whether there exists any general principle of trademark-related law that would have regulated the allegedly offending conduct. Some of the cases hold, and others imply, that there is no such principle.<sup>112</sup> A few contain dicta or

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108. See *infra* Part I.C. Compare Folsom, *supra* note 3, at 186-91 (describing ways in which *Brookfield* is wrong), *id.* at 194-96 (describing why *Netscape* is wrong), *id.* at 199-201 (describing why *1-800 Contacts* is wrong), and *id.* at 208-13 (describing why *Holiday Inns* is wrong), with *id.* at 225-26 nn.358-59 (making an effort to save the cases, but concluding it is not worth the candle).

109. Nonsense in the law is bad enough, see Folsom, *supra* note 8, at 104 n.124 (claiming that ridicule is one of two or three things a rule of law may not well survive), but this is worse than nonsense. See CHARLES DICKENS, *OLIVER TWIST* 407 (Richard Clay Ltd. 1983) (1838) (observing, when informed that "the law supposes that your wife acts under your direction": "If the law supposes that," said Mr. Bumble . . . , 'the law is a ass—a [sic] idiot. If that's the eye of the law, the law is a bachelor; and the worst I wish the law is, that his eye may be opened by experience—by experience.").

110. Compare "those who can analyze, those who can't count" (proverbial saying, distinguishing analysis from counting), with "the unplanned life is not worth examining" (adding an important corollary to the notion that "the unexamined life is not worth living"). See MORTIMER J. ADLER, *ARISTOTLE FOR EVERYBODY* 77 (1978) ("Socrates, who was Plato's teacher, as Plato was Aristotle's, said that an unexamined life is not worth living. Aristotle went further and said that an unplanned life is not worth examining.").

111. See Folsom, *supra* note 3, at 219-20.

112. See *id.* at 219. One advantage claimed for the new factor proposed by this Article is that the "nature and place of use" can adapt to new circumstances without the need to wait for a new statute for each new technological offense, or for each new



alternate holdings that seem to suggest there might be some such principle. These representative cases include offending actors and offending conduct such as these:

- Terri Welles used a trademarked expression owned by Playboy Enterprises as an invisible magnet to draw users to her Web site—No trademark infringement for the more significant of her uses of those expressions and no finding of liability on any other basis in respect of those uses.<sup>113</sup>

- Michael Doughney used a trademarked expression belonging to People for the Ethical Treatment of Animals as an attenuated address within a domain name calculated to draw users to his Web site, which was devoted to “people eating tasty animals”—No trademark infringement, but liability under a trademark-related law against “cybersquatting.”<sup>114</sup>

- Sporty’s Farm, L.L.C., which used a trademarked expression belonging to another within a domain name, blocked the other from obtaining an Internet domain name including its own trademark—No trademark infringement, but liability under trademark-related laws against cybersquatting and dilution.<sup>115</sup>

- Dennis Toeppen warehoused domain names, including trademarked expressions, and offered to sell them to the owners of

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technique of giving offense, so it is of some importance that the new factor be able to handle cases such as these. See *infra* Part III.B-C.

113. The expressions included “playboy” and “playmate” as magnets within invisible metatags and “playmate of the year” on the masthead of Terri Welles’ Web site. *Playboy Enters. v. Welles*, 279 F.3d 796, 800 (9th Cir. 2002) (finding no liability but permissible, nominative use when a former Playboy-brand, Playmate-style naked model used trademarked expressions belonging to Playboy Enterprises in invisible metatag magnets to draw traffic to her Web site; use was presupposed). Meanwhile, Welles’ visible use of the expression “PMOY” (“Playmate of the Year”), displayed on “wallpaper” at her site, was enjoined. *Id.* at 804; see also Folsom, *supra* note 3, at 213-27.

114. The domain name was “peta.org.” See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 367-69 (4th Cir. 2001) (finding use, likelihood of confusion, and liability under the federal Anti-Cybersquatting Consumer Protection Act’s anti-cybersquatting provisions).

115. *Sporty’s Farm, L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 496-99 (2d Cir. 2000) (affirming a judgment and approving an injunction for cybersquatting under the federal Anti-Cybersquatting Consumer Protection Act, and for dilution under the Federal Trademark Dilution Act when blocking a competitor by registering a domain name including the competitor’s mark and then assigning the domain name to a noncompeting, wholly-owned subsidiary; use was presupposed, but no appeal was taken from the trial court’s rejection of trademark infringement claims because of its finding that the parties were operating in wholly unrelated businesses); see also Folsom, *supra* note 3, at 213-27.

the trademarks—No trademark infringement, but liability under a trademark-related law against dilution.<sup>116</sup>

There are a number of other mark-related problems that have been proposed by various commentators. When combined with all of the prior examples, they establish a partial list of open questions (or questions to which the cases have given doubtful or conflicting answers) that must include at least these:<sup>117</sup>

- Is it trademark infringement to embed another's trademark in an Internet domain name? Or in a phone number? What if the offending expression is merely warehoused by a domain name or phone number registration unaccompanied by active use of the offending Web site or phone number? What if the offending party does not initiate any sale of the expression back to the proprietor or otherwise avoids the indicia of the clumsy cybersquatter? And what if the expression is a mark not famous enough to qualify for anti-dilution protection?

- Is it trademark infringement to embed another's trademark in HTML metatags or in buried code, tags, or invisible (hidden) text?

- Is it trademark infringement to sell advertising triggered by a trademarked expression? Does it make a difference how the trigger is set or activated, how it is marketed or bundled, or whether it is associated with a disclaimer of some sort?

- Is it trademark infringement to sell enhanced relevancy rankings? And is it trademark infringement to spoof a relevancy ranking system by a method relying in part upon some use of a trademarked term?

- Is it trademark infringement to embed another person's trademark as part of an e-mail address or as a subdirectory name?

- Is it trademark infringement to associate another's trademark with spam messages or fraudulent, illegal, or other unwelcome intrusions?

- Is a disclaimer enough to avoid liability in any or all of the situations in which there might otherwise be liability for an invisible or attenuated use? Can the law require a disclaimer, or can the law require any other reasonable steps to avoid "passing off" or likelihood

116. *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1324-27 (9th Cir. 1998) (finding commercial use of the mark and liability for dilution under the Federal Trademark Dilution Act when Toeppen obtained domain name registrations covering more than 100 well-known marks, including "Panavision" and "Panaflex," and then set himself up in the "business" of selling them back to the trademark proprietors); see also Folsom, *supra* note 3, at 213-27.

117. See *supra* notes 64-103 and accompanying text (reviewing representative cases); *infra* text accompanying notes 139-71 (setting forth other problems with invisible or attenuated uses in cyberspace that might be expected to require a resolution); accord Folsom, *supra* note 3, at 213-27 (presenting the same list).

of confusion? Does bad faith figure? Does actual confusion? Does “direct” versus “indirect” (vicarious or other grounds for secondary liability) afford a meaningful basis for distinguishing and providing different legal responses to, say, the person who purchases a trademark-triggered keyword and associates it with an advertisement for goods or services, as opposed to a resource provider who merely sells or otherwise enables the trademark trigger that is then employed by another person as an invisible, attenuated, or expropriating marker or spoiler in space?

Any explicit solution of these ad hoc problems would have to come in a subsequent article<sup>118</sup> as part of the test conditions for the new factor proposed herein. That is, if the new factor can resolve the conflict between the over- and underprotection cases, it should be expected also to resolve the large number of otherwise indeterminate cases in their shadow. This Article anticipates the new factor will resolve these other questions in addition to resolving the leading cases. The leading cases are in conflict because they both overprotect and underprotect.<sup>119</sup> The leading cases are wrong because, among their other infelicities, *Brookfield* rewards a reverse domain name hijacker;<sup>120</sup> *Netscape* misses a likely instance of true preclusion-style initial interest confusion;<sup>121</sup> *1-800 Contacts* misses the chance to say there is no likelihood of confusion with a weak or nonexistent mark, while also missing the chance to say that offensive, unconsented, and intrusive adware or spyware that monitors and then responds to a user-inputted trademarked term might very well constitute an offending use;<sup>122</sup> and *Holiday Inns* inexplicably privileges a predator who lured its customers, all of whom were seeking the mark proprietor, and trying to find a Holiday Inn.<sup>123</sup> And as the next subpart asserts, they are not even proper applications of ordinary principles of trademark-related law.

### C. Ordinary Principles of Applicable Law

This Article asserts there are problems in the leading cases and has pointed out they are in conflict with one another.<sup>124</sup> Before being

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118. See *infra* Part III.E (describing what remains to be done).

119. See *supra* text accompanying notes 72-103; see also Folsom, *supra* note 3, at 227, 236 (asserting the overprotection line of cases conflicts with the underprotection line, and both lines conflict with ordinary principles of trademark law).

120. Folsom, *supra* note 3, at 190 n.225.

121. *Id.* at 190 n.245; Folsom, *supra* note 4, at 112 n.92.

122. Folsom, *supra* note 3, at 198 n.257.

123. *Id.* at 205-06 (analyzing the harm). There was probably a true preclusion-style initial interest confusion problem here as well.

124. See *supra* text accompanying notes 72-122; see also Folsom, *supra* note 3.

able to assert they are also likely to either undermine the foundational values of cyberspace or to disfigure the law itself, it is necessary to explain in some greater detail both the foundational characteristics of cyberspace and also the underlying principles of trademark-related law relevant to mark-type disputes in space.<sup>125</sup> Complicating this discussion is the uneasy notion that the governing law is itself not altogether free from doubt<sup>126</sup> and that there is no small confusion about the nature of cyberspace.<sup>127</sup> Without more carefully describing the norm against which the cases must be measured, not much can be done. Accordingly, this section will explain what this Article means by “ordinary principles” of trademark-related law.<sup>128</sup>

### 1. Ordinary Principles of Trademark-Related Law

There are articulable principles of “ordinary” trademark law. This is true even though there is a noticeable pressure on, and equivocation within, the ordinary principles of trademark law such that the law is notably in flux (or might seem to be). There are also a number of cognate or otherwise related laws, rules, and norms not strictly part of trademark law, but affecting marks and therefore comprising a domain of trademark-related law that must be taken into account. To provide a benchmark against which to evaluate the leading cases and to test the proposed solution, this subsection will discuss: (a) the principles of ordinary trademark law most applicable to cyberspace; (b) the impact of doctrinal creep, reverse doctrinal creep, feedback loops, and equivocation in ordinary trademark law;

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125. The foundational characteristics of cyberspace are described, *supra*, at notes 34-51 and accompanying text. The relevant principles of ordinary trademark and related law will be described in this Section. *See also* Folsom, *supra* note 3, at 140-47 (describing these principles in greater detail).

126. *See infra* text accompanying notes 129-71; *see also* Frank H. Easterbrook, *Cyberspace and the Law of the Horse*, 1996 U. CHI. LEGAL F. 207, 208 (“[The] principal conclusion: Develop a sound law of intellectual property [outside of cyberspace], then *apply* it to computer networks.” (emphasis added)).

127. *See supra* text accompanying notes 17-33; *see also* LESSIG, *supra* note 10, at 6, 66, 82 (affirming the view that cyberspace “is” not anything other than code, and asserting that it has no essential nature); Lessig, *supra* note 46, at 505-06 (noticing that cyberspace is different in its effects, but notably shying away from claiming that cyberspace “is” anything—other than, perhaps, a region created by “code” that Proteus-like becomes whatever a coder might code it to be). *But see* Folsom, *supra* note 4, at 80 (defining an objective cyberspace with observable characteristics that constitute its values).

128. This Article and the prior articles have already explained what is signified by an objective cyberspace. *See supra* text accompanying notes 39-62. This section will draw the connection between ordinary principles of trademark-related law and the real relations and events that are occurring in an objective cyberspace, some of which support and some of which harm the foundational values of cyberspace.

and (c) certain other trademark-related laws, rules, and norms that affect cyberspace.

## 2. Ordinary Trademark Law

The leading cases say they are merely applying ordinary principles of trademark law to cyberspace.<sup>129</sup> These ordinary principles are neither infinitely plastic nor hidden. They are stated in the leading treatises,<sup>130</sup> in popular law school teaching materials on trademark and unfair competition law,<sup>131</sup> or on so-called “Internet” or “cyberspace” law,<sup>132</sup> in the guidelines used by federal trademark examiners,<sup>133</sup> and unless otherwise provided, in the Federal Trademark Act.<sup>134</sup> Moreover, the ordinary principles of trademark law have recently been restated by the American Law Institute.<sup>135</sup> Together, these provide a standard benchmark against which to measure the cases that take trademark law to the Internet and elsewhere into cyberspace. Beyond trademark, there are other legal domains that apply a trademark-related analysis or remedy to mark-type disputes in space.<sup>136</sup>

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129. See *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999); *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 626 (6th Cir. 1996); Folsom, *supra* note 3, at 182 n.184.

130. JEROME GILSON, *TRADEMARK PROTECTION AND PRACTICE* (2005); MCCARTHY, *supra* note 78, § 23:6; see also Folsom, *supra* note 3, at 147-50.

131. ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY, THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* (2003); see also GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY* (2d ed. 2007); JANE C. GINSBURG, JESSICA LITMAN & MARY L. KEVLIN, *TRADEMARK AND UNFAIR COMPETITION LAW* (4th ed. 2007); MAGGS & SCHECHTER, *supra* note 14; Folsom, *supra* note 3, at 147-50.

132. RADIN ET AL., *supra* note 17; see also PATRICIA L. BELLIA, PAUL S. BERMAN & DAVID G. POST, *CYBERLAW: PROBLEMS OF POLICY AND JURISPRUDENCE IN THE INFORMATION AGE* (3d ed. 2007); RAYMOND S. R. KU & JACQUELINE D. LIPTON, *CYBERSPACE LAW CASES AND MATERIALS* (2d ed. 2006); PETER B. MAGGS, JOHN T. SOMA & JAMES A. SPROWL, *INTERNET AND COMPUTER LAW: CASES, COMMENTS, QUESTIONS* (2d ed. 2005); RICHARD WARNER, GRAEME DINWOODIE, HAROLD KRENT & MARGARET STEWART, *E-COMMERCE, THE INTERNET, AND THE LAW: CASES AND MATERIALS* (2007); Folsom, *supra* note 3, at 147-50.

133. U.S. PATENT AND TRADEMARK OFFICE, *TRADEMARK MANUAL OF EXAMINING PROCEDURE* (2005) [hereinafter TMEP]; see also Folsom, *supra* note 3, at 147-50.

134. Trademark (Lanham) Act of 1946, 15 U.S.C. §§ 1051-1127 (2006) (permitting federal registration of marks, and a federal cause of action for infringement and unfair competition, presumably on the basis of ordinary principles of trademark and unfair competition law except where otherwise provided); see also Folsom, *supra* note 3, at 147-50.

135. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 cmt. d (1995).

136. These include anti-dilution law, anti-cybersquatting law, the uniform domain name dispute resolution procedures, unfair competition, and various other regulations,

Infringement liability under ordinary trademark law depends upon "likelihood of confusion," which is the foundation of trademark law.<sup>137</sup> The test for likelihood of confusion is determined by a multifactor analysis,<sup>138</sup> differing from court to court in the specific formulation, but containing a substantial common set of concerns.<sup>139</sup>

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norms, market factors, and architectural limitations. See *infra* text accompanying notes 172-81 (noting that the categories of law, norms, markets, and architecture as constraints on cyberspace are courtesy, of course, of Professor Lessig who formulated them in, among other places, LESSIG, *supra* note 10); see also Folsom, *supra* note 3, at 168-79.

137. *E.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20, cmt. g (1995); MCCARTHY, *supra* note 78, § 23:1.

138. Among the more famous of the particular multifactor formulations are the "Polaroid" factors:

- (1) the strength of [the senior user's] mark, (2) the degree of similarity between [the senior user's mark and the other's expression], (3) the proximity of the products, (4) the likelihood that the prior owner will bridge the gap [between the products], (5) actual confusion, (6) the [junior user's] good faith in adopting its own [expression], (7) the quality of the defendant's product, and (8) the sophistication of the buyers.

Polaroid Corp. v. Polaroid Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961) (enumeration added). This is a test designed to handle claims of likelihood of confusion, extending, by its fourth factor, to *noncompeting* products as well as to competing products, see *infra* text accompanying note 139 (competing products). Among the many other influential multifactor lists is that included in the RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995): (1) the similarity between the respective designations (including sight, sound, and meaning); (2) "the degree of similarity in marketing methods and channels of distribution" for the products; (3) "the characteristics of the prospective purchasers of the [products] and the degree of care they are likely to exercise in making purchasing decisions"; (4) "the degree of distinctiveness" of the proprietor's mark; and (5) if the products differ, the likelihood that prospective consumers would expect a person in the position of the mark proprietor to expand its marketing or sponsorship into (or more nearly adjacent to) the product line of the offending actor; or (6) if the geographic markets differ, the extent to which the proprietor's mark is identified with the proprietor within the geographic territory of the offending actor. *Id.* § 21. The Restatement considers the circumstances of intent and of actual confusion separately from its main list. *Id.* § 22 (explaining when and why "intent" might appropriately figure in the likelihood of confusion analysis even though liability may attach without any culpable intent on the part of the offending actor); *id.* § 23 (explaining when and why "actual confusion" or its absence might appropriately figure in the analysis even though liability may attach without any actual confusion at all).

139. A typical multifactor test for *competing* products (that is, goods or services that are identical, related, complementary, or substitutionary) will use: (1) one or more mark-to-mark factors to compare the degree of similarity in sight, sound, and meaning of the proprietor's mark against the offending user's expression (assuming they are not identical) and (2) one or more market-to-market or consumer-related factors to assess the degree of consumer sophistication and care, in light of the manner of presentation and impression made in the relevant market by the competing expressions (assuming they are not displayed or advertised identically and adjacent to one another, or to the identical set of potential consumers at the same time). See, *e.g.*, RESTATEMENT §§ 20-23 (generalizing the common factors into a relatively short list); DINWOODIE & JANIS,

While this concept “seems disarmingly simple, and sometimes is,<sup>140</sup> it does have at least five [related] doctrinal generalizations and two

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*supra* note 131, at 480-82 (summarizing, in tabular form, the various specifications of the standard tests as articulated in each of thirteen federal appellate courts, some of which count as many as thirteen factors); MCCARTHY, *supra* note 78, §§ 24:30 to :43. In assessing product closeness for nonidentical, but arguably competing products, examples serve to illustrate related, complementary, and substitutionary categories: milk and ice cream might be considered more or less related depending on current social and marketing expectations, a hammer and nail are complementary, and a hammer and a screwdriver are substitutionary. *See* Borden Ice Cream Co. v. Borden's Condensed Milk Co., 201 F. 510 (7th Cir. 1912) (discussing milk and ice cream: the relationship between milk or condensed milk likened to a component part, and ice cream likened to a finished product or counted as a separate and noncompeting consumer good, based on the consumer expectations prevalent in an older, pre-brand expansion commercial marketing environment, and finding no likelihood of confusion); WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 153-54 (2003) (“[N]ails are complements of hammers . . . nails are substitutes for pegs or screws.”); RICHARD A. POSNER, ECONOMIC ANALYSIS OF LAW 44 (7th ed. 2007) (“A screwdriver and a screw are complements; a screwdriver and a hammer are substitutes.”).

For *noncompeting* products, the multifactor tests are expressed in ever lengthening lists, as each test must add one or more additional product-to-product factors to assess the degree of source or sponsorship connection between the noncompeting products, and/or to assess the mark proprietor's intent to expand or franchise a mark into new territory (product line expansion or geographic expansion) and/or the consumers' expectation of such expansion or of remote sponsorship of unrelated products. *Id.*

In the cases and commentary, it is almost universally acknowledged that every specified factor list in every particular test for likelihood of confusion is nonexclusive and may be supplemented by any other factor that might prove to be useful as circumstantial or indirect evidence relevant in answering the ultimate question commonly accepted by all of the courts (but which cannot be well answered by any direct evidence): is there a likelihood of confusion? *See generally* RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995); DINWOODIE & JANIS, *supra* note 131; MCCARTHY, *supra* note 78. In practice, and for reasons that are sometimes left unsaid (perhaps no more than for reasons of simple judicial economy, some courts seem more inclined to drop inapplicable factors from a longer list than to fashion new factors to supplement a shorter list), some courts act as if there is an identical set of factors for both competing and noncompeting goods and announce a full-bore noncompeting product analysis, even in the run-of-the-mill competing products cases that could have been handled under a shorter list. This is one reason why the factor lists compiled by Professors Dinwoodie and Janis can range from a low of six factors to a high of thirteen factors. *See* DINWOODIE & JANIS, *supra* note 131, at 482 (summarizing, among others, the Tenth Circuit's six-factor test that seems optimized for competing goods, and the Federal Circuit's thirteen-factor test that seems designed to account for noncompeting goods as well).

