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Identifier Registries

Trademark law could in theory function perfectly well without registration. For much of its history, U.S. trademark law did just that, and even today many marks are never registered. But federal registration provides a crucial measure of clarity about trademark rights. The clarity is even sharper in non-U.S. systems in which priority is based exclusively on registration. If a mark is registered, the registrant has exclusive rights over its use; if a mark is unregistered, it is free for the taking by the first registrant.

But the federal Principal Register *is not the only registry*. There are also registries of telephone numbers, radio callsigns, domain names, and much more. If a trademark is a source-designating symbol, then these registries also allocate trademark rights. Control of a registration means control of a trademark within a particular domain.

Registries systematically raise two kinds of issues. The first is how each registry implements – or does not – fundamental trademark concepts like distinctiveness, priority, and likelihood of confusion. Or, if you prefer your concepts in the form of a question, what kinds of symbols can be registered at all, who is entitled to register one, and when will a registration be refused because it is too similar to an existing registration? The second is how these trademark-like rules interact with the actual trademark system. Do trademark rights also give rights over registrations, or vice-versa, or neither?

What makes these questions so difficult is that a registry typically exists because of a coordination problem in a particular domain, and the nature of that problem drives the design of the registry. In allocating phone numbers, for example, ownership of a number must be wholly unambiguous. Telecom companies must know exactly how to route a call to a given number. The trademark system can tolerate a degree of concurrent use that the telephone system cannot. This means that the telephone system cannot simply defer to trademark law; sometimes, its internal needs must take precedence.

At the same time, it is a rare registry that can ignore trademarks entirely. Almost any resource valuable enough to be registered can be used in a way that creates consumer confusion. Courts and the registry's operator must take trademark law and trademark policies into account.

How they do so varies by the type of registry involved.

A Broadcast Callsigns

The Federal Communications Commission requires every broadcast radio and television station to have a "callsign" (or "call letters"): a unique sequence of letters. At first, callsigns were three letters, but they rapidly ran out, so the Federal Radio Commission (the FCC's predecessor) switched to four letters, like KEXP and WCBS. By FCC policy, callsigns for stations east of the Mississippi River start with "W" and callsigns for stations west of the Mississippi start with "K."

Today, the FCC maintains an **online system** for stations to reserve callsigns. Prior to the Internet, a station was expected to "telephone the Commission's call sign desk and inquire as to the availability of the call signs in which they are interested."¹ Then it could request its desired call sign by letter. The FCC will not grant requests for a callsign currently in use by another station. This is an absolute nationwide priority rule. Moreover, only active stations may hold a callsign; a station that plans to start broadcasting in the future must have a construction permit from the FCC before it can reserve one. This is an intent-to-use system in which the FCC checks the bona fides of the intent.

The problem comes because callsigns are attractive service marks for broadcasters. If you must frequently announce your callsign on air, you might as well use it as mark to identify yourself to consumers. New York radio listeners are familiar with "1010 Wins the News," the slogan of the AM news station WINS, which broadcasts at 1010 kHz. Seattle listeners tune in to the FM alternative/indie station KEXP, which broadcasts at 90.3 MHz.² Not every station does this. iHeartRadio, for example, uses "KISS-FM" as a mark for dozens of top-40 radio stations around the country, but *not* including the rock station in San Antonio whose callsign really is KISS. For that matter, iHeartRadio plasters its name all over its stations, proudly proclaiming its corporate blandness. But it is a rare station – even one that also uses other marks – that does not incorporate its callsign into its branding to listeners. Indeed, a callsign can become well-known simply through consistent use by a station in its programming. WSM, broadcasting from Nashville, Tennessee, started life as "We Shield Millions," but became known as the home of the Grand Ole Opry.

Wherever you see trademarks, look for the trademark law. Until 1983, the FCC took the position that because it licensed call signs and could reassign them if necessary, stations did not own their call signs.³ Instead, it conducted a mini-examination process on each application for a callsign. It would refuse to grant requests for callsigns that it considered not in good taste.⁴ In addition, it would refuse requests for the initials of a president or living former president, the United States of America, or any of its agencies or departments, unless special dispensation was granted. These kinds of exclusions, if not always the details, should be familiar from Lanham Act section 2(a), 2(b), and 2(c).

1. FCC 98-324, FCC Rcd. 1235 (1998)

2. KEXP used to be KCMU, but switched to its current callsign in a partnership with the Experience Music Project, a boondoggle of a museum funded by the eccentric Microsoft billionaire Paul Allen. The Experience Music Project is now the Museum of Pop Culture, but the radio station kept the callsign.

3. See generally Milan D. Meeske & José Maunez-Cuadra, *Protecting Radio Call Letters and Slogans as Trademarks*, 36 J. BROADCASTING & ELECTRONIC MEDIA 267 (1992).

4. Can you think of any four-letter combinations that start with K or W that are in bad taste? Please don't share them.

The FCC also enforced a rule much like the Lanham Act's section 2(d) exclusion for marks likely to cause confusion. It would refuse to assign callsigns that "were phonetically and rhythmically similar to existing call letters of stations in the same area, so that the stations would likely be confused."⁵ This rule was much narrower than the full multi-factor analysis conducted by the courts in a trademark case; it focused on whether the callsigns would sound alike when read aloud on air. It also implicitly recognized a kind of geographic priority for callsigns: a hypothetical WMNN in Miami could block a proposed WMNM in Fort Lauderdale, but not one in Boston.

But the FCC dropped this policy in 1983 and adopted a much narrower rule. Now, a station may request any callsign it wants, as long as the callsign is not currently in use by another station.⁶ "Objections to the assignment of requested call signs will not be entertained at the FCC."⁷ In effect, this any-available-callsign policy treats only identical callsigns as creating a likelihood of confusion. From a trademark perspective, the policy is broader than necessary in that it prevents a station in Alaska and one in Arkansas from using the same callsigns, even though they serve utterly distinct markets. And the policy is narrower than necessary in that it allows nearby stations to have near-identical callsigns, e.g. WMNN and WMNM could serve the same city. The FCC does not care, because the main purpose of callsigns is station identification: stations must announce their callsigns on the air every hour.⁸

The FCC's decision to drop its soundalike test in favor of a strict-identity test looks like a middle finger to trademark law, but it is not. The FCC's position should not be understood as saying that trademark considerations are irrelevant in assigning callsigns. Rather, it says that the FCC's callsign registry is *the wrong forum* for sorting out the trademark issues. The USPTO can perform substantive trademark examination because it has a staff of trademark experts who understand the issues. The FCC has a staff of electrical engineers who understand signal power and interference. Trademark issues are not in their wheelhouse. The FCC's policy toward confusion in the callsign registry is, quite appropriately, "tell it to the judge." And some station owners do just that.

The courts have recognized that callsigns frequently function as service marks. In *In re WSM, Inc.*, the owners of WSM tried to register WSM with the USPTO. The examiner refused, arguing that the FCC "licenses applicant to broadcast, approves applicant's call letters, and retains the power to revoke the license to broadcast along with the call letters used to identify the station," so that the station could not control the mark and therefore did not own it.⁹ The TTAB reversed, explaining that the FCC's broadcast regulation and operation of a callsign registry did not turn it into a mark owner:

The relationship between broadcasters and the FCC is analogous to other areas of commerce where businesses are regulated by government agencies. Pharmaceutical manufacturers, for example, operate under complex regulations es-

5. *In re WSM, Inc.*, 225 U.S.P.Q. 883 (TTAB 1985).

6. 47 CFR § 73.3550

7. 47 CFR § 73.3550(g).

8. 47 CFR § 73.1201.

