
**FROM BOOK COVERS TO DOMAIN NAMES:
SEARCHING FOR THE TRUE MEANING OF THE
CLIFFS NOTES TEMPORAL TEST FOR PARODY**

Brian R. Landry*

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Parody—the close imitation of the style of an author or work for comic effect or ridicule—has existed for centuries and continues to be a vibrant part of American culture.¹ Because parodies such as Darrell Hammond’s imitation of the political talk show *Hardball with Chris Matthews* on *Saturday Night Live* may serve as valuable cultural commentary, parodies are given certain First Amendment protections from regulation under copyright and trademark law.²

This Note examines the requirements for establishing a parody under federal trademark law. In particular, it suggests that the Fourth Circuit decision in *PETA v. Doughney*³ misinterpreted the Second Circuit’s requirements for establishing a parody in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*⁴ Through examination of both *PETA* and *Cliffs Notes*, this Note argues that especially where a court is applying a balancing test animated by free speech concerns (as the Second Circuit did in *Cliffs Notes*), a court should consider the consumer’s reception and interpretation of the expression as a whole and in context of the medium of the expression. The Note argues that it makes little sense to subject

* Managing Editor, Journal of High Technology Law. J.D. Candidate, Suffolk University Law School, 2007.

1. *L.L. Bean, Inc. v. Drake Publ’rs, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987); WEBSTER’S NEW COLLEGIATE DICTIONARY 827 (1979). See also BLACK’S LAW DICTIONARY 1190 (8th ed. 2004) (“A transformative use of a well-known work for purposes of satirizing, ridiculing, critiquing, or commenting on the original work, as opposed to merely alluding to the original to draw attention to the later work.”).

2. See, e.g., *L.L. Bean*, 811 F.2d 26. In this example, *Saturday Night Live*’s (*SNL*’s) parody would presumably receive additional, albeit non-legal protection, as *SNL* is broadcast NBC, the majority owner of MSNBC, which broadcasts *Hardball with Chris Matthews*.

3. 263 F.3d 359 (4th Cir. 2001).

4. 886 F.2d 490 (2d Cir. 1989).

defendants to an overly rigid definition of parody that does not account for a consumer's actual experience of the expression.

Parody is at least as old as Greek civilization⁵ and has found expression through society's evolving technologies.⁶ However, like never before, computers and the Internet have democratized expression, including parodic expression, by lowering the cost and expanding the reach of all forms of written and visual communication.⁷ As a result, individuals with moderate skill and minimal assets have the ability to create powerful and effective social commentary.⁸ The legal consequences of parody are complex. While parody – a form of social and political commentary – may annoy or anger its target, as a legal matter it may also infringe or otherwise harm protected trademark rights, even in light of significant First Amendment protection.⁹

5. *L.L. Bean*, 811 F.2d at 28.

6. *See, e.g.*, *Hustler Magazine v. Falwell*, 485 U.S. 46, 48 (1988) (parody in the form of a liquor advertisement in magazine); *Lyons P'ship v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999) (parody by mascot incorporating the children's character Barney); *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317, 318-19 (2d Cir. 1982) (theatrical parody); *MasterCard Int'l, Inc. v. Moulton*, 2004 U.S. Dist. LEXIS 11376 (S.D.N.Y. June 22, 2004) (website); *Gen. Elec. Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. (BNA) 1036 (D. Mass. 1979) (modified logo on clothing); *Girl Scouts of the United States v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1230 (S.D.N.Y. 1969) (poster). Litigation surrounding the Barney trademarks remained in the courts for five years with the Electronic Frontier Foundation recently seeking declaratory judgment that use of Barney in a website depicting the (satanic) "secret 'double life'" of the character. The case was recently settled. *See* Complaint at 2, *Frankel v. Lyons P'ship*, No. 06-CV-6413 (S.D.N.Y. Aug. 23, 2006), available at <http://www.eff.org/legal/cases/barney/> (follow "Complaint" and "Settlement Agreement" hyperlinks).

7. *Cf.* STUART BIEGEL, *BEYOND OUR CONTROL? CONFRONTING THE LIMITS OF OUR LEGAL SYSTEM IN THE AGE OF CYBERSPACE* 12 (2001) (discussing the ebb and flow of the Internet as a "level playing field"). *But see* Miguel C. Danielson, *Confusion, Illusion and the Death of Trademark Law in Domain Name Disputes*, 6 U. FLA. J. TECH. L. & POL'Y 219, 220 (2001) (suggesting that corporate pressures are threatening the democratizing qualities of the Internet); Catherine Yang, *At Stake: The Net as We Know It*, BUS. WK., Dec. 26, 2005, at 38 (discussing moves to erode the principle of "net neutrality" under which all packets are treated the same while traveling over the Internet, regardless of who sent them).

8. *See, e.g.*, Christopher Palmeri, *America's Energy Morass*, BUS. WK. ONLINE, Oct. 31, 2005, at http://www.businessweek.com/bwdaily/dnflash/oct2005/nf20051031_4168_db016.htm (discussing Internet parodies featuring the chairman of Exxon biting into an oil barrel like Dracula).

9. *E.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. i (1995). *See* 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:155 (4th ed. 2005) ("No one likes to be the butt of a joke, not even a trademark. But the requirement of trademark law is that a likely confusion of source, sponsorship or affiliation must be proven, which is not the same thing as a 'right' not to be made fun of."); Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1080

I. Emergence of Modern Trademark Law

Although the concept of trademark law is centuries old, the current incarnation of federal trademark law (the Trademark Act of 1946, commonly referred to as the Lanham Act) is now over 60 years old.¹⁰ Trademarks are a breed of unfair competition law whose primary purpose is to prevent consumer confusion as to the origin of goods.¹¹ Essentially, trademarks function as “warranty of sameness,” assuring consumers that they will receive a product of the quality received the last time they purchased a product bearing the same mark.¹² By preventing confusion as to the source, trademark law encourages businesses to produce quality goods and services because they stand a greater chance of reaping consumer good will.¹³

A cause of action for trademark infringement is established by showing that use in commerce of a similar (or identical) mark will create a “likelihood of confusion” as to the source of either the goods or the mark in the minds of ordinary consumers.¹⁴ Once this likelihood of confusion is established, the Lanham Act provides an expansive set of remedies including injunctive relief,¹⁵ recovery of defendant’s profits,¹⁶ treble damages,¹⁷ and in cases of intentional

(1986). The availability of injunctions under the Lanham Act can pose particular trouble from a First Amendment perspective as a prior restraint on publication. Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark and Copyright: Remedies Without Wrongs*, 65 B.U.L. REV. 923, 949 (1985).

10. 15 U.S.C. § 1051 (2000). Congress passed the Lanham Act on July 5, 1946. See generally 1 MCCARTHY, *supra* note 9, §§5:1-5:4. The Lanham Act is just one of many sources of trademark protection; state statutory and common law trademarks still exist. See, e.g., PETA v. Doughney, 263 F.3d 359, 362 (4th Cir. 2001). More importantly, trademark dilution statutes have proliferated at both the state and federal level. See *infra* note 20.

11. 15 U.S.C. § 1114(1)(a) (prohibiting the use of a mark that is “likely to cause confusion...”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9; 1 MCCARTHY, *supra* note 9, § 5:2. Cf. Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927) (suggesting that trademarks be viewed as property).

12. See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 167 (2003); 1 MCCARTHY, *supra* note 9, § 3:10. See also H.R. REP. NO. 109-23, at 4 (2005) (“When an individual encounters a mark [...], he or she can develop an association between a product or service and its corresponding quality, brand reputation or origin.”).

