THE MISUSE OF TRADEMARK LAW TO CONTROL FREE EXPRESSION

By Ronald D. Coleman[1]

1) Introduction

Until fairly recently, many non-lawyers – and far too many lawyers, including many who practice regularly in the intellectual property field – have been under the mistaken impression that the Lanham Act is an all-purpose "brand control" law that gives the owner of a trademark registration the right to determine what strangers may say about their product or service. It is not that. Nothing in the Lanham Act, or the common law of trademark and unfair competition, however, makes it illegal to describe a thing by the use of the trademark by which it is known.

For over a decade, trademark infringement claims, especially based on Internet use — where, under the "initial interest doctrine" (discussed below) no real damage need ever be proved, or even pleaded, to maintain an action — were the handmaidens of litigants with deep pockets and thick skins utilizing the courts to silence critics. One early case typifying this trend was Jews for Jesus v. Brodsky, 993 F. Supp. 282 (D.N.J. 1998), in which the "Jews for Jesus" – or "J4J" – Christian missionary organization won a trademark infringement claim against the registrant of the name "jewsforjesus.org" and "jews-for-jesus.com," who had posted websites at those URL's that were frankly critical of the organization's outlook and tactics. As one commentator observed pungently years later:

> J4J sued for trademark infringement. To win, however, J4J had to prove that the mark was used "in commerce." Unlike copyright, trademark only protects a commercial use (which can include non-profit). In addition, under traditional

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trademark law, J4J had to prove that someone coming to the webpage would be confused and believe the content was actually sponsored by J4J and that the person was receiving J4J services.

On first glance, under traditional trademark law, this should have been a no brainer. Brodsky was not offering anything in commerce. He was engaging in protected first amendment expression. I can hand out pamphlets in real space that purport to give "The Real Story About J4J" and say all kinds of nasty things about them and it is protected First Amendment speech. The alternative would be to allow anyone who wished to trademark their name and then suppress all critical speech via application of trademark.

But the judge in the case, who displayed an amazing ignorance of the Internet . . . was gonna get Brodsky no matter what. Reading the opinion, it is clear that the judge was just outraged at the idea of this "Deception" of using J4J's name to attract attention to Brodsky's site. The fact that you could do the same thing quite legally in meat space [i.e., off the Internet] did not appear to have any impact. Nor did the fact that Brodsky's actions did not preclude J4J from getting their own speech out there. (They had, after all, picked first).

So to find a commercial use, the court invented a new doctrine. Brodsky hadn't asked for any money, but he had linked to another non-commercial website which, along with all its other speech, solicited contributions (by mail, this was before most organizations took online contributions). Stretching beyond any law which had previously existed, the Brodsky court found that this linking to another site that did ask for money was somehow a use "in commerce." . . .

O.K., but how to deal with the question of [likelihood of] confusion? Here the judge at least relied on a pre-existing doctrine, albeit a rather rare one, "initial interest confusion." Normally, to prove trademark infringement, you need to show that the person was deceived or likely to be deceived at the point of sale. "Initial interest confusion" is a doctrine holding that if you attract someone's interest to your product using someone else's trademark, or one confusingly similar, it is an infringement even if the person knows full well at the time of purchase that the item is not connected with the infringing trademark. . . .

This decision had a slew of negative consequences. First, it dramatically expanded the definition of "in commerce" to include links that might ask for money. Second, it elevated the "initial interest confusion" doctrine from curiosity to mainstream. Over the next several years, judges unfamiliar with the internet would adopt the logic of Brodsky that a trademark holder had a right to "their" name, in all its permutations and in any TLD, regardless of the actual use of the name. This, in turn, lead to the passage of the Anti-Cybersquatting Protection Act (ACPA) . . .

H. Feld, "Jews for Jesus Rises Again," Wetmachine blog, January 6, 2006, found at http://tales-of-the-sausage-factory.wetmachine.com/jews-for-jesus-rises-again/. Now largely discredited, the *Brodsky* decision was, as Feld notes, followed consistently by courts for the better part of the next decade.