9. *WSM*, 225 U.S.P.Q. 883.

established and administered by a federal agency. The right to market a particular drug is granted by the agency and may be withdrawn by the agency for particular health or safety reasons at any time. The ownership of the trademarks used to identify these goods is obtained by the manufacturers through adoption and use, just as with any other trademark or service mark. The fact that sales are regulated by the agency and the agency may withdraw the right to market the goods has no bearing on the manufacturers' ownership of, and right to register, these trademarks during the time while they are in lawful use. If and when the agency rules that a manufacturer may no longer sell a particular product, the use of the mark in connection with that product ceases. If that or a similar product is not sold again the manufacturer will no longer be able to maintain trademark rights with respect to that particular kind of product. As with any other goods or services, the rights in the marks are tied to use.¹⁰

The FCC could not unilaterally withdraw a callsign or force a station to change it. It could terminate WSM's license, and if it did, then WSM might lose its trademark rights through (involuntary) abandonment because it could not legally continue to broadcast. But while it did broadcast, it identified itself to listeners with the WSM mark, and that was enough to make it a mark owner entitled to registration.¹¹ Note that these rights through use will naturally tend to be geographic, since a station will be heard or seen almost entirely within its service area – although that tendency may be fading somewhat now that stations often also simulcast on the Internet.

Where there are trademark rights, there is also the possibility of infringement. In *Draper Communications, Inc. v. Delaware Valley Broadcasters Ltd. Partnership*, for example, WBOC-TV, broadcasting from Sussex County, Delaware, sued over a planned WBOT-TV, to broadcast from Wilmington, Delaware, about 80 miles away.¹² Delaware is not a large state, and their service areas would overlap. The plaintiff's expert, a professor of linguistics, testified that "of the 17,576 logically possible sets of call letters east of the Mississippi, only 7 sets were as confusable as the two sets involved here."¹³ The defendant's expert, a professor of mass communications, testified that consumers primarily identify television stations by channel number rather than call sign.¹⁴ After an extensive discussion of the practices of local TV viewers in a market partially, but not completely, now served by cable television, the court agreed with the plaintiff and entered an injunction against the use of WBOT for the defendant's callsign. Although the court took into account the context of how callsigns are assigned and used, this was in all respects a standard, fulsome likelihood-of-confusion analysis.

The FCC's callsign policies anticipate such cases:

However, [the FCC's policy of not hearing objections] does not hamper any party from asserting such rights as it may

10. *Id.* at *2.

11. Did it need to show secondary meaning in WSM, or was use sufficient?

12. *Draper Commc'ns, Inc. v. Del. Valley Broad. Ltd. P'ship*, 505 A. 2d 1283 (Del. Ct. Chancery 1985).

13. *Id.* at 1291.

14. So maybe a channel number could be a service mark too . . . ?

have under private law in some other forum. Should it be determined by an appropriate forum that a station should not utilize a particular call sign, the initial assignment of a call sign will not serve as a bar to the making of a different assignment.¹⁵

15. 47 CFR § 73.3550(g)

That is, if a court forces a station not to use a particular callsign, the FCC will allow it to pick a new one instead.

To summarize, the assignment of callsigns illustrates all of the major trademark issues with a registry.

- A registry establishes a priority system, giving registrations have superior rights to subsequent ones. This system can be based purely on priority of registration, or it can – like trademark law – take existing uses into account.
- A registry must have and enforce rules about which identifiers are too similar to existing ones. The rules can be simple (e.g., only exact duplicates are forbidden) or more complicated (e.g., sound-alikes).
- A registry will usually have some rules that are driven by the technical needs of the system it relates to, e.g., station identification.
- A registry can have other rules based on substantive policies, e.g. no callsigns in bad taste.
- Like trademark law, the registry may required continued use to maintain rights. A station cannot continue to reserve its callsign if it stops broadcasting.
- The nature of confusion *within the registry* may not be the same as consumer confusion *in the marketplace*, because of the different contexts. The FCC was concerned about radio callsigns sounding the same during station identification, but consumers also encounter callsigns on billboards and in newspaper ads, where they can be seen as well as heard.
- The registry, regulators, and the courts must decide how significant a registration is in creating trademark rights.
- Conversely, they must also decide how much weight to give trademark rights in allowing or prohibiting a registration.
- The existence of the registry, and the nature of the system it exists to serve, can be highly relevant in trademark litigation.

Keep these issues in mind as you read the remainder of this chapter.

B Telephone Numbers

Holiday Inn is a nationwide chain of budget hotels for families on vacation, which it operates under the HOLIDAY INN family of marks.¹⁶ For many years, its reservations hotline had the telephone number 800-465-4329, which spells 800-HOLIDAY on a phone keypad. In 1993, a company called Call Management reserved the number 800-405-4329, which

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

is exactly the same except that it uses a 0 instead of a 6. Some customers, intending to make reservations at Holiday Inn, dialed "0" instead of an "O" when phone-spelling out "HOLIDAY." They reached one of Call Management's partner travel agencies, which were more than happy to book them a Holiday Inn reservation and take a commission. Holiday Inn sued for trademark infringement. How should we think about this practice? The answer depends on the interaction of trademarks and the telephone system's registry of numbers.

Like callsigns, telephone numbers are also regulated by the FCC, but there is a twist. There are about 30,000 licensed broadcasters in the United States, and they change callsigns infrequently. This is a small enough administrative load that the FCC can administer it directly. But there are 330 million people in the United States – over 10,000 times as many – and it is not uncommon for people to change numbers.¹⁷ As a result, while the FCC makes rules about assigning telephone numbers, it hands the actual administration of them off to two layers of intermediaries. Individual telephone companies assign numbers to their subscribers, and the companies receive blocks of numbers from the North American Numbering Plan Administrator.

In a technical sense, if not a trademark sense, callsigns are arbitrary. Any set of letters will do, as long as it is distinct from the letters used by other stations. Not so for telephone numbers. They play an essential, *functional* role in the technological operations of the telephone system. For many years, telephone calls were routed mechanically: the clicks of a telephone dial were used by enormous switching equipment to connect the caller's telephone to the callee's. This system was a technological marvel, and it was deeply, inherently geographic. A local *exchange* of a few thousand lines shared a common prefix,¹⁸ and every phone number in the area it served had its own unique number starting with that prefix. In turn, these exchanges were eventually grouped into *area codes*, e.g., New York City was 212, Chicago was 312, Denver was 303, and so on. Thus, for example, the Hotel Pennsylvania's full number is 212-736-5000.

While stability of numbers was important, for obvious reasons, people often moved, as people are wont to do. When they did, they received a new number at their new address. *It could not have been otherwise.* It was simply not technically possible to route calls from the old number to the new address, which would typically be served by a different exchange, and quite possibly a different local telephone company. Indeed, sometimes numbers would need to be reassigned for purely technical reasons; development in an area could force exchange or area code boundaries to be redrawn. Sacramento was initially part of 415 (along with San Francisco), but it shifted from 415 to 916 in 1950. Then the boundaries of 916 gradually shrank from all of northeastern California to the Sacramento area, as areas were hived off to become 707 and 530, and then 279 was added as an overlay to cover new numbers in Sacramento. Thus, just as the FCC argued that individual stations did not own their callsigns, neither individuals nor telephone companies owned

17. New phone who dis?

18. Some of these prefixes had mnemonics, and some of these mnemonics are immortalized in popular culture, like **PE**nnsylvania and **BU**tterfield.

their telephone numbers. Indeed, most numbers were simply assigned: by NANPA to telephone companies in blocks, and by companies to subscribers one by one.

So far, this seems like a completely non-trademark registry. But capitalism finds a way. Businesses gradually realized that some of these randomly assigned numbers could be used to spell out short phrases using the keypad code in which ABC are on 2, DEF are on 3, and so on. For example, in 1982, William Alexander realized that 800-FLOWERS would be a great telephone number for a florist.¹⁹ At the time, the corresponding number, 800-356-9377, was assigned to Capitol Warehousing, a transportation company. They ran a test by placing ads in the New Orleans area, during which calls for both truck brokerage and flower delivery were directed to the same number. It was encouraging enough that they had AT&T transfer the number to a new venture, 800-Flowers, Inc., which is the predecessor in interest of into 1-800-FLOWERS.COM, Inc, which still uses the number and a **similarly named website**, and has a market capitalization of nearly \$2 billion.