140. “Confusion is most likely to result when an unauthorized party uses a mark identical to that of the [proprietor] on the exact same type of goods or services as are sold by the [proprietor] and sells those in the exact same geographic area.” SCHECHTER & THOMAS, *supra* note 131, at 637. Such cases would be relatively simple, but:

[further] observations [that are] most relevant to invisible and attenuated uses on the Internet or in cyberspace.”<sup>141</sup> These seven concepts derive from the “likelihood of confusion” standard and tend to give trademark law its distinctive metaphysic, or at least a level of nuance that requires some care on the part of juridical agents when taking ordinary law into cyberspace.

Here are the five generalizations and two further observations derived from ordinary principles of trademark law’s “likelihood of confusion” standard that are particularly relevant to invisible and attenuated users in space. The ordinary principles, rules, or nonexclusive multifactor tests for likelihood of confusion: (1) do not forbid mere inconvenience or a mere possibility of confusion;<sup>142</sup> (2) do not limit themselves to confusion of the source of goods or services (or products) sold or offered for sale, but cover confusion as to sponsorship of products as well as their source (embracing so-called promotional items),<sup>143</sup> which is to say the offending conduct is better

Of course most litigated cases of trademark infringement are not this easy. It is quite common to encounter legal controversies where the [offending party] is using a similar, but not identical version of the [proprietor’s] trademark . . . or where the [offending party] is using the same marks on different types of goods . . . or where the [offending party] is doing business in a region of the country remote from the [proprietor’s] area of operations . . . . Moreover these permutations can be combined.

*Id.*; see also Folsom, *supra* note 3, at 151 n.45 (quoting SCHECHTER & THOMAS, *supra* note 131, at 637).

141. Folsom, *supra* note 3, at 139.

142. *Id.* at 151-52.

“Likelihood of confusion” does not require that any confusion actually occur, and yet it demands more than a mere possibility of confusion. “Many consumers are ignorant or inattentive so that some are bound to misunderstand no matter how careful a producer is.” If liability attached merely at the level of “possible” confusion, then trademark law would overprotect the proprietor by reference to “a small and naive segment of the public.” What is protected against is confusion and its likelihood, not some inconvenience or frustration, and not naivete or their likelihood (or their actuality). The harm of overprotection would be to take words or other designations out of common usage to a degree greater than necessary to prevent a likelihood of confusion.

*Id.* at 152 (citing and quoting SCHECHTER & THOMAS, *supra* note 131, at 638).

143. SCHECHTER & THOMAS, *supra* note 131, at 638; Folsom, *supra* note 3, at 152-53.

Source confusion exists if consumers are likely to think the proprietor of the mark provided the goods or services that are offered by the offending user. This would tend to involve direct or indirect competitors offering the same or related goods or services, perhaps including complements and substitutes, where the offending party is seen to be trading off the goodwill of the mark proprietor. Sponsorship confusion exists if consumers are likely to think the proprietor has licensed or otherwise endorsed the goods or services of the offending party. This can involve non-competing goods and promotional



understood as “marketing” of products by way of a “designation” that causes a likelihood of source or sponsorship confusion;<sup>144</sup> (3) are not concerned about the small number of ill-informed consumers who might experience a likelihood of confusion;<sup>145</sup> (4) involve questions of

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goods. What is protected against is not only source confusion but also sponsorship confusion, and sponsorship confusion is increasingly important in a merchandising and franchising commercial culture.

Folsom, *supra* note 3, at 152-53 (citing SCHECHTER & THOMAS, *supra* note 131, at 638-39).

144. That is to say, the action requirement of trademark likelihood of confusion is met by “marketing.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20(1) (1995) (stating that an offending actor is subject to liability if “in *marketing* the actor’s goods or services, the actor uses a designation that causes a likelihood of confusion” that “the goods or services marketed by the actor are produced [or] sponsored; or . . . [if] approved [by the mark proprietor]” (emphasis added)). Although not entirely free from doubt, “marketing” is almost certainly what provides the substantive component of “use in commerce” as that expression is “used” in the Lanham Act. See Lanham Act § 32, 15 U.S.C. § 1114 (2006) (predicating trademark infringement liability on “use in commerce”); *id.* § 43(a), 15 U.S.C. § 1125(a) (predicating unfair competition liability on “use in commerce”); *id.* § 45, 15 U.S.C. § 1127 (defining “use in commerce” as the “bona fide use of a mark in the ordinary course of trade”). Infringement by “marketing” products by the use of an offending designation within the meaning of the Restatement (or by the Lanham Act’s “bona fide use . . . in the ordinary course of trade”) may be met by offers or sales of products, or by conduct that promotes or approves of products. The touchstone is whether the marketing of products leads to likelihood of source confusion or sponsorship confusion. It may be a pity the drafters of the Lanham Act expressed themselves by the phrase “bona fide use of a mark in the ordinary course of trade” because, in the infringement context, the junior user cannot have a “mark” at all. Unless it is a blatant case of counterfeiting or the like, the junior user has only a designation that is more or less similar to the senior user’s mark, but at the end of the day there can be only one mark and that is the senior’s. Even in the case of counterfeiting, it is the senior’s mark that the junior is using and, again, there is only one mark and it is not the junior’s. No doubt, the drafters might have supposed common law courts would not forget the common law basis of trademark rights, and might have anticipated such courts would continue to apply common law principles to make sense of the Lanham Act formulations that attempted to capture the underlying rules of common law trademarks for purposes of establishing federal registration and related federal rights in respect of marks. To be sure, “use in commerce” also adds a necessary federal jurisdictional dimension to the Lanham Act beyond the common law’s substantive requirement that the offending actor merely market some products, perhaps locally, but that is a rather pedestrian observation.

145. SCHECHTER & THOMAS, *supra* note 131, at 639; Folsom, *supra* note 3, at 153-54.

Liability will not attach for “likelihood of confusion” unless an “appreciable” or “substantial” number of consumers are likely to be confused. This disregards conduct that will confuse only the “(hopefully small number of) inattentive or foolish consumers.” Trademark protects the substantial number of consumers, not the few, and this is increasingly important as new technological uses invite users of different attention levels to participate in conduct that implicates trademarked designations, and then habituates those users to the customs, or at least the architecture, of the new

fact, or at least mixed questions of fact and law;<sup>146</sup> and (5) include special cases that make sense in context, but otherwise do not (including "initial interest" confusion).<sup>147</sup> The ordinary principles lead to two further observations. Ordinary trademark law: (6) already embraces a flexible remedy, often injunctive relief, but then only in the public interest and in accord with ordinary equitable

technological environment. Neither the foolish nor the few should be a drag on the others who know what they are doing in cyberspace, nor should the interests of those few who are just learning to surf in cyberspace dominate the interests of the substantial numbers who have been in cyberspace for more than a few minutes or outweigh the public interest in a robust and navigable cyberspace.

Folsom, *supra* note 3, at 153-54 (footnotes omitted) (citing SCHECHTER & THOMAS, *supra* note 131, at 639-40).

146. SCHECHTER & THOMAS, *supra* note 131, at 640; Folsom, *supra* note 3, at 154-55. "Likelihood of confusion" is determined on "a multi-factor analysis, which differs in its precise formulation while maintaining substantial commonality in various jurisdictions." *Id.* at 154; *see supra* notes 138-39. "Each of the federal circuits has its own variation of the list of factors, and so does the Restatement." Folsom, *supra* note 3, at 154. In any event, the factors are "not meant to be rigid formulae, and are only meant as a guide to resolving the ultimate question, which remains 'likelihood of confusion.'" *Id.*

147. SCHECHTER & THOMAS, *supra* note 131, at 650; Folsom, *supra* note 3, at 155-57.

There are several other peculiarities in determining "likelihood of confusion," each of which makes sense in context but each of which can be taken dramatically out of context. One peculiarity is this: likelihood of confusion is usually assessed at the point of sale, but sometimes before. This temporal disruption can lead to a finding of likelihood of confusion (prior to sale) in the absence of any possible confusion whatsoever (at the time of sale). This, in turn is complicated by disclaimers that sometimes suffice to dispel any confusion (at the point of sale) but at other times fail to dispel confusion. A presale problem gives rise to what is called "initial interest confusion"—the actionable harm to the proprietor of the mark occurs if, because of likely confusion prior to the point of sale, the proprietor "may be precluded from further consideration by the potential purchaser in reaching his or her buying decision." Initial interest confusion might seem very like a finding of trademark infringement liability in the absence of likelihood of confusion, but its rationale is in fact based on a temporal likelihood of confusion (presale) that likely deprives the mark proprietor of a potential customer (at the point of sale). The problem with point of sale disclaimers is that, even though they may be clearly worded, it is not so clear whether they are effective. Sometimes disclaimers are sufficient, sometimes not, depending on the circumstances. It is debatable whether the findings of initial interest confusion liability, when they are based on confusion created prior to a sale even though dispelled by the time of sale, are in the nature of a prophylactic remedy, a moral condemnation of nearly fraudulent conduct, an economic calculus, or are simply irrational, but it is beyond debate that the tendency to make such findings of liability exists.

Folsom, *supra* note 3, at 155-57 (footnotes omitted) (citing SCHECHTER & THOMAS, *supra* note 131, at 650).

principles;<sup>148</sup> and (7) suffers from multiple ambiguity and equivocation, especially in connection with the (at least) four senses in which the word “use” figures in trademark law.<sup>149</sup>

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148. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 (1995); Folsom, *supra* note 3, at 157-59.

The remedy in trademark law is one that fits the nature of the harm. The standard remedy is often an injunction. This is because of the ordinary injunction factors, and not because of a property analysis or automatic rule. It is a consequence of the purpose and rationale of trademark law—if there has been something very like deception, then there is no remedy unless and until the deception stops, and the nature of the injunctive relief is tailored to the nature of the harm against the public interest.

Folsom, *supra* note 3, at 157-58; *see also* RESTATEMENT § 35 cmt. a (“[T]he judicial preference for injunctive relief in unfair competition cases is not an exception to ordinary remedial principles, but rather an application of those principles in a context in which injunctive relief is ordinarily the most appropriate remedy.”); *id.* § 35 cmt. b (“[A] prevailing plaintiff is ordinarily awarded injunctive relief to protect both the plaintiff and the public from the likelihood of future harm . . . . Although injunctive relief is routinely granted in unfair competition cases, the remedy remains subject to equitable principles . . . . The plaintiff’s interest in protecting the good will symbolized by its trademark or in preserving a truthful marketplace is unlikely to be adequately secured by monetary relief, and the equities thus normally favor the award of an injunction. The public interest in preventing confusion and deception also typically weighs in favor of an injunction.”). The ordinary injunction factors are irreparable injury, the inadequacy of money damages, balancing of the hardships between plaintiff and defendant, and the public interest. *See eBay, Inc. v. MercExchange L.L.C.*, 547 U.S. 388, 391 (2006); Folsom, *supra* note 8.

149. Folsom, *supra* note 3, at 159-64. “Use” might signify: (1) an offending party’s “use” of an expression that is likely to cause confusion with another’s designation, (2) which designation itself has been “used” by its proprietor in association with goods or services so that it might qualify to be a trademark, and which, if it is asserted to be protected under the Lanham Act, (3) has been “used” by its proprietor in connection with interstate commerce that Congress may regulate, and which, if it is sought to be registered under the Lanham Act, (4) has been “used” by its proprietor in such a manner as might be evidenced by a specimen of use acceptable to an examiner at the U.S. Patent and Trademark Office, and sufficient to support federal registration. *Id.* at 159-60. Of these four senses of the word “use” only one (the first) has anything to do with an offending party, and there all it signifies is some conduct by an actor in marketing the actor’s goods or services using a designation that gives rise to a likelihood of confusion with the goods or services of another person, the proprietor of the mark in question. *Id.* at 162. The other three senses have to do with the proprietor’s level of use in three different contexts. *Id.* at 162-63. It is bad practice to conflate the four senses and it is a mistake to suppose that the offending party must satisfy any but the first of the four. *See, e.g., id.* at 159 nn.89-93, 161 nn.96-105, 206 nn.287-303, 232 n.382; *infra* notes 242-44 and accompanying text (sampling some of the scholarly opinions).

There might even be yet a fifth sense of “use”—to signify that “use” sufficient to support a charge of counterfeiting, including criminal liability for “using” a spurious mark in connection with trafficking in goods or services, the “use” of which is likely to cause confusion, to cause mistake, or to deceive within the meaning of § 2320 of the Trademark Counterfeiting Act. 18 U.S.C. § 2320 (2006); Folsom, *supra* note 3, at 164

### 3. Doctrinal Creep, Reverse Creep, Equivocation, and Feedback Loops

Having obtained a mark, the proprietor has acquired not a property interest in the designation, but a right to prevent an offending use that creates a likelihood of consumer confusion.<sup>150</sup> Ordinary trademark law, characterized by infringement based upon “likelihood of confusion” rather than upon any property in the mark, is in tension with other law and with countervailing trends in trademark law itself towards propertization of expressions.<sup>151</sup> Certain exceptions and doctrinal quirks in ordinary trademark law appear to very nearly countenance liability in the absence of any likelihood of confusion, and in these situations, trademark rights more nearly resemble property rights. “Doctrinal creep” is a name for the tendency that presses such exceptions and doctrinal adaptations from the extraordinary or extreme cases that spawned them back into the run-of-the-mill cases, exerting a pressure on ordinary trademark law itself.<sup>152</sup> The cases that exhibit doctrinal creep begin to approach an alternative rationale that would support a rule of liability in the absence of likelihood of confusion. Such cases include those that apply “initial interest confusion” in circumstances that are not as fitting or extreme as those that defined the doctrine.<sup>153</sup> They also include those that apply a dilution-style analysis to trademark cases not as extreme as those that created the doctrine, and to which dilution does not apply.<sup>154</sup>

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n.94. Of these four (or even five) “uses,” only one—the first one listed (the one which causes a likelihood of confusion)—is needed to support liability. See *supra* note 144.

150. RESTATEMENT §§ 18-20.

151. The entire anti-dilution project, which creates liability in the absence of likelihood of confusion, has about it something in the nature of propertization, as do other legal doctrines, collectively referred to as “doctrinal creep.” It would appear there is no general need to propertize words or language, and there is some reason to resist the tendency. See generally LANDES & POSNER, *supra* note 139, at 170-71 (noting that it “makes economic sense for frequently used words to be short” and giving examples of “efficient language rules” sufficient to establish “the only point that bears importantly on trademarks—that language is created and maintained and creatively altered without a system of property rights in words, grammatical forms, and so on” and concluding that the costs of enforcing a system of property rights in words “would be immense” and “may be a sufficient explanation for why there is no such system”).

152. See Folsom, *supra* note 3, at 164-68 (discussing doctrinal creep); Lemley, *supra* note 11, at 1698-1705.

153. Among the cases in cyberspace that raise concerns about this type of doctrinal creep are: *Playboy Enterprises v. Netscape Communications Corp.*, 354 F.3d 1020 (9th Cir. 2004); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999).

154. Folsom, *supra* note 3, at 164-67; see *infra* notes 172-74 and accompanying text (discussing dilution as trademark-related doctrine).

If doctrinal creep is confined to cases in which there is liability without any realistic likelihood of confusion, such as those cases pressing initial interest confusion and dilution beyond their ordinary confines, then doctrinal creep may be understood more generally as a pro-proprietor extension of liability. However, and at the same time, there is an opposite tendency at work, also encroaching on ordinary principles of trademark law, but from the opposite direction. It must be remarked there is also a sort of “reverse doctrinal creep” (an anti-proprietor contraction of liability) or equivocation by which some courts are declaring no infringement even where there might be a likelihood of confusion.<sup>155</sup> The leading examples of this “reverse creep” are based upon an equivocation in the term “use,” which in turn permits (or compels) a determination that some actors who have caused a likelihood of confusion, and even those who have caused actual confusion with predatory intent, have nonetheless failed to “use” a designation “as” a mark at all and so are outside the reach of trademark law altogether.<sup>156</sup>

This Article asserts “reverse creep” is based on an equivocation by which certain instances of “likelihood of confusion” in cyberspace did not result in liability because the offending conduct that caused such confusion did not, according to some courts, count as a “use” as a mark within the meaning of the law.

Of course, before there can be any liability for likelihood of confusion, there must be an offending *use*. But “use” is an

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155. Folsom, *supra* note 3, at 167 n.122.

156. It would appear such cases are not in accord with ordinary principles of trademark law. *See supra* notes 144, 149 (noting, with approval, the Restatement’s view that infringement consists in “marketing” goods or services by use of a “designation” that causes a likelihood of confusion as to source or sponsorship; and counting the four or five equivocal senses of the term: “use”—both of which argue against any separate “use” “as” a mark requirement as a necessary condition for a finding of trademark infringement); *see also* Folsom, *supra* note 3, at 167-68. Among the cases in cyberspace that raise concerns about this type of reverse doctrinal creep, or equivocation, are *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400 (2d Cir. 2005), and *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 620-22 (6th Cir. 1996). While expressing considerable, and well-founded skepticism concerning likelihood of confusion on the record before it, *1-800 Contacts* seems to have indicated it wouldn’t have made any difference to the outcome, even if there might have been a likelihood of confusion (a question not before the court, given its threshold finding there was no offending use for purposes of invoking any likelihood of confusion analysis). *1-800 Contacts*, 414 F.3d at 412. *Holiday Inns* included express findings of actual confusion as well as likelihood of confusion, and yet there was no liability, given the Sixth Circuit’s holding there was no offending use. *Holiday Inns*, 86 F.3d at 625-26. There are, however, some commentators who approve of a separate “use” “as” a mark requirement, at least as a threshold matter in cyberspace. *See infra* note 240 (summarizing).

equivocal word and there are at least four senses in which trademark law considers "use." There must be (1) some offending *use* that causes a likelihood of confusion<sup>157</sup> (2) in respect of a designation that is itself being *used* as a mark by a senior user. Moreover, if the Federal Lanham Act is invoked against infringement or to support registration, there must also be (3) a *use* in interstate commerce subject to federal jurisdiction, and (4) if the Federal Lanham Act is invoked in order to support registration, there must be a *use* which is evidenced by a formally submitted specimen of the mark as used and sufficient in the eyes of the Patent and Trademark Office (PTO) to obtain registration.<sup>158</sup>

A problem of equivocation occurs when someone mistakenly demands that an offending actor satisfy the same level of mark-creating "use" to avoid infringement as a mark proprietor must to ensure validity.<sup>159</sup> The mistake is to insist that an alleged infringer must have used a designation in a way that would have created a mark of its own. Instead, all the alleged infringer must do to incur liability is engage in conduct (to "use" a designation in marketing goods or services) causing a likelihood of confusion with a valid mark of another person, and hence with goods or services of the other.<sup>160</sup> The mark proprietor must, of course, prove validity of its own mark by proving the mark proprietor itself has used the designation in question as a mark. But then all the proprietor of a valid mark need show is that the alleged offending actor engaged in conduct employing a designation in such a way as to cause a likelihood of confusion with goods or services associated with the proprietor's mark—the offending actor must "market" goods or services using a "designation" that causes a likelihood of confusion, but it need do no

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157. But the "use" need only be of a "designation": all that is required of an offending actor is "marketing" of goods or services by use of a designation that causes a likelihood of confusion as to source, sponsorship or approval of those goods or services. *Supra* note 143; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 (1995).

158. Folsom, *supra* note 3, at 159-60 (first emphasis added).

159. The problem also occurs when someone mistakenly demands that an offending actor establish jurisdiction or registrability under the Lanham Act, *supra* note 149 (giving the four senses of "use" and specifying the three that apply only to the mark proprietor).