The high-water mark of this approach to trademark infringement on the Internet, which lent itself so readily to the use of trademark claims to remove content from websites despite the complete absence of any plausible likelihood of confusion claim, was probably achieved by the court in *Jones Day v. Blockshopper LLC*, 08CV4572 (N.D. Ill. Nov. 13, 2008). As described by Public Citizen, the public-interest organization:

> Jones Day, a national law firm, found it objectionable when BlockShopper.com, a web site that reports on real estate transactions in tony neighborhoods in several cities, published articles on condo purchases by two associates in its Chicago office. It sued BlockShopper claiming that by mentioning the firm name in headlines in the articles, and by linking to the associates' bio pages on the Jones Day web site, BlockShopper infringed and diluted its trademark. In a brief co-authored with the Electronic Frontier Foundation, Public Citizen argued that the trademark claims were preposterous and, in any event, were barred by the First Amendment which protects the right to publish truthful information even if the information is about a trademark holder and hence uses the trademark to convey the truth. The trial judge refused to accept the amicus brief and denied the motion to dismiss. The case was eventually settled.

Public Citizen website, found at https://www.citizen.org/litigation/forms/cases/getlinkforcase.cfm?cID=501. In all likelihood the outcome in Jones Day was also not a little related to a sense of judicial outrage, but, as with *Brodsky*, among trademark practitioners and free speech advocates, criticism of the decision was widespread. In both cases it seemed clear that a wrong had been done by someone, to someone. The question, however, was, why should punishment for this wrong be visited on the Lanham Act?

The progress of the law away from such outcomes has been less than meteoric, but it has, as discussed below, been fairly consistent. *Jones Day* – a decision featuring both a gross misapplication of trademark law and a strong inference of big-law-firm favoritism – was arguably the end of the line for the over-the-top misuse of the Lanham Act to silence speech having no meaningful trademark or consumer protection implications at all.

2) Fair use

The classic defense of such use of a trademark is fair use, i.e., "a use, otherwise than as a mark . . . which is descriptive of and used fairly and in good faith only to describe the goods or services." 15 U.S.C. § 1115(b)(4). Fair use "permits others to use a protected mark to describe aspects of their own goods." *Car–Freshner Corp. v. S.C. Johnson & Son, Inc.,* 70 F.3d 267, 270 (2d Cir. 1995). A useful, recent and entirely apposite summary of the black-letter law of fair use in trademark is found in *Wi-Lan, Inc. v. LG Electronics, Inc.*, 10 CIV.432 LAK AJP, 2011 WL 3279075 (S.D.N.Y. Aug. 2, 2011) *report and recommendation adopted as modified as to other issues,* 10 CIV.432 LAK AJP, 2012 WL 760148 (S.D.N.Y. Mar. 7, 2012). The court stated as follows (emphasis added):

> Merely using a logo to identify the company associated with that logo, without more, does not constitute trademark infringement. *See, e.g., Tiffany (NJ) Inc. v. eBay Inc.,* 600 F.3d 93, 102–03 (2d Cir.) ("[A] defendant may lawfully use a defendants' trademark where doing so is necessary to describe the defendants' product and does not imply a false affiliation or endorsement by the defendants of the defendant."), *cert. denied,* 131 S.Ct. 647 (2010); *New Kids on the Block v. News Am. Publ'g, Inc.,* 971 F.2d 302, 308 (9th Cir.1992) ("'When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth." (quoting *Prestonettes, Inc. v. Coty,* 264 U.S. 359, 368, 44 S.Ct. 350, 351 (1924) (Holmes, J.))); *Yurman Studio, Inc. v. Castaneda,* 591 F.Supp.2d 471, 500–01 (S.D.N.Y. 2008) ("[T]he doctrine of nominative fair use protects the commercial use of another's trademark as long as the user does not use the mark to refer to its own products, use the mark

> more than is necessary to identify the product, or use the mark in a way that suggests sponsorship by the owner of the mark."); *Invicta Plastics (USA) Ltd. v. Mego Corp.,* 523 F.Supp. 619, 623 (S.D.N.Y. 1981) ("Truthful references to the trademark of another are permissible as long as the 'unauthorized' reference does not cause confusion as to the source"); *see also,* 4 J. Thomas McCarthy, Mccarthy On Trademarks & Unfair Competition (4th ed. 2011) § 23:11 ("[A] use of another's trademark to identify, not the defendant's goods or services, but the **plaintiff's** goods or services .... is not an infringement so long as there is no likelihood of confusion.").