As this example suggests, the rules that subscribers cannot select and do not own their telephone numbers have weakened considerably. Mobile numbers can travel anywhere a user goes. Many companies give users a selection of available numbers, and Internet-based telephone services like Google Voice can let users select numbers in many different area codes. Numerous services let users select and sign up for specific "vanity" phone numbers that spell something appealing, provided their desired number is available.²⁰ Indeed, thanks to improvements in computerized switching, the FCC now requires telephone companies to cooperate in "number portability" – enabling a subscriber to take a phone number from one location and company to another, as long as it is technically feasible.

But one important limit on holding telephone numbers remains. It is illegal to "warehouse," "hoard," or "broker" toll-free numbers.²¹ A telephone cannot reserve a toll-free number without having a subscriber for whom it is being held, and a subscriber cannot reserve more toll-free numbers than it intends to use, or acquire a toll-free number for the purposes of selling it. These rules should be familiar; toll-free numbers, like trademarks and call signs, cannot be registered without an intent to use. The point of these rules is to prevent speculation, reduce the technical burden of database entries for unused numbers, and ensure that if no one else is actually using 800-599-5426 to provide a toll-free service, it remains available for Kwyjibo Electronics.

For the most part, the FCC, NANPA, and telephone companies do not try to implement any substantive policies when reviewing requests for telephone numbers. There are many technical limitations, having to do with service areas, available number blocks, and reserving certain number combinations (e.g. no number can start with 911, which is reserved for emergency services, or 411, which is reserved for directory services). But there are no other policies embedded in registry rules. One reason is that because most numbers are treated as opaque strings

19. *Jahn v. 1-800-Flowers.com, Inc.*, 284 F.3d 807 (7th Cir. 2002). In the United States, numbers with "area" codes starting with 8 (e.g. 800, 888, etc.) are "toll free" and are billed to the number owner, rather than the caller. This was a big deal when phone calls were expensive. Numbers in the 900 "area" code are "pay-per-call" and the caller pays a charge to the number owner. USA Today's New Kids survey, in the Trademark chapter, used a 900 number.

20. Mine is 657-LAW-CODE. The public radio call-in quiz show *Wait Wait, Don't Tell Me!* is 1-888-WAIT-WAI.

21. 47 CFR §§ 52.106, .107

of digits and because any given string of digits maps to many different letters (e.g. 387-8459 could be either FUR-UGLY or DUSTILY), there is no particular concern about a number having a particular meaning. Another is that consumer confusion of numbers *as such* is uncommon; callers are expected to dial the digits of a number exactly, and are rarely exposed to near-identical numbers in daily life (as most numbers are essentially randomly assigned). So the registry-level standard of likelihood of confusion is typically the same as for call signs: exact identity.

Returning to our opening example, it is now clear that Call Management obtained 800-405-4329 legitimately, as far as the telephone system is concerned. Holiday Inn could have reserved this number at any time. Indeed, some of its competitors, like Red Roof Inns, did just that for their own 800 numbers (800-RED-ROOF has two 6s for Os). But the number was available when Call Reservations checked, and the general rule is that any available number may be reserved. This simple rule keeps the intricate dance of assigning and returning telephone numbers moving briskly.

But just as with call signs, the fact that a telephone number can be *registered* does not necessarily mean that it can be *used* without trademark trouble. Call Management was exploiting a very specific form of consumer confusion: at the instant of being connected, most consumers who reached it were under the impression that they had dialed Holiday Inn. Of course, this by itself is not actionable; most wrong numbers are innocent mistakes on everyone's part. The Sixth Circuit held that the same was true here because Call Management was *passively* exploiting consumers' misdials. It did not take out advertisements claiming to be Holiday Inn, or promote its misleadingly similar number. It simply sat back and waited for the calls to come in.

Contrast *Dial-A-Mattress Franchise Corp. v. Page*, where the plaintiff had the number 628-8737 (which spells MATTRES) in New York City area codes and advertised with the phrase "DIAL-A-MATTRESS and drop the last 'S' for savings."²² The defendant acquired 1-800-628-8737 (i.e. 1-800-MATTRES) and advertised his business under that number. The Second Circuit held that this actively created consumer confusion and could be prohibited. MATTRESS was generic for mattresses, but the slogan DIAL-A-MATTRESS was not, and the use of a similar phone number made the defendant's use confusingly similar. Similarly, in *American Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp*, the plaintiff's mark was AMERICAN AIRLINES and the defendant used the number 1-800-AMERICA, advertised itself as an airline company, and listed its company name as "A 1-800-A-M-E-R-I-C-A-N." The court emphasized that its "wrongful conduct lies in its misleading use of the 'Airline Companies' yellow-pages listing rather than its mere use of its telephone number as such."

This may seem like awfully fine hair-splitting, but there is an important principle here. Trademark law cares about preventing consumer confusion, but its quest to prevent confusion cannot be all-consuming. The telephone system and the registry of telephone numbers have im-

22. *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989).

portant policy values embedded in their rules. It is important that numbers flagged as available for assignment actually be available. An innocent business should not be put in the position of being forced to change its telephone number just because the number happens to be too similar to someone else's number or trademark. Thus, cases like *Holiday Inns, Inc. v. 800 Reservation, Inc.* refuse to find a defendant liable simply for using a telephone number. This doctrine is in some tension with the unfair-competition idea that confusion created in bad faith is actionable – Call Management certainly acted to take advantage of consumer confusion, and it is not hard to imagine the *Blinded Veterans Ass'n v. Blinded American Veterans Foundation* court ordering it to play a disclaimer at the start of each call that it is not Holiday Inn and is not affiliated with Holiday Inn. But the idea is intelligible enough. If Holiday Inn cared enough about the risk of misdialing, it should have actually reserved the number in question. It cannot sit back and later sandbag a competitor by asserting trademark rights over the number. Only if the competitor engages in some additional conduct directly targeted to Holiday Inn's goodwill will Holiday Inn have a claim.

One last twist. The FCC experimented once with a system allowing trademark owners to claim toll-free numbers corresponding to their marks.²³ In the 1990s, facing the near exhaustion of available 800 numbers, the FCC released 888 as a new option. In the run-up to the availability of 888, the FCC gave holders of existing 800 vanity numbers a right of first refusal over the corresponding 888 numbers.²⁴ It could reserve the number, but would need to actively invest in, advertise, and use it.

This is our first example of a *sunrise period* in a new registry – one that gives existing trademark owners a first chance to claim a corresponding registration. Sunrise periods can be attractive because there are no reliance interests in the previously unavailable identifiers. But giving trademark owners rights over too many new identifiers can defeat the purpose of opening up the space in the first place. If every 800 number owner simply claims the same number in 888, 877, 866, and so on, the available semantic space has not actually increased. The active-use requirement – familiar from trademark law – served as a deterrent to such behavior. At any rate, the market voted with its wallet; few trademark owners took advantage of the procedure. The FCC chose not to repeat the precedent when it opened up 877 two years later, or 866 after that, or so on.

C Business Names

States regulate business names in several ways. The first is that corporations and other artificial entities must have *official names*. These names are important for legal purposes. If the Hudsucker Holding Corporation, Hudsucker Industries, Hudsucker Inc., and the Hudsucker Operating Company are distinct entities, then contracting parties need to know with exact certainty whom they are dealing with, and plaintiffs need to

23. Diana Lock, *Toll-Free Vanity Telephone Numbers: Structuring a Trademark Registration and Dispute Settlement Regime*, 87 CAL. L. REV. 371 (1999).