13. 1 MCCARTHY, *supra* note 9, § 2:15. See generally LANDES & POSNER, *supra* note 12, at 166-209 (discussing how trademarks lower the search costs associated with making a purchase).

14. 3 MCCARTHY, *supra* note 9, § 23:1. See PETA, 263 F.3d at 364 for the trademark infringement requirements in the Fourth Circuit.

15. 15 U.S.C. § 1116.

16. *Id.* § 1117(a).

17. *Id.*

infringement, attorney fees.¹⁸

Trademark law has grown in two major respects since the passage of the Lanham Act.¹⁹ First, state and federal trademark dilution statutes prohibit use of another's famous trademark in a manner that would diminish the mark's ability to distinctly identify the source of goods.²⁰ Trademark dilution occurs through blurring and tarnishment. Blurring is caused by use of similar marks on noncompeting goods or services (e.g. Sony basketballs made by someone other than Sony) such that when a consumer hears or sees the mark (e.g. in conversation), they must ponder whose product the mark identifies.²¹ Statutes preventing "dilution by blurring" protect the distinctiveness of the mark against non-competing and non-confusing uses of the mark by others. Tarnishment, another form of trademark dilution, may occur where a junior mark is associated with goods that do not reflect well on the owner of the senior mark (such as pornography).²² Such use by the junior mark causes a negative consumer perception of the senior mark.²³ Anti-dilution statutes are critiqued as transforming trademark rights from intellectual or intangible property rights into rights akin to real property rights (or "rights in gross") by allowing owners to exclude anyone from using the mark because the statutes do not require a showing of consumer confusion or competition of goods.²⁴

18. *Id.*; 5 MCCARTHY, *supra* note 9, §§ 30:99-30:100.

19. See 1 MCCARTHY, *supra* note 9, §§ 5.5-5.11 for comprehensive coverage of Lanham Act amendments. Prof. Port discusses a third change, 15 U.S.C. § 1051(b), creating an "Intent to Use" or ITU registration procedure for reserving trademarks before use in commerce. Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827, 829 (2000).

20. See, e.g., Federal Trademark Dilution Act of 1995, Pub. L. 104-98, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. §§ 1125, 1127), *amended by*, Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (2006) (amending actual confusion requirement as interpreted by *Mosely v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) and criteria for "famous marks"). As of 2006, thirty-six states have passed anti-dilution statutes. International Trademark Association, US State Chart of Anti-Dilution Statutes, <http://www.inta.org/> (search "anti-dilution"; then follow "US State Chart of Anti-Dilution Statutes" hyperlink) (last visited Nov. 21, 2006). See generally Schechter, *supra* note 11, at 819 ("The mark actually *sells* the goods. And, self-evidently, the more distinctive the mark, the more effective is its selling power.").

21. 4 MCCARTHY, *supra* note 9, § 24:68; Schechter, *supra* note 11, at 825.

22. See, e.g., *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (Defendants used plaintiff's mark in a pornographic parody of plaintiff's advertisements.)

23. See, e.g., *id.* (While the court found no likelihood of confusion, liability was imposed under Georgia's anti-dilution statute.)

24. See, e.g., Port, *supra* note 19, at 874-75; Julie Zando-Dennis, Note, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of*

The second major development in trademark law was the passage of the Anticybersquatting Consumer Protection Act of 1999 (ACPA).²⁵ The ACPA was designed to reach activities that may or may not be within the reach of the Lanham Act, namely the bad faith registration of domain names with the intent to profit.²⁶ The ACPA lists nine factors indicative of bad faith, including the intellectual property rights of others in the domain name and attempts by the defendant to sell the domain name for financial gain without actually having used the domain name.²⁷ These factors figure prominently into court decisions, but courts are not limited to these factors in assessing bad faith.²⁸ Remedies available under sections 34 (injunctive relief) and 35 (monetary damages) of the Lanham Act are available under the ACPA.²⁹ Additionally, the ACPA allows the plaintiff to elect to receive statutory damages between \$1,000 and \$100,000, as set by the court, per domain name registered, instead of actual damages and profits.³⁰

As with other lawsuits, the defendant in a trademark suit may have a number of legal avenues to pursue in resisting the suit. Beyond procedural grounds such as venue and jurisdiction objections, the defendant may choose to attack the plaintiff's trademark by objecting to its registration or challenging its use in commerce which is a

1995, 11 CARDOZO WOMEN'S L.J. 599 (2005). *But see* Brief for Intellectual Property Law Professors as Amicus Curiae Supporting Respondents at 1-2, Mosely v. V Secret Catalogue, Inc. 537 U.S. 418 (2003) (No. 01-1015), 2002 WL 1967938 (arguing that a likelihood of dilution does not overly expand trademark rights). *See generally* LANDES & POSNER, *supra* note 12, at 206-09 (evaluating the economic underpinnings of dilution statutes).

25. 15 U.S.C. § 1125(d).

26. S. REP. No. 106-140, at 4 (1999). In order to violate the ACPA, the defendant need not set up a website at the domain name. Furthermore, even if the user sets up a legitimate website at the domain name that does not create a likelihood of confusion, liability still may exist if there is a bad faith attempt to profit. *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264 (4th Cir. 2001).

27. 15 U.S.C. § 1125(d)(B)(i); 4 MCCARTHY, *supra* note 9, § 25:78; Elizabeth D. Lauzon, Annotation, *Validity, Construction, and Application of Anticybersquatting Consumer Protection Act*, 15 U.S.C.A. § 1125(d), 177 A.L.R. FED. 1 (2005).

28. 15 U.S.C. § 1125(d)(B)(i).

29. S. REP. No. 106-140, at 16-17; 4 MCCARTHY, *supra* note 9, § 25:78. *See* 15 U.S.C. § 1125(d)(2)(D)(3). Note that references to the Lanham Act by practitioners often refer to the structure of the Act as enacted by Congress. For example, section 1 of the Lanham Act has been codified at 35 U.S.C. § 1051, section 34 is codified at 35 U.S.C. § 1116 and section 35 is codified at 35 U.S.C. § 1117.

30. 15 U.S.C. § 1117(d); 4 MCCARTHY, *supra* note 9, § 25:78. *See also* Susan Schultz Laluk, *Anticybersquatting Consumer Protection Act*, in 1 INTERNET LAW & PRACTICE c. 14, § 14:40 (2004) (discussing cases and factors in damage awards).

requirement for registration under section 1 of the Lanham Act.³¹ The defendant may challenge the actual infringement claim by contesting the evidence of actual or likely confusion.³² Depending on the circumstances of the infringement, the defendant may also claim that the work is a parody and is therefore either not infringing or, if it is infringing, protected by the First Amendment.³³

A. Parody

A parody is a literary, musical or artistic “work in which the style of an author or work is closely imitated for comic effect or in ridicule.”³⁴ Parody has a long cultural history including use by the most distinguished writers and artists.³⁵ Because the nature of parody requires the parodist to imitate the targeted work, parody may give rise to claims under copyright and/or trademark law, depending on the form of the expression itself.³⁶ Importantly, parodies are often not directed at the original work, but rather at a societal problem or another person or entity.³⁷ For example, in the case of *Mutual of*

31. 15 U.S.C. § 1051(3)(C); 5 MCCARTHY, *supra* note 9, § 34:5. Such an attack is similar to attacking the validity of a patent in a patent infringement suit.

32. 5 MCCARTHY, *supra* note 9, § 34:5. Courts have developed multi-factored tests for likelihood of confusion, the most famous being the *Polaroid* factors. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.) (Friendly, J.), *cert. denied*, 368 U.S. 820 (1961). *See also* *Lyons P’ship v. Giannoulas*, 179 F.3d 384, 388-89 (5th Cir. 1999) (“digits of confusion” test).