160. To be sure, the offending conduct must cause a likelihood of confusion with some sort of goods or services that are the same as, or related to, or substitutionary for or complementary of products associated with another's mark; or it must cause a likelihood of confusion of sponsorship, source, or the like—but that is simply what is meant by "likelihood of confusion" in the context of trademark infringement. If such qualifications as these need to be made more explicit, as by saying the offending conduct must cause a likelihood of confusion "in commerce" or some such thing, there is no harm done, and it is to be hoped the mistaken equivocation is still avoided without adding yet another equivocation in respect of "use in commerce" to the equivocation already in play: "use" *simpliciter*.

more than that to incur liability.<sup>161</sup> Equivocation of various “use” requirements that confuses or conflates the lower, offending-conduct type of “use” with the higher level sufficient-to-create a mark type of “use” introduces, at best, a needless complication<sup>162</sup> or an interesting distinction that pushes the inquiry back a step (perhaps ensuring some modest care in assessing certain cases of vicarious liability),<sup>163</sup> and at worst, a clear error.<sup>164</sup>

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161. Although it might seem to be begging the question, it is hard to think of a word for such “conduct” that causes a likelihood of confusion in connection with an expression other than the word “use” to signify that the actor has “used” the expression. All the conduct that is ever required of the offending actor is that it “market” goods or services using a “designation” that causes a likelihood of confusion. *Supra* note 144.

162. In a large number of cases, the alleged infringer, especially a good faith infringer who believes it has a legitimate right to use a particular expression as a mark, probably *will* use it “as” a mark. *See generally supra* note 140 and accompanying text (coinciding with the “easy” and perhaps common case remarked upon by SCHECHTER & THOMAS, *supra* note 131, at 637-38). But this is to complicate things to the point of missing the obvious wrongdoer who might very well *not* use an expression “as” a mark or might use without advertising or promotion of the type a mark proprietor might be expected to employ. Instead, and without advertising, publicity, or fanfare (and almost certainly with some degree of silence or secrecy), the actor simply passes off its goods or services as those of the mark proprietor, in a use that causes a likelihood of confusion. *See Folsom, supra* note 3, at 210 nn.302-03 (providing multiple examples of passing off, counterfeiting, and other offending uses that cause a likelihood of confusion without advertising or promoting the offending use). In cyberspace particularly, it is possible for an actor to place an expression as a marker, address, or magnet to draw traffic, or to warehouse an expression as spoiler, a roadblock, or detour to retard, waste, or divert traffic. *See id.* at 211. Surely these are “uses” and certainly the law must consider whether they are “uses” that cause a likelihood of confusion or that trigger liability on some other basis. *See id.* at 212 n.309. It is, in fact, the “nonuse” faction that is actually begging the question: is there liability? To answer by saying there can be no liability despite conduct that has caused a likelihood of confusion, because the conduct is no “use,” is to say something peculiar in light of the evident facts. *See supra* note 109 (expressing Bumble’s concern, not so much with the doctrine of coveture, but with the counterfactual nature of its consequences); *supra* note 144 and accompanying text (asserting the offending conduct comprises “marketing” goods or services using a “designation” that causes a likelihood of confusion); *see also Folsom, supra* note 3, at 232-33 (collecting authorities); *id.* at 159 nn.89-93, 161 nn.96-105, 206 nn.287-303, 232 n.382 (describing consequences).

163. If the “nonuse” faction is distinguishing direct from indirect liability, in the sense that, say, Google, Inc. is not “using” a trademarked expression merely by putting it in play as a keyword for targeted advertising, that still leaves at least two questions: (1) is Google’s customer, who purchased the keyword trigger, “using” it? And (2) if so, why wouldn’t Google, under ordinary principles applicable to vicarious or indirect infringement, have the potential liability of any other indirect infringer for such use? *See supra* note 97 and accompanying text. Indirect liability for invisible, attenuated, or expropriating uses in cyberspace must be handled in a separate article. *See discussion infra* Part III.E. In cases of vicarious liability involving a resource provider in space, it may be important to distinguish situations in which the provider is itself spoofed and

A “feedback loop” in trademark law consists of a question-begging exercise in circular reasoning about previously unsettled questions of trademark law based on assumptions about the very unsettled law at issue.<sup>165</sup> As Professor Denicola has pointed out in the context of promotional goods,<sup>166</sup>

[t]here is more than a little circularity in basing a legal right to control unauthorized ornamental use on the assumptions that consumers make about the official sponsorship of the ornamental items [when those assumptions themselves] rest in turn on consumers’ views about whether trademark owners have the legal right to control such use.<sup>167</sup>

As Professors Maggs and Schechter amplify the matter, whenever there is a “feedback loop” between “legal doctrine and public perceptions,” the law will find itself in a dilemma.<sup>168</sup> “If the law *forbids* third parties from [making any particular attenuated use of a mark], then consumers will always assume [any such uses] are ‘sponsored’ by that trademark owner, and they will be likely confused about sponsorship” if anyone else should make such an attenuated

is in some sense a victim (as when someone fools the provider into awarding a higher relevancy ranking than would otherwise be expected using the trademarks of another person) from situations in which the provider is cooperating (as by selling enhanced relevancy rankings keyed to trademarks or by selling keyword advertising triggers associated with trademarks).

164. To say that an offender must “use” an expression in such a way as to cause a likelihood of confusion is to say no more than that there must be some offending “conduct” that causes a likelihood of confusion. Folsom, *supra* note 3, at 209-10. It cannot be the case that no one offends unless that one is also trying to use the expression “as” a mark that would have been registrable to it in the first place. *Id.* (counting cases in which there is liability for offending conduct without any such “use”); *see supra* note 149 (describing four senses of “use” in trademark law and cyberspace); *supra* notes 144, 157 (asserting that the “use” which amounts to offending conduct comprises nothing more than “marketing” goods or services using a “designation” that causes a likelihood of confusion); *see also* Folsom, *supra* note 3, at 232-33 (collecting authorities); *id.* at 159 nn.89-93, 161 nn.96-105, 206 nn.287-303, 232 n.382 (describing consequences); *infra* notes 242-44 and accompanying text (sampling some of the scholarly opinions).

165. *See* MAGGS & SCHECHTER, *supra* note 14, at 308-09.

166. “Promotional” goods are those that bear a trademark and yet are almost certainly not made by the mark proprietor. *Id.* If there is any likelihood of confusion, it cannot be in relation to the source or origin of the promotional goods, but only in relation to sponsorship of them by the proprietor of the mark in question. *See supra* note 143 (implying no one thinks the mark-bearing jackets, baseball caps, coffee mugs, key chains, and the like are produced by mark proprietor). If one didn’t already know that such sponsorship could be assumed, one would not be able to be confused. *See supra* note 160.

167. Robert C. Denicola, *Freedom to Copy*, 108 YALE L. J. 1661, 1668 (1999); *accord* MAGGS & SCHECHTER, *supra* note 14, at 309.

168. MAGGS & SCHECHTER, *supra* note 14, at 308-09.



use without authorization from the mark proprietor.<sup>169</sup> But “if the law *permits* third parties to use marks on goods of this sort, consumers would quickly come to learn that numerous vendors” make such uses and “there would be no confusion on encountering such items in the marketplace.”<sup>170</sup> When the legal issue presented is whether there *is* any legal right to prohibit the attenuated use in question, it would seem the feedback loop is an exercise in circular reasoning that begs the question. The phenomenon is not limited to the problem of promotional goods, but is more general in trademark law. The feedback loop is exemplified in the current approaches to invisible, attenuated, and expropriating uses of marks in cyberspace, and the desired solution should guard against it, or at least be explicitly aware of it.<sup>171</sup>

#### 4. Trademark-Related Laws, Rules, and Norms

Of course, trademark is not the only game in town, and there are other statutes, private ordering arrangements, and various other self-help remedies, norms, and related laws that also affect mark-type conflicts in cyberspace. Each of these adds their own “factors” into the already crowded list of factors with which ordinary trademark law already deals. Among the more significant of these cognates pertinent to marks in space are:

(1) the Federal Trademark Dilution Act (FTDA),<sup>172</sup> as amended and replaced by the Trademark Dilution Revision Act (TDRA),<sup>173</sup> establishing a dilution offense against a mark;<sup>174</sup>

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169. *Id.* (emphasis added) (speaking in the context of promotional goods).

170. *Id.* at 309 (emphasis added).

171. *See, e.g.,* Panavision Int'l. L.P. v. Toppen, 141 F.3d 1316, 1324-27 (9th Cir. 1998) (extracting a conclusion of consumer confusion from what this Article refers to as an attenuated or expropriating use of a mark: if the mark proprietor had the exclusive right to use its trademark in an Internet domain address, then if a third party were to appropriate the domain name, and warehouse it even without making any other “use” of it, consumers would still attribute the domain name’s inactivity to the mark proprietor and would still suffer a likelihood of confusion as a result—but the question before the court was whether the mark proprietor had any such exclusive right). Of course, the feedback loop in relation to invisible, attenuated, and expropriating uses in cyberspace under the current case law goes the opposite direction as well. That is, if we simply assume the mark proprietor has no exclusive right to the use in question, then there cannot be any consumer confusion.

172. Federal Trademark Dilution Act (FTDA) of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. § 1125(c) (2006) (sometimes referred to as § 43(c) of the Lanham Act)).

173. Trademark Dilution Revision Act (TDRA) of 2005, Pub. L. No. 109-312, 120 Stat. 1730 (2006) (codified at 15 U.S.C. § 1125(c) (2006) (sometimes referred to as § 43(c) of the Lanham Act)).

(2) the Anti-Cybersquatting Consumer Protection Act (ACPA),<sup>175</sup> establishing a squatting offense against a mark incorporated within a domain name on the Internet;<sup>176</sup>

174. The dilution offenses reach any commercial use in commerce that “lessens the capacity” of a famous mark to identify and distinguish goods or services . . . by blurring the capacity of the proprietor’s mark to distinguish the proprietor’s goods or services or by tarnishing the reputation of the proprietor’s mark . . . even in the absence of any competition between the offending party and the mark proprietor and in the absence, therefore, of any likelihood of confusion . . . .

Folsom, *supra* note 3, at 171-72 (citing Lanham Act §§ 43(c)(1), 45). Dilution “factors come in as guidance on the question of the ‘fame’ or ‘highly distinctive’ nature of a mark because anti-dilution protection is strictly limited (so it was hoped) to only those marks that are famous and highly distinctive.” *Id.* at 173 (citing Lanham Act § 43(c)(1)).

The FTDA provides a list of eight non-exclusive factors for guidance as to what constitutes fame: (1) the degree of inherent or acquired distinctiveness of the mark, (2) the duration and extent of use of the mark in connection with the goods and services with which it is primarily associated, (3) the duration and extent of advertising and publicity of the mark, (4) the geographical extent of the trading area in which the mark is used, (5) the channels of trade for the goods and services with which the mark is primarily associated, (6) the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s proprietor and by the offending party, (7) the nature and extent of concurrent use of the same or similar designations by third parties, and (8) whether the mark was federally registered.

*Id.* at 173-74 (discussing FTDA/TDRA factors).

175. Anti-Cybersquatting Consumer Protection Act (ACPA) of 1999, Pub. L. No. 106-113, 113 Stat. 1501 (codified at 15 U.S.C. § 1125(d)(1)(A)(i) (2006)) (sometimes referred to as § 43(d) of the Lanham Act).

176. “The ACPA creates an action in favor of a mark proprietor against a ‘cybersquatter’ who (i) has registered, is using, or is trafficking in a domain name that is confusingly similar to the proprietor’s mark, and (ii) has done so with a ‘bad faith intent to profit’ from the designation.” Folsom, *supra* note 3, at 174 (citing Lanham Act § 43(d)(1)(A)). There is another provision to protect personal names against “cyberpiracy,” codified at 15 U.S.C. § 1129, and sometimes referred to as § 47 of the Lanham Act. Cybersquatting factors come in as guidance on what constitutes “good faith” or “bad faith.”

The first four ACPA factors tend to indicate good faith: (1) whether the offending party can show any trademark rights of its own in the designation, (2) whether the designation is actually the name of the offending party, (3) whether the offending party has ever used the designation in any legitimate business activity apart from the domain name transactions, and (4) whether the offending party is making a bona fide noncommercial or “fair” use of the designation. The next four ACPA factors tend to indicate bad faith: (5) whether the offending party has an intent to divert consumers from the mark proprietor’s online location to an offending site that could “harm the goodwill” of the proprietor’s mark, (6) whether the offending party offered to sell the designation to its proprietor without ever having legitimately used it or has engaged in a past pattern of making such offers, (7) whether the offending party supplied false identifying information when it applied for the

(3) the quasi-privately ordered Uniform Domain Name Dispute Resolution Policy (UDRP) included in the user agreements incident upon private registration of a domain name with an ICANN-influenced registrar,<sup>177</sup> establishing rights to protest another's domain name registration;<sup>178</sup>

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domain name or has engaged in a past pattern of such conduct, and (8) whether the offending party has registered multiple domain names similar to the trademarks of multiple other persons. The last of the ACPA factors is (9) the strength or fame of the proprietor's mark.

Folsom, *supra* note 3, at 174-75 (discussing ACPA factors).

177. Internet Corporation for Assigned Names and Numbers (ICANN), Uniform Domain Name Dispute Resolution Policy (UDRP) (as approved by ICANN on Oct. 24, 1999), <http://icann.org/dndr/udrp/policy.htm>.

178. See Folsom, *supra* note 3, at 176-77.

A trademark proprietor will prevail against a person who has registered the proprietor's mark as part of a domain name upon demonstrating three elements: (i) the domain name in question is identical or confusingly similar to a trademark in which the proprietor has rights, (ii) the domain name registrant has no rights or legitimate interests in the offending designation included in the domain name, and (iii) the offending domain name was registered and is being used in bad faith.

The UDRP provides a set of four non-exclusive factors to provide guidance on what constitutes "bad faith" as contemplated by the third element of the UDRP complaint: (1) whether the offending user (domain name registrant) registered or acquired the domain name primarily for the purpose of selling, renting, or transferring the domain name either to the trademark proprietor or to a competitor of the proprietor for a price in excess of the cost of acquiring the domain name, (2) whether the offending user registered the domain name to prevent the trademark proprietor from using its mark in a domain name, or the offending user has engaged in a pattern of such conduct, (3) whether the offending user registered the domain name primarily to disrupt the business of a competitor, or (4) whether by using the domain name the offending user has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the proprietor's marks as to source or sponsorship.

The UDRP provides three more factors, also non-exclusive, to give guidance on how to show whether the offending user has some right or legitimate interest in the offending designation included in the domain name, as contemplated in the second element of the UDRP complaint: (5) whether, before any notice to the offending user of the dispute, the offending user had made use of or demonstrable preparations to use the designation included in the domain name in connection with a bona fide offering of goods or services, (6) whether the offending user has been commonly known by the designation included in the domain name even if the offending user never acquired any trademark rights in the designation, or (7) whether the offending user is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

*Id.* (discussing UDRP factors).

(4) the general law of unfair competition, establishing basic norms at least against passing off and against the misappropriation of certain intangible trade values;<sup>179</sup> and

(5) various other constraints and influences arising out of the general architecture<sup>180</sup> of cyberspace and self-help mechanisms embraced by those who traffic there.<sup>181</sup>

Adding to the trademark factor analysis already discussed, each of the TDRA, ACPA, UDRP, unfair competition, and architectural

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179. See generally RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2-8 (1995) (discussing the passing-off style of unfair competition and deceptive marketing, and relevant factors); *id.* §§ 38-49 (discussing the misappropriation-style of unfair competition, and factors relevant to a non-open-ended tort limited to defined classes of intangible trade values).

180. See LESSIG, *supra* note 10, at 40 (discussing an architecture, or “code” of security for commerce in cyberspace). “For commercial use of the Internet and of cyberspace, Professor Lessig observes that ‘the Net will need a far more general architecture of trust—an architecture that makes possible secure and private transactions.’ The elements, or factors, of this architecture include (1) authentication, (2) authorization, (3) privacy, (4) integrity, and (5) non-repudiation.” Folsom, *supra* note 3, at 177-78 (quoting LESSIG, *supra* note 10, at 40 (summarizing observations made by Gail Grant)) (discussing architectural factors).

181. One representative of self-help remedies arising out of the architecture of cyberspace is the Mail Abuse Prevention System Realtime Blackhole List (MAPS RBL). These are social norms promulgated at least as early as 2000 by MAPS, a California limited liability company. See RADIN ET AL., *supra* note 17, at 23-25 (describing MAPS, and noting the limits of concerted private action as a way of exercising control); see also Revised Rationale for RBL, July 19, 2000, <http://www.mail-abuse.org/rbl/rationale.html>; Definition of Spam, [http://www.mail-abuse.com/spam\\_def.html](http://www.mail-abuse.com/spam_def.html) (last visited Apr. 6, 2007); Guidelines for Reporting Email Abuse, [http://www.mail-abuse.com/pdf/AN\\_Reporting\\_SPAM\\_052604.pdf](http://www.mail-abuse.com/pdf/AN_Reporting_SPAM_052604.pdf) (last visited Apr. 6, 2007) [hereinafter MAPS Guidelines]. MAPS has been acquired and is now part of Trend Micro Inc. See MAPS Website, <http://www.mail-abuse.com/index.html> (last visited May 22, 2007).

MAPS is a self-help response that seeks to isolate abusive conduct by blacklisting and denying access not just to “spammers” but to the Internet Service Providers (ISPs) that host or otherwise enable them. A recipient of spam may nominate a spammer for inclusion on the Realtime Blackhole List (RBL). If a spammer is blacklisted, then the host ISP or other ISP that enabled the spammer will itself be blacklisted. Many non-offending ISPs have voluntarily subscribed to the list, and they will use the blacklist automatically to reject mail sent from any domain name hosted or enabled by any of the offending ISPs on the blacklist. The offending ISP is treated as an aider and abettor to the spammer that resides on the ISP or runs data through it, and the object of this private ordering system “is to provide blacklisted ISPs with a powerful incentive to get themselves off the list, which they can accomplish by conforming to MAPS’ rules.” The offending conduct is spamming, and spam is defined in the rules. In addition to these private self-help measures, there are laws regulating spam.

Folsom, *supra* note 3, at 178-79 (footnotes omitted) (discussing MAPS as a private ordering norm arising out of an architectural factor).

considerations generates yet additional factors for analysis, each adding another level of detail to the overall mix of factors.

*D. This Is a Systemic Failure, Predicted by New Institutional Economics*

As previously asserted, and as demonstrated in my prior articles, the leading cases are not just in conflict with each other and with ordinary principles of trademark-related law, they are wrongly decided. They do not reach the correct results, but instead they reward reverse domain name hijackers;<sup>182</sup> they overlook real instances of preclusion-style initial interest confusion<sup>183</sup> even as they generally overextend that doctrine;<sup>184</sup> they mistake the reach of weak or nonexistent marks while turning cyberspace into an outlaw zone;<sup>185</sup> and they privilege pirates while threatening legitimate mappers who seek to fund their activities by charging for targeted advertising.<sup>186</sup> They do not reach their results for the right reasons, but instead misapply the doctrine of initial interest confusion,<sup>187</sup> and by equivocation misapply the threshold requirement that there must be an offending "use."<sup>188</sup> They are not, despite their obvious care and attention to detail, meticulous craftsmanship, and elegant language,<sup>189</sup> persuasively reasoned. No amount of careful prose can

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182. This is the result in *Brookfield*, 174 F.3d 1036 (9th Cir. 1999), where the court awarded preliminary injunctive relief against the defendant because of trademark infringement in the domain name.

183. This is what happened in *Netscape*, 354 F.3d 1020 (9th Cir. 2004).

184. Overprotection by overextension of initial interest confusion is a product of *Brookfield* and *Netscape*.

185. This is the result of *1-800 Contacts*, 414 F.3d 400 (2d Cir. 2005).

186. It is hard to escape the conclusion that the result in *Holiday Inns* was to privilege a pirate, who intentionally diverted business intended for the proprietor of the Holiday Inn trademark, and that the result in *Netscape* was to create vulnerability for value-added resource providers who were trying to pay for their activities by way of keyword-triggered targeted advertisements keyed on trademarked expressions.

187. *Brookfield* and *Netscape* misapply a radical version of initial interest confusion to invisible and attenuated users in cyberspace who placed magnets and addresses to draw traffic.