24. For the FCC's reasoning, see *In the Matter of Toll Free Service Access Codes Fourth Report and Order*, 13 FCC Rcd. 9058 (1998). Among other things, the FCC also considered but rejected the use of lotteries and auctions to assign toll-free numbers.

know which entity to sue. Indeed, the process of incorporation itself incorporates²⁵ a registry. Every state maintains an office that accepts incorporation filings and allows the public to search its records, pulling up basic information such as the entity's name, address, and date of incorporation.²⁶

These corporate registries typically use a first-to-file priority system. Under the Model Business Corporation Act, the similar standard is that a proposed new name must be "distinguishable upon the records" from existing names.²⁷ A comment explains how this standard operates in practice:

The principal justifications for requiring a distinguishable official name are (1) to prevent confusion within the secretary of state's office and the tax office and (2) to permit accuracy in naming and serving corporate defendants in litigation. Thus, confusion in an absolute or linguistic sense is the appropriate test under the Model Act, not the competitive relationship between the corporations, which is the test for fraud or unfair competition. The precise scope of "distinguishable upon the records of the secretary of state" is an appropriate subject of regulation by the office of secretary of state in order to ensure uniformity of administration. Corporate names that differ only in the words used to indicate corporateness are generally not distinguishable. Thus, if ABC Corporation is in existence, the names "ABC Inc.," "ABC Co.," or "ABC Corp." should not be viewed as distinguishable. Similarly, minor variations between names that are unlikely to be noticed, such as the substitution of a "," for a "." or the substitution of an Arabic numeral for a word, such as "2" for "Two," or the substitution of a lower case letter for a capital, such as "d" for "D," generally should not be viewed as being distinguishable.²⁸

Notice the two uses cases: within the state's regulatory offices, and by lawyers looking to sue and serve the proper defendant. These are both searches by *experts*, not by the general public. The result is that the test for confusion is narrow, but not completely mechanical.

The MBCA also provides a clear explanation of why this standard, rather than trademark likelihood of confusion, is appropriate:

The elimination of the "deceptively similar" requirement that appeared in earlier versions of the Model Act is based on the fact that the secretary of state does not generally police the unfair competitive use of names and, indeed, usually has no resources to do so. For example, assume that "ABC Corporation" operates a retail furniture store in Albany, New York, and another group wants to use the same name to engage in a business involving imports of textiles in New York City. . . . If the second group uses a distinguishable official

25. Pun intended.

26. Here is Delaware's.

27. MBCA § 4.01(b)

28. MBCA § 4.01 cmt. b.

name, like “ABD Corporation” . . . the secretary of state will usually not know in what business or in what geographical area “ABC Corporation” is active or what name ABD Corporation is actually using in its business . . .²⁹

29. MBCA § 4.01 cmt. b.

Much like the FCC, a secretary of state’s office does not have the depth of factual information and domain expertise to resolve contests over whether two names create a likelihood of confusion in practice. Thus, the registration process is streamlined, and questions of consumer confusion are kicked over to the courts.

Once again, allowing registrations under such circumstances creates the question of what effect the registration ought to have in trademark disputes. But here, the answer is easy: absolutely none. Recall that in *Galt House Inc. v. Home Supply Co.*, one of the competing claimants incorporated a business under the name Galt House. Quoting a corporate-law treatise, the court explained, “Mere incorporation under a particular name does not create the right to have such name protected against use by another.”³⁰ The corporate registry is a business-facing public record. Consumers do not read it. Unless and until a business starts advertising or selling to consumers, it has not actually established any goodwill. The corporate-name registry serves a wholly *non-trademark* role.

30. *Galt House Inc. v. Home Supply Co.*, 483 S.W.2d 107, 112. (Ky. 1972).

Still, the occasional consumer-confusion concept sneaks into the rules on acceptable corporate names. We have already seen that under the former version of the MBCA, secretaries of state did some policing of “deceptively similar” names. Another issue is that some terms have legislatively fixed meanings; corporations cannot use them unless the terms really are descriptive of its business. Consider *Harvard Business Services v. Coyle*, in which the plaintiff tried to file a certificate of incorporation for a corporation to be called “Bank Financial Services, Inc.”³¹ The Delaware Secretary of State rejected the filing because the corporation was not authorized to engage in the business of banking.³² The court upheld this action, even though there was no express statutory prohibition on this use of the word “bank.” It had this to say about the Secretary’s discretion to refuse other proposed names:

31. *Harvard Bus. Servs. v. Coyle*, 1997 Del. Super. LEXIS 70 (1997).

32. Banking is heavily regulated, and requires a specific type of corporate charter and compliance with numerous oversight provisions.

Surely, if an incorporator attempted to incorporate in Delaware using obscene or libelous language in the proposed corporate name, the Secretary would have the discretion to refuse such a filing. Similarly, if a proposed corporation’s name consisted of five hundred words, the Secretary would have the authority to refuse to accept the certificate of incorporation for filing if the overly lengthy corporate name would cause undue confusion or difficulty in administration. This discretion is not delineated in the statute, but seems implicit in the Secretary’s duty to accept corporate filings.³³

33. *Harvard Bus. Servs.*, 1997 Del. Super. LEXIS 70.

Another type of business name registry is more closely related to trademark law. Many states regulate *assumed names*: i.e., names used

by a person or business when they present themselves to consumers under a name other than their own. The official name on the corporate paperwork may be Sanchez Grocery and Deli, but if the sign out front says Manuela's Deli, people who shop there won't know what entity to hold legally responsible in case something goes wrong. Thus, Sanchez Grocery and Deli will need to file paperwork with the state stating that it is *doing business as* (or "d/b/a") Manuela's Deli. A customer who is injured on the premises can then search the database to find out who to name as a defendant in a complaint.³⁴

The names on a d/b/a registry are often the actual service marks – whether registered or not – that a business uses when transacting with the public. Again, mere registration creates no goodwill as such, and hence no trademark rights. Only actual use with the public can do so.

An important difference is that here, there is no need to police the registry for confusing similarity. It is entirely possible for multiple businesses to use identical assumed names in wholly non-confusing ways: Manuela's Deli in New York City and Manuela's Deli in Buffalo are geographically remote. Similarly, Acme for a plumber and Acme for an import-export broker are not likely to cause any consumer confusion.

Occasionally – and more in the past than today – registry authorities would attempt to exclude certain names from being registered as assumed names. In *Cooper v. Goodman*, a filer attempted to register the names "The Brothel," "The Garden of Erotic Pleasures," "Theatre O," and "Club Orgy," and the county clerk refused "because they would be employed for deceptive purposes indicating that some kind of illegal or otherwise obscene activity may be expected within the establishments so described."³⁵ Note the combination of deceptiveness, illegality, and immorality concerns – three distinct trademark rationales – at work in this refusal. Denying registration had important legal consequences, because without the certificate, the filer could not legally operate its clubs under those names. The court reversed and ordered the names registered:

Obviously, the assumed names on the certificates were adopted for the purpose of obtaining publicity, public attention, and curiosity with the expectation they would promote business for the establishments. In fact, they may invite the attention of the Police Department, which would cause the establishments to be under police surveillance. In such case the public would be protected from illegal activities.

The filing of a certificate does not imply governmental approval of the assumed name or of the business activity. The filing is statutorily required for the purpose of identifying the person operating the business under such assumed name.³⁶

There is a consumer-protection flavor to d/b/a registration that sometimes shows up in state laws. In *Friedman v. Rogers*, for example, Texas prohibited the practice of optometry under an assumed name.³⁷ As the

34. "The obvious purpose of the Fictitious Names Act is to protect persons giving credit in reliance on the assumed or fictitious name and to definitely establish the identity of the individuals owning the business for the information of those who might have dealings with the concern." *Fremd v. Horne*, 1990 WL 362051 (Pa. Com. Pl. 1990)

35. *Cooper v. Goodman*, 65 Misc. 2d 939 (N.Y. Sup. Ct. 1971).

36. *Id.* at 940.

37. *Friedman v. Rogers*, 440 U.S. 1 (1979).

Supreme Court explained in upholding the statute against a Constitutional challenge:

The possibilities for deception are numerous. The trade name of an optometrical practice can remain unchanged despite changes in the staff of optometrists upon whose skill and care the public depends when it patronizes the practice. Thus, the public may be attracted by a trade name that reflects the reputation of an optometrist no longer associated with the practice. A trade name frees an optometrist from dependence on his personal reputation to attract clients, and even allows him to assume a new trade name if negligence or misconduct casts a shadow over the old one. . . .