33. For a list of affirmative trademark infringement defenses, see 5 MCCARTHY, *supra* note 9, § 34:5.

34. WEBSTER’S NEW COLLEGIATE DICTIONARY, *supra* note 1, at 827. *See also* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580-81 (1994); *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267 (S.D.N.Y. 1992) (“Parody implicates an element of ridicule or at least mockery”); BLACK’S LAW DICTIONARY, *supra* note 1, at 1190 (“A transformative use of a well-known work for purposes of satirizing, ridiculing, critiquing, or commenting on the original work, as opposed to merely alluding to the original to draw attention to the later work.”). *See generally* MARGARET A. ROSE, *PARODY: ANCIENT, MODERN, & POST-MODERN* (1993) (discussing the history of parody, its differences from other forms of literary or artistic criticism and its symbolism). While trademark and copyright parody laws do vary in some key respects, an analogy to the parody/fair use defense of copyright law in resolving trademark parody claims has been suggested. 5 MCCARTHY, *supra* note 9, § 34:156.

35. Chaucer, Shakespeare and Voltaire have written parodies. *E.g.*, *L.L. Bean, Inc. v. Drake Publ’rs, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987). On the opposite extreme, parody has also been the tool of pornographers. *See, e.g., id.* at 27.

36. *See, e.g., Acuff-Rose*, 510 U.S. 569 (suit for copyright infringement); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989) (suit for trademark infringement); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (suit for copyright and trademark infringement).

37. *Cf. Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d

Omaha, Inc. v. Novak, the defendant-artist modified the “Mutual of Omaha” logo and put it on t-shirts to reading “Mutant of Omaha” claiming to comment on the nuclear arms race, not to criticize the insurance company.³⁸ Courts in trademark and copyright cases have vacillated on whether fair use protection extends to works (known as satires) which critique an object other than the original work.³⁹

Trademark parodies present two obvious “defenses” to a claim of trademark infringement.⁴⁰ The first defense is to challenge the likelihood of confusion, an element of trademark infringement.⁴¹ The accused infringer may argue that although a consumer might believe for an instant that the offending product is affiliated with the target of the parody, the consumer will quickly realize that it is a parody.⁴² Unfortunately, the value of the likelihood of confusion defense has been diminished in the area of parodies as a result of expanded trademark protections under anti-dilution statutes and the view that trademark protection extends “rights in gross” to trademark owners.⁴³

200, 206 (2d Cir. 1979) (Second Circuit rejected defendants’ argument that they were using replicas of plaintiff’s cheerleading costumes to comment on the role of sexuality in sports).

38. 836 F.2d 397, 403 (8th Cir. 1987) (affirming the grant of a preliminary injunction against defendant-artist).

39. *Compare, e.g., Dr. Suess Enters. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, (S.D. Cal. 1996) (denying fair use for book using the style of DR. SUESS, THE CAT IN THE HAT to poke fun at the O.J. Simpson trial), *with Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (holding of fair use for photographs of Barbie doll being attacked by household appliances).

40. Parody is not a true legal defense. *See infra* note 45.

41. *See* 15 U.S.C. § 1125(a)(1) (2000) (creating liability for the use in commerce of “any word, term, name, symbol, or device” which “is likely to cause confusion” as to the “origin, sponsorship, or approval” of goods).

42. *See Girl Scouts v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969) (Defendant produced and distributed poster of a pregnant young woman wearing a Girl Scout uniform and the phrase “BE PREPARED”. The court found that the while a consumer may initially believe the poster was produced by the Girl Scouts, such belief would be fleeting because the poster was contrary to the organization’s values.) *See also Lyons P’ship v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999) (affirming ruling that use of Barney look-alike constituted a parody and that this finding of parody could be used as a factor in the Fifth Circuit’s “digits of confusion” analysis). *Cf. New York Stock Exch., Inc. v. Gahary*, 196 F. Supp. 2d 401, 406 (S.D.N.Y. 2002) (noting that the “sheer outrageousness” of defendant’s messages impersonating Richard Grasso, CEO of the New York Stock Exchange, as well as the posting of the message on the Internet bulletin board RagingBull.com bolstered defendant’s claim that defendant intention was not to impersonate Grasso).

43. *See Shaughnessy, supra* note 9, at 1092-99. *Cf. Dorsen, supra* note 9, at 947 (arguing that the proper view of dilution statutes is not to prevent reputational damage to the mark, but rather to protect, from overuse in other areas, the mark’s ability to identity goods). Additionally, the initial interest confusion doctrine would weaken this defense by focusing on the consumer’s first impressions, as

As a result, courts may find that although there exists no likelihood of confusion, the mark holder has still suffered reputational damage.⁴⁴ Because of the limited protection of the likelihood of confusion defense, a second defense has assumed an important role.

The second “defense” available to a claim of trademark infringement is claiming that parody is a form of constitutionally protected speech.⁴⁵ Unfortunately, courts have been inconsistent in deciding whether parody deserves protection under the First Amendment.⁴⁶ In particular, courts have had two stumbling blocks.⁴⁷ First, some courts have held that private actions to enforce trademarks are not subject to First Amendment freedom of speech strictures.⁴⁸ Second, some courts have viewed trademarks “as a type of ‘private property.’”⁴⁹ Under the second analysis, the exercise of trademark rights need not yield to the First Amendment where

opposed to what the consumer believed at the time of sale. *See infra* pp. 27-28.

44. *See, e.g.*, Pillsbury Co. v. Milky Way Prods., Inc., 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981).

45. Prof. McCarthy explains that parody is not an affirmative defense to trademark infringement, but rather a factor to be balanced by the court. 5 MCCARTHY, *supra* note 9, § 31:153. *But see* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 33-34 (1st Cir.) (suggesting that parody might be a complete defense to trademark infringement in the First Circuit, especially if it is noncommercial parody), *cert. denied*, 483 U.S. 1013 (1987); *infra* p. 39.

46. *Compare, e.g.*, Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979) (denying First Amendment protection) *with, e.g.*, L.L. Bean, 811 F.2d at 29-35 (holding that First Amendment protection exists). One commentator has suggested that such decisions are driven by the court’s assessment of the artistic merits of the parody. Dorsen, *supra* note 9, at 926-27. The merit of this argument can be seen in the evaluation of the pornographic parody in L.L. Bean. 811 F.2d at 29-35. The First Circuit reversed the grant of injunction because the grant depended upon “an untoward judicial evaluation of the offensiveness or unwholesomeness of the appellant’s materials” and considerations of the “coarseness and baseness” of the parody. *Id.* at 33-34. Such evaluations, the court stated, are in conflict with Supreme Court. *Id.* (citing Cohen v. California 403 U.S. 15, 25 (1971)). In contrast, Prof. McCarthy has suggested that commercial use of a trademark is the main factor in cases where courts have rejected First Amendment disputes. 5 MCCARTHY, *supra* note 9, § 31:152.

47. Shaughnessy, *supra* note 9, at 1108-12. For a comprehensive overview of federal trademark parody decisions, see Jordan M. Blanke, *Victor’s Little Secret: Supreme Court Decision Means More Protection for Trademark Parody*, 13 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1053 (2003).

48. Shaughnessy, *supra* note 9, at 1110-11. *See* Reddy Commc’ns, Inc. v. Envtl. Action Found., Inc., 199 U.S.P.Q. (BNA) 630 (D.D.C. 1977) (rejecting argument that under *Shelly v. Kraemer*, 334 U.S. 1 (1948), state action occurs when the courts are used to enforce private rights). *Contra* L.L. Bean, 811 F.2d at 30 n.2 (citing N.Y. Times v. Sullivan, 376 U.S. 254 (1964)); 5 MCCARTHY, *supra* note 9, § 31:143.