The decision in *Cintas Corp. v. Unite Here*, 601 F. Supp. 2d 571 (S.D.N.Y. 2009) *aff'd*, 355 F. App'x. 508 (2d Cir. 2009) is instructive. In *Cintas* a uniform supplier sued a number of labor unions and their employees, bringing claims under RICO, the Lanham Act, and New York state law. Defendants were accused of trademark infringement for their use of plaintiff's trademark, CINTAS, for a website called "Cintas Exposed" bearing the domain name www.cintasexposed.org. *Id.* at 575. Cintas claimed that this website "competed unfairly . . . confusing [its] customers, diverting customers, [and] sales and profits away from [it]." *Id.* The Southern District of New York dismissed the trademark claim. After setting out the *Polaroid* factors and finding that at least four of them favored defendants, the court wrote:

> Defendants are not using the "CINTAS" mark as a "source identifier", but rather solely to criticize Cintas's corporate practices. *See United We Stand Am., Inc. v. United We Stand Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997) (noting there is no justification for relief under Section 1114 and 1125(a), when "the defendants ... us[e] plaintiff's mark not in a manner that would create confusion as to the source, but rather as part of a message whose meaning depend[s] on reference to plaintiffs' product"). While the materials available on Defendants' websites may disparage Cintas, the likelihood that Cintas's actual or potential customers would be confused about who provides CINTAS goods and services is remote.

Id. at 579. This decision is particularly notable because it stands for the proposition, which is widely misapprehended, that a Lanham Act claim can be dismissed on likelihood of confusion grounds at the pleadings stage. There is nothing about the analysis typified by the decision in

Cintas which requires that parties expend fortunes in discovery before applying it to the facts as alleged in the pleadings. *See*, *Architectural Mailboxes, LLC v. Epoch Design, LLC*, 99 U.S.P.Q.2d 1799, 2011 WL 1630809 (S.D. Cal., April 28, 2011) at *4. Indeed, justice, judicial efficiency and just plain fairness demand that like any other meritless case, a meritless Lanham Act claim can be dismissed and that the mere cost of meritless litigation not be made a tool to silence expression.

The defense of fair use, in fact, raises the bar when analyzing whether a plaintiff trademark holder has alleged actionable likelihood of confusion. "Since the burden of proving likelihood of confusion rests with the [trademark owner], and the fair use defendant has no free-standing need to show confusion unlikely, it follows . . . that some possibility of consumer confusion must be compatible with fair use, and so it is." *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121-22 (2004). Defendants seeking dismissal of claims on fair use grounds can argue that the plaintiff is attempting to utilize the Lanham Act and other laws aimed at unfair competition as speech-control measures. Under the right circumstances, judges may be receptive to the argument that rather than protecting legitimate brand rights or avoiding consumer confusion, a plaintiff's real agenda is to prevent consumers from having the ready ability to compare their offerings with those of competitors, as they can do far more readily and coherently by using a plaintiff's trademark.

But a trademark owner's rights are violated only where an unauthorized use "has a substantial capacity to mislead consumers (or other concerned actors in the marketplace) into a confusion as to the entity furnishing the goods or services." *Yankee Pub. Inc. v. News America Pub. Inc.,* 809 F. Supp. 267, 272-73 (S.D.N.Y. 1992). Even under §43(a) of the Lanham Act, which protects against trademark likelihood of confusion not only as to source, but also as to affiliation, connection, sponsorship, association, or approval, courts are taking an increasingly skeptical view of the proposition that a defendant's use of a plaintiff's trademarks could not plausibly lead even the dimmest Internet user to believe that the plaintiff was the source of the publication, advertisement, product or service in question. Still, this breadth of "association" is often difficult for defendants to overcome. As commentator Prof. Eric Goldman noted in discussing *Amerigas Propane, L.P. v. Opinion Corp*., 2012 WL 2327788 (E.D. Pa. June 19, 2012):