[In a previous case *Ellis Carp*] operated 71 optometrical offices in Texas under at least 10 different trade names. From time to time, he changed the trade names of various shops, though the licensed optometrists practicing in each shop remained the same. He purchased the practices of other optometrists and continued to practice under their names, even though they were no longer associated with the practice. In several instances, *Carp* used different trade names on offices located in close proximity to one another and selling the same optical goods and services. The offices were under common management, and had a common staff of optometrists, but the use of different trade names facilitated advertising that gave the impression of competition among the offices.³⁸

38. *Id.* at 13.

There was also evidence that Texas's motivation was to protect individual optometrists from competition by chains, so the consumer-protection rationale may have been a bit of a smokescreen. But the general point stands. A d/b/a registry sits at the nexus between a state's regulation of companies and the trademarks they use to market themselves to the public.

D ISBNs

An International Standard Book Number is a 13-digit number used to uniquely identify a book.³⁹ It starts with the prefix 978, then contains sections for a group (a national or geographic region), a publisher, a title, and a checksum digit that helps detect errors if any of the numbers are accidentally mistyped. An international association of more than 160 ISBN agencies divide up the space of possible ISBNs and assign them to publishers within their own territories. When a publisher receives a block of ISBNs, it assigns them to individual titles and editions that it publishes. Every ISBN in use is supposed to be registered with R.R. Bowker, which maintains an industry-wide database of ISBNs. Once assigned, an ISBN is never supposed to be reused, so that it can remain a permanently unique identifier. Publishers are also not supposed to sell

39. See generally *FAQs: General Questions*, http://www.isbn.org/faqs_general_questions.

or assign their ISBNs to each other.

The system is meant to ensure that every edition of a book has a unique ISBN. It provides a unique identifier for specifying an edition with certainty. If you want the eleventh edition of my Internet Law casebook, you should get the book with ISBN 978-1-943689-13-2. The tenth edition was 978-1-943689-10-1.⁴⁰ These are different, and if you try to buy one of them from a used bookseller, you should object if you receive the other. ISBNs are heavily used inside the publishing industry to track information about books and their distribution: e.g., Amazon uses them to link information about books.

The space of distinct ISBNs in theory consists of 1 billion distinct identifiers, which seems like a lot. At roughly two million published worldwide per year, this works out to a 500-year supply. But because so much information is encoded into the first few fields of the ISBN, they are distributed unevenly. In addition, the rise of self-publishing has fueled a significant rise in the demand for ISBNs. In popular regions, such as the United States, ISBNs can cost \$125 for one or \$925 for ten.⁴¹ One consequence is that publishers will sometimes reuse an ISBN for a new edition of a book, or sometimes even on a completely unrelated book. ISBN agencies will shortly begin assigning blocks of ISBNs that start with the prefix 979 as their supplies of 978 ISBNs are exhausted.

At this point, you may be thinking something like, "This is an IP textbook, but where is the IP law in the ISBN registry?" We have seen that identifiers in other registries can function as trademarks, and that trademark law can give rights over some identifiers. But both of these tendencies are severely attenuated for ISBNs. Why might that be?

E Domain Names

Now for the big Kahuna, domain names. The short version is that every computer on the Internet has one or more Internet Protocol (IP) addresses that can be used by other computers to send messages to and from it. But IP addresses, which are made up of a 32-bit number written as four numbers between 0 and 255 separated by dots, e.g. 23.185.0.2, are cumbersome for humans to use and remember. Thus, the Internet also has a Domain Name System that assigns *domain names* and can translate a human-readable domain name like `tech.cornell.edu` into the corresponding IP address.

For IP survey purposes, you can think of the DNS as a single giant registry that is available online and provides an answer whenever a person or computer wants to look up a domain name. It is administered by the Internet Corporation for Assigned Names and Numbers (ICANN) and operated by a variety of companies around the world. The actual entries in each registry are handed out on a first-come, first-serve basis by *registrars* like Google Domains, Register.com, and Gandi. There is an annual fee for each registration, part of which is kept by the registrar, part of which goes to ICANN, and part of which goes to the registry operator. If a registrant stops paying the fee, the domain name be-

40. Notice that the group and publisher fields are the same, but the title and checksum fields are different.

41. They can be purchased directly from Bowker. Does its dual status as a registry operator and as a sales agent for ISBNs create a conflict of interest?

comes unclaimed and registrable again. There is a substantial business in buying unused domain names, paying the annual registration fees, and waiting for someone to come along who is interested in purchasing them.

The USPTO previously took the position that the top-level-domain part of a domain name (e.g. .com or .org) served no source-indicating function and therefore never affected the distinctiveness of a mark. The Supreme Court rejected that view in *US Patent & Trademark Office v. Booking.com BV*, emphasizing that the meaning of a putative trademark is what consumers perceive it to be:

A "generic.com" term might also convey to consumers a source-identifying characteristic: an association with a particular website. As the PTO and the dissent elsewhere acknowledge, only one entity can occupy a particular Internet domain name at a time, so a consumer who is familiar with that aspect of the domain-name system can infer that BOOKING.COM refers to some specific entity. See also Tr. of Oral Arg. 5 ("Because domain names are one of a kind, a significant portion of the public will always understand a generic '.com' term to refer to a specific business..."); post, at 2312-2313 (the "exclusivity" of "generic.com" terms sets them apart from terms like "Wine, Inc." and "The Wine Company"). Thus, consumers could understand a given "generic.com" term to describe the corresponding website or to identify the website's proprietor.⁴²

As part of its administration of the DNS, ICANN adopted the Uniform Domain-Name Dispute Resolution Policy, or UDRP. The following language is required to be included in all contracts to register domain names in most top-level domains. "You" refers to the the party registering a domain-name; "we" is the domain-name registrar (e.g. Google Domains or Namecheap).

4. *Mandatory Administrative Proceeding.* –
 - a. *Applicable Disputes.* – You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts that
 - (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
 - (ii) you have no rights or legitimate interests in respect of the domain name; and
 - (iii) your domain name has been registered and is being used in bad faith.
 - b. *Evidence of Registration and Use in Bad Faith.* – For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be

42. US Patent & Trademark Office v. Booking.com BV, 140 S. Ct. 2298 (2020).

present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
 - (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
 - (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
 - (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.
- c. *How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.* – Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):
- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
 - (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
 - (iii) you are 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 or service mark at issue.
- i. *Remedies.* – The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the com-

plainant.

- k. *Availability of Court Proceedings.* – The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel’s decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel’s decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

An actual UDRP proceeding is an arbitration before a panel of one or three arbitrators. ICANN maintains a <http://www.icann.org/en/dndr/udrp/approved-providers.html> list of approved dispute-resolution bodies. For example, one is the World Intellectual Property Organization. It currently charges \$1,500 for a dispute involving 1 to 5 domain names, or \$4,000 for a three-member panel. UDRP proceedings are conducted entirely online.

Note that although the UDRP purports to specify its own standard of decision (including a list of activities constituting “bad faith”), that standard is deeply rooted in trademark concepts like “confusingly similar” and “rights or legitimate interests.” It is therefore rooted in trademark law, but not the trademark law of any jurisdiction. It is more of a free-floating worldwide trademark law of the Internet, and indeed UDRPs have come to have their own particular norms and standards.

Consider *Philip Morris USA Inc. v. Computer Services, Inc.* The complainant (as the party initiating a UDRP is called) was the cigarette company that owned the MARLBORO mark and used the domain name <marlboro.com>. The respondent registered the site <marlboro-sucks.com> and did nothing with it for eight years. It did not resolve to

any actual website; it merely displayed an error message. Under *Radiance Foundation, Inc. v. NAACP*, this would probably be a protected non-commercial use, and indeed the respondent so argued, writing “There is zero proof of cybersquatting or commercial use of the domain marlborosucks.com and this complaint should be thrown out immediately. ... I would like this case resolved immediately so that I can proceed with my plans for the domain.” But the arbitrator disagreed:

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark MARLBORO MARKS.