49. Shaughnessy, *supra* note 9, at 1111-12. *See, e.g.*, Dallas Cowboys Cheerleaders, 604 F.2d at 206.

“adequate alternative avenues of communication exist.”⁵⁰ For example, in the oft-cited *Dallas Cowboys Cheerleaders* case, the Second Circuit rejected the argument that the defendant’s use of cheerleading costumes resembling the plaintiff’s actual costumes in a pornographic film constituted a parody of the role of sexuality in sports because the defendant had other means by which to express this opinion.⁵¹ Other courts have utilized a balancing approach that weighs the public interest in being free from confusion as to source of the good or service with the public interest in parody and free speech.⁵² And still other courts have completely exempted noncommercial parody from liability under the Lanham Act.⁵³

B. Assessing the Likelihood of Confusion

A more basic problem underlies courts’ parody analysis and leads to this Note’s main critique of the analysis in the *PETA* decision. The critical element in assessing traditional trademark infringement is a likelihood of consumer confusion.⁵⁴ Whether the parody is infringing a trademark holder’s rights in their trademark depends on whether consumers are likely to be confused as to the trademark’s significance in the parody (*i.e.* whether the mark is identifying the trademark holder as the source of the parody).⁵⁵ Somewhat surprisingly, courts are not of a uniform mind on when to assess this potential confusion. Most courts find liability when confusion results in a sale.⁵⁶ This makes clear sense. Some courts go farther, however,

50. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987); *Dallas Cowboys Cheerleaders*, 604 F.2d at 206, *questioned by* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). Prof. McCarthy points out that the cases applying the “alternative avenues” test involved the use of a mark to parody something other than the original. 5 MCCARTHY, *supra* note 9, § 31:144.

51. *Dallas Cowboys Cheerleaders*, 604 F.2d at 206.

52. *E.g.*, *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 926-28 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901-02 (9th Cir. 2002); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989), *applying* *Rogers*, 875 F.2d at 994. *But see* *Mattel*, 296 F.3d at 901 (distinguishing, but not deprecating *Dr. Suess Enters. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1570 (S.D. Cal. 1996), which applied the no alternative means test where the parody does not target the original). *See generally* 4 MCCARTHY, *supra* note 9, § 28:41.

53. *L.L. Bean, Inc.*, 811 F.2d at 33 (“The Constitution does not, however, permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context.”).

54. *E.g.*, 3 MCCARTHY, *supra* note 9, § 23:1.

55. *E.g.*, *Dallas Cowboys Cheerleaders*, 604 F.2d at 204-05.

56. *E.g.*, 3 MCCARTHY, *supra* note 9, § 23:5.

imposing liability when confusion occurs but does not result in a sale.⁵⁷ This controversial doctrine of “initial interest confusion” is perhaps best summed up by the Ninth Circuit in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*:⁵⁸

Suppose West Coast’s competitor (let’s call it “Blockbuster”) puts up a billboard on a highway reading – “West Coast Video: 2 miles ahead at Exit 7” – where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast’s store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there.⁵⁹

In the context of parody, the notion of initial interest confusion causes tension because parodies are often initially, although perhaps only initially, confusing to the viewer.⁶⁰

*C. Cliffs Notes, Inc. v. Bantam Doubleday
Dell Publishing Group, Inc.*

57. *Id.* § 23:6. The initial interest confusion doctrine has been applied recently to search engine manipulation on the Internet. Compare *Brookfield Comm’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (recognizing initial interest confusion) with *Lamparello v. Falwell*, 420 F.3d 309, 315-318 (4th Cir. 2005) (refusing to adopt the initial interest confusion test and clarifying that *PETA* did not adopt such a test), *cert. denied*, 126 S.Ct. 1772 (2006). See generally Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 COLUM. J.L. & SOC. PROBS. 439 (2000).

58. 174 F.3d 1036 (9th Cir. 1999). See generally 3 MCCARTHY, *supra* note 9, § 23:6. A seminal case of the initial interest confusion doctrine is *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, where the Second Circuit imposed liability for defendant’s use of the mark Pegasus Petroleum because consumers might associate the mark with Mobil’s “flying horse.” 818 F.2d 254, 259 (2d Cir. 1987) (“For example, an oil trader might listen to a cold phone call from Pegasus Petroleum ... when otherwise he might not, because of the possibility that Pegasus Petroleum is related to Mobil.”). For a sample criticism of the initial interest doctrine, see Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004). Other courts go even further to find liability when confusion occurs not between consumers and the good, but between admirers of the consumer who has purchased the good. *E.g.*, *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Lecoultrre Watches, Inc.*, 221 F.2d 464 (2d Cir.) (the “Atmos Clock” case), *cert. denied*, 350 U.S. 832 (1955). This is “secondary” or “post-sale” confusion. 3 MCCARTHY, *supra* note 9, § 23:7.

59. *Brookfield Comm’ns.*, 174 F.3d at 1064. But see *Danielson*, *supra* note 7, at 243-46 (criticizing the *Brookfield* analogy).

60. See, *e.g.*, *Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112, 1123 (S.D.N.Y. 1980); *Girl Scouts v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969). Cf. *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (court interpreted letter from consumer objecting to use of plaintiff’s trademark in a pornographic setting as not showing confusion, but inquiring if plaintiffs intended to take action against defendants).

In what has become the leading decision on the temporal components of what constitutes a parody, the Second Circuit considered the liability of the makers of Spy Notes, a parody of the popular Cliffs Notes.⁶¹ Spy Notes were “double parodies,” poking fun at both the popular Cliffs Notes study guides as well as modern novels.⁶² While Spy Notes used the familiar yellow and black design attributed to Cliffs Notes, it also indicated that it was a “satire” in several locations in bright red text on the cover.⁶³ Additionally, the books “analyzed” by Spy Notes were not in Cliffs Notes collection.⁶⁴ While illustrating the inherent conflict between parody and trademark, the Second Circuit made its much cited, and arguably misunderstood, statement:

A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused.⁶⁵

The court went on to apply a balancing test between the public interest in free expression and the public interest in avoiding consumer confusion before vacating the injunction.⁶⁶ The requirement that these two messages be conveyed simultaneously will be referred to in this Note as the “temporal test.”⁶⁷

III. *PETA v. Doughney*

While the Internet existed when the Second Circuit wrote its *Cliffs Notes* opinion in 1989, the Internet had not become anywhere near as prevalent as it would become or shown itself as a potential “Wild

61. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

62. *Id.* at 492.

63. *Id.*

64. *Id.* at 496.

65. *Id.* at 494. Given the context of the quote, it seems more reasonable to interpret this as commentary suggesting a constrained reading of the Lanham Act in artistic parody situations than as a maxim of black letter law.

66. *Id.* at 494-97 (applying *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)).

67. The word “temporal” is borrowed from the field of formal verification of software/hardware. Temporal refers to the logic of time (e.g., *A* must happen before *B*, *C* cannot happen until *D* occurs, *E* and *F* must occur simultaneously or *G* and *H* can never exist at the same time). See generally KATHY FISLER, AN INTRODUCTION TO CTL (2001), <http://web.cs.wpi.edu/~kfisler/Courses/525V/S02/Lectures/ctl-motivation.pdf> (last visited Nov. 10, 2006). Given the rigid, logic-based interpretation of the rule by the Fourth Circuit in *PETA*, use of this term seems appropriate.