> Unlike some of my trademark scholar peers, I'm not a big fan of nominative fair use as a protection for review websites because it's so hard to win on motions to dismiss (and isn't guaranteed on summary judgment, either). This case illustrates that point nicely. The judge says that it would be "premature" to rule on nominative fair use on a motion to dismiss. The judge wants to see more about the likelihood of consumer confusion; and while it's likely a "gripe site" (in the court's words) would prove that it had to use the plaintiff's trademarks in order to refer to the plaintiff, the court wants to see more about whether PissedConsumer took only what was necessary and accurately reflected the relationship between Amerigas and PissedConsumer.

Many of the cases generating the development in this area of law involve "gripe sites" which provide a forum for consumers – real or, perhaps, not to real – to complain about businesses. An entire subsidiary field of litigation, beyond the scope of this paper, has arisen concerning the anonymity of those posting such content, which are often alleged by plaintiffs – not without some justification, as it turns out – to be "sock puppets" created by competitors.

The business model of such sites is to solicit user gripes and then to utilize aggressive search engine optimization ("SEO") to drive Internet searches about subject businesses to their websites. Revenue comes by advertising, often via affiliate networks that utilize context-sensitive algorithms which generate ads offering products or services that may compete with (and, as litigation also sometimes proves, infringes the trademark of) the business is the subject of the reviews. In some cases, the gripe site operators offer to reduce the visibility or SEO factor of negative reviews in return for payments from subjects. Others pair these services, which some business indignantly describe as "shakedowns," with successful consumer complaint mediation programs and a surprising degree of industry buy-in. Other sites, including review sites such as Yelp.com, a recent subject of extensive litigation, have less negative agendas and, it may be posited, less cynical revenue models. Even then, they have been the subject of lawsuits by businesses that have suffered negative reviews, often on spurious trademark infringement grounds.

The trend, only recently reversed, of deferring to trademark holders' claims of infringement based largely on rough association between a trademark and commentary actually represented a temporary bout of judicial amnesia concerning trademark law. In *Girl Scouts of U. S. of Am. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969), for example, the court rejected transient confusion in a social-commentary context based on the sale of an animated poster depicting a young but very pregnant female in Girl Scouts uniform.

> Even if we hypothesize that some viewers might at first believe that the subject of the poster is actually a pregnant Girl Scout, it is highly doubtful that any such impression would be more than momentary or that any viewer would conclude that the Girl Scouts had printed or distributed the poster.

304 F. Supp. at 1231. (Notably this case preceded the enactment of the federal dilution tort by over a decade.) As recognized in *Girl Scouts*, ephemeral moments of confusion that do not threaten to divert sales or otherwise cause tangible economic infringement activity are not evidence of actionable harm under the Lanham Act. Real harm must be shown to recover for any tortious conduct, but all the more so when such harm is posited as a basis for overcoming the constitutional protection of free speech. See, *id.* at 1235.

Arguably the "source of origin" analysis in *Girl Scouts* was rendered at least questionable as the concept of what trademarks communicated to consumers evolved along with the importance of brands and marketing. The new thinking was reflected in the 1962 amendment of the Lanham Act removing language that limited actionable confusion, mistake or deception to "the source of origin of such goods and services." This trend accelerated as the value of trademark licensing, franchises, co-branding, affiliate marketing, and original equipment manufacturer relationships exploded, and in 1989 § 43(a) was broadened to protect not only against confusion as to source, but with respect to "affiliation, connection, sponsorship, association, and/or approval." *See*, S. Baird, "Seth Godin on Trademark?," Duets Blog, March 1, 2001, found at http://www.duetsblog.com/2010/03/articles/trademarks/seth-godin-on-trademark/. Still, as will be demonstrated below, courts have not, in recent years, hesitated to draw the line – even with respect to allegations of concepts as vague as "affiliation" – where confusion is implausible and the obvious purpose of bringing a Lanham Act claim is to shut down criticism or competition.