The term “sucks” is a well-known pejorative descriptive word most often, in the Internet community, signifying or otherwise associated with sharp criticism. The Panel takes judicial notice of the fact that a domain name which contains the term “sucks” appended to a mark (e.g., in the form of (mark + sucks).gTLD), typified by the disputed domain name here, generally serves as a signal to an Internet viewer that a website accessed through such a name contains content highly critical, often caustic, in some fashion towards an owner of the mark and/or the goods or services which the owner provides.

Consequently, from a simple comparison of the name to the Complainant’s mark MARLBORO MARKS, no doubt exists that the disputed domain name is confusingly similar to the mark. The name <marlborosucks.com> consists of the term MARLBORO followed by the well-known term “sucks”. The name also contains the generic Top-Level Domain (gTLD) “.com”. The addition of the gTLD is generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It has become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain (SLD), that results from modifying the mark, to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent’s incorporation of the term “sucks” to form the SLD clearly constitutes such a minor variation and, as such, does not avoid a finding of confusing similarity.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to support a claim of rights

or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant's MARLBORO MARKS Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent never did and does not now use nor has ever made any demonstrable preparations to use the disputed domain name to resolve to an operational website through which it does or will make *bona fide* offerings of any goods or services. Passively holding a domain name, which infringes the trademark rights of another, for nearly an 8 year period does not qualify, on any basis, as a *bona fide* offering of goods and services.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by the disputed domain name or any of the Complainant's MARLBORO Marks.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel believes the Respondent was well aware of the Complainant and its mark MARLBORO, and the substantial reputation, goodwill and fame which that mark acquired and the exclusive rights which the Complainant held in its MARLBORO Marks when the Respondent registered the disputed domain name. Nevertheless, the Respondent held the name, without ever using it to resolve to an operational website, for a period now reaching nearly 8 years. Even now, the Respondent merely states that it has "plans" to use the name without defining, with any degree of specificity whatsoever, what those plans are, and when and how they will be implemented. Such a vague assertion leads the Panel to believe that the Respondent has no concrete plans at all to ever use the name to resolve to an operational website and, during the course of holding the name for nearly 8 years, never did.

The disputed domain name, being a "sucks"-based name, could, under a proper set of circumstances, legitimately serve as an address of a noncommercial, operational website, e.g., a so-called gripe site, through which the Respondent posts content critical of the Complainant and/or its cigarette products offered under its mark MARLBORO. However, none of those circumstances has apparently ever existed here and certainly do not now exist. This is plainly evident as one absolutely crucial threshold requirement is glaringly absent: legitimate use. Apart from any illegitimate

use, the Respondent has simply never used and does not now use the domain name at all. It merely passively holds the name and has done so for nearly 8 years.

Each of the federal cases which the Respondent cites for the proposition that free speech rights attach to a sucks-based domain name is not only clearly distinguishable from the present facts but is irrelevant to those facts simply because in each such case the name at issue was actually used by a defendant as an address of an operational noncommercial website providing critical comment, an aspect totally missing here. Specifically, in *Bosley Medical Institute v. Kremer*, a disgruntled customer registered and used a domain name incorporating plaintiff's mark for a website detailing investigation against plaintiff and other information "highly critical" of plaintiff).

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.⁴³

43. *Radiance Found., Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015).

This conclusion is hard to support under U.S. trademark law as we have seen it. It is a little more defensible – even if still problematic – in light of the UDRP's policy to prevent *cybersquatting*: holding on to a domain name in order to sell it to a trademark owner or extort a payment from the mark owner. (The line between permissible domain-name brokering and prohibited cybersquatting can be a fuzzy one.) The respondent was not trying to extract money from Marlboro, but he also wasn't doing anything with the domain, despite having plenty of time to do so, which seems to have weighed heavily with the arbitrator. So although the DNS allows for much more extensive hoarding of unused domain-names than the FCC's callsign or telephone-number systems, the UDRP has a bit of a tilt toward favoring use over nonuse.

F Online Accounts

How about social media accounts at services like Twitter, Twitch and Instagram? By now it should be obvious that usernames check all of the boxes for an identifier registry with trademark implications. Users can pick their own usernames, only one user can have a given username at a time, priority goes to the first to sign up, usernames can have trademark meaning, and consumer confusion can result. What's a platform to do?

Twitter's **Trademark policy** prohibits the use of a trademark "in a manner that may mislead or confuse others about your brand affiliation." It also gives a limited priority right to trademark owners, although enforcement is in Twitter's discretion: "We reserve the right to reclaim usernames on behalf of businesses or individuals that hold legal claim or trademark on those usernames." This is more intensive trademark

policing than other registries we have seen engage in. Why might that be? One obvious reason is that Twitter is far more deeply involved in user behavior because it provides not just a registry but a forum in which users can actually use trademarks. Other registries can convincingly argue that they can neither control nor monitor how registrants use their identifiers in the world. But Twitter can see – and if it wants to, stop – how users tweet using their usernames.

If Twitter pays attention to trademark infringement, it must also pay attention to trademark defenses. It makes exceptions to its trademark policy for uses “outside the scope of the trademark registration”⁴⁴ (e.g. in other countries) and for “[n]ominative and other fair uses of trademarks . . . so long as the account is clearly distinguished from the trademark owner. This includes use by resellers in certain regions and accounts engaging in parody, commentary, or news.” In addition it has a **separate policy** on “parody, newsfeed, commentary, and fan accounts” which require the account bio to include a word like “parody,” “fake,” “fan,” or “commentary” to communicate that “the user is not affiliated with the account subject,” and not to use the exact name of the subject. This rule does not track trademark law, which is more open-ended – but services that operate at Twitter scale prefer to use clear, simple content-moderation rules whenever they can.

Twitter also has an **anti-squatting** rule that should look familiar.

You may not engage in username squatting. Accounts that are inactive for more than six months may also be removed without further notice. Some of the factors we take into consideration when determining what conduct is considered to be username squatting are:

- the number of accounts created;
- creating accounts for the purpose of preventing others from using those account names;
- creating accounts for the purpose of selling those accounts; and
- using feeds of third-party content to update and maintain accounts under the names of those third parties.

What other kinds of trademark issues would you expect to arise on Twitter?

G License Plates

Every car must have a license plate (or plates, depending on the state) to legally be driven on the public roads. The purpose of this requirement is right there in the name: the plate bears a unique registration “number,” composed of letters and/or numbers, that corresponds to the owner’s registration paperwork for the car. A state issues a registration only when an applicant demonstrates that they own the car, supplies proof that they have sufficient liability insurance, and certifies the car’s current

44. What about unregistered trademarks?

mileage. The license plate allows law enforcement to look up the car's registration information in case of an accident or suspected crime. It also allows other people to identify a car they have seen.

For many years, license plates were assigned either in numerical order or essentially arbitrarily. However, there proved to be substantial individual demand for "personalized" or "vanity" plates with a specific number with particular meaning to the registrant. My grandmother, for example, used SL 1440 – her initials, and her address. States charge a fee for vanity plates, which many people are quite willing to pay. Estimates are that there are 10 million or more vanity plates on the roads.