West” of intellectual property and other laws that it had when the *PETA* case entered the courts in the late 1990’s.⁶⁸ In 1995, when the Internet was at a relative stage of infancy, Michael Doughney registered the domain name *peta.org*.⁶⁹ Domain names provide an easy way for web users to locate servers on the Internet by allowing users to remember words instead of Internet Protocol (IP) addresses (the Internet equivalent of a phone number or street address).⁷⁰

Doughney registered the domain name on behalf “People Eating Tasty Animals,” a fictitious organization that Doughney indicated was a non-profit.⁷¹ *PETA®* is, of course, a registered trademark and acronym for the organization People for the Ethical Treatment of Animals.⁷² Once registered, *peta.org* directed users to Doughney’s website that contained the title “People Eating Tasty Animals” in large type, a description of the “organization” and links to approximately 30 sites relating to “meat, fur, leather, hunting, and animal research,” among others.⁷³ At the bottom of the page, the

68. See, e.g., *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001). Cf. BIEGEL, *supra* note 7, at 1-12 (questioning the “Wild West” analogy).

69. *PETA v. Doughney*, 113 F. Supp. 2d 915, 918 (E.D. Va. 2000). Domain names are registered and parsed from right to left. ANDREW S. TANNENBAUM & MAARTEN VAN STEEN, *DISTRIBUTED SYSTEMS* 201-05 (2002). For example, to retrieve documents located on *www.wpi.edu*, the “edu” name server is first contacted, which returns the IP address for the name server for the “wpi” domain (130.215.36.18), which in turn returns the IP address for its “www” server (130.215.36.202). By registering “*peta.org*,” Doughney secured the rights to configure any servers to that name, including the popular “www.”

70. E.g., Danielson, *supra* note 7, at 222. See note 69, *supra*. See generally *White Buffalo Ventures, LLC v. Univ. of Tex. at Austin*, 420 F.3d 366, 369 n.6 (5th Cir. 2005), *cert. denied*, 126 S.Ct. 1039 (2006).

71. *PETA*, 113 F. Supp. 2d at 918. Doughney acknowledged that he was aware that the top level domain (TLD) “org” was “generally accepted as denoting a nonprofit organization.” Brief of Appellee/Cross-Appellant at *9, *PETA*, 263 F.3d 359 (4th Cir. 2001) (Nos. 00-1918, 00-2289), 2000 WL 33988618 [hereinafter *PETA*’s Appellate Brief]. While this is the general use of the “org” domain name, it appears that there was not a top level domain designated for individuals in 1995. JULIE K. PETERSEN, *THE TELECOMMUNICATIONS ILLUSTRATED DICTIONARY* 271 (2d ed. 2002); J. Postel, RFC 1591: Domain Name System Structure and Delegation 2 (Mar. 1994), <http://www.ietf.org/rfc/rfc1591.txt>. At present, the TLD “name” has been reserved for individuals and “org” is unrestricted. Internet Corporation for Assigned Names and Numbers (ICANN), ICANN | FAQs, <http://www.icann.org/faq/> (last visited Nov. 10, 2006).

72. *PETA v. Doughney*, 263 F.3d 359, 363 (4th Cir. 2001) (citing U.S. Trademark Registration No. 1,705,510); *PETA*, 113 F. Supp. 2d at 918.

73. *PETA*, 263 F.3d at 363-66. Ironically, *PETA* apparently had engaged in similar conduct with regards to Ringling Bros., Vogue and Procter & Gamble. *PETA*, 113 F. Supp. 2d at 921. While Doughney raised this issue both at the original trial and on appeal, this argument was quickly rejected by the district court and not discussed by the Fourth Circuit. *Id.*; Appellant’s Opening Brief at 12-14,

website inquired “Feeling lost? Offended? Perhaps you should, like, *exit immediately*.” along with a link to PETA’s official site.⁷⁴

In 1996, PETA asked Doughney to relinquish the domain name in light of PETA’s trademark registration of the PETA mark.⁷⁵ PETA alleged, in other words, that Doughney was infringing or diluting PETA’s trademark because use of the PETA mark in the domain name was likely to confuse or mislead users of the Internet into believing that peta.org was affiliated with, sponsored by, or originated with PETA.⁷⁶ After Doughney’s refusal, PETA complained to Network Solutions, Inc. (NSI), the registry for the ‘org’ top level domain (TLD).⁷⁷ While the dispute was pending, Doughney was quoted as stating, “[i]f they want one of my domain names, they should make me an offer.”⁷⁸ Following this statement and others by Doughney, PETA brought suit for service mark infringement, unfair competition, dilution and cybersquatting.⁷⁹ PETA sought to enjoin Doughney’s use of the mark and the transfer of the domain name.⁸⁰

The Federal District Court for the Eastern District of Virginia rejected Doughney’s “defense” that his website was a parody because the two images required for a parody under *Cliffs Notes* were not shown simultaneously.⁸¹ The court held that in order for Doughney’s use of peta.org to be a parody, it must convey two messages simultaneously: (1) that his site was the PETA site and (2) that it was

PETA, 263 F.3d 359 (No. 00-1918), 2000 WL 33988619 [hereinafter Doughney’s Appellate Brief]; Memorandum of Points & Authorities, *PETA*, 113 F. Supp. 2d 915 (No. 99-1336-A), 2000 WL 34498658.

74. *PETA*, 263 F.3d at 363 (emphasis in original denotes a hyperlink).

75. *Id.* (citing U.S. Trademark Registration No. 1,705,510).

76. See PETA’s Appellate Brief, *supra* note 71, at 3.

77. *PETA*, 263 F.3d at 363. This complaint resulting in peta.org being placed on “hold” status under NSI’s Dispute Resolution Policy. *Id.* at 363 n.1. Such complaints are now handled under the ICANN UDRP, an arbitration agreement that parties assent to when registering a domain name. ICANN, Uniform Domain-Name Dispute-Resolution Policy (Nov. 9, 2005), <http://www.icann.org/udrp/udrp.htm>.

78. *PETA*, 263 F.3d at 363, quoting *Non-Profit Groups Upset by Unauthorized Use of Their Names on the Internet*, THE CHRONICLE OF PHILANTHROPY, Nov. 14, 1996.

79. *PETA*, 263 F.3d at 363. While service marks technically are associated with services and trademarks are associated with goods, the requirements are essentially the same. The term “trademark” is often used to describe the full range of marks covered by the Lanham Act. 1 MCCARTHY, *supra* note 9, § 3:1. See 15 U.S.C. § 1127 (2000).

80. *PETA*, 263 F.3d at 363. After the resolution of the appeal, the domain name was transferred to PETA. Doughney maintains his website at <http://mtd.com/tasty/>.

81. *PETA v. Doughney*, 113 F. Supp. 2d 915, 921 (E.D. Va. 2000). Oddly, the district court did not cite *Cliffs Notes*.

not the PETA site.⁸² The Fourth Circuit Court of Appeals affirmed the grant of summary judgment on the same grounds.⁸³

Doughney weakened his parody defense by admitting that “‘many people’ would initially assume [because of the peta.org domain name] that they were accessing an authentic PETA web site.”⁸⁴ In doing so, he foreclosed the argument that many domain names refer to the content of the website, not the source, making it unreasonable and unlikely that people would believe that PETA was the source of his website.⁸⁵ Moreover, he also foreclosed the argument that because of the inherent unpredictability of the World Wide Web, especially in 1996, most users do not have any expectations of what page they will receive when they type a domain name or execute a search through a search engine.⁸⁶ Additionally, both courts, likely because of Doughney’s concessions,⁸⁷ appear to assume that consumers operate on a web browsing model where they type in a

82. *Id.*

83. *PETA*, 263 F.3d at 366-67. Both the district court and the Fourth Circuit found as a preliminary matter that Doughney’s use of the mark was commercial because it was in connection with goods and services, i.e., preventing users from reaching PETA’s goods and services or linking to other websites that offered goods and services. *Id.* at 365-66, *aff’d* 113 F. Supp. 2d at 919. The lack of a clear standard regarding what constitutes commercial speech has been recently criticized. See R. Kent Warren, Note and Recent Developments, *Interpreting Commercial Speech Under the Lanham Act’s Commercial Use Requirement: Tension Between Online Trademark and First Amendment Free Speech Rights*, 4 FIRST AMEND. L. REV. 342 (2006).