188. *1-800 Contacts* and *Holiday Inns* misapply a misplaced "use" requirement to rule out entirely the possibility of legal regulation of activity that (at least in the case of *Holiday Inns*) clearly resulted in actual confusion, intentionally designed to prey upon consumer mistakes in finding a desired product source. See *1-800 Contacts*, 414 F.3d at 400; *Holiday Inns, Inc., v. 800 Reservation, Inc.* 86 F.3d at 619, 621 (6th Cir. 1996).

189. There can be no doubt that each of the representative decisions is the result of analysis and of careful thought. The fact that they fail is not, therefore, because of any failure of effort or care on the part of the juridical agents involved. It is, instead, because of a systemic failure in the law of trademark-related offenses in cyberspace to

disguise the clear sense that these cases are simply wrong on the merits, in their reasoning, or both.<sup>190</sup> The first set of cases overprotects and the second set of cases underprotects marks in space.

Meanwhile, the third set of cases—the representative ad hoc cases between the overprotection and underprotection extremes—are examples of overreliance on related law and special statutes outside of trademark law. They leave the common law ill-equipped to react to the predictable next generation of cases that will fall outside of the special statutes. The law might, of course, simply play a constant game of statutory catch-up, with a new, almost immediately outdated, statute du jour enacted from time to time to meet the formerly new technological offense du yester-jour.<sup>191</sup>

None of this is surprising. Each of the cases seizes upon a doctrine not unheard of within ordinary trademark law, and each of them has a certain kind of logic.<sup>192</sup> The particular and general

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provide a useful rule of thumb for efficient resolution of unusual (in ordinary space) but run-of-the-mill (in cyberspace) cases.

190. This is not to derogate the reasonable concerns and accommodations reached in those cases, *see supra* Part I.B.1-3, but to claim that existing law is to blame, if anything is, because it is the home of heretofore latent antimony or paradox, now exposed in cyberspace. When juridical agents faithfully attempt to apply existing law and yet reach plausible but opposite results, the fault is not with the agents. *See Folsom, supra* note 8, at 89 n.90 (repeating a startling reversal rate in certain patent cases, and suggesting it may be due to incoherencies in the law, rather than the collective fault of the district court judges).

191. But that would seem to be, on the face of it, a bad idea. *See Lewellyn, supra* note 12 (offering up the law's delay in coping with new relationships as a deficiency in the law). Consider also the lingering impact of obsolete technologies on the law itself—while search engine technology may have left behind the metatag strategy employed by the junior user in *Brookfield*, the case still casts a powerful shadow: (1) it still stands for the proposition that initial interest confusion attaches when there is any effective magnet, and (2) it should not be gainsaid that it at least possibly created a feedback loop of its own—perhaps the older word count algorithm was an efficient one for search engines to employ, and if the law had prevented the use of trademarked or other terms to spoof the algorithm, either the algorithm would still be in use, or (when replaced or downgraded) the algorithm would have been replaced or downgraded because of efficiency concerns rather than as a result of a legal determination that left it vulnerable.

192. If it were not, in fact, the case that an effective magnet does draw potential consumers on the strength of the goodwill of another's mark, and if it were not, in fact, the case that an attenuated or invisible use is not easily reconciled with a "likelihood of confusion" standard, the cases would be truly inexplicable and unexpected. But because each line of cases does recognize an operative fact relevant to trademark law, each represents a level of workmanship that exonerates the juridical agents involved, but indicts the current rules and norms under which the juridical agents are operating. This Article contends the failure is systemic, and therefore will not be remedied by any "more careful" application of existing rules, but only by the designed development of a transformed rule—in short, the new factor specified by this Article.

failures manifested in trademark law in cyberspace are not entirely unique to trademarks in cyberspace and are not wholly unexpected.<sup>193</sup> New Institutional Economics (NIE) predicts this sort of failure whenever any agent is possessed of limited time and resources, and when other conditions are also present.<sup>194</sup>

The conditions predicting juridical failure in cyberspace include: (1) a number of juridical agents having no special training or expertise in cyberspace or in intellectual property, no rational incentive or opportunity to gain such expertise, and only sporadic and occasional exposure to cases that raise the issues;<sup>195</sup> (2) a relatively complex, not to say metaphysical field of law, with specialized doctrines, equivocal word usage,<sup>196</sup> and an uncertain intersection with related fields<sup>197</sup> well known to some but not to all

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193. Having begun with the data, *see supra* note 71, and having now arrived at a perplexing conclusion, it is now appropriate to inquire whether there might be some theory to explain why the cases have so completely resisted a good solution. New Institutional Economics (NIE) provides some intriguing suggestions. *See* Folsom, *supra* note 4, at 113-14 (quoting, in each instance, Professor Stephen Bainbridge and others for the underlying insights, which were then developed by Professor Bainbridge in the context of the business judgment rule); Folsom, *supra* note 3, at 228-32.

194. *See, e.g.*, Folsom, *supra* note 4, at 113-14; Folsom, *supra* note 3, at 140-47.

195. *See* Folsom, *supra* note 4, at 113-14.

196. As many as thirteen likelihood of confusion factors derived from the common law, *see supra* notes 138-39, need to be applied with sensitivity towards seven generalizations and observations most relevant to cyberspace, *see supra* notes 140-47 and accompanying text, all without excessively propertizing trademark by doctrinal creep on the one hand, or minimizing its domain by reverse doctrinal creep on the other, or falling into equivocal word usage or assumptions in any event.

197. Some thirteen likelihood of confusion factors and seven generalizations and observations relevant to cyberspace might intersect with as many as eight anti-dilution factors determined by federal statute (FTDA/TDRA), *supra* note 174; nine anti-cybersquatting factors specified in federal statute (ACPA), *supra* note 176; seven uniform dispute resolution factors established by private contract or consent (UDRP), *supra* note 177; an indeterminate number of unfair competition factors derivable from the common law or summarized in the Restatement, *supra* note 179 and accompanying text; five factors suggested by the underlying architecture of the code itself, *supra* notes 141-47 and accompanying text; and an indeterminate number of other factors, derivable from various observable norms (MAPS or other self-help regimes), *supra* note 181, in order fully to evaluate any one particular case. This, of course, might be relatively straightforward in practice and it might be easy enough to combine all these factors and factor sets as necessary, carefully sifting each as applicable to any given problem. That is, it might be said that all any juridical agent need do is be more aware of existing rules, and apply them more sensitively. But there is more to overcome, and at some point an overload might be expected, especially when judges must rely upon the instrumental interpretations offered in the sometimes uncollegial context of litigation, and always under time pressure and page limitations.

juridical agents<sup>198</sup> that is made worse because much of this is masked behind an apparently simple, short, and easy rule set;<sup>199</sup> and (3) those occurring within a specialized context that introduces a level of real and apparent technological complexity beyond the prior training of, or even antithetical to, the common training and customary thinking of many juridical agents.<sup>200</sup>

Some have suggested this may not be so difficult a problem to solve, and it may be that all any juridical agent needs to do is be more vigilant, not only in counting factors, weighing and balancing them, but in doing so with an appreciation of the underlying principles that inform them.<sup>201</sup> But if it really were possible to apply “ordinary principles of trademark law” to invisible and attenuated uses in cyberspace under these conditions and constraints, it might be expected it would have happened already. Thus, the cases would not be in conflict with each other, decided wrongly, and contrary to the principles of ordinary trademark law.

Instead, given the complications listed and notwithstanding the excellence of the juridical agents involved, it would be odd if they did get things exactly right.<sup>202</sup> This is a simple observation, reinforced by clear predictions of NIE.<sup>203</sup> If the problem is by the NIE book, the

198. Some juridical agents are lawyers (and judges or professors) who have specialized in trademark-related law, including trademark registration practice under the Lanham Act, transactional counseling to clients, and litigation. Others are less specialized, or are new to the field.

199. The black-letter portion of the Restatement is surprisingly brief (and so is the Lanham Act), and its application may seem easy. *See supra* notes 134-35. One might be excused for thinking “likelihood of confusion” is a simple, short, and utterly intuitive standard, one that a child could understand and apply without any need for reflective thought, much like an oversimplified version of the tort law “negligence” standard that it so superficially resembles.

200. The failure of the law to define cyberspace or to characterize what happens among the typical users there might be the “last straw” which breaks the back of the juridical agent, finally causing, or revealing, the underlying systemic capability problem. *See UsingEnglish.com*, <http://www.usingenglish.com/reference/idioms/last+straw.html> (last visited on July 6, 2008) (“The last straw is the final problem that makes someone lose their temper or the problem that finally brought about the collapse of something. It comes from an Arabic story, where a camel was loaded with straw until a single straw placed on the rest of the load broke its back.”); *see also* NationMaster.com, <http://www.nationmaster.com/encyclopedia/straw-that-broke-the-camel's-back> (last visited Aug. 22, 2008) (“This is a reference to any process by which cataclysmic failure . . . is achieved by a seemingly inconsequential addition . . .”).

201. *See infra* note 242 (recommending a more careful application of ordinary principals as a solution to the problem of trademark-related disputes in cyberspace).

202. *See supra* notes 120-23, 182-90 and accompanying text (privileging pirates and threatening value-added mappers, indexers, and resource providers, which are the wrong results, for the wrong reasons, unpersuasively explained).

203. *See supra* notes 193-200 and accompanying text (relying especially on Professor Stephen Bainbridge).



solution is also by the NIE book. What is needed is a new rule of thumb, a new heuristic or at least a transformed, yet recognizably law-based factor that will allow juridical agents to rationally do what they are competent to do best—to exercise judgment in accordance with rules based on everyday observations, possible of demonstration in a juridical forum, and capable of predictable, principled, and practical resolution.

It might be taken as established that there is currently a problem with marks in space. It is an explicit claim of this Article that doctrinal, analytic, and descriptive methods lead to that conclusion, and that it is not merely an arbitrary determination. The next part of this Article relies upon the preceding analytic and descriptive claims that there is an objective cyberspace comprising an architecture with a foundational activity set that constitutes its nature or values,<sup>204</sup> and within which ordinary principles of trademark-related laws have led to cases that are in conflict.<sup>205</sup> Part II will seek to derive objective factors appropriate for adapting ordinary principles of trademark-related law to cyberspace and it will propose a transforming factor: “the nature and place of use” to adjust any given legal domain, including trademark-related law, to the reality of contests in such a cyberspace.<sup>206</sup>

## II. ANALYZING THE PROBLEM (OBJECTIVE FACTORS)

In the following subsections, three analytic propositions will be stated, but under separate subheadings. To aid in keeping the propositions recognizably in order, each of the three will be designated by a bold-faced, sequential number.<sup>207</sup> The first two propositions are in the nature of preliminary expressions, leading to the third. The third proposition yields a general factor (“the nature and place of use”). All three propositions are primarily in the nature of analytically objective statements, derived from the previously reported facts and inferences about cyberspace, what happens there,

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204. *Supra* notes 34-52 and accompanying text; Folsom, *supra* note 4; Folsom, *supra* note 3, at 140-47.

205. *Supra* notes 107-09 and accompanying text; Folsom, *supra* note 4, at 101-09; Folsom, *supra* note 3, at 225-27, 236-37.

206. Folsom, *supra* note 4, at 117-18; Folsom, *supra* note 3, at 236-37.

207. This Part II presents propositions 1-3. Part III will present further propositions 4-6. For convenience, all six propositions are abstracted and printed, in order, in Appendix A to this Article. The propositions are explained in this Article in the order of presentation. For convenience, an alphabetized glossary is appended as Appendix B.

and the applicable principles of ordinary law related to mark-type conflicts in space.<sup>208</sup>

A. *Positing a First Statement: Cyberspace*

“Markers” are used in cyberspace as invisible or attenuated addresses or magnets. “Spoilers” are used as roadblocks or detours. Both markers and spoilers constitute invisible and attenuated uses, and some of them constitute expropriating uses.<sup>209</sup> Accordingly, a first set of terms proposed by this Article permits the shorthand, but highly specified expression:

01 The problem for trademark law is what, if anything, to do about *markers or spoilers that are invisible, attenuated, or expropriating uses in cyberspace* (and incidentally, by or through a *cyberspace gateway* implicating in various degrees a characteristic *cyberspace activity set*). The desired legal solution is one that will enhance that activity set for the aggregate benefit of the *typical actors* in cyberspace in the context of trademark-related disputes.

In evaluating this first expression, here is what the highlighted terms signify:

*Invisible, attenuated, or expropriating trademark-type uses in cyberspace* are uses of a designation by an actor that include a trademarked term of another, and which serve as an invisible or attenuated address or magnet to draw users or electronic agents to the actor rather than to the other (a marker), or which operate as a roadblock or detour effectively expropriating and preventing another from employing its own marks (a spoiler). Such invisible, attenuated, or expropriating addresses, magnets, roadblocks, and detours function as markers or spoilers rather than, or in addition to, serving “as” a mark on the Internet or elsewhere in cyberspace. Invisible or attenuated markers are said to be invisible or attenuated relative to an ordinary observer (they are markers not necessarily promoted or associated with goods or services in a way immediately visible to an observer), even though they are embodied in a tangible medium of expression from which they can be perceived, reproduced, or communicated, including by way of a machine or other device.

An example of an invisible and attenuated use would be an embedded tag or other marker within a Web site, ordinarily invisible to a user, but which is designed to reach a search engine such as

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208. See *supra* Part I (presenting those facts and drawing the related inferences).

209. Sometimes it is easier and more convenient simply to refer to all invisible, attenuated, or expropriating uses as “markers” in cyberspace, but sometimes it is important to distinguish markers from spoilers. In this Article, the context should make it clear how the expressions are being used.

Google in order to draw traffic to a site of someone other than the mark proprietor. Another example would be a keyword marker based on a trademarked expression that triggers targeted advertising for goods or services offered by a competitor of the mark proprietor. An example of an expropriating use would be the preemptive registration of another's mark as an address, such as a vanity phone number or domain name. Invisible and attenuated uses are, in a sense, similar to the use of expressions in ordinary space by information aggregators/brokers, or in comparative advertising to point to another product or provider, or by a consumer who simply chooses to use someone else's mark in a nominative sense. Invisible or attenuated uses in ordinary space are in contrast to the "ordinary" use of an expression "as" a mark, or in some other "ordinary" offending but highly visible use in marketing the actor's goods or services that causes a likelihood of confusion. Because of the nature of cyberspace, it is also possible to use a marker as a roadblock or as a detour. These, too, constitute invisible, attenuated, or expropriating uses and can be distinguished (if necessary) from pure markers by referring to these users as spoilers.

*Cyberspace* is an embodied switched network for moving information traffic (a cyberspace "gateway" or an architecture), further characterized by varying degrees of access, navigation, information-activity, augmentation, and trust on the network (a foundational "activity set"). High (or deep) space displays a higher degree of these foundational characteristics than low (or shallow) cyberspace: an operational definition. Compare "shmyberspace"<sup>210</sup> as a rough synonym for low or shallow cyberspace, and contrast "the metaverse" as a term that signifies a virtual reality, or shared images, almost approaching a consensual hallucination.<sup>211</sup>

A *cyberspace "gateway"* is an embodied switched network for moving information traffic. It constitutes the threshold of cyberspace and is part of its architecture. Examples include the Internet and the phone system. The gateway is a necessary, but not a sufficient condition for cyberspace, as it is one part of the operational definition of cyberspace.

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210. See, e.g., Folsom, *supra* note 4, at 100 (recounting Schechter and Thomas' use of "shmyberspace" and Sommer and others' concern with overhyping of cyberspace); *id.* at 96 n.49 (a manifesto of cyber-exceptionalism). The terms proposed herein are intended to accommodate both sides. True and high cyberspace really is an objective place with definable values. Shmyberspace, on the other hand, is scarcely any special place at all, and like low cyberspace, it involves little more than ordinary transactions transposed into a new medium without much to add to ordinary law.

211. See *supra* notes 25-26 and accompanying text.

The *cyberspace* "activity set" is as set forth above (it includes various degrees of access, navigation, information-activity, augmentation, and trust). The activity set is the other part of the operational definition of cyberspace.

*Markers or spoilers in cyberspace* are expressions placed in cyberspace and that function as an address, magnet, and/or mark to draw a user to an expected destination (a marker), and sometimes as a roadblock or detour to deceive or to hinder a user from reaching an otherwise expected destination, or to prevent a mark proprietor from employing its own marks as addresses (a spoiler).

*The typical actors in cyberspace in the context of trademark-related disputes* include surfers and mappers, spoofers and trappers, spoilers and arbitrageurs, shills and advertisers, shoppers, consumers, competitors, and mark proprietors. If the public interest in trademark law generally (and in ordinary space) is already balanced among consumers, competitors, and mark proprietors, then the aggregate balance in cyberspace should not only preserve the preexisting balance but also, other things being equal, favor mark proprietors, surfers, shoppers and mappers over spoofers, trappers, spoilers, shills, and expropriating users. The public's interest in the activities of various rent-seeking arbitrageurs, including information brokers and aggregators, will vary according to the specific conduct involved.

Because the terms have been thus specified, it is possible to talk about invisible, attenuated, or expropriating uses in cyberspace, and in relation to a phone system or the Internet in a way that is meaningful. Thus, we are able to identify what it is we are discussing, and also what we are not. We may also assert there is a "problem" that has a "desired" solution at least in a contingent, and somewhat analytical, sense.<sup>212</sup>

### *B. Positing a Second Statement: Cyberspace Interventions*

Addresses or magnets are embodied as markers in an objective cyberspace. They exist precisely because they have a persistent, objective ability to bend, draw, or otherwise attract an augmented presence in space. They do not exist at random or by accident, but

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212. See *supra* notes 55-56 (proposing a contingent or hypothetical "good" and "bad" for cyberspace, but primarily as an analytical and hypothetical rather than as a deontological proposition). By the way, if this usage is too imprecise, then let it be said that these first three propositions are simply "more" analytical than the last three propositions, which are "more" normative, and let it be said that each has a little of both. That is to say, in no sense does the solution proposed by this Article depend upon whether its moral taxonomy is rightly named or whether its compartments are watertight, but they do seem to be useful categories, usefully suggestive of a productive methodology.

are designed to draw traffic. Roadblocks or detours function as spoilers and exist because they can spoil navigation by detouring or hindering a user from reaching an expected destination, or by putting an expression off limits as an address available to someone else. An additional set of terms captures the problem in the law's current response to invisible and attenuated uses. These permit a second shortened, but highly specified expression:

**02** Invisible, attenuated, or expropriating uses in cyberspace can constitute potentially *offending uses* of designations that may cause a likelihood of confusion, or that may spoil and prevent marks from functioning as addresses otherwise available to a mark proprietor, to the extent they are objective and persistent *cyberspace interventions* with observable effects on *cyberspace users*.

In evaluating this second expression, here is what the highlighted terms signify:

*Cyberspace Interventions* are consented or unconsented, harmless or predatory, value-adding or free-riding activities by an actor in cyberspace that have an objective effect on other persons or electronic agents, especially by drawing other persons or agents to a destination; by inviting or influencing other persons or agents (including directories or search engines) to list a destination as something different from or more relevant than what it is; or by preventing ready navigation to an otherwise intended destination. *Cyberspace interventions* are usually described from the point of view of the other person or persons affected.

*Cyberspace Users* are a subset of the typical actors in cyberspace. Of the larger group of typical actors, it is surfers, shoppers, and consumers of varying levels of expertise and awareness who will generally be the focus of concern because they will be the supposed victims of likelihood of confusion. The same user might simultaneously act in more than one capacity and on more than one level of expertise or awareness, or a user might sequentially move from one capacity or level to another (the term includes electronic agents). In the context of expropriating use, spoilage, or waste of a mark or its goodwill, the cyberspace user also includes the mark proprietor or the creator of the goodwill, as well as the actor who has expropriated the goodwill of the mark.

*Offending Use* is conduct that may cause a likelihood of confusion or other specific harm in connection with marketing of goods or services. In cyberspace, an offending use includes:

[Alt. 1]. Use of an expression as an address, magnet, or mark that may cause a likelihood of confusion in connection with marketing goods or services; or as a roadblock or detour in connection

with, or as an interference with, marketing goods or services that either causes a likelihood of confusion or spoils, wastes, blocks or expropriates the value of a mark of another (see "cyberspace interventions" for an alternate formulation: offending "use" consists in any cyberspace intervention that causes one of the specified harms).