The license plate system is a registry. And as soon as states began letting individuals choose their license plate numbers, they opened up the whole can of trademark worms. Here, for example, are Nevada's rules on priority, which grant priority based on filing, with a 30-day period to reserve a number and then follow up with an actual application:

The person who first applies for a particular letter or number or combination of letters, numbers or spaces and pays the prescribed fee for registration and for the personalized prestige license plates has priority to receive plates with that particular letter or number or combination of letters, numbers or spaces once the application has been accepted by the Department.⁴⁵

45. Nev. Admin. Code § 482.320(7).

Any letter or number or combination of letters, numbers or spaces which is available for issuance may be reserved for a period of 30 days after the date on which the applicant makes his or her reservation with the Department.⁴⁶

46. Nev. Admin. Code § 482.340.

And here are some of Nevada's rules on acceptable vanity-plate numbers:

1. The letter "O," the letter "I" and the letter "Q" must not be used alone but may be used with a combination of other letters and numbers if the combination does not create confusion between the letter "O" or "Q" and the number "0" or between the letter "I" and the number "1." . . .
6. No combination of letters, numbers or spaces is allowed if it:
 - (a) Creates confusion with any combination on other license plates.
 - (b) Expresses contempt, ridicule or superiority of: (1) Race; (2) Ethnic heritage; (3) Religion; or (4) Gender.
 - (c) Contains any connotation that is sexual, vulgar, derogatory, profane or obscene.
 - (d) Contains a direct or indirect reference to a (1) Drug or drug paraphernalia; or (2) Gang.
 - (e) Makes a defamatory reference to a person or group.⁴⁷

47. Nev. Admin. Code § 482.320.

Which of these are confusion-based, which of them correspond to other non-confusion-based exclusions in Lanham Act section 2, and which of

them are new?

Bonus question: which of these exclusions are constitutional? A full answer will need to wait for the (not-yet-written) First Amendment chapter, but as a foretaste, consider *Mitchell v. Maryland Motor Vehicle Administration*.⁴⁸ John T. Mitchell, a resident of Maryland, applied for the vanity plate number MIERDA, which is Spanish for “shit.” The state granted his application, but received a complaint about the plate two years later, which led it to rescind the plates under a state regulation which allowed it to deny or recall plates containing “profanities, epithets, or obscenities.” The court upheld the rejection as being reasonable and viewpoint-neutral. But this decision was pre-*Matal v. Tam* and pre-*Iancu v. Brunetti* and may not survive them.

48. *Mitchell v. Md. Motor Vehicle Admin.*, 148 A.3d 319 (Md. 2016).

H Stage Names

Actors Equity, the union of stage actors in the United States, has a “Professional Name Policy” for its members.⁴⁹ Every member must be enrolled under their stage name, which will be – indeed *must be* – used for all of their contracts, billings, and programs. And here is what it has to say about similar names:

49. ACTORS EQUITY, PROFESSIONAL NAME POLICY (1986). SAG-AFTRA, the union of film, television, and radio actors, has a similar policy.

The Association shall not enroll an applicant under a name, nor shall a member use a name which is the same as, or resembles (so closely as to tend to be confused with), the name of an existing enrolled member, except that an applicant may enroll under and use such name professionally upon proof of consent by the existing member, or a finding by the National Council that under the circumstances there is no likelihood of confusion, or that there are extenuating circumstances.⁵⁰

50. *Id.*

Priority based on registration! Likelihood of confusion! Concurrent use by consent! Did a trademark registry write this policy? It is also fun to note that name priority rights are lost if a member resigns, is expelled, or remains on inactive status (i.e. not working on any productions and not paying dues) for five years. Yet another registry ties rights to continued use of the identifier.

Stage names can of course be trademarks. Abel Tesfaye holds trademark registration no. 4421959 for THE WEEKND. And any essentially commercial stage production with proper credits will be a goodwill-creating use in commerce. Indeed, it will also qualify the actor to join Actors Equity, so that there is a natural coincidence between use and the right to enroll under one’s stage name. But the parallel breaks down a bit once we dig into the details of when Equity regards a name as confusingly similar:

If an applicant or member must change or alter his/her name to distinguish it from an existing member, he/she may change the first and/or last name completely or add a full middle name. (Note: The use of a middle initial under these circumstances is not acceptable.)

For every Barbara Hershey (born Barbara Lynn Herzstein) there is a Neil Patrick Harris who uses their middle name for professional disambiguation. This middle-name rule is not the same as trademark's likelihood-of-confusion standard. It is more restrictive in some ways, and less restrictive in others. But it *works in context*. There is a restricted universe of actors working on stage productions, and among that universe, a unique full name is sufficient for precise identification.

Actors Equity stage names have the force of law behind them. To be sure, Actors Equity is not an arm of the government; it has no jurisdiction over non-members. But by contract, members agree to its name rules when they join, and also by contract theatrical producers agree to employ only Equity members and to follow Equity credit rules. Contract law will back up its rules if needed.

But there are also registries that operate informally. Consider roller derby. As David Fagundes describes in *Talk Derby to Me*, skaters typically compete under "derby names" like Paris Killton, Helen Wheels, Reyna Terror, or Penny Dreadful.⁵¹ Some play up their personas; others appreciate the privacy of not being easily identifiable by employers. According to the skaters Fagundes interviewed, there is a strong norm against adopting a derby name, like Princess Slay-Ya, that another skater is already using. According to one of them, "When you bite on someone's style you look like a douche and so uncool. Just imagine finding out at 2:30am in a bar when you are not completely sober that the person you are talking to has an almost identical name as yours. SUPER ANNOYING."

Derby girls care about maintaining the uniqueness of their aliases for three primary reasons. First, names in derby function as trademarks do in the commercial world: they ensure that skaters will not be confused with one another and that the viewing public can tell skaters apart. This is particularly true in the context of actual bouts, when announcers rely on derby names to relay action to spectators over a public-address system. . . .

Second, . . . skate names are a repository for the identities that skaters work so hard to create in a subculture that is profoundly important to them. . . .

Third, . . . [n]ot all names are created equal. Even if there is an infinitude of possible names, only some of those names will suit a skater's personality and style, so that a world in which skate names must be unique may well cause a newer skater to experience a much lower chance of being able to claim a name that truly suits her.⁵²

A skater adopts another skater's name risks being insulted, shunned, or perhaps even punched.

As one rollergirl put it, "sure there's no laws in place – you don't even have to register your derby name – it's COUR-

51. David Fagundes, *Talk Derby to Me: Intellectual Property Norms Governing Roller Derby Pseudonyms*, 90 TEX. L. REV. 1093 (2012).



Elliot Page as "Babe Ruthless" in *Whip It* (2009)

52. *Id.* at 1110 to 1112.

TESY. Ref might not see you smash me in the face—but I know, and trust me baby, I’m comin for ya.”⁵³

53. *Id.* at 1124.

Fagundes describes in detail an online registry of derby names, the Master Roster, with over 10,000 names:

Three core principles govern derby name regulation. First is a uniqueness requirement: only one skater can skate under a given name. The second instantiates the idea of priority: where two names are identical or excessively similar, the skater with the earlier claim to the name has the right to use it. The third creates elemental standards for resolving overlapping name conflicts: where two names are reasonably similar, the second skater must ask the first skater for permission to use the name. This permission must be in writing and submitted to the Master Roster’s administrators in order to authenticate it. . . .

The Master Roster’s name search feature allows users to determine the degrees of similarity between a proposed name and existing names, and this result strongly determines the likelihood that a name will be accepted or rejected. . . . For example, inputting the name “Nurse Wretched” into the name checker returns the result that the name is identical to a preexisting name (“Nurse Wretched”), of high similarity to another preexisting name (“Nurse Ratchet”), and of low similarity to yet another one (“Wretched”). . . . These results are advisory rather than dispositive, though: the administrators retain discretion over the acceptance and rejection of all proposed derby names, which is particularly salient in cases where a name has a non-trivial degree of similarity to a preexisting one.

The Master Roster’s substantive rules are supported by a number of formal registration procedures. For instance, skaters are advised not to submit a name until they have been participating in derby for at least a couple of months in order to avoid wastefully registering a name to beginning skaters who end up dropping out or failing to make a team. . . . Priority in cases of identical submissions is determined by the date stamp on the e-mail received by the Master Roster’s administrators. In other words, registration is a matter of filing priority, not actual use, so that if two skaters simultaneously seek to register the same name, the Master Roster’s administrators will register the first submission they receive, regardless of which skater adopted the name first.