84. *PETA*, 113 F. Supp. at 921. *Cf.* *Paccar Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 250 (6th Cir. 2003) (“words in many domain names can and do communicate information as to the source or sponsor of the web site”), *overruled on other grounds by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998) (“We reject [the] premise that a domain name is nothing more than an address. *But see Doughney’s Appellate Brief*, *supra* note 73, at 18 (arguing that the district court erred by assuming that consumers would form an opinion about Doughney’s website solely by its domain name). A significant purpose of a domain name is to identify the entity that owns the web site.”); *Cardservice Int’l v. McGee*, 950 F. Supp. 737, 741 (E.D. Va.), *aff’d*, 129 F.3d 1258 (4th Cir. 1997) (unpublished opinion at 1997 WL 716186) (“Cardservice International’s customers who wish to take advantage of its internet services but do not know its domain name are likely to assume that ‘cardservice.com’ belongs to Cardservice International.”); David M. Kelly, “*Trademark.com*” *Domain Names—Must They Communicate the Website’s Protected Content to Avoid Trademark Liability?*, 33 AIPLA Q.J. 397, 412 (2005).

85. *Cf. Doughney’s Appellate Brief*, *supra* note 73, at 14-15, 30. For example, the website pizzarellifanpage.com, although devoted to the jazz guitarist John Pizzarelli, is not operated or affiliated with the musician or his agents. The John Pizzarelli Fan Page, <http://pizzarellifanpage.com> (last visited Nov. 10, 2006).

86. See Danielson, *supra* note 7, at 229-34.

87. *Supra* note 84.

domain name blindly.⁸⁸ Given the growth of search engines by the late-1990's, this seems simplistic at best.⁸⁹ Indeed, securing the peta.org domain name would not necessarily assure Doughney of increased search engine rankings because emerging search engines such as Google were using algorithms to rank pages based on how many other websites link to them rather than domain names.⁹⁰

IV. Analysis

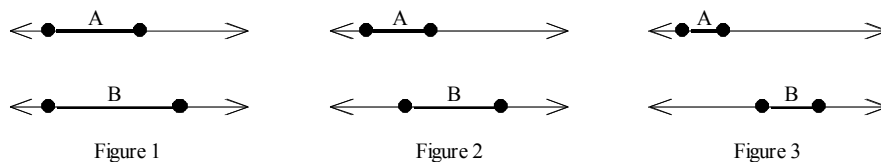
Both the district court and the Fourth Circuit may have extended the *Cliffs Notes* precedent beyond the Second Circuit's intention and beyond the temporal requirement's logic. While "simultaneous" is well understood to mean occurring at the same time, this is not the only reasonable definition. *Webster's* defines simultaneous as "existing or occurring at the same time" (emphasis added).⁹¹

88. *PETA*, 263 F.3d at 366-67 (citing *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1435 (S.D.N.Y. Mar. 24, 1997) ("seeing or typing the 'planned parenthood' mark and accessing the web site are two separate and nonsimultaneous activities")), *aff'g PETA*, 113 F. Supp. at 921.

89. Indeed, with the recent developments in personalized portals and search engines, the likelihood of confusion may have decreased because computers may deduce that a user who had previously accessed the website of The American Society for the Prevention of Cruelty to Animals was seeking the People for Ethical Treatment of Animals website, not Doughney's website, when searching for "PETA." See generally CASS SUNSTEIN, *REPUBLIC.COM* (2001).

90. See Sergey Brin & Lawrence Page, *The Anatomy of a Large-Scale Hypertextual Web Search Engine*, 30 *COMPUTER NETWORKS & ISDN SYSTEMS* 107 (1998), available at <http://www7.scu.edu.au/1921/com1921.htm> (discussing the PageRank metric). As a key part of Google, the PageRank metric remains dominant today. Junghoo Cho & Sourashis Roy, *Impact of Search Engines on Page Popularity*, in *PROCEEDINGS OF THE 13TH WWW CONFERENCE* (2004), available at <http://www.www2004.org/proceedings/docs/1p20.pdf>. However, this does not necessarily mean that an authentic PETA website would rank higher than Doughney's site, especially if Doughney's site garnered popularity, along with many links for humor purposes.

91. *WEBSTER'S NEW COLLEGIATE DICTIONARY*, *supra* note 1, at 1075. *Black's Law Dictionary* does not define simultaneous. The difference between "existing" and "occurring" can perhaps best be understood graphically.



"Occurring" refers to the instant at which something takes place (i.e. the beginning of an event). "Existing" includes the duration of an event. In Figure 1, A and B both occur at the same time and coexist (for at least some instant). In Figure 2, A and B coexist (at least for some instant, but do not occur at the same time. In Figure 3, A and B neither occur at the same time, nor coexist. See also STEVEN M.

Furthermore, some courts have interpreted simultaneous to mean “at substantially the same time.”⁹² As applied to *Cliffs Notes*, a prospective purchaser would have juggled the belief that the book was published by Cliffs Notes and was *not* published by Cliffs Notes at “substantially the same time,” before deciding that it was indeed not published by Cliffs Notes.⁹³ In such a situation, both thoughts would have coexisted in his mind at the point when he saw notes on the book cover indicating that it was a satire. Similarly, in *PETA*, a viewer would have held both beliefs simultaneously for the moment when the page loads and they initially view it.⁹⁴

More importantly, even if the Second Circuit intended a stricter reading of its requirement that the conveyance of both messages must *occur* at the same time (meaning that they both leave the server at the same time or are presented to the user at the exact same instant), the Second Circuit itself has rarely if ever adhered to such a rigid standard, even in *Cliffs Notes*.⁹⁵ Unless the reader visually takes in

KAPLAN, WILEY ELECTRICAL & ELECTRONICS ENGINEERING DICTIONARY 712 (2004) (defining simultaneous as “[o]ccurring, performed, or existing at the same instant” or “[o]ccurring, performed, or existing concurrently”).

92. BALLENTINE’S LAW DICTIONARY 1182 (3d ed. 1969) (“The word [simultaneously] does not necessarily mean at the very same instant, but may, and often does mean at substantially the same time.”), *citing* Cloyes v. Middlebury Elec. Co., 80 Vt. 109, 119 (1907). *See also* Am. Sur. Co. of N.Y. v. Mosher, 48 Ariz. 552, 564 (1936); White v. Taylor, 281 S.W.2d 237, 240 (Tex. Civ. App. 1955), *rev’d* 286 S.W.2d 925 (Tex. 1956). *But cf.* Thomas v. Anderson, 96 Cal. App. 2d 371, 375-77 (Cal. Dist. Ct. App. 1950). *See generally* Uniform Simultaneous Death Act §§ 2-3 (1993) (adopting survival by 120 hours requirement to avoid litigation over whether deaths were simultaneous).