[Alt. 2]. Any conduct which causes an expression (1) to be perceived or communicated, or fixed in a tangible medium of expression from which it may be perceived, reproduced, communicated, or inserted, either directly or with the aid of a machine or device, (2) by or to any person, machine, device, or agent, including an electronic or technologically-based agent, now known or later developed (3) in connection with marketing goods or services, and (4) which causes a likelihood of confusion; or which draws, pulls, or diverts another person or virtual agent away from an intended location; or which spoils, wastes, blocks, or expropriates the mark of another; or by which marketing messages based upon a senior mark might be intercepted, diverted, or blocked.

Because the terms have been defined, it becomes possible to discuss whether, when, and how, exactly, it is that invisible, attenuated, or expropriating uses actually can lead to a likelihood of confusion or can spoil addresses or expropriate or waste trademarks and their associated goodwill in cyberspace. It is one of the assertions of this Article that when an invisible, attenuated, or expropriating use by a cyberspace actor constitutes a deliberate cyberspace intervention with a real effect on a cyberspace user, it is an activity that can lead to a likelihood of confusion or that can cause spoiling, attenuated likelihood of confusion, or expropriation in cyberspace, and is within the scope of trademark-related law and a trademark-like remedy.

Importantly, if trademark law is not to fall into the antitechnology snare that so bewildered copyright for nearly seventy years, these definitions are not only reasonable and permissible, but they are urgently needed. Consider copyright's problematic assertion—enshrined in 1908 by the Court's formulation in *White-Smith*<sup>213</sup> and not undone in all its ramifications until after 1976<sup>214</sup>—

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213. *White-Smith Music Co. v. Apollo*, 209 U.S. 1, 17 (1908) (defining a copy of a musical composition to be "a written or printed record of it in intelligible notation" and observing that the musical tones produced by the player piano roll at issue in the case were "not a copy which appeals to the eye"). It would be fair to say that *White-Smith* required a "visually perceptible" copy and that it rejected unreadable matter.

214. *White-Smith* by its terms affected copyright infringement by unauthorized copies, but its ramifications also extended to creation and publication of works of authorship in tangible copies. *Cf. id.* at 17 ("A musical composition is an intellectual creation which first exists in the mind of the composer. . . . It is not susceptible of

that there can be no copyright infringement unless there is a “copy,” and there can be no copy unless an ordinary human being can read it. If we can call that approach the “*White-Smith* bias” against unreadable technology, it is not hard to see that the supposed “use as a mark” requirement tends to spread the *White-Smith* bias by introducing it into trademark law.<sup>215</sup> Just as *White-Smith* stood for the now discarded notion not only that there can be no copyright infringement without a “copy,” but that the concept of “copy” must exclude unreadable new technologies, so the nascent *White-Smith* bias in trademark law stands for the notion that there can be no trademark infringement without an offending “use-as-a-mark” and which then proposes to define the concept of offending “use-as-a-mark” to exclude clearly offending conduct in cyberspace.

The *White-Smith* bias introduced an antitechnological approach to copyright. An analogous *White-Smith* bias would, if embraced in

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being copied until it has been put in a form which others can see and read.”). Observant commentators have pointed out that “[w]hile the *outcome* of the case was overruled by the 1909 Act, its *way of thinking* survived until the 1976 Act was passed—and even beyond.” CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI & TYLER OCHOA, COPYRIGHT LAW 65 (7th ed. 2006).

215. I thank Professor Laura Heymann for critical comments on an earlier version of this manuscript which led to my understanding that I had proposed a “nature and place of use” factor for new technological uses in cyberspace (as in my prior articles) without having explicitly discussed the anti-*White-Smith v. Apollo* approach to copyright and trademark law which I have been taking for granted. What may have been implicit before is now made explicit here. I also acknowledge Professor Michael Landau’s electronically published abstract in which he has asserted the same view of *White-Smith*, as an analog to the trademark use-as-a-mark controversy that is advanced here. Professor Landau has observed:

Several courts have held that unless the trademark holder’s mark is actually visual[ly] displayed, there cannot be a “use-in-commerce.”

The analysis based upon “visual display” is reminiscent of the 1908 holding on *White-Smith v. Apollo*, in which the Supreme Court held that player-piano rolls were not copies of the embodied musical compositions because the rolls could not be read and understood by the naked eye. Holding that there is no use without a “visual display,” leaves trademark holder without a remedy in “passing off” cases in which the defendant sells substitute goods, but does not actually display or otherwise communicate the mark to a consumer. For example, under that logic, if a restaurant routinely substitutes “Pepsi” and “Smirnoff” every time that customers ask for “Pepsi” or “Grey Goose”, but [does] not display or speak either the Pepsi or Smirnoff mark, there could be no Lanham Act jurisdiction.”

Michael Landau, Trademark “Use” and Internet Keyword Advertising: Resolving the Confusion, <http://www.law.berkeley.edu/institutes/bclt/ipsc/papers/Landau.doc> (last visited October 20, 2008). Compare *id.*, with Folsom *supra* note 3, at 163 n.104 (stating that advertising and promoting are not required to constitute an offending use in ordinary space), and *id.* at 210 n.303 (asserting that product substitution cases in ordinary space do not require a showing of any offending “use-as-a-mark” by advertising or promotion to support a trademark remedy).

trademark law, introduce a similar antitechnological approach to trademark in cyberspace. In the case of copyright, the error was forced by the Supreme Court, as well as by the logic of the then-existing copyright act's structure, language, and prior case law, and took an act of Congress to undo. But in the case of trademark, there is no persuasive precedent, and certainly no uniform or emerging trend or consensus in the decided cases that would force the *White-Smith* bias into trademark law.<sup>216</sup> It would be an unforced error, and one that should be avoided. The answer is a simple refusal to jerry-rig any strange new "use-as" a mark requirement. The new factor proposed in this Article makes it clear that the answer to unexpected and machine-readable new technological offending uses in cyberspace should parallel the answer previously formulated to machine recognizable but otherwise unreadable new uses in copyright, learning from the experience there and rejecting the *White-Smith* bias in trademark just as it was eventually rejected in copyright. Limitations against overprotection of marks in cyberspace are built into the new factor, without the need for artificial barriers at the "use" level.<sup>217</sup>

C. *Positing a Third Statement: The Nature and Place of Use (General)*

Cyberspace interventions occur in an objective cyberspace and in the context of ordinary principles of law that are sensitive to various factor lists—lists that are famously nonexclusive. To those lists may be added yet one more factor, appropriate to mark-type conflicts in cyberspace:

03 Invisible, attenuated, or expropriating uses in cyberspace constitute potentially offending "uses" in marketing goods or services, or other conduct that might cause a likelihood of confusion, with the source or sponsorship of goods or services of a mark's proprietor, or that spoil and prevent marks from functioning as addresses otherwise available to a mark proprietor, to the extent they are objective and persistent *cyberspace interventions* with observable effects on *cyberspace users*. To assess whether they do so (or not) under ordinary principles of trademark-related law, the following new factor

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216. See *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1218-19 (11th Cir. 2008) (distinguishing *1-800 Contacts* on the basis that *Axiom's* metatag uses resulted in some visual display); *id.* at 1219-20 ("[T]o the extent the 1-800 Contacts court based its 'use' analysis on the fact that the defendant did not *display* the plaintiff's trademark, we think the Second Circuit's analysis is questionable.")

217. See *infra* Parts III.B-C (describing the limited remedy and the fully specified factor).



should be added to any already existing nonexclusive factor list:  
“*the nature and place of use.*”

The “nature and place of use” is a new factor that fits easily within every trademark jurisdiction’s likelihood of confusion factor list.<sup>218</sup> Because it explicitly raises the “*place of use*” as an express limitation, it resists any tendency towards accidental doctrinal creep, or reverse doctrinal creep, and it confines its adaptive approach to cyberspace only. Moreover, while it permits consideration of the “*place of use,*” it invites distinctions based upon the degree to which a particular cyberspace intervention is in “high” or “low” cyberspace—based on the degree to which the foundational cyberspace activity set is impacted—and so reserves the ability to distinguish between transactions that are merely transposed from ordinary space without special claim to special treatment in cyberspace and those that might differ in some more important way.

Because this new factor also raises the “*nature of use*” as an express limitation, it permits consideration of what is happening. The new factor invites consideration whether the allegedly offending actor is a value-adding or free-riding mapper or trapper, spoofer or arbitrageur, shill or advertiser. The new factor invites consideration whether the hypothetical (or actual) “victim” was on guard, experienced, intentionally searching, or taken unawares by an invited or uninvited, value-adding or predatory cyberspace intervention. In short, the new factor is intended to provide and encourage realistic assessments of what is really happening in an objective cyberspace. The new factor is not limited in its application to classic trademark analyses. To the extent any other cognate or related field of law, regulation, norm, or ordering permits, the new factor may be applied, and vice versa. The new factor, crossing related legal disciplines, might tend to reconcile and coordinate the various regimes so that they act for a common goal in cyberspace.

If this new factor, expressed in a generalized formula (“the nature and place of use”) were all that this Article produced, it would be an improvement over existing law. At the very least, it would give meaning to the claim, made by some commentators, that the problems of marks in space would become manageable if only the existing ordinary principles were applied more carefully.<sup>219</sup> The generalized “nature and place of use” is derived from existing ordinary principles and is offered as a first approximation of a solution to the problem of mark-type disputes in cyberspace. It

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218. See *supra* notes 138-39 (describing the factor lists).

219. See Folsom, *supra* note 3, at 232 n.380 (citing representative commentators for this position); *supra* note 242.

modestly redirects the attention of juridical agents to the possibility that there may be some distinctions between cyberspace (the place of use) and what happens there (the nature of use), and ordinary space that might actually make a difference and that might call for some different results. This might be accomplished by tools that are derived analytically from existing materials, and that would be applied more or less objectively to the characteristic mark-type disputes that have arisen in cyberspace.

*D. Summary: The Limits of Analysis (Incomplete Analytics)*

The first three propositions tend to be more nearly analytic than the next set of propositions (set forth in Part III of this Article). The first three propositions are derived from facts and relationships that appear in reported decisions, and from inferences that are, so it is hoped, explained, explicit, and direct. These propositions should lead to a more definite juridical treatment of mark-type disputes in cyberspace. At the very least, they may serve to precipitate a discussion that might lead to yet different conclusions than those proposed here, all with the goal of producing a more principled and predictable resolution of the problems. The modest conclusion—that a generalized new “nature and place of use” factor will improve the analysis of mark-type disputes in an objective cyberspace—is a small, but important step forward.

These first three propositions, including the “nature and place of use” factor, do not, however, get very far beyond the analytical level. In particular, they do not clearly and definitely “choose” one version of cyberspace over any other version. To be sure, they strongly suggest the general desirability of favoring guides and disarming pirates, and they express a general preference for adopting (or adapting) legal rules aimed at enhancing the foundational values of an objective cyberspace rather than inadvertently destroying those values. But they do not actually design, on a normative level, an explicit solution that is purposely and transparently aimed at facilitating a consciously selected architecture. To do that, it may be well to admit there are limits to any non-normative analysis, and to conclude the solution thus far proposed in this Article might constitute an example of “incomplete analytics.” It is good as far as it goes, but it is incomplete because it does not add an explicit normative element. Part III of this Article advances an additional and more normative proposal. Propositions 4-6, which follow, add a normative dimension to the descriptive and analytical propositions so far advanced.

### III. DESIGNING A SOLUTION: SPACE PIRATES, GUIDES, AND THE PUBLIC INTEREST

In the following subsections, three further propositions are stated, but under separate subheadings. To aid in keeping the propositions recognizably in order, each of the three is designated by a bold-faced, sequential number, beginning with number four, following the first three propositions which were set forth in Part II.<sup>220</sup> The fifth proposition is perhaps out of order. It is actually the remedy provision and it might have been expected to come last in the list.<sup>221</sup> It sets forth a limited, tailored, and flexible remedy, with full recognition of the nature of the harm, which is an invisible, attenuated, or expropriating use, in light of the public interest in a robust and freely navigable cyberspace. The limited and flexible remedy of the fifth factor is essential to the solution proposed herein and is a core component of the fully specified factor. The sixth and final proposition is the fully specified new factor—the “nature and place of use” factor—expanded for rule-based application. The sixth proposition might stand alone, but it is most fully specified and understood in light of the prior propositions that explain its terms, and especially in light of the limited and flexible remedy that informs the new factor.

#### A. *Choosing to Disarm Pirates (Broad Liability)*

The markers or spoilers that cause concern in cyberspace do not happen by chance. They are caused by something, and they do not cause themselves. The persons who place them have different motives and interests. But motives aside, such persons place markers that point somewhere other than might be expected or block otherwise available addresses and thereby affect navigation in cyberspace by virtue of where they point and how they point, pull, or otherwise affect traffic. These terms permit a more explicit statement about what is wrong with the current law (its problem). They also provide the normative direction for the answer (its solution):

**04** The problem with the law’s current response to invisible, attenuated, or expropriating uses in cyberspace is that it does not distinguish very well between harmless cyberspace interventions and predatory cyberspace interventions. A

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220. Part III presents propositions 4-6. Part II presented propositions 1-3. For convenience, all six propositions are abstracted and printed, in order, in Appendix A to this Article. For convenience, an alphabetized glossary is appended as Appendix B.

221. The remedy proposition is placed fifth, rather than sixth, simply so that the sixth and final proposition might be self-standing (the sixth proposition incorporates the remedy and so completes the analysis).

properly designed law ought to support the values of cyberspace by helping the *hitchhiker* and by favoring the *hitchhiker's guide*. This means the law ought to favor the *cyberspace resource provider* (the mapper or "guide") and ought to disfavor the *cyberspace pirate*. Other things being equal, if existing law can be so directed, it ought to be.

In evaluating this fourth expression, here is what the highlighted terms signify:

*Hitchhiker* — a surfer; anyone who is engaged in information-seeking activity in cyberspace.

*Hitchhiker's Guide* (or "*Guide*") — (1) a mapper or a guide; anyone who places or controls the placement or allocation of addresses or magnets, publishes addresses or magnets, or otherwise promotes navigation in cyberspace by methods now known or hereafter developed; (2) a map, guidebook, or comparable resource; something produced by a mapper or a guide, as for example, a search engine or directory; a shorthand name to describe a navigational resource provided by a cyberspace resource provider.

*Cyberspace Resource Provider* — anyone who provides essential, useful, or value-added resources in support of high cyberspace values, but especially those not conventionally rewarded for doing so, such as the search engine or directory provider (or any comparable service provider in respect of later-developed methods). In some cases, the search engine provider's economic return is in contrast to that of the commercial hardware or software developer under existing conventions by which hardware and software developers routinely sell or license their products to end users, but according to which the end user regards the browser or the search engine as something that ought to be "free," or in which some market, mechanism, or practical factor drives the browser, the search engine, or the directory provider's price towards zero while the costs might be significantly higher than zero. There may also be significant barriers to entry for new cyberspace resource providers, especially those who must compete against providers who are government funded or subsidized, or who have dominant positions in other markets that support their resource-providing activities, or who have become previously entrenched.

*Cyberspace Pirate; Piracy* — (1) a person who commits piracy, but in cyberspace especially, one who does so by changing the map, moving markers, placing false markers, and otherwise planting deceptive magnets or addresses; or by spoiling, wasting, or expropriating markers; (2) the acts or actions of a pirate that tamper with the map to cyberspace or with the useful navigation of cyberspace, as by tampering with addresses or magnets, planting deceptive addresses or magnets, or blocking or spoiling addresses

otherwise available. A magnet or address is deceptive to the extent it draws a user to an otherwise unintended destination or hinders a user from reaching an intended destination. Piracy is more harmful to the extent it is more uninvited, unexpected, predatory, and non-value-adding.

Because the fourth assertion has been made expressly, it is now possible to reevaluate the cases, testing them to see whether there is any disagreement with this fourth assertion. Some of the cases, in fact, seem to be opposed to a common sense view of the cyberspace environment. That is, some of the cases (including some of the leading cases) seem to reward or privilege the pirate,<sup>222</sup> while penalizing or credibly threatening to penalize the cyberspace resource provider, especially those who seek to pay for their activity by selling targeted advertising.<sup>223</sup> By operationalizing the new factor, it now becomes possible to more easily articulate the reasoning behind, and the basis for, the objection to the current crop of cases that seem strangely (if not perversely) inverted in their results (if not their sensibilities). It is also possible to transform the new factor from its general statement, “the nature and place of use,”<sup>224</sup> into a more rule-specific form for legal application.

It is also worth noting that the specified form of this fourth proposition actually defines the expression “pirate.” In so doing, it avoids prior tendencies towards name-calling in the absence of substance.<sup>225</sup> A “pirate” is not some sort of generalized insult (or

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222. The case that comes immediately to mind is *Holiday Inns*, 86 F.3d 619 (6th Cir. 1996), which held that there was no Lanham Act violation where, even though the defendant trapped for customers who were trying to find the plaintiff, the conduct did not amount to “use” of the plaintiff’s mark.

223. The cases that come immediately to mind are *Netscape*, 354 F.3d 1020 (9th Cir. 2004), and its spawn. See *supra* note 81-89 and accompanying text (targeting Google’s plan for keyword targeted advertising, where the keywords include trademarked expressions).

224. The general form: “nature and place of use” has been given in the prior articles, and is the third proposition advanced in this Article. The factor now is able to be more completely specified for rule-based application, as proposition six below.

225. See, e.g., *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 612-13 (1950) (Black, J., dissenting) (“I heartily agree with the Court that ‘fraud’ is bad, ‘piracy’ is evil, and ‘stealing’ is reprehensible. But in this case, where petitioners are not charged with any such malevolence, these lofty principles do not justify [the result].”). It would seem that, not only were petitioners not charged with “piracy,” but that the majority used the word as an after-the-fact pejorative label, attached to an infringer who had not, in fact, literally infringed the patented invention at all. One might have guessed that “designing around” the “metes & bounds” of the claimed invention was what responsible contributors to the public good might have been expected to do. Such persons might be wrong, and so liable in hindsight. But to call

some equally non-content-based compliment, depending on the subject's sensibilities), but instead constitutes significant speech, defined by the actor's conduct, and susceptible of forensic proof.<sup>226</sup> Indeed, the ability to "poll" the allegedly infringing actor at the point of offense, at the time the conduct is occurring, and with the ability to include the surfer in the polling transaction, is what transforms the new factor in cyberspace into one that can really discriminate between pirates and value-adding resource providers.<sup>227</sup>

*B. Serving the Public Interest (Narrowly Tailored, Flexible Remedies)*

In addition to being specified for rule-based application, the new factor also needs to be controlled. It needs to be controlled against doctrinal creep and against reverse doctrinal creep and from unexamined feedback loops.<sup>228</sup> The new factor is already under control, in a first sense, by the articulation of the general factor itself—the "nature and place of use" by its own terms applies only in cyberspace, nowhere else—and yet there is one more way to provide even more and better control. This is by explicitly specifying a common, graduated, proportionately limited, and flexible remedy.

The prior terms permit an expressly targeted analysis that can categorize cyberspace interventions and, at the same time, rate their impact on the fundamental values of cyberspace. It becomes possible,

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them names would seem an unbecoming insult, needlessly added to the weight of the injunction or damages they are made to bear for having guessed wrong.

226. The "pirate," as defined in this Article, is one who tampers with addresses or magnets; plants deceptive address or magnets; or blocks or spoils addresses otherwise available in cyberspace, thereby effectively denying access, making navigation difficult if not impossible, diverting information activity, taking advantage of the vulnerability of augmented presences, and destroying trust. This sort of pirate bears little resemblance to the romantic, good at heart figures of Captain Blood or Captain Reynolds. See RAFAEL SABATINI, CAPTAIN BLOOD: HIS ODYSSEY 1 (Norman S. Berg 1977) (1922) (introducing the adventures of a medical doctor who finds himself transformed into a gentleman pirate: "Peter Blood, bachelor of medicine and several other things besides, smoked a pipe and tended the geraniums boxed on the sill of his window above Water Lane in the town of Bridgewater"); SERENITY, *supra* note 1 (recounting Captain Reynolds's good deed). And yet, even a "pirate" is not always engaged in his or her occupation, and the flexible remedy of the new factor provides a way to make the policeman's lot a much more happy one, by fitting the remedy to the offense. See *supra* text accompanying note 148 (setting forth the remedy); cf. W.S. GILBERT & ARTHUR SULLIVAN, PIRATES OF PENZANCE (1879) ("When a felon's not engaged in his employment . . . or maturing his felonious little plans . . . his capacity for innocent enjoyment . . . is just as great as any honest man's.").