3) Initial interest confusion

Building on the amended Lanham Act's broadened protection against "affiliation"-based confusion, courts began to expand the rationale for finding trademark infringement in the 1990's with the advent of the dubious "initial interest confusion" doctrine. Essentially corrosive of the fair use defense, the initial interest concept posits that the Lanham Act "forbids a competitor from luring potential customers away from a producer by initially passing off its goods as those of the producer's, even if confusion as to the source of the goods is dispelled by the time any sales are consummated." *Lamparello v. Falwell*, 420 F.3d 309, 315-16 (4th Cir.

2005) (internal quotations omitted). For years it routinely replaced traditional tort concepts of harm, or even likelihood of harm, with a highly subjective, almost strict liability standard applied to those who use others' trademarks on the Internet.

The doctrine was famously rationalized in the Ninth Circuit's opinion in *Brookfield Communics., Inc. v. West Coast Entmt. Corp.,* 174 F.3d 1036, 1064 (9th Cir. 1999) utilizing the analogy of a misleading highway sign that imposes harm by causing consumers to "get off at the wrong exit." *Id.* But the concept of "initial interest," with its tenuous claim to describing tort-induced harm where none has really occurred, has been the subject of considerable criticism in general – especially in the Internet context. A number of Circuit courts of appeal and numerous district courts have expressed considerable skepticism about whether the doctrine of initial interest confusion is valid at all. *See*, e.g., *Lamparello*, 420 F.3d at 317; *Hasbro, Inc. v. Clue Computing*, 232 F.3d 1, 2 (1st Cir. 2000). Developed in a traditional, "brick-and-mortar" sales context, the doctrine was meant to be applied only where "a potential purchaser is initially confused [such that] the [senior seller] may be **precluded from further consideration.**" *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546 (Fed. Cir. 1990) (emphasis added) – only once the potential customer is "off the highway." For this reason, the application of this analogy to the virtual as opposed to a real world was questioned in *Bihari*, where the court wrote:

> The harm caused by a misleading billboard on the highway is difficult to correct. In contrast, on the information superhighway, resuming one's search for the correct website is relatively simple. With one click of the mouse and few seconds delay, a viewer can return to the search engine's results and resume searching for the original website.

Bihari, 199 F.Supp.2d at 320, n. 15. Based on the same reasoning, and citing *Bihari* for the point, the Eastern District of New York wrote in *Devere Group GmbH v. Opinion Corp*., 877 F.Supp.2d 67 (E.D.N.Y. July 13, 2012):

> The doctrine [of initial interest confusion] is not applicable here. [The consumer gripe site] PissedConsumer.com does not divert Internet users away from deVere's website because deVere does not have a website that competes for business with PissedConsumer.com; Opinion Corp. provides a forum for customer criticism of businesses, while deVere provides financial services. *See Bihari,* 119 F.Supp.2d at 320 (for purposes of the initial interest confusion doctrine, a "gripe site" was not in competition with the business that its contents criticized); *see Lamparello v. Falwell,* 420 F.3d 309, 317 (4th Cir.2004) (the "critical element" of initial interest confusion – "use of another firm's mark to capture the markholder's customers and profits – simply does not exist when the alleged infringer establishes a gripe site that criticizes the markholder."). Initial interest confusion does not arise "in circumstances where the products in question are used for substantially different purposes and therefore the merchants are not in close competitive proximity." *Big Star Entertainment, Inc. v. Next Big Star, Inc.,* 105 F.Supp.2d 185, 209–10 (S.D.N.Y. 2000). Accordingly, deVere's allegations "do not create any plausible inference of intentional deception"; there is no risk that a customer seeking deVere financial services would mistakenly visit and divert their business to PissedConsumer.com. *Cintas,* 601 F.Supp.2d at 579.

