

XIII. TRADEMARKS/CYBERSQUATTING

A. CASE LAW

1. U.S. Courts of Appeal

- a. *Newport News Holdings Corp. v. Virtual City Vision Inc.*
98 USPQ2d 1441**

The U.S. Court of Appeals for the Fourth Circuit ruled on April 18, 2011 that district court properly granted summary judgment for plaintiff clothing retailer, doing business under “Newport News” mark, on its cybersquatting claim, even though defendants prevailed in earlier Uniform Domain Name Dispute Resolution Policy proceeding, since, at time of UDRP decision, defendants’ “newportnews.com” website simply provided information about city of Newport News, Va., and defendants subsequently changed site to one primarily devoted to women’s fashions.

2. U.S. District Courts

- a. *Rackly Bilt Custom Trailers Inc. v. Harley Murray Inc.*
95 USPQ2d 1730**

The U.S. District Court for the Eastern District of California on June 9, 2010 granted defendant summary adjudication of Plaintiff’s claim for cybersquatting under 15 U.S.C. § 1125(d), based on defendant’s registration of “racklybilt.com” and other domain names using forms of Plaintiff’s business name, since defendant did not use domain names in connection with goods or services, set up website using names, offer to sell names, or profit from registering names.

- b. *Microsoft Corp. v. Shah*
98 USPQ2d 1404**

The U.S. District Court for the Western District of Washington ruled on January 12, 2011 that plaintiff is permitted to assert novel cause of action for contributory cybersquatting in action alleging that defendants sought to profit in bad faith by selling method that teaches others how to trade on widespread recognition of plaintiff’s trademarks in order to drive traffic to given website; Anticybersquatting Consumer Protection Act has been broadly interpreted, and cybersquatting is tort-like cause of action to which theory of contributory liability appears to be naturally suited.

- c. *Volvo Trademark Holding AB v. Volvospare.com*
2010 WL 1404175**

The U.S. District Court for the Eastern District of Virginia, which had *in rem* jurisdiction over a Web site registrant located outside the United States, on April 1, 2010 granted summary judgment in favor of the plaintiff, finding that the registrant was acting in bad faith

with the intent to profit, and that the volvospare.com domain name was confusingly similar to the famous and distinctive VOLVO trademark.