93. *Cf.* Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc., 886 F.2d 490, 496 (2d Cir. 1989) (“Moreover, even for those few readers who might be slightly confused by the cover, the most likely reaction would be to open the book.”).

94. Compare this situation to other cases where infringers have created websites that not only mimic the domain name, but also mimic the style of the target’s website. *See, e.g.,* Fairbanks Capital Corp. v. Kenney, 303 F. Supp. 2d 583, 589-90 (D. Md. 2003) (“for several moments after landing on defendants’ site, such users will experience genuine confusion over the source of the information being provided”), *cited in* Kelly, *supra* note 84, at 430.

95. *See* Yankee Publ’g Inc. v. News Am. Publ’g Inc., 809 F. Supp. 267 (S.D.N.Y. 1992) (applying *Cliffs Notes* “parody test” as a guide, but holding that the key question was not whether the challenged work was a parody, but rather whether the work was permitted under the *Rogers* balancing test as applied in *Cliffs Notes*). *Cf.* Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 417-18 (S.D.N.Y. 2002) (holding that trademark infringement did not occur, in part, because “taken as a whole and in context, as it should be for a fair evaluation, Nature Labs’ presentation accomplishes what it must”); Girl Scouts v. Bantam Doubleday Dell Publ’g Group, Inc., 808 F. Supp. 1112, 1121 (S.D.N.Y. 1992), *aff’d* 996 F.2d 1477 (2d Cir. 1993) (holding that *Cliffs Notes* extended the *Rogers* test to the area of parody; it did not limit the application of *Rogers* to

the entire book cover in *Cliffs Notes* at once (which is unlikely given how we process words and images), the reader, presumably reading from top to bottom, might first get the impression that this is a product of Cliffs Notes, a split second before receiving the impression that this is not a product of Cliffs Notes, but rather a parody.⁹⁶ Similarly, in *PETA*, assuming as we must because of Doughney's admission that most users would believe they were viewing the PETA website because they had typed www.peta.org, this belief would be challenged within a few seconds⁹⁷ by a website prominently bearing the name "People Eating Tasty Animals" that promotes fur and hunting.⁹⁸

parody situations). *But see* New York Stock Exch., Inc. v. Gahary, 196 F. Supp. 2d 401, 406 (S.D.N.Y. 2002) (While noting that "[t]o presume bad faith on the part of every parodist would be both unfair and inefficient, ... [t]he critical question, in this context, is whether the parody ... simultaneously conveys the contradictory message 'that it is not the original.'").

96. This is essentially note 91's Figure 2, with the impression that the book was a product of Cliffs Notes being "A" and the impression that it was *not* Cliffs Notes being "B." *Supra* note 91.

97. As of November 10, 2006, the homepage of Doughney's People Eating Tasty Animal site (last updated on Sept. 9, 1996 according to change log in HTML source code) was 33664 bytes (269312 bits). People Eating Tasty Animals, <http://www.mtd.com/tasty> (last visited Nov. 10, 2006). Assume that the average user accessed the Internet through a 14.4k modem in 1996. *Cf.* Graphic, Visualization, & Usability Center, *GVU's 6th WWW User Survey*, http://www.cc.gatech.edu/gvu/user_surveys/survey-10-1996/ (last visited Jan. 16, 2006) (Survey suggests that just over half of Internet users connected via 28.8k modem. However the survey technique made it biased towards heavy users of the Internet who would likely have newer and faster modems.). This maximum speed will not be achieved because of noise, attenuation, etc., so assume that a download speed of 12,000 bits per second is achieved. Downloading the entire homepage will take just over 22 seconds, excluding any additional time for the user to send the request to the ISP, the ISP to contact Doughney's web server, the server to retrieve the page and send it back to the ISP. For a comprehensive explanation of modem technology, see ANDREW S. TANENBAUM, *COMPUTER NETWORKS* 124-30 (4th ed. 2003). However, Internet browsers (e.g. Internet Explorer) are capable of rendering portions of pages as they load, so a user could probably gather that Doughney's site was not in fact PETA's before the entire page loaded.

In contrast, Internet providers are now offering home internet connections with downloads speeds of 10 megabits per second or higher. *See, e.g.*, Brier Dudley, *Verizon's fiber-optic, speedy Net on the way*, SEATTLE TIMES, Nov. 30, 2005, at C1. Even assuming that the maximum realized speed is only 8 megabits per second, it would theoretically take 0.034 second to download Doughney's homepage from the ISP.

98. *Cf.* Girl Scouts v. Personality Posters Mfg. Co., 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969) (finding that the while a consumer may initially believe the poster was produced by the Girl Scouts, such belief would be fleeting because the poster was contrary to the organization's values). *Cf. generally* Gahary, 196 F. Supp. 2d at 406 (noting that the "sheer outrageousness" of defendant's messages impersonating Richard Grasso, CEO of the New York Stock Exchange, as well as the posting of the message on the Internet bulletin board RagingBull.com bolstered

Clearly, this would create a conflicting belief in the viewer's mind that must be resolved.⁹⁹ Moreover, in several cases, clearly antithetical messages have destroyed confusion initially caused solely by the domain name.¹⁰⁰ The *PETA* court focused on the temporal delay of the second message caused in part by the still evolving Internet architecture and technology.¹⁰¹ However, focusing on the delay between when the page is requested or the domain name is resolved and when the actual page is displayed to the user, positions the *PETA* decision to become obsolete as web server and download speeds increase, causing download times to shrink.¹⁰²

A strict reading of "simultaneous" in evaluating the existence of parody effectively prohibits the use of an entity's name as a domain name by a site criticizing that entity.¹⁰³ While Congress may have

defendant's claim that defendant intention was not to impersonate Grasso).

99. See *supra* note 93.

100. *E.g.*, *Lamparello v. Falwell*, 420 F.3d 309, 315 (4th Cir. 2005) ("No one would believe that Reverend Falwell sponsored a site criticizing himself...") *cert. denied*, 126 S.Ct. 1772 (2006); *Savannah College of Art and Design, Inc. v. Houeix*, 369 F. Supp. 2d 929, 951 (S.D. Ohio 2004), *cited in Kelly, supra* note 84, at 483. See generally *Girl Scouts*, 304 F. Supp. at 1231.

101. *PETA*, 263 F.3d 359, 366-67 (4th Cir. 2001), *aff'g* 113 F. Supp. 2d 915, 921 (E.D. Va. 2000).

102. *Cf. City of Akron v. Akron Ctr. for Reprod. Health*, 462 U.S. 416, 458 (O'Connor, J., dissenting) (suggesting that the *Roe v. Wade* trimester model for assessing the constitutionality of abortion regulations "is clearly on a collision course with itself" because of its reliance on medical technologies and standards to define what procedures were safe and when fetal viability occurred).