The opinion in another PissedConsumer.com case, *Ascentive, LLC v. Opinion Corp.*, 842 F. Supp. 450 (E.D.N.Y. 2011), expresses similar skepticism regarding initial interest confusion in general, and as applied to claims of this nature specifically:

> Th[e "highway sign"] analogy and Brookfield itself have been roundly criticized by courts and commentators. . . .The Court agrees with the criticism that the harm caused by initial interest confusion in the internet context is minimal as "with one click of the mouse and a few seconds delay, a viewer can return to the search engine's results and resume searching for the original website." Bihari, 119 F.Supp.2d at 320 n. 15.
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> In any event, unlike in Brookfield, plaintiffs and PissedConsumer are not competitors. In such circumstances, as the Ninth Circuit acknowledged, "the likelihood of confusion would probably be remote. . . . Additionally, unlike in Brookfield, PissedConsumer is using the marks to describe the contents of its pages concerning Ascentive and Classic, not to suggest affiliation or source. . . .

842 F.Supp.2d at 466-67.

Decisions such as these may be seen as striking a significant blow to the doctrine of initial interest confusion. It is not, however, dead. As Eric Goldman noted in his discussion of *Amerigas Propane*, in which the Eastern District of Pennsylvania refused to dismiss the Lanham Act claim against PissedConsumer.com:

> I keep trying to declare the initial interest confusion doctrine dead, but judges aren't cooperating! The judge [in *Amerigas Propane*, however] says that initial interest confusion is still a viable theory in the Third Circuit (he's correct as a matter of precedent), and thus Amerigas can keep arguing it. Unfortunately, like the likelihood of consumer confusion, the judge does hint that it's probably going to fail later; the judge says "it may ultimately be difficult to establish initial interest confusion in this case." Once again, lots of wasted time and money ahead!

E. Goldman, "Another Bad Ruling for PissedConsumer on Trademark and 47 USC 230 Claims--Amerigas v. Opinion Corp.," Technology & Marketing Law Blog, found at http://blog.ericgoldman.org/archives/2012/06/another_bad_rul_1.htm.

Goldman's observation, premised on the plastic nature of Lanham Act "affiliation" claims, is well taken. Yet notably, in *Devere*, *supra*, the Eastern District of New York dismissed the Lanham Act claims by reference to the *Polaroid* factors set forth in *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) which, despite the amendment of the Lanham Act and regardless of the state of "initial interest confusion" is still the standard for evaluating likelihood of confusion in the Second Circuit:

> Several of the Polaroid factors weigh against deVere's Lanham Act claim. First, deVere's services do not compete with those of Opinion Corp. See Cadbury Beverages, Inc. v. Cott Corp., 73 F.3d 474, 480 (2d Cir.1996) ("The 'proximity-of-the-products' inquiry concerns whether and to what extent the two products compete with each other."). Nor has deVere provided any allegations of actual consumer confusion. See id. ("While evidence of actual confusion is not

> necessary to the defendants' claim, 'its lack may under some circumstances be used against the defendants.' ") (quoting Hasbro, Inc. v. Lanard Toys, Ltd. 858 F.2d 70, 78 (2d Cir. 1988)). In addition, there is no issue of deVere wishing to "bridge the gap" between its products and Opinion Corp.'s product. This factor refers to the defendants' "interest in preserving expansion and entering into related fields." *Hormel Foods Corp. v. Jim Henson Productions, Inc.,* 73 F.3d 497, 504 (2d Cir. 1996). DeVere "has shown no intention of entering into the field" of consumer complaint websites, "and there is no evidence that consumers would relate [deVere] to such an enterprise." *Id.* Finally, deVere has not alleged bad faith on the part of Opinion Corp. because, in the trademark context, "[b]ad faith generally refers to an attempt by a junior user of a mark to exploit the good will and reputation of a senior user by adopting the mark with the intent to sow confusion between the two companies' products." *Star Indus.,* 412 F.3d at 388.

