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US: TRADE MARKS

Gripe sites and fair use

Individuals interested in creating an online forum to voice criticism about a particular company's product or service offering often register domain names which incorporate a company's trade mark to be used as so-called gripe sites. These individuals typically claim that their use of a third party's trade mark as part of a domain name constitutes a fair use of that trade mark, thereby creating a legitimate non-commercial interest for the domain name registrant in owning the domain name at issue.

However, simply because the domain name incorporating a third party's trade mark was registered for use to voice concern or criticism about the product identified by the trade mark does not mean that this use is a fair use of the trade mark. The issue has been deemed to be not one of freedom of speech and expression but the choice of the domain name used to exercise such freedoms. Specifically, the issue when determining whether use of a third party's trade mark in connection with a domain name used for a gripe site is whether the particular domain name selected was necessary for

the function of product review, comment or criticism to be carried out.

IP tribunals such as the World Intellectual Property Organization Arbitration and Mediation Center have routinely held that if the registrant of a particular domain name could have selected a domain name adequately reflecting both the object and independent nature of its web site and instead chose a domain name which incorporates the third party's trade mark, the registrant has intentionally created a situation which is at odds with the legal rights of the trade mark owner and which misleadingly diverts internet users. There are multiple ways in which an individual interested in creating a gripe site can style a domain name making fair use of a trade mark without violating a trade mark owner's proprietary rights.

Accordingly despite a domain name owner's claim of fair use, gripe sites do not necessarily provide the owner with a legitimate interest in the domain name, thereby rendering such domain names subject to a compelled transfer to the trade mark owner.

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