The process of adding names to the registry raises a correlative problem: what to do with names of skaters who have quit or retired? This problem looms more and more as the number of derby girls grows ever larger and names grow

ever scarcer. Skaters (and name wranglers) are encouraged to notify the Master Roster’s administrators when they are no longer using their names, and leagues often submit lists of names to the Master Roster that are to be deleted. . . .⁵⁴

54. *Id.* at 1118–20.

For what it’s worth, the Master Roster has been dormant since 2012 – the year Fagundes’s article was published. The site [Derby Roll Call](#) is active, with 38,064 registrations as of when I last checked. It, however, does *not* enforce a duplicate-names rule:

Wait, you allow duplicate names?

Yup. Given how many people are finding out about derby every single day, it’s inevitable two people will come up with the same name at the same time. Who are we to decide who got there first? The site’s approach is to accept this duplication and try to inform everyone about the situation.

What does this say about “rights” in derby names? About identifier registries?

Problems

Dilly Pickles Problem

Your client is Dilly Pickles, a supplier of artisanal local pickles to restaurants and organic stores in a six-state region around New York City. It holds registrations on DILLY PICKLES and on a logo that shows an anthropomorphic pickle smiling and showering in a rain of dill. Its packaging is primarily blue and white, with a checkerboard pattern. It has a website at [dillypickles.com](#) with wholesale ordering information, its telephone number for customers is 1-800-PICKLES, and it is registered in New York State as Franzese Pickle Corp. d/b/a Dilly Pickles. It has an Instagram account at [@DillyPickles](#) where it posts carefully composed artsy photographs of its different kinds of pickles, and reshapes stories from some of its clients.

Last month, a major national food conglomerate launched a line of jarred pickles sold in supermarkets nationwide called DILLY OF A PICKLE. Its packaging is green-and-red, with a striped pattern. It has a website at [dillypickle.com](#) with information about its products and a map showing supermarkets that carry its products. Its website lists the telephone number 1-800-PICKLES, which plays a recorded message about how tasty its pickles are. The subsidiary that controls the DILLY OF A PICKLE brand is registered in California as Dilly of a Pickle, Inc. It has applied to the USPTO to register DILLY OF A PICKLE, DILLY PICKLE, and a logo of a mascot named Dilly Pickle, an anthropomorphic pickle smiling and playing the guitar. It has a Twitter account at [@DillyPickles](#) and an Instagram account at [@DillyPickle](#), both of which mostly post product photos.

What should your client do?

ISBN Problem

You represent Prototype Publishing, a small publisher of technical books for the software- and hardware-engineering communities. You have recently discovered that Type O Positive, a publisher of urban vampire erotica, has been assigning ISBNs to dozens of its titles from a block of 100 that you purchased from Bowker. Your books are sold as both high-quality softbound reference manuals and as ebooks; Type O’s books are sold exclusively as ebook downloads. By your calculations, you have used 23 of the ISBNs on your own titles, 73 have been used by Type O, and just 4 remain. Of the 23 you have used, it appears that Type O has *also* assigned the same ISBN to one its own titles in 9 cases. Type O has been apparently using your ISBNs for months and the books sold using them have collectively had tens of thousands of sales. What, if anything, should you do about it?

Ticker Symbol Problem

A ticker symbol is a short string of a few letters that identifies a stock, mutual fund, or other publicly traded security. Well-known examples include T for AT&T, DIS for the Walt Disney Company, and GOOG for Google. Ticker symbols are used by humans to look up and talk about stocks (e.g., “\$GME to the moon 🚀🚀🚀”), in data feeds to report prices,⁵⁵ and on exchanges to make actual trades. You should be able to shout “Buy 100 AAPL” to your broker, and your broker should be able to key in the order, both with absolutely no ambiguity whatsoever.

Securities are traded on numerous exchanges (there are currently 13 nationally registered stock exchanges in the United States), and for one to be traded on an exchange, it must have a ticker symbol. There are currently on the order of about 15,000 exchange-traded securities in the United States.

Trademark and consumer-confusion issues arise around ticker symbols with some regularity. For example:

- In 2014, Google announced that it was acquiring Nest Labs, which made “smart” thermostats and other home devices, for \$3.2 billion. Investors immediately ran up the price of NEST by 1900 percent, to a new high of 10 cents per share. Unfortunately, Nest Labs was privately traded and did not have a ticker symbol. Instead, NEST belonged to Nestor, Inc., a completely unrelated and nearly bankrupt company.
- In 2013, Twitter announced that it planned to conduct an initial public offering. Investors immediately ran up the price of Tweeter Home Entertainment Group, TWTRQ, a consumer electronics retailer.
- The stock of Forward Industries, a technology distributor with ticker symbol FORD, moves in partial correlation with the stock of

55. This is where the name “ticker” symbol comes from.



Nestor stock price before and after Nest acquisition announcement

the Ford Motor Company, ticker symbol F, even though the two are in unrelated lines of business.

- The stock of the Coca-Cola Bottling Company Consolidated, ticker symbol COKE, the largest independent bottler of COCA-COLA products with a market capitalization of \$3.7 billion, moves whenever the Coca-Cola Company, ticker symbol KO, with a market capitalization of \$235 billion, makes significant announcements.
- In 1997, the Central Parking Corporation, whose ticker symbol is PK, sued another parking lot management company which had just renamed itself to Park One Incorporated and adopted "pk1" as a trademark. Central Parking claimed that it had trademark rights in PK by virtue of its ticker symbol and those rights were infringed by "pk1".
- In 1981, the Exxon Corporation, one of the world's largest oil-and-gas companies, ticker symbol XON, sued XOIL Energy Resources, Inc. for adopting the ticker symbols XOIL and XPLR. Exxon's stock traded on the principal exchanges, while XOIL's stocks traded in the smaller "over-the-counter" market in which buyers and sellers deal directly with each other.
- The Medtronic corporation makes medical devices like pacemakers and artificial heart valves. It was initially listed on the NASDAQ exchange under the ticker symbol MDTR. It moved to the New York Stock Exchange in 1977, but at the time NYSE ticker symbols were required to be three or fewer letters, so Medtronic adopted MDT. In 1988, the MDT Corporation, which also makes medical products, applied to list its stock on the NYSE, but was informed that its first choice of ticker symbols, MDT, was not available. MDT sued the NYSE, arguing that it was the senior user of MDT in the medical-products field, and thus that the NYSE was liable for contributory trademark infringement.
- In 2018, the fertilizer company PotashCorp merged with Agrium to become Nutrien. In the process, it gave up its former ticker symbol, POT. Nearly 40 companies requested the ticker symbol.

Design a set of rules to handle trademark and other confusion issues relating to ticker symbols. Your rules should deal both with the policies used by exchanges to assign, change, and reclaim ticker symbols, and also with how courts should approach ticker symbols in trademark litigation. Explain how your rules would deal with each of the cases above, and with any other issues you can anticipate. For an added challenge, consider the fact that a security can be initially listed on any exchange, but that ticker symbols should be interoperable and portable between exchanges (just as telephone numbers are assigned by a particular company but can be dialed from anywhere and can be moved to a different company).

Your *pro bono* client is a paramedic and emergency ambulance driver who lives in Wichita, Kansas. She competes for the Wichita Tornadoes roller derby team under the name Ophelia Pulse. Her persona on the track is a buff, brawling medical professional; she wears ripped scrubs and a stethoscope. When she began skating two years ago, she checked the Derby Roll Call registry and found names like Ophelia Pain and Ophelia Bones, but no Ophelia Pulse, so she started skating under the name and registered it with Derby Roll Call.

She has recently been contacted by a drag queen who has been performing under the stage name Ophelia Pulse in Orlando, Florida for seven years and is upset at the similarity of the names. She accuses your client of deliberately picking the name to mock her. Her persona on stage is goth-influenced Victorian, with a long black mourning dress and heavy, smudged eyeliner. There is no canonical registry of drag names. Your client did not perform a Google search when she picked the name; if she had, she would have found several dozen hits for the performer in Orlando, including several modeled photographs and video clips of her performances.

Counsel your client on what she should do.