227. See *infra* notes 229-31 and accompanying text for a discussion of polling in connection with the new factor.

228. See *supra* notes 152-54 and accompanying text (doctrinal creep), 155-64 (reverse doctrinal creep), 165-71 (feedback loops).

as a result, to distinguish positive and helpful markers and those who place or support them, from negative and harmful markers and those who place or support them. It is also possible to assess any marker or spoiler (and the one who placed it or removed it) as contributing a greater or lesser benefit to cyberspace, or imposing a greater or lesser harm. When this can be done by polling a consumer at the point of the cyberspace intervention, it ought to be done.<sup>229</sup> Another set of terms is that which leads to a controlling point of this Article, transforming the new factor into a rule-specified form, with explicit attention to the remedy because of its importance to the total analysis:

05 A *common remedy* to mark-type disputes in cyberspace caused by cyberspace interventions or offending uses in cyberspace will afford a strong heuristic, a rule of thumb that will control and unify not only trademark law, but also the related bodies of law, private orderings, and norms. The *common remedy* is a reasonable technological accommodation in relation to the invisible, attenuated, or expropriating cyberspace intervention or offending use that called for a remedy in the first place, and which is sensitive to *polling* either a potential consumer at the point of the intervention or the offending actor itself. Those remedies include a technologically efficient and effective: (1) notice, (2) disclaimer, (3) forced redirect or forced release, (4) assignment or transfer, or (5) opt-out. The remedies are additive and do not exclude other remedies if the conduct in question also violates other laws or regulations beyond those herein specified for cyberspace interventions.

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229. "Polling . . . in computer science, refers to actively sampling the status of an external device by a client program . . . . Polling is most often used in terms of input/output (I/O), and is also referred to as polled I/O . . ." Polling (computer science), [http://en.wikipedia.org/wiki/Polling\\_\(computer\\_science\)](http://en.wikipedia.org/wiki/Polling_(computer_science)) (last visited Oct. 26, 2008). In this context, polled I/O is the situation in which "the computer does nothing other than check the status of the I/O device until it is ready, at which point the device is accessed. In other words the computer waits until the device is ready. Polling also refers to the situation where a device is repeatedly checked for readiness, and if it is not [ready] the computer returns to a different task." *Id.*

By analogy, reasonable technological accommodations can interpose effective notices, disclaimers, redirects/releases, and opt-outs (the common remedy which will be asserted in proposition five of this Article), and can do so at the point of the cyberspace intervention, and in real-time. By polling a potential consumer at the point of intervention, there will be much better direct evidence whether the potential consumer was likely to be confused. In another sense, when a mark proprietor asks an offending user to provide a notice, disclaimer, redirect/release, or an opt-out, the offending user is being asked to self-identify as a value-adding provider or as a pirate. The request itself, and the response to it, serve to poll the offending actor, and reliably to self-categorize the actor.

In evaluating this fifth expression, here is what the highlighted terms signify (given that *Y* is the intended destination, but a user is drawn to *X* instead because of a cyberspace intervention):

The *common remedy for invisible, attenuated, or expropriating uses* includes one or more of the following: a technologically effective (1) disclaimer, (2) notice, (3) forced redirect/release, (4) assignment or forced auction, or (5) opt-out. The common remedy is additive to other "ordinary" remedies. If the only harm is an attenuated or invisible use by a cyberspace intervention, then some aspect of the common remedy is the presumptive limit. If there is additional harm, including ordinary, visible, and direct use of an offending expression "as" a mark or otherwise causing an ordinary likelihood of confusion, then the ordinary trademark remedies may be added on top of these.

(1) A "*disclaimer*" in cyberspace is, by a technological means, the intervention of a non-avoidable and conspicuous message to this effect: "X is not affiliated with, sponsored by, licensed by, or endorsed by Y."

(2) A "*notice*" of another address in cyberspace is, by a technological means, the intervention of a non-avoidable message coupled with a forced user-choice to this effect: "you have reached X but you might have intended to reach Y. You may reach Y [by clicking here] [by dialing this phone number]." If the offending actor is a search engine, a directory, or a keyword advertiser or the like, the notice might take the form: "you have entered (or triggered an ad based on) Y, which is a trademarked expression. If you want to continue your search by finding the owner of the trademark, click [here]; if you want to continue with a more generalized search for goods or services more or less like Y-brand products, click [here]."

(3) A "*forced redirect/release*" has two aspects, related to each other but different in their scope and effect:

3.1. A "*forced redirect*" in cyberspace is, by a technological means, a non-avoidable, forced *change* of the user's augmented presence whereby the user is actually rerouted from *X* to *Y*, or the user is confronted with a required choice so the user must affirmatively choose either *X* or *Y* (and though the user is "at" *X*, the user cannot proceed any further in either *X* or *Y* until the user elects one or the other). If the offending actor is a search engine, a directory, or a keyword advertiser or the like, the forced redirect would force an affirmative election after the corresponding notice.

3.2. A "*forced release*" in cyberspace occurs where, by a technological means, the user is given instructions about how to reach *Y* and then is actually *dropped* from *X* altogether with instructions to try again to reach either *X* or *Y* (and the user will also have been given instructions that if the user really intends to find *X*, the user must enter a new "clean" address for *X* that really has



nothing at all to do with *Y*, and that only the use of the clean address will actually get the user to back to *X*).

(4) An “*assignment or auction*” in cyberspace occurs where *Y* becomes the owner of the offending invisible, attenuated, or expropriated marker, or else where *X* is forced to auction the marker to a population of non-piratical users (perhaps including not only *Y* but also *Z*, another valid trademark proprietor).

(5) An “*opt-out*” in cyberspace is a notice to this effect: “You are experiencing some invasive technology that intercepts your keystrokes and sends you information as a result. While some persons might consider this a feature, others might object. If you object, you may ‘opt-out’ by [clicking here].”

*Polling* includes (a) an inquiry made to the user (potential consumer) at the point of the cyberspace intervention or within a reasonable proximity to the intervention and that seeks to determine whether the user is likely to be confused by the intervention, and (b) an inquiry made by or on behalf of a mark proprietor to an offending actor that seeks to determine whether the actor is a value-added provider. Polling will typically be in relation to the common remedy—a user may be polled, and an *offending actor* may be polled separately. In the one case, by asking the user to select one of the remedies offered, and in the other case, by asking the offending actor to provide one or more of the notice, disclaimer, redirect/release, or opt-out procedures, thereby satisfying the user and the mark proprietor, and categorizing the offending actor at the time and place of the request.

Polling is an advantage afforded by the possibility of changing the code in cyberspace.<sup>230</sup> Each of the notice, disclaimer, redirect/release, or opt-out necessarily involves the potential victim of the trademark-related offense and may help to determine whether that person is a victim or not. As pointed out, the person affected might be in cyberspace as a surfer, spoofer, arbitrageur, shill, advertiser, shopper, consumer, or in some combination of roles simultaneously or sequentially. If he or she is looking for information arbitrage, he or she might desire to navigate in cyberspace by markers, including those that include a trademarked expression. If the user chooses to use such expressions in a nominative sense, after

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230. The ability simply to change the code, and thereby to alter the objective reality of cyberspace, is a feature remarked upon by Professor Lessig. LESSIG, *supra* note 10, at 12-13 (solving the poisonous flower problem by rewriting the code to change the properties of the poisonous object, and doing so in a Pareto superior move to boot).

an explicit notice, disclaimer, redirect, or opt-out, then it is hard to maintain the user is even remotely likely to be confused.<sup>231</sup>

Likewise, as pointed out, the offending user may itself have a navigation-enhancing or value-adding role to play in cyberspace, and if the offending user is asked by a mark proprietor to place a notice, disclaimer, redirect/release, or opt-out for the benefit of potential visitors, it is hard to imagine a non-pirate who would absolutely refuse any such accommodation. If there were truly value-adding services on offer, the offending actor would expect to attract those who were seeking such services. The value-adding service provider would seem to have no legitimate purpose in avoiding one of these accommodations. On the other hand, a pirate would reveal itself by refusing any of them.

The advantage of polling is that it replaces after-the-fact guesses, inferences, hunches, and other indirect proofs of likelihood of confusion (all of which are further complicated by the distinctive differences of the characteristic users of cyberspace and their dramatically different search strategies) with direct information. The information is direct, it is useful, and it very nearly eliminates the potential for actionable harm at the very point of the intervention. It provides essentially customized relief, appropriate to the nature of cyberspace. It preserves robust cyberspace navigation and information-activity in a way that is self-adjusting. It tends to eliminate the need for survey evidence or other indirect proofs. It connects with the common remedy, because it permits and encourages transactional lawyers and their clients to voluntarily reach an accommodation prior to litigation.

Cooperatively with the polling technique, and yet independently of it, the common remedy for a cyberspace intervention in a pattern case may be summarized briefly. The pattern case may be put as

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231. What is striking is the interrelatedness of liability and remedy. If the allegedly infringing actor associates an effective disclaimer, notice, redirect/release, or opt-out with the invisible, attenuated, or expropriating use, and if the asserted "victim" then willingly proceeds after having been polled, there can be no likelihood of confusion, by initial interest or otherwise. This, of course, is because the allegedly infringing actor has already voluntarily accepted the remedy the law would have mandated. The converse is also strikingly true: the invisible, attenuated, or expropriating use creates liability unless accompanied by an effective disclaimer, notice, redirect/release, or opt-out. Also, the device of polling the allegedly infringing actor by requesting the common remedy strikingly categorizes the actor as a value-adding resource provider or a pirate. This is because of the strong inference that really valuable services offered by a resource provider will continue to attract consumers after they have been polled, so that such a provider will not refuse the request. But the pirate who offers only misdirection, spoofing, and deceit will be much less likely to maintain any traffic after polling, and so would be expected to refuse the request. Polling removes the guess work.

follows: let there be some conduct by *X* that employs a mark of *Y* as an invisible, attenuated, or expropriating address, magnet, roadblock, or detour (a cyberspace intervention by *X*). It can be understood that (1) the *disclaimer* is pure information about *X*'s "non-relationship" with *Y*; (2) the *notice* is yet further information, identifying another address and containing information about, and a realistic opportunity to find, *Y* (but the user remains "at" the place fixed by *X*); (3) the forced *redirect/release* actually goes further yet and deposits the user "at" *Y*, or at least disconnects the user from *X*, and requires an affirmative reconnection by the user to a clean destination; (4) the *assignment/auction* goes so far as to put the marker or spoiler into the hands of *Y* (or another non-piratical user); and (5) the *opt-out* lets the user remove unwanted, invasive agents that monitor the user's activities.

These are graduated steps. Each of them is designed to provide a juridical agent with the ability to fashion a remedy proportionate to the offending cyberspace intervention and reasonable in relation to the harm done. Moreover, each is designed to take account of the public interest in a robust and navigable cyberspace. This common remedy gives the juridical agent the toolbox from which it can permit value-adding mappers and guides to provide essential value-added resources to cyberspace (subject to reasonable technological accommodations to mark owners who might be offended by such invisible and attenuated uses), while discouraging pirates. A juridical agent should attach a lower level common remedy, such as a disclaimer or notice, to lower level cyberspace interventions. This permits progressively higher level remedies, including a forced redirect/release, reassignment, or auction for higher level cyberspace interventions. The result matches the remedy not only to the degree of the offense, but also to the characteristics of the offending user, in light of the public interest in a freely navigable cyberspace accompanied by sufficient trust so that the augmented presence in space can avoid predatory diversions.

These remedies are always additive and supplemental. In a cyberspace dispute that also presents a clear violation of ordinary trademark law, these remedies for the invisible, attenuated, or expropriating use do not prevent a juridical agent from applying the full battery of remedies appropriate to ordinary trademark infringement. They simply allow a court to do less by way of remedy when there is less (or something markedly different from traditional liability or harm) by way of harm from the cyberspace intervention.

The explicit specification of the common remedy is essential to an understanding of what the new factor is intended to do. Moreover, it demystifies what a "disclaimer" can or cannot do, and helps to

explain when and whether it is effective. If a pure disclaimer is not effective, then a more explicit notice can be compelled; if a disclaimer and notice are not enough, then a forced release/redirect can be required; and if these are not enough to protect the public and the trademark proprietor, the final sanction is an assignment or auction. Where the offense is caused by invasive triggers, an opt-out would be appropriate. In cyberspace, the notice can include a live link on the Internet or something equivalent on the phone such as an inserted message or menu, thereby making disclaimers and notices more effective in cyberspace compared to ordinary space.<sup>232</sup>

Not to be gainsaid is the fact that the common remedy also gives voice to the user, the supposed victim in all of trademark-related law. For once, the user is consulted and effectively polled. As a result, his or her actual preferences will figure into the situation, and the offending activity will be regulated in light of the public's interest, reliably ascertained.

In addition, the common remedy also reminds all juridical agents that injunctive relief remains an equitable remedy subject to equitable factors.<sup>233</sup> It ensures, specifically, that the public interest in a robust and navigable cyberspace will not be disserved by the type of broad injunction that might follow from overprotection of marks in space.<sup>234</sup>

The common remedy is a modest remedy, and it is modest because the "nature and place of use" in cyberspace requires a certain humility. Despite the advantages of polling, and despite the care invited by the new factor, it is not likely that every cyberspace intervention will always be neatly and accurately characterized, or that cyberspace users will be known (or even knowable) to a judicial decision maker. It is possible that some cyberspace resource providers will not always be readily distinguished from space pirates,

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232. See Folsom, *supra* note 3, at 156 n.75 (referring to empirical findings and other authorities suggesting disclaimers may be of doubtful efficacy in ordinary space).

233. See *eBay, Inc. v. MercExchange L.L.C.*, 547 U.S. 388, 391 (2006) (listing four factors in a patent case: irreparable injury, inadequate remedy at law, balance of the hardships favors the party seeking the injunction, and the public interest is not disserved by entry of an injunction); Folsom, *supra* note 8, at 101 (suggesting the applicability of the *eBay* analysis to trademark cases); see also *supra* note 148 (asserting that trademark cases already were, as a matter of course, sensitive to the equitable analysis prior to *eBay*).

234. It is interesting to note how the common remedy reframes the results in the notorious overprotection case, *Brookfield*. There was both a reassignment (the domain name was assigned to the senior party) and a kind of, sort of, coexistence (the junior party was permitted to keep a magnet in place so long as there was a space between the sensitive words that comprised the composite mark—"movie [space] buff" was permitted, though "moviebuff" was forbidden). Under the common remedy, perhaps a simple notice or redirect from the junior's to the senior's site would have done the job.

or that some new technological use will arise in a way that baffles analysis. In part because of these uncertainties, but in larger part because there is simply no need for any greater remedy, the common remedy is the regulating and controlling rule of thumb. It cannot overprotect and it will not underprotect marks in space. It cannot spread outside of cyberspace by accidental “doctrinal creep” or “reverse” doctrinal creep.

There may be much that remains to be done to flesh out the contours of the common remedy. It might be asked: who has the burden to prove the existence of a reasonable technological accommodation? What, exactly, is “reasonable” in this context (is it a splash screen, a window at a corner of an opening screen, or something otherwise conspicuous)? Who has to pay for the implementation of the technological accommodation (will all the cost be borne by the offending actor, or might the mark proprietor and the offending actor split the costs)? These and other questions remain to be worked out, but this is what the judicial process is better equipped to do. Rather than attempting to become software engineers, juridical agents may wrestle with more legally-resolvable questions such as these. This is because the questions raised by the common remedy become questions of judgment against a background of a principled, practical, and predictable rule.

### *C. Designing Useful Law: Deriving a Fully Specified Factor*

All of what has gone before now permits the statement of the new factor in rule-specific form for invisible, attenuated, and expropriating uses in cyberspace. In this Article, it is referred to as the fully specified factor because it expands the more general “nature and place of use” in greater detail and it supplies a normative dimension<sup>235</sup> to the application of the factor:

**06** The fully specified “nature and place of use” is a factor added to legal analysis in trademark-related disputes in cyberspace, and especially to cyberspace interventions or offending uses by invisible, attenuated, or expropriating users. The specified factor explicitly considers whether the offending conduct is a cyberspace intervention and weighs its impact on cyberspace users, taking into account:

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235. The normative dimension includes an express preference for mappers (the hitchhiker’s guide and its providers) over pirates, and an express interest in the public interest in a freely navigable cyberspace. It goes beyond the analytical observation that it is appropriate to consider the “nature and place of use” and actually implements a choice in the public interest.

(a) the nature of the cyberspace intervention or offending use (whether it is harmless, value-adding, predatory, neutral, invited, uninvited, expected, or unexpected);

(b) the nature of the offending party (whether mapper or guide, spoofer, trapper, spoiler, pirate, arbitrageur, shill, advertiser, or other) and whether the offending party is a direct, indirect, or vicarious participant in the offending activity;

(c) the nature of the supposed victim and the nature of any other interests involved (whether surfers, shoppers, customers, competitors, mark proprietors, or others including the public interest in a robustly navigable cyberspace), and whether the surfer, shopper, or customer is skilled, "on notice," or aware at the point of the cyberspace intervention, or is caught unawares and not "on guard";

(d) the place of use, including the degree to which the foundational cyberspace activity set of access, navigation, information-activity, augmentation, and trust is implicated in any particular place within cyberspace (whether the place of use is high or low, deep or shallow cyberspace);

(e) the presence or absence of any other "ordinary" trademark factor, or of those factors most applicable to invisible, attenuated, or expropriating uses, and the presence or absence of any other generally recognized factor that might show good faith or bad faith under cognate laws or norms (including anti-cybersquatting factors under the ACPA or dispute resolution factors under the UDRP); and

(f) the presence or absence of polling and any other circumstance reasonably related to the conflict between users in space.

After taking these into account, a judge should be able to explicitly assess the public interest in a robust cyberspace (that is, the public interest in access, navigation, information-activity, augmentation, and trust) and to assign some proportionate level of the common remedy matching the effect of the cyberspace intervention with a reasonable technological accommodation in relation to its harm. The judge may do this in addition to assessing any other remedy in respect of any other actionable legal harm, and with such damages as may be established.

In evaluating this sixth expression, there are no highlighted terms because each has been specified previously. The value of this final expression is that it puts everything together in one place. It expressly identifies the kind of facts about which any fact-based inquiry ought to be concerned. Unlike current methods, the proposed new factor goes beyond noticing the unremarkable features of a given

cyberspace intervention (i.e., many current cases seem content to note of some offending conduct simply that it is on the Internet, and is bothersome, as if some legally operative consequence were supposed to follow), and the new factor frames the inquiry in a way designed to lead to useful answers based on evidence capable of demonstration.

The initial two sentences of the fully specified factor concentrate on the nature and place of use, in respect of cyberspace interventions and their impact on cyberspace users. Subparagraph (a) invites attention to the nature of the intervention. It reminds all parties that even the most sophisticated user might still be taken unawares by certain invisible, attenuated, or expropriating uses, and that predatory, uninvited, unexpected, and non-value-adding conduct is more offensive to the public interest in a robust and freely navigable cyberspace than the opposite conduct.

Subparagraph (b) invites consideration of the nature of the offending party and encourages a normative treatment based on a preference for encouraging mappers and disarming pirates. It should not be forgotten that many mappers provide targeted advertising or other fee-based services to persons who are themselves cyberspace users, often involving trademarks that will be the subject of yet further invisible, attenuated, or expropriating uses by such fee-paying clients. The new factor permits a juridical agent to treat all invisible users alike, or in an appropriate case, to distinguish between invisible users who are more like "direct" infringers and those (such as some resource providers) who are more like "indirect" or vicarious infringers. Because the new factor already includes a limited and proportionate remedy in the public interest, the ability to discriminate between direct and indirect infringers may be an unnecessary safeguard to protect the public interest in search engines and like navigation services in cyberspace; but the ability to discriminate on this basis is nonetheless expressly provided in case it should be needed in some as yet unforeseen circumstances.