An alternative reading of *Cliffs Notes*, however, could subject Doughney to liability for not conveying the contradictory messages simultaneously. (Recall that the definition of simultaneous includes existing or occurring.) WEBSTER'S NEW COLLEGIATE DICTIONARY, *supra* note 1 at 1075. Under this theory, Doughney conveyed the first message (that his site was the authentic PETA site) passively when he registered the domain name peta.org. This caused the message that his site was PETA's to be actively conveyed when a user requested the website peta.org, causing their ISP to request the server associated with peta.org from a domain name server which would return the IP address for Doughney's server. See note 69, *supra*. The second message, that Doughney's website was not PETA's, would not be conveyed until the web server was contacted. Although Doughney makes a passive assertion that his site is PETA's through registration, this registration should not be separated from the content of his website for purposes of the *Cliffs Notes* test because from the average user's perspective, converting a domain name into an IP address is an invisible part of retrieving a web page. *Cf. Perfect 10 v. Google, Inc.*, 416 F.Supp.2d 828, 843 (C.D. Cal. 2006) (adopting the "server test" for assessing whether a party displays a work for purposes of copyright infringement because the test "is based on what happens at the technical-levels as users browse the web, and thus reflects the reality of how content actually travels over the internet before it is shown on users' computers")

103. Of course, Doughney could have registered the venerable domain name, www.petasucks.com or some analogue or derivative thereof. *Cf. Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998) (denying

intended this result when passing the ACPA,¹⁰⁴ where the Lanham Act can serve as an independent basis of liability, one must ask whether this is appropriate standard for judging a likelihood of confusion.¹⁰⁵

Moreover, a strict application of *Cliffs Notes*' temporal logic in the domain name context is essentially a use of the much criticized initial interest confusion theory under a different name.¹⁰⁶ By focusing solely on whether the contradictory messages were communicated at the exact same time, the court places undue weight on what the consumer initially believed, rather than taking a broader, more

trademark infringement claim against owner of www.compupix.com/ballysucks.com). However, it is unclear whether establishing Doughney's site at www.mtd.com/peta would constitute trademark infringement. See Eugene P. Sunday, Note, *The Dark Side of the Dot Com—Protecting Trademark Use in the Post Domain Paths of URLs*: Interactive Products Corporation v. A2Z Mobile Office Solutions, 326 F.3d 687 (6th Cir. 2003), 29 DAYTON L. REV. 465 (2004).

104. See *PETA*, 263 F.3d at 367-69, *aff'd* 113 F. Supp. 2d at 920-21. But cf. S. REP. NO. 106-140, at 9 (“[W]hile noncommercial uses of a mark, such as for ... parody ... are beyond the scope of the bill’s prohibitions, the fact that a person uses the domain name at issue in connection with a site that makes a noncommercial or fair use of the mark does not necessarily mean that the domain name registrant lacked bad faith.”).

105. Indeed, it is questionable whether it was necessary for the district court and/or the Fourth Circuit to decide the *PETA* case on traditional trademark infringement grounds when the ACPA was arguably designed to handle exactly this type of conduct. While the applicability of the ACPA (passed in 1999) to conduct in 1995 and 1996 was challenged as unconstitutional by Doughney, Doughney's Appellate Brief, *supra* note 73, at 46, both courts found little problem, constitutionally or otherwise, in imposing ACPA liability for all of Doughney's actions. *PETA*, 263 F.3d 359, 368 (4th Cir. 2001), *aff'd* 113 F. Supp. 2d 915, 920-21 (E.D. Va. 2000). Moreover, the three remedies sought by *PETA* were equally, if not more, available for violations under section 1125(d) (cybersquatting) vs. section 1125(a) (trademark infringement). In its motion for summary judgment, *PETA* sought (1) transfer of the domain name peta.org, (2) an injunction prohibiting Doughney from using any domain name confusingly similar to *PETA*'s mark and (3) award of attorney's fees and costs pursuant to section 35 of the Lanham Act. Memorandum in Support of Plaintiff's Motion for Summary Judgment on Its Amended Complaint and Pursuant to the Newly Enacted Anticybersquatting Consumer Protection Act, *PETA*, 113 F. Supp. 2d 915 (No. 99-1336-A), 2000 WL 34498663. The transfer of the domain name and injunction are equally available under the court's equity powers codified in Lanham Act § 34. 15 U.S.C. § 1116(a) (2000) (courts “shall have power to grant injunctions, according to the principles of equity [...], to prevent a violation under subsections (a), (c), or (d) of section 1125 of this title”). Similarly, attorneys fees and costs are both available under Lanham Act § 35. 15 U.S.C. § 1117(a). One possible rationale for imposing liability under both theories is that the combined violations constituted an “exceptional” case justifying attorney's fees. *Id.* However, both courts ruled that this was not such a case. *PETA*, 263 F.3d at 370, *aff'd* 113 F. Supp. 2d 915.

106. Cf. *Brookfield Comm'ns, Inc. v. West Coast Entm't Corp.* 174 F.3d 1036 (9th Cir. 1999).

commonsensical view of the expressive message and interpretation by an ordinary consumer.¹⁰⁷ By penalizing the defendant for not immediately countering the first message, the Fourth Circuit followed courts operating under the initial interest confusion theory.¹⁰⁸ This is particularly ironic because the Fourth Circuit has explicitly refrained from adopting the oft-criticized initial interest confusion theory.¹⁰⁹

Parody should not be subject to such rigid requirements imposed by the *PETA* courts because parody is just one factor in determining whether trademark infringement has occurred.¹¹⁰ Moreover, parody is not a complete defense to a trademark infringement claim.¹¹¹ Rather, the effectiveness of the parody will necessarily impact the likelihood of confusion.¹¹² Additionally, taking this broader, less formalistic view of parody is consistent with the philosophy of courts, including the *PETA* court, that courts should not consider “how closely a fragment of a given use duplicates the trademark,” but rather “whether the use in its entirety creates a likelihood of confusion.”¹¹³

107. *PETA*, 263 F.3d at 370 (“an internet user would not realize that they were not on an official PETA web site until after they had used PETA’s Mark to access the web page ‘www.peta.org.’”) (quoting *PETA*, 113 F. Supp. 2d at 921).

108. Cf. *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000) (holding that disclaimer was insufficient to remedy initial interest confusion), cited in *Kelly*, *supra* note 84.

109. See *Lamparello v. Falwell*, 420 F.3d 309, 315-316 (4th Cir. 2005), *cert. denied*, 126 S.Ct. 1772 (2006); *Kelly*, *supra* note 84 at 468-71. The Fourth Circuit in *Lamparello* discussed *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. Mar. 24, 1997), and *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J. 1998), two cases where courts focused extensively on the confusing nature of the domain name. *Lamparello*, 420 F.3d at 317-18, n. 6. The court stated that these cases were “wrongly decided” because in ignoring the content of the site, the courts “cut [the initial-interest confusion theory] from its moorings to the detriment of the First Amendment.” *Id.* However, some courts in the Fourth Circuit have since given some limited recognition to the initial interest confusion theory. See *GEICO v. Google, Inc.*, 2005 U.S. Dist. LEXIS 18642 at *14-16 (E.D. Va. Aug. 8, 2005) (discussing initial interest confusion as a means of establishing Lanham Act liability), *Asia Apparel, LLC v. Ripsweat, Inc.*, 2004 U.S. Dist. LEXIS 29208 (W.D.N.C. Sept. 17, 2004) (“This argument fails to take account of ‘initial interest’ confusion.”). For an example of criticism of initial interest confusion, see *Dogan & Lemley*, *supra* note 58.

110. Note 45, *supra*.

111. *Id.*

112. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989) (“A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that is *not* the original... To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused.”).

113. *PETA*, 263 F.3d at 366 (emphasis added), quoting *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 318 (4th Cir. 1992), citing 2 MCCARTHY, *supra*

This more flexible approach to parody, however, is only relevant where a court takes a balancing approach to regulating noncommercial speech under the Lanham Act. The *Cliffs Notes* court undertook such an approach in finding that slight risk of consumer confusion posed by the Spy Notes books was outweighed by the public interest in parody and free speech.¹¹⁴ The Fifth, Sixth and Ninth Circuits have adopted similar approaches.¹¹⁵ In contrast, under an “alternative avenues” test, the public interest in parody is irrelevant as compared with the importance of trademark protection.¹¹⁶ If the speaker/artist had alternative means of expressing the message, there is no First Amendment violation.¹¹⁷ At the other end of the spectrum, under *L