Devere Group GmbH v. Opinion Corp., 11-CV-3360 FB LB, 2012 WL 2884986 (E.D.N.Y. July 13, 2012). Similarly, in *Ascentive*, *supra*, the court denied a motion by the plaintiffs for a preliminary injunction for supposed trademark infringement and other torts of competition meant, as here, solely to remove certain businesses from a website that provided consumer information not under their control, holding that whatever the operators of the website were engaged in, it was certainly not trademark infringement. Because there was no plausible likelihood of confusion, plaintiffs were found unlikely to succeed on the merits of their claims and their preliminary injunction motion was denied:

> This same conclusion [that confusion arising out of the use of metatags is not likely] holds true for [defendant] PissedConsumer's use of the plaintiffs' marks in the content of the PissedConsumer site itself. . . .
>
> There is little likelihood that a potential consumer visiting PissedConsumer would be confused about whether it was the source of plaintiffs' goods or whether Ascentive or Classic sponsored or otherwise approved of PissedConsumer's use of their marks. Indeed, the domain names here . . . Instead, after a brief inspection of the content of PissedConsumer's website, the user would realize that they were visiting a third-party gripe site for "pissed" consumers. The Court thus concludes that PissedConsumer's use of plaintiffs' marks in domain names and in the text of the site itself is not likely to cause

> confusion as to whether PissedConsumer was the source of plaintiffs' products or whether plaintiffs approved of or otherwise endorsed the use of their marks.

842 F. Supp. 2d at 464. Similarly, the court in *Boarding School Review, LLC v. Delta Career Education Corp*., 1:11-cv-08921-DAB (SDNY March 29, 2013) dismissed, in a declaratory judgment actions, counterclaims for trademark infringement against a website that collated and published information about community colleges brought by an owner of for-profit schools seeking to have their institutions removed from the site. While lacking the severely negative connotation of "PissedConsumer.com," the court still agreed with the website owner that nothing on the website suggested – either in name or "after a brief inspection of the content" of the website" – that it was a website operated by the owners of the trademarks for the schools which were used to describe them. Not every Lanham Act case needs discovery and "development" to be seen as meritless.

4) Section 230

Section 230 of the Communications Decency Act (47 U.S.C. § 230, or "Section 230" of the "CDA") prohibits the imposition of liability under state law on any user or provider of "interactive computer service" for publishing content provided by another. Section 230 provides, in pertinent part, that "No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider," *id.* § 230(c)(1), and that "No cause of action may be brought and no liability may be imposed under any State or local law that is inconsistent with this section," *id.* § 230(e)(3).

Gripe sites and review sites fall squarely within the protection of the statute, which applies to all state law claims, however styled, so long as the act complained of is the publication of third party content. *See Gucci Am., Inc. v. Hall & Assocs*., 135 F.Supp.2d 409, 417 (S.D.N.Y.2001) (citing legislative history of Section 230); *see also Zeran v. Am. Online, Inc.*, 129 F.3d 327, 330 (4th Cir.1997) (holding that "lawsuits seeking to hold a service provider liable for its exercise of a publisher's traditional editorial functions such as deciding whether to publish, withdraw, postpone or alter content are barred" by Section 230); *Barrett v. Rosenthal*, 40 Cal.4th 33, 51 Cal.Rptr.3d 55, 146 P.3d 510, 518 n. 9 (2006) (collecting cases). Section 230 defines "interactive computer service" as "any information service, system, or access software provider that provides or enables computer access by multiple users to a computer server, including specifically a service or system that provides access to the Internet." Gripe sites and review sites are "interactive computer service[s]" and qualify for immunity under Section 230 – arguably as an Internet search engine within the meaning of the statute that allows members of the public to search its directory of webpages and is therefore an "information service ... that provides or enables computer access by multiple users to a computer server" – and, more straightforwardly, on the grounds that the claims against them are premised on liability under state law for publishing "content" originated by others. *See e.g.*, *Murawski v. Pataki,* 514 F. Supp. 2d 577, 591 (S.D.N.Y. 2007).