Subparagraph (c) directs attention to the supposed victim and to the interests of other parties, including those of the public. The polling technique that is incorporated in the new factor is a code-based means to enable a more confident assessment of the actual interests of the persons involved. The factor reinforces the intuition that some weight should be given to what is happening at the point of the cyberspace intervention and reiterates the importance of circumstantial sophistication in cyberspace: the same person may manifest different capacities sequentially in cyberspace and may shift focus even during the same "session." There is no basis upon which a juridical agent may simply assume a unitary sophistication

level in cyberspace, not even in a single person during a single session.

Subparagraph (d) directly focuses on the degree to which the “place” of use actually impinges upon the foundational activity set. Those places which more directly impinge are in “high” or “deep” space, and might be more needful of protection than those which are less fundamental. There may be different places within cyberspace, some having less need for legal intervention than others. The new factor is explicitly designed to protect the more important interests, and the ones that most affect the public interest.

Subparagraph (e) is a reconciling and unifying factor. It need not be the case that every new cyberspace intervention requires its own new legal innovation or statutory response. Likewise, it need not be the case that each legal domain must proceed in isolation of the other relevant bodies of rules. This factor invites a juridical agent to accept and to borrow factors that, by hypothesis, already reflect a public interest, already articulated in a closely related or cognate field. If there is a reasonable connection among related disciplines, the new factor can and should unify them. In particular, there may be good reason to adapt the common law to apply to vanity phone numbers those factors designed by statute to apply to domain names, and to reasonably extend both the common law and statutory unfair competition factors as pirates become more agile in expropriating marks.

Subparagraph (f) accounts for actors who have responded to polling and those who have not. It would be appropriate for juridical agents to assess a common remedy with some regard to how difficult any actor has made things for others, and with regard to whether there has been any manifest willingness to accept reasonable technological accommodations.

Finally, the last paragraph of the new factor presents the public interest and the common remedy transparently as explicit considerations.

Some test cases would be more helpful than any further listing of circumstances<sup>236</sup> because such cases will themselves provide the material for applying the specific guidance this sixth expression provides. It should be noted at the outset, however, that this “nature and place of use” approach already avoids some of the more serious problems, not only of the current cases, but of the currently proposed solutions.

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236. Testing against the cases is something that can be done elsewhere. See *infra* Part III.E.



D. *The Advantages of Designed Law (Making Sense of Cyberspace)*

It is a claim of this Article that the nature and place of use actually works within the context of existing trademark law, related laws, and norms,<sup>237</sup> and that it is, not coincidentally but by design, actually capable of use in juridical disputes. Parties can actually adduce reasonably obtainable evidence gathered at non-prohibitive cost. Judges (and juries) can actually understand, evaluate, and use such evidence. Transactional lawyers can avoid unpredictable litigation because the stakes are well defined by the common remedy and supported by the polling techniques that will predict outcomes.

That is to say, the polling techniques afford one very useful way to develop evidence under the new factor. Polling would allow a mark proprietor to simply, in effect, ask the offending party by way of a demand letter to accept one of the common remedies and thereby do two things: self-categorize the offending party and resolve the conflict. This is a kind of self-policing. The offending party's response (or lack of response) should itself provide a substantial clue to, or the definitive proof of, the nature of its conduct and the appropriate level of the common remedy that should attach.

If an offending party claims it is merely providing harmless, neutral, or value-adding services, and if there is a reasonable technological accommodation that can be afforded the mark proprietor, it is hard to imagine why the offending party would not readily consent. The inference following from such consent is that this is a relatively harmless or benign cyberspace intervention. The costs of accommodation would be low. The inference is that the offending conduct, if accompanied by an accommodation from the offending actor, almost certainly must be by a navigational marker that could be useful to surfers, shoppers, or consumers (enough of whom would voluntarily return to the offending actor so as to validate the offending actor's claim to innocent, fair, and value-adding use). The resulting situation is one that almost certainly cannot give rise to an actionable harm to mark proprietors, because the otherwise harmful effects, and any possible likelihood of

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237. It is, simply, one more factor. The ordinary trademark likelihood of confusion factor lists are open-ended, inviting the application of any other relevant factor. See *supra* note 138. Moreover, it is a factor not incompatible with unfair competition's passing-off-style prohibition of deceit, likelihood of confusion, and the like. It fits, as well, with unfair competition's protection against misappropriation of intangible trade values. It also is designed to fit alongside the various other trademark-related norms, rules, and regulations. See *supra* Part I.C.4. The designed nature of the factor, and the common remedy, will unify the various approaches to cyberspace interventions.

confusion, are controlled and channeled by the offending actor's technological accommodation. The offending actor's consent would be expected to result in a negotiated accommodation, easily accomplished by private bargaining between parties who are aware of the reasonable demands of the common remedy. A disclaimer, notice, or redirect/release would be something the parties would be expected to agree upon without much prodding.

Conversely, if an offending party refuses a reasonable technological accommodation to ameliorate a cyberspace intervention, it is hard to credit any claim that there was some legitimate reason for refusal. The inference follows from the refusal to accommodate that this is, at best, an effort to waste, spoil, or improperly arbitrage value against someone else's goodwill, or at worst, an instance of predatory conduct that violates the good of cyberspace and the public interest in access, navigation, information-activity, augmentation, and trust.

If such highly relevant evidence can be obtained merely by polling the offending actor, this new factor can perhaps provide a welcome counterbalance to the already bloated (and expensive), expanding, and not entirely relevant proofs currently offered to prove likelihood of confusion or its opposite in cyberspace. The judicial system would need to be invoked only to adjudicate (a) among persons who have agreed in principle to a technological accommodation but who disagree on its exact nature or implementation, or who face factual disputes, and then based on evidence that is neither technologically mystifying nor within the particular province of battling experts, and (b) among persons who have refused any accommodation at all after a cyberspace intervention, and who present legal and factual matters that are capable of rule-based resolution by juridical agents. The judicial determinations could be based on a legal standard that makes sense.

Finally, the new factor and its common remedy are designed to counterbalance any distortion that might otherwise be introduced by the new factor itself. The new factor is designed to resist both doctrinal creep and reverse doctrinal creep, and to avoid illicit question-begging that might occur by an unacknowledged feedback loop. It also overcomes the tendency in existing law to err in the direction of radical misuse of the initial interest sentiment as if it alone could dispose of the cases, and it also overcomes the initially interesting notion that "nonuse" "as" a mark can afford any principled, practical, or predictable way to distinguish pirates from guides in cyberspace. The new factor and its common remedy is

proportionate, flexible, and as subtle as the invisible, attenuated, or expropriating use that calls for it.<sup>238</sup>

*E. What Remains to Be Done*

Prior articles have asserted there is a need for an explicit factor that can transform relevant trademark-related law into a principled, practical, and predictable rule based solution to the problem of marks in space. The prior articles asserted that a new factor—"the nature and place of use"—can do so. This Article has now fully specified that factor for trademark-related disputes in the context of an objective cyberspace with characteristic values. While the fully specified factor leads to a set of terms that may require some reflection, all the terms are already raised by the actual conflicts, new relations, and concrete facts in the reported cases and in the ubiquitous experiences of ordinary persons in actual cyberspace. This Article presumes it is natural to talk about, for example, the problem of invisible, attenuated, and expropriating uses of trademarked designations as addresses, magnets, and/or marks that function as markers or spoilers in an objective cyberspace that is valuable to the extent of reliable and trustworthy access, navigation, information-activity, and augmented presences, because that is what is actually happening. This Article has demonstrated the possibility of formulating a fully specified factor that can afford a comprehensive solution to the characteristic problems of mark-related disputes in cyberspace by rewriting the code of cyberspace as a reasonable technological accommodation that favors mappers, guides, surfers, and consumers, and disfavors pirates.

It remains only to test the new, fully specified factor against the cases to see how it works, to assess its costs, to determine whether it is economically efficient, and to consider the theoretical justification for using the law as a lever to rewrite the code or architecture of cyberspace to solve the mark-type problems there. The test would provide illustrations and solutions in answer to the common problems of marks in space. Such a test should assess not only the costs of the solution as borne by cyberspace actors, but also the costs to juridical agents to be borne by them as judicial transaction costs. It should also, perhaps, more explicitly address and resolve the

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238. The cyberspace pirate's imagined stealth is not wholly unrelated to the imagined stealth of the ordinary pirate, as expressed in song: "With cat-like tread, upon our prey we steal. In silence dread, our cautious way we feel. No sound at all! We never speak a word; a fly's foot-fall would be distinctly heard . . ." GILBERT & SULLIVAN, *supra* note 226. In cyberspace, these things do leave a trace more noticeable than a fly's foot-fall.

doctrinal confusion over initial interest confusion in cyberspace,<sup>239</sup> the recently discovered (or proposed) use “as” a mark requirement as a threshold filter in cyberspace,<sup>240</sup> vicarious liability considerations that might impede a resource provider (such as Google) in cyberspace,<sup>241</sup> and other theoretical concerns passed over in this Article. Such a theoretical discussion, following some practical illustrations in a future article, might also resolve some of the apparent tensions among the commentators.

Some commentators advise that the problems of marks in space may be solved by a more careful application of existing principles of ordinary trademark law.<sup>242</sup> Others, or at least one, cautiously

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239. The problem addressed by this Article is not “initial interest confusion” taken alone, but is the larger problem of transforming and adapting the law to deal comprehensively with marks in space. Nonetheless, this Article suggests, in passing, an answer to the initial interest confusion question. *See supra* note 78 (suggesting the better-reasoned cases in ordinary space require a preclusion-style of initial interest confusion before imposing liability). Ambush-style or loglo-morphing-style initial interest confusion might also be recognized in cyberspace, or elsewhere. *Cf.* STEPHENSON, *supra* note 25, at 7-8 (using “loglo” to refer to re-configurable light-cell based glowing logos in an imagined future; I am suggesting that imaginary billboards such as these allow us to reframe the billboard analogy previously referenced, *supra* note 52, and to rethink initial interest confusion in cyberspace, or elsewhere). A subsequent article might more directly deal with initial interest.

240. The problem addressed by this Article is not whether there is now, or ever has been, a “use-as-a-mark” requirement in trademark law, but is the larger problem of transforming and adapting the law to deal comprehensively with marks in space. Nonetheless, this Article suggests, in passing, an answer to the use “as” a mark proposal. *See supra* note 156 (embracing the Restatement’s more orthodox formulation: trademark infringement consists in “marketing” goods or services using a “designation” that causes a likelihood of confusion as to source, sponsorship, or approval of goods or services; and counting the four or five equivocal senses of the term “use”); *supra* notes 157-64 (discussing the use-as-a-mark proposal as constituting “reverse doctrinal creep”). There never has been any general requirement that an offending actor must use a designation “as” a mark as a threshold to liability, nor is there any need to cobble any such requirement together simply to avoid overprotecting marks in space. The more comprehensive approach of the fully specified new factor described in this Article protects both cyberspace and the law itself without the need to make up new and harmful legal doctrines. A subsequent article might more directly deal with the proposal advanced by other commentators that mark-related liability in cyberspace (and perhaps elsewhere) may follow only upon an offending use “as” a mark.

241. *See supra* note 150 and Part III.C.06(b) (taking note of the potential issue, and providing for it, if necessary, in the fully specified “nature and place of use” factor).

242. *See, e.g.,* Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 838 (2004) (arguing that the law does not need to change to deal with Internet keywords, but courts need to apply it correctly); David M. Fritch, *Searching for Initial Interest Confusion and Trademark Protection in Cyberspace*, 6 U. PITT. J. TECH. L. & POL’Y 1 (2005); Daniel C. Glazer & Dev R. Dhamija, *Revisiting Initial Interest Confusion on the Internet*, 95 TRADEMARK REP. 952, 953 (2005); David M. Klein & Daniel C. Glazer, *Reconsidering Initial Interest*

endorse what this Article condemns as the *Brookfield-Netscape* overprotection line of cases.<sup>243</sup> Others, or at least one, strongly favor what this Article condemns as the *Holiday Inns* and *1-800 Contacts* underprotection line of cases.<sup>244</sup> While it is sufficient for the present Article merely to propose a complete and comprehensive solution to the problem of marks in space while avoiding peripheral squabbles over the assorted piecemeal approaches to smaller bits of the picture, it might be useful in a subsequent article to more directly address some of the theoretical issues, together with some of the remaining practical economic concerns.

## CONCLUSION

Invisible and attenuated users create mark-type conflicts in an objective cyberspace (an embodied switched network for moving information traffic, further characterized by varying degrees of access, navigation, information-activity, augmentation, and trust) because actors can place markers as invisible addresses and magnets

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*Confusion on the Internet*, 93 TRADEMARK REP. 1035, 1064 (2003) (arguing that the traditional trademark likelihood of confusion factors, excluding initial interest confusion, together with the FTDA and ACPA are adequate to protect senior users).

243. Chad J. Doellinger, *Trademarks, Metatags and Initial Interest Confusion: A Look to the Past to Re-Conceptualize the Future*, 41 IDEA 173, 200, 219, 225 (2001) (noting that *Brookfield's* application of the initial interest confusion doctrine was too broad, but arguing that "[t]he mere appearance of [the] defendant's web site on a search engine results list necessarily indicates consumer confusion at a certain level" and the initial interest confusion doctrine, properly understood, is the correct way to apply trademark law to metatag and search engine use of trademarks). *But see* Chad Doellinger, *Recent Developments in Trademark Law: Confusion, Free Speech and The Question of Use*, 4 J. MARSHALL REV. INTELL. PROP. L. 387 (2005) (discussing recent U.S. Supreme Court trademark jurisprudence as suggesting a general trend that might possibly be applicable in the context of metatags or domain names, and which more nearly approaches the view that if the designation is not used as a mark, then there might be no liability).

244. Widmaier, *supra* note 106, at 703-07. There are others who have, apparently, joined Professor Widmaier. *See generally* Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007) (expressing skepticism that there is a separate "use" "as" a mark requirement while noting that there are those who have proposed such a requirement); Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) (replying to Professors Dinwoodie and Janis, and advocating a separate "use" requirement); Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703 (2007) (responding to Dogan and Lemley's reply to Dinwoodie and Janis). In their popular trademark casebook, and prior to pointing out their own skepticism that there is any such separate use requirement, Professors Graeme Dinwoodie and Mark Janis concede that "the balance of scholarly commentary appears to favor a 'trademark use' requirement." DINWOODIE & JANIS, *supra* note 131, at 472 (collecting commentators who apparently favor such a requirement).

in space, and others can index or key those markers so that others can find them—all in support of the very values that enable cyberspace. But other actors can spoof or trap, waste or spoil those values.

Mark-type conflicts occur in an objective cyberspace because designations can be used there somewhat unconventionally as an address, magnet, and/or mark (or as a detour or roadblock). Invisible, attenuated, or expropriating uses of trademarked expressions can be made by invited or uninvited, harmless or predatory, value-adding or free-riding surfers and mappers, spoofers and trappers, spoilers or arbitrageurs, shills or advertisers, as well as by shoppers, consumers and competitors, and persons who are simultaneously acting in more than one capacity or sequentially shifting from one to another. Because legal decision makers are institutionally constrained from becoming familiar enough with current trademark doctrines or with the complex technological and practical background upon which those doctrines turn in cyberspace, and because there is presently no way to discover the facts worth knowing, decision makers can no longer reliably proceed on an ad hoc basis, but require a new rule of thumb, a heuristic, to solve these conflicts.

Current law is unable to deal with invisible, attenuated, and expropriating uses of expressions in cyberspace because it has no tool by which legal decision makers can distinguish fair from unfair competition in space, and no rule or rubric by which ordinary trademark law can be extended and applied to the characteristic conflicts of marks in space in a way that is at once principled, practical, or predictable. The leading cases are wrong because they have not purposefully defined the nature of cyberspace, nor have they usefully distinguished the kinds of conflicts that typically occur among the characteristic users there. They have seized upon the clumsy, not to say inelegant tools of “initial interest” on the one hand, and “use” “as” a mark on the other hand. Those tools do not and cannot be made to work coherently, much less correctly. As a result, the cases are in conflict with one another and with ordinary principles of trademark law, and are dramatically missing the mark in cyberspace.<sup>245</sup>

This Article goes beyond the analytic, descriptive, and doctrinal observations made in my prior articles. This Article is normative in its orientation and not only proposes a solution to the problem of invisible and attenuated users and conflicts of marks in space, but also fully specifies it in an explicitly and transparently normative fashion. It prefers guides and other value-adding resource providers

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245. ARISTOTLE, *supra* note 56, at bk. I, ch. ii (asserting if you cannot see a target, you are likely to miss it).

to pirates. It prefers a robust, freely navigable, and reasonably trustworthy cyberspace to the opposite. It prefers surfers, shoppers, and consumers to those who would distort their opportunities in space by misdirection, spoofing, and deceit. It prefers the public interest to the interest of whatever faction happens to show up in court on any given day.

The solution is a new factor—"the nature and place of use"—which is not only new in its precise formulation, but also a recognizable transformation of existing law. In fact, this new factor is more nearly like traditional trademark-related law than the current attempts to simply, but clumsily, apply "ordinary" principles of law to mark-related disputes in cyberspace. The approach proposed by this Article is not just some academic exercise. It is intended to provide a working solution to invisible, attenuated, and expropriating uses of magnets and addresses in cyberspace that actually solves the problem by channeling activity in the least intrusive manner. The remedy is to require a reasonable technological solution to attenuated and invisible uses of marks in cyberspace, while leaving intact the ordinary principles of trademark law. It is at once a designed solution and a normative solution. It candidly seeks to disarm pirates. Moreover, the proposed solution of this Article chooses to support an accessible, navigable, active-information enabled, augmented presence supporting, fundamentally trustworthy cyberspace because this Article candidly contends such a cyberspace is in the public interest and is already regulable in that direction by recognizable principles of existing law.

The new factor solves the initial interest confusion overprotection cases. It solves the no-use/no-foul underprotection cases. In so doing, it better answers the need to apply recognizable trademark-related law in cyberspace. The new factor contains at least three safety valves against inadvertent destruction of cyberspace, and also against undesired doctrinal creep. First, it is limited by "place" of use to cyberspace only, and by "nature" of use to predatory uses. Second, it is limited by its flexible common remedy to preserve a robust and freely navigable cyberspace in the public interest. Third, it is limited by its polling technique to factual inquiries more nearly capable of determination than under current approaches.

The solution reframes non-rivalrousness of marks in cyberspace, reconceptualizes excludability in space, and rebalances the public interest in assessing injunctive relief as encouraged by both traditional trademark and unfair competition principles and as

reiterated in *eBay*.<sup>246</sup> This approach recognizes the potential of trademark to waste or spoil the commons in space and transforms the law to prevent that from happening. What remains to be done includes testing the new factor, including some cost assessment. What also remains is to answer the deliberate question whether to expand this solution, not by doctrinal creep, but purposefully, to other problem trademarks and to the more general task of disintegrating intellectual property.<sup>247</sup> The proposed solution is one that chooses to enlist the reasonable resources of existing juridical agents and of existing legal doctrines, modestly but purposefully transformed to rewrite the code of cyberspace in order to do some good.<sup>248</sup> It may not be the task of law to remedy every problem, but there are some problems it is both authorized and equipped to handle, and those it should.<sup>249</sup>

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246. See *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006) (“The decision to grant or deny permanent injunctive relief is an act of equitable discretion by the district court, reviewable on appeal for abuse of discretion.”); Folsom, *supra* note 8 (proposing criteria for determining the exercise of discretion in the public interest).

247. Folsom, *supra* note 8, at 102 n.120, suggests a disintegration project to divide “intangible products of the mind” into two species: “(1) intellectual property and (2) intellectual activity not rising to the level of intellectual property.” The first species might ordinarily be accompanied by expansive injunctive relief (at least as a pattern). The second species might be one in which the public interest is disserved by such expansive relief; a more narrowly tailored, proportionate, and flexible remedy, like the common remedy proposed for cyberspace interventions herein, would be more appropriate for that second species.

248. It is, after all, appropriate for the law, other things being equal and the rules providing the necessary flexibility, to do good rather than harm, to choose doing good rather than the opposite. See generally THOMAS AQUINAS, 2 SUMMA THEOLOGICA Pt. I-II, Q. 94, Art. 2, at 222 (Mortimer J. Adler ed., Encyclopedia Britannica, Inc. 1952) (“Hence this is the first precept of law, that good is to be pursued and done, and evil is to be avoided.”); *supra* notes 55-56 (asserting a provisional “good” and “bad” for the law in cyberspace). As Professor Lessig observes: in cyberspace, we must choose. LESSIG, *supra* note 10, at 140. Why not, then, choose something that is at once useful, possible, practical, and good (and also better than any alternative presently in view)? The law of cyberspace would have nothing to lose except its incoherence, and much to gain.

249. This is a limited goal. See AQUINAS, *supra* note 248, Pt. I-II, Q. 96, Art. 2-3 at 231-33 (warning against the impossible, counterproductive, and immodest attempt to repress all wrongs or to require every kindness by the misguided enactment of human laws that might try to forbid all vice or to mandate all the acts of virtue). But where it is possible to transform existing law which already has intruded into cyberspace, to do so better to serve the felt needs of society, and at the same time to serve the common good in cyberspace, it should be done. This is a benefit that the method of modern moral realism, as exemplified by this Article, can provide to existing law.



APPENDIX A: CYBERSPACE PROPOSITIONS AND FACTORS<sup>250</sup>

The six factors presented here are extracted from the Article, and presented in the order given in the Article. The last statement is the fully specified factor. It incorporates the elements of the prior factors and is designed for rule-based application. As a result, the last statement “is” the new factor and might be read alone, but the prior factors are provided both for the sake of transparency and also to show the progression of the propositions. The propositions are modular in the sense that a juridical agent designing a solution to the problem of markers in space might, over time, start by embracing the first, then the second, and so on, without having to embrace all of them at once. All of the factors are keyed to terms more fully defined elsewhere in the Article. Key terms indicated in italics here are defined in the glossary in Appendix B.

The first proposition: cyberspace and trademark law.

**01** The problem for trademark law is what, if anything, to do about *markers or spoilers* that are *invisible, attenuated, or expropriating uses in cyberspace* (and incidentally, by or through a *cyberspace gateway* implicating in various degrees a characteristic *cyberspace activity set*). The desired legal solution is one that will enhance that activity set for the aggregate benefit of the *typical actors* in cyberspace in the context of trademark-related disputes.

The second proposition: cyberspace interventions relating to marks.

**02** Invisible, attenuated, or expropriating uses in cyberspace can constitute potentially *offending uses* of designations that may cause a likelihood of confusion, or that may spoil and prevent marks from functioning as addresses otherwise available to a mark proprietor, to the extent they are objective and persistent *cyberspace interventions* with observable effects on *cyberspace users*.

The third proposition: a generalized statement of the new factor.

**03** Invisible, attenuated, or expropriating uses in cyberspace constitute potentially offending “uses” in marketing goods or services, or other conduct that might cause a likelihood of confusion, with the source or sponsorship of goods or services of a mark’s proprietor, or that spoil and prevent marks from functioning as addresses otherwise available to a mark

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proprietor, to the extent they are objective and persistent *cyberspace interventions* with observable effects on *cyberspace users*. To assess whether they do so, or not, under ordinary principles of trademark-related law, the following new factor should be added to any already existing nonexclusive factor list: "*the nature and place of use.*"

The fourth proposition: choosing to favor guides and choosing to disarm pirates (broad liability).

**04** The problem with the law's current response to invisible, attenuated, or expropriating uses in cyberspace is that it does not very well distinguish between harmless cyberspace interventions and predatory cyberspace interventions: a properly designed law ought to support the values of cyberspace by helping the *hitchhiker* and favoring the *hitchhiker's guide*. This means the law ought to favor the *cyberspace resource provider* (the mapper or "guide") and ought to disfavor the *cyberspace pirate*. Other things being equal, if existing law can be so directed, it ought to be.

The fifth proposition: a common remedy for mark related cyberspace interventions—choosing to provide narrowly tailored, flexible remedies consistent both with traditional remedies that have long been part of trademark and unfair competition law, and also with the rationale of *eBay* that has recently reemphasized the public interest involved in injunctive remedies in intellectual property cases.

**05** A *common remedy* to mark-type disputes in cyberspace caused by cyberspace interventions or offending uses in cyberspace will afford a strong heuristic, a rule of thumb that will control and unify not only trademark law but also the related bodies of law, private ordering, and norms. The *common remedy* is a reasonable technological accommodation in relation to the invisible, attenuated, or expropriating cyberspace intervention or offending use that called for a remedy in the first place and which is sensitive to *polling* either a potential consumer at the point of the intervention, or the offending actor itself. Those remedies include a technologically efficient and effective: (1) notice, (2) disclaimer, (3) forced redirect or forced release, (4) assignment or transfer, or (5) opt-out. The remedies are additive, and these remedies do not exclude other remedies if the conduct in question also violates other laws or regulations beyond those herein specified for cyberspace interventions.

The sixth proposition: a fully specified factor appropriate for rule-based applications to mark-type disputes in an objective cyberspace.

**06** The fully specified "nature and place of use" is a factor added to legal analysis in trademark-related disputes in cyberspace,

and especially to cyberspace interventions or offending uses by invisible, attenuated, or expropriating users. This specified factor explicitly considers whether the offending conduct is a cyberspace intervention and if so, the factor weighs its impact on cyberspace users, taking into account:

(a) the nature of the cyberspace intervention or offending use (whether it is harmless, value-adding, predatory, or neutral; invited, uninvited, expected, or unexpected);

(b) the nature of the offending party (whether mapper or guide; spoofer, trapper, spoiler, pirate, arbitrageur, shill, advertiser, or other) and whether the offending party is a direct, indirect, or vicarious participant in the offending activity;

(c) the nature of the supposed victim and the nature of any other interests involved (whether surfers, shoppers, customers, competitors, mark proprietors, or others including the public interest in a robustly navigable cyberspace), and whether the surfer, shopper, or customer is skilled, "on notice," or aware at the point of the cyberspace intervention, or is caught unawares and not "on guard";

(d) the place of use, including the degree to which the foundational cyberspace activity set of access, navigation, information-activity, augmentation, and trust is implicated in any particular place within cyberspace (whether the place of use is high or low, deep or shallow cyberspace);

(e) the presence or absence of any other "ordinary" trademark factor, or of those factors most applicable to invisible, attenuated, or expropriating uses, and the presence or absence of any other generally recognized factor that might show good faith or bad faith under cognate laws or norms (including anti-cybersquatting factors under the ACPA or dispute resolution factors under the UDRP); and

(f) the presence or absence of polling and any other circumstance reasonably related to the conflict between users in space.

After taking these into account a judge should then explicitly assess the public interest in a robust cyberspace (that is, the public interest in access, navigation, information-activity, augmentation, and trust), and assign some proportionate level of the common remedy matching the effect of the cyberspace intervention with a reasonable technological accommodation in relation to its harm. The judge may do this in addition to assessing any other remedy in respect of any other actionable legal harm, and with such damages as may be established.

APPENDIX B: CYBERSPACE GLOSSARY<sup>251</sup>

*Standard Terms.* This Article uses a number of standard cyberspace or technology-related terms. Definitions or descriptions are given in this Article (and are, for the most part, the subject of standard definitions, not coined herein) or at the following:

*Directory* – “an index that is compiled by human beings . . . [and] tend[s] to have fewer, but higher quality, links”;<sup>252</sup>

*Internet* – see *supra* note 17;

*Search Engine* – a search engine, like a directory, is a searchable index of resources available on the Internet. The “central difference” between a directory and a search engine is that a directory is an index compiled by human beings while a search engine is an index compiled by an autonomous software agent with search and decision criteria determined by programmed logic and algorithms.<sup>253</sup> Among current well-known search engines are Altavista and Google; among the popular directories are Yahoo! and Ask Jeeves.<sup>254</sup>

*New Terms.* The following terms are among those used in this Article in a specialized manner. While they are not inconsistent with standard terminology, they are in some sense coined herein:

1. *Attenuated, invisible, or expropriating trademark-type uses in cyberspace* — uses of a designation by an actor which include a trademarked term of another, and which serve as invisible or attenuated address or magnet to draw users or electronic agents to the actor rather than to the other (a “marker”), or which operate as a roadblock or detour effectively expropriating and preventing another from employing its own marks (a “spoiler”). Such invisible, attenuated, or expropriating addresses, magnets, roadblocks, and detours function as markers or spoilers rather than, or in addition to, serving “as” a mark on the Internet or elsewhere in cyberspace. Invisible and attenuated markers are said to be invisible and attenuated relative to an ordinary observer (they are markers not necessarily promoted or associated with goods or services in a way immediately visible to an observer), even though they are embodied in a tangible medium of expression from which they can be perceived,

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252. RADIN ET AL., *supra* note 17, at 80.

253. *Id.*

254. *Id.*

reproduced, or communicated, including by way of a machine or other device.

2. *Common remedy for invisible, attenuated, or expropriating uses* — one or more of the following: a technologically effective (1) disclaimer, (2) notice, (3) forced redirect/release, (4) assignment or forced auction, or (5) an opt-out. The common remedy is additive to other “ordinary” remedies: if the only harm is an attenuated or invisible use by a cyberspace intervention, then some aspect of the common remedy is the presumptive limit. If there is additional harm, including ordinary, visible, and direct use of an offending expression “as” a mark or otherwise causing an “ordinary” likelihood of confusion, then the ordinary trademark remedies may be added on top of these. (In the following discussion, it is assumed that *Y* is the intended destination, but a user is drawn to *X* instead because of a cyberspace intervention).

(1) A “*disclaimer*” in cyberspace is, by a technological means, the intervention of a non-avoidable and conspicuous message to this effect: “*X* is not affiliated with, sponsored by, licensed by, or endorsed by *Y*.”

(2) A “*notice*” of another address in cyberspace is, by a technological means, the intervention of a non-avoidable message coupled with a forced user-choice to this effect: “you have reached *X* but you might have intended to reach *Y*. You may reach *Y* [by clicking here] [by dialing this phone number].” If the offending actor is a search engine, a directory, keyword advertiser, or the like, the notice might take the form: “you have entered (or triggered an ad based on) *Y*, which is a trademarked expression. If you want to continue your search by finding the owner of the trademark, click [here]; if you want to continue with a more generalized search for goods or services more or less like *Y*-brand products, click [here].”

(3) A “forced redirect/release” has two aspects, related to each other but different in their scope and effect:

3.1. A “*forced redirect*” in cyberspace is, by a technological means, a non-avoidable, forced *change* of the user’s augmented presence to this effect: the user is actually rerouted from *X* to *Y*, or the user is confronted with a required choice so the user must affirmatively choose either *X* or *Y* (and though the user is “at” *X*, the user cannot proceed any further in either *X* or *Y* until the user elects one or the other). If the offending actor is a search engine, a directory, keyword advertiser, or the like, the forced redirect would force an affirmative election after the corresponding notice.

3.2. A “*forced release*” in cyberspace is to this effect: by a technological means, the user is given instructions about how to reach *Y* and then is actually *dropped* from *X* altogether with instructions to try again to reach either *X* or *Y* (and the user will also have been given instructions that if the user really intends to find *X*, the user must enter a new “clean” address for *X* that really has nothing at all to do with *Y*, and that only the use of the clean address will actually get the user back to *X*).

(4) An “*assignment or auction*” in cyberspace is to this effect: *Y* becomes the owner of the offending invisible, attenuated, or expropriated marker, or else *X* is forced to auction the marker to a population of non-piratical users (perhaps including not only *Y* but also *Z*, another valid trademark proprietor).

(5) An “*opt-out*” in cyberspace is a notice to this effect: “You are experiencing some invasive technology that intercepts your keystrokes and sends you information as a result. While some persons might consider this a feature, others might object. If you object, you may ‘opt-out’ by [clicking here].”

The *disclaimer* is pure information about *X*’s “non” relationship with *Y*. The *notice* contains information about, and a realistic opportunity to find *Y* (but the user remains “at” *X*). The forced *redirect/release* actually deposits the user “at” *Y*, or at least disconnects the user from *X*. The *assignment/auction* goes so far as to put the marker into the hands of *Y* (or another non-piratical user).

3. *Cyberspace* — an embodied switched network for moving information traffic (a cyberspace “gateway” or an architecture), further characterized by varying degrees of access, navigation, information-activity, augmentation, and trust on the network (a foundational “activity set”). High (or deep) space displays a higher degree of these foundational characteristics than low (or shallow) cyberspace: an operational definition. Compare “shmyberspace” as a rough synonym for low or shallow cyberspace, and contrast “the metaverse” as a term that signifies a virtual reality, shared imagination, or a consensual hallucination.

4. *Cyberspace Activity Set* — varying degrees of access, navigation, information-activity, augmentation, and trust. The activity set is one part of the operational definition of cyberspace.

5. *Cyberspace Gateway; Gateway* — an embodied switched network for moving information traffic: the threshold of cyberspace, and part of its architecture. Examples include the Internet and the phone system. The gateway is a necessary, but not a sufficient condition for cyberspace: it is one part of the operational definition of cyberspace.

6. *Cyberspace Interventions* — consented or unconsented, harmless or predatory, value-adding or free-riding activities by an actor in cyberspace that have an objective effect on other persons or electronic agents, especially by drawing other persons or agents to a destination; by inviting or influencing other persons or agents (including directories or search engines) to list a destination as something different from or more relevant than what it is; or by preventing ready navigation to an otherwise intended destination. Cyberspace interventions are usually described from the point of view of the other person or persons affected (see “offending use”).

7. *Cyberspace Resource Provider* — anyone who provides essential, useful, or value-added resources in support of high cyberspace values, but especially those not conventionally rewarded for doing so: the search engine or directory provider (or any comparable service provider in respect of later-developed methods). In some cases, the search engine provider’s economic return is in contrast to that of the commercial hardware or software developer under existing conventions by which hardware and software developers routinely sell or license their products to end users, but according to which the end user regards the browser or the search engine as something that ought to be “free,” or in which some market, mechanism, or practical factor drives the browser, the search engine, or directory provider’s price towards zero while the costs might be significantly higher than zero. There may also be significant barriers to entry for new cyberspace resource providers, especially those who must compete against providers who are government funded or subsidized, or who have dominant positions in other markets that support their resource-providing activities, or who have become previously entrenched.

8. *Cyberspace’s Typical Actors (in the context of trademark-related disputes)* — surfers and mappers, spoofers and trappers, spoilers and arbitrageurs, shills and advertisers, shoppers, consumers, competitors, and mark proprietors. If the public interest in trademark law generally (and in ordinary space) is already balanced among consumers, competitors, and mark proprietors, then the aggregate balance in cyberspace should not only preserve the preexisting balance but also, other things being equal, favor mark proprietors, surfers, shoppers, and mappers over spoofers, trappers, spoilers, shills, and expropriating users. The public’s interest in the activities of various rent-seeking arbitrageurs, including information brokers and aggregators, will vary according to the specific conduct involved

9. *Cyberspace Users (supposed victims)* — a subset of the typical actors in cyberspace. Of the larger group of typical actors, it is

surfers, shoppers, and consumers of varying levels of expertise and awareness who will generally be the focus of concern because these will be the supposed victims of likelihood of confusion. The same user might simultaneously act in more than one capacity and on more than one level of expertise or awareness, or a user might sequentially move from one capacity or level to another (the term includes electronic agents). In the context of expropriating use, spoilage, or waste of a mark or its goodwill, the cyberspace user also includes the mark proprietor, or the creator of the goodwill, and the actor who has expropriated the goodwill of the mark.

10. *Gateway* — see “cyberspace” and “cyberspace gateway” above.

11. *Hitchhiker* — a surfer: anyone who is engaged in information-seeking activity in cyberspace

12. *Hitchhiker's Guide (or "Guide")* — (1) a mapper, or a guide; anyone who places or controls the placement or allocation of addresses or magnets, publishes addresses or magnets, or otherwise promotes navigation in cyberspace by methods now known or hereafter developed; (2) a map, guidebook, or comparable resource. Something produced by a mapper or a guide, as for example, a search engine or directory; a short-hand name to describe a navigational resource provided by a cyberspace resource provider.

13. *Markers or spoilers in cyberspace* — expressions placed in cyberspace and that function as address, magnet, and/or mark to draw a user to an expected destination (a “marker”), and sometimes as roadblock or detour to deceive or to hinder a user from reaching an otherwise expected destination, or to prevent a mark proprietor from employing its own marks as addresses (a “spoiler”).

14. *Offending Use* — conduct that causes a likelihood of confusion or other specific harm in connection with marketing of goods or services. In cyberspace, an offending use includes:

[Alt. 1]. Use of an expression as an address, magnet, or mark that causes a likelihood of confusion in connection with marketing goods or services; or as a roadblock or detour in connection with, or as an interference with, marketing goods or services that either causes a likelihood of confusion or spoils, wastes, blocks, or expropriates the value of a mark of another (see “cyberspace interventions” for an alternate formulation: offending “use” consists in any cyberspace intervention that causes one of the specified harms).

[Alt. 2]. Any conduct which causes an expression (1) to be perceived or communicated, or fixed in a tangible medium of expression from which it may be perceived, reproduced, communicated, or inserted, either directly or with the aid of a machine or device, (2) by or to any person, machine, device, or agent, including an electronic or technologically-based agent,



now known or later developed (3) in connection with marketing goods or services, and (4) which causes a likelihood of confusion; or which draws, pulls, or diverts another person or virtual agent away from an intended location; or which spoils, wastes, blocks, or expropriates the mark of another; or by which marketing messages based upon a senior mark might be intercepted, diverted, or blocked.

15. *Pirate; Piracy* — (1) a person who commits piracy, but in cyberspace especially, one who does so by changing the map, moving markers, placing false markers, and otherwise planting deceptive magnets or addresses; or by spoiling, wasting, or expropriating markers; (2) the act or actions of a pirate: activities that tamper with the map to cyberspace or with the useful navigation of cyberspace, as by tampering with addresses or magnets or planting deceptive addresses or magnets, blocking or spoiling addresses otherwise available. A magnet or address is deceptive to the extent it draws a user to an otherwise unintended destination, or hinders a user from reaching an intended destination. Piracy is the more harmful to the extent it is the more uninvited, unexpected, predatory, and non-value-adding.

16. *Polling* — (1) an inquiry made to the user (potential consumer) at the point of the cyberspace intervention or within a reasonable proximity to the intervention and which seeks to determine whether the user is likely to be confused by the intervention; (2) an inquiry made by or on behalf of a mark proprietor to an offending actor which seeks to determine whether the actor is a value-added provider. Polling will typically be in relation to the common remedy—a *user* may be polled, and an *offending actor* may be polled separately: in the one case, by asking the user to select one of the remedies offered, and in the other case, by asking the offending actor to provide one or more of the notice, disclaimer, redirect/release, or opt-out procedures, thereby satisfying the user and the mark proprietor, and categorizing the offending actor at the time and place of the request.

17. *Principles of trademark law especially relevant in space* — There are seven principles of ordinary trademark law especially relevant to mark-type disputes in cyberspace. Likelihood of confusion (1) does not prohibit mere inconvenience or possibility of confusion, (2) can involve sponsorship as well as source, (3) is not for the small number of confused consumers, (4) raises questions of fact, (5) to the extent it is a mixed question of law and fact, must guard against errors introduced by doctrinal creep, reverse doctrinal creep, and feedback loops, (6) may be resolved at the remedy stage by flexible relief, and (7) to the extent it depends upon a legal determination of “use,” must guard against the multiple ambiguity of “use” in

trademark law, and must focus on the question whether the conduct in question is an “offending use” (and not upon the irrelevant question whether it is a “use sufficient to create trademark rights” or “use in interstate commerce sufficient to sustain federal jurisdiction under the Lanham Act”).

*18. Principles of trademark-related law especially relevant to marks in space* — There are other domains, outside of ordinary trademark law, that are especially relevant to mark-type disputes in cyberspace: (1) dilution, under the Federal Trademark Dilution Act or the Trademark Dilution Revision Act, (2) cybersquatting offenses, under the Anti-Cybersquatting Consumer Protection Act, (3) compelled dispute resolution, under the Uniform Dispute Resolution Policy of compliant domain name registries, (4) unfair competition offenses, under common law protection against appropriation of intangible trade values and under the Lanham Act, and (5) various norms, architectural, and market factors.

*19. Use* — see “*offending use*” and “*cyberspace interventions*.”