The provisions of Section 230 apply in state as well as federal courts. One recent case is *Reit v. Yelp!, Inc.*, 29 Misc. 3d 713, 716-17 (Sup. Ct, New York Cty. 2010). There, the plaintiff Reit, while acknowledging that the defendant Yelp! was an Internet computer service, insisted, as plaintiff suggests here, "that the CDA does not immunize it from defamation here because its removal of posts was not editorial, but business related. Specifically, Reit argued that the selective removal of all of his positive reviews was more than the action of an editor 'simply selecting material for publication.' This distinction, Reit argued, makes Yelp! an internet content provider." *Id*. at 716-17, 907 N.Y.S.2d at 413-14. The trial court disagreed and dismissed the complaint, explaining as follows:

> *Shiamili [v. Real Estate Group of New York, Inc.*, 68 A.D.3d 581, 892 N.Y.S.2d 52 1st Dept., 2009] is analogous to the present matter. In *Shiamili*, the plaintiff sued an interactive computer service for defamation based on information published on its website. The complaint alleged that the defendants "choose and administer content" that appears on the website. *Shiamili* argued that the defendants "engaged in a calculated effort to encourage, keep and promote bad' content on the Web site." The

> First Department held that this allegation does not raise an inference that defendants were information content providers within the meaning of the CDA because "message board postings do not cease to be data provided by another information content provider merely because the construct and operation of the Web site might have some influence on the content of the postings" (*Id*., at 583, 892 N.Y.S.2d 52).
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> Here, Yelp is an interactive computer service. The allegedly defamatory content was supplied by a third party information content provider and consisted of a message board posting. That Yelp allegedly uses "bad" posts in its marketing strategy does not change the nature of the posted data.
>
> Moreover, Yelp's selection of the posts it maintains on Yelp.com can be considered the selection of material for publication, an action "quintessentially related to a publisher's role" (*Green v. America Online (AOL)*, 318 F.3d 465, 471 [3rd Cir.], *cert. denied*, 540 U.S. 877, 124 S.Ct. 200, 157 L.Ed.2d 140 [2003]). Accordingly, Yelp may not be considered an internet content provider, so that Reit's defamation claims are barred by the CDA.

Id. Similarly, in *Braverman v. Yelp, Inc.*, 2013 NY Slip Op 31407 (NY Sup. Ct June 28, 2013), the court held as follows:

> Yelp is entitled to immunity because this action is based on reviews written by other content providers — Yelp users — and not based on any content that Yelp itself created or developed.
>
> Yelp's alleged act of filtering out positive reviews does not make Yelp the creator or developer of the alleged defamatory reviews. Yelp's choice to publish certain reviews — whether positive or negative — is an exercise of a publisher's traditional editorial function protected by the CDA. Moreover, Section 230 does not distinguish between neutral and selective publishers in its grant of immunity.
>
> In addition, Yelp's placement of a Best of Yelp list on the same web page as the reviews does not make Yelp the creator or developer of the reviews. Yelp's choice to insert a Best of Yelp list on the web page is an editorial choice as to what content to display on the page, and it is a separate section from the user reviews.

5) Conclusion

What is notable about the two exemplary cases discussed at the beginning of this paper – and, in fact, many of the other early decisions along these lines – is that in both situations, the defendants had in fact committed morally dubious acts. In *Brodsky*, the defendant had, in fact, utilized the Jews for Jesus registered trademark in a domain name in a manner that would, under the ACPA, have readily been found to be in bad faith. But there was no ACPA; the judge was offended by the trickery; and accepted the argument that the Lanham Act was broad enough of a weapon to solve the plaintiff's problem. Similarly, in *Jones Day*, the BlockShopper site retaliated against the lawyers that represented its adversaries by linking to their law firm bios and photographs and listing home purchases by individual attorneys. This was ugly and unjustifiable conduct, and here too the judge was determined not to let it stand. The Lanham Act's flexible mandate to prevent "unfair competition" was deemed a good enough vehicle to achieve this end.

Thus in both cases a certain rough justice may have been achieved. But the damage done to trademark law and to innumerable clients – plaintiffs and defendants, successful and unsuccessful – much less to the cause of free expression by such judicial "creativity," which has only recently begun to be redressed systemically, easily outweighs the harms these decisions sought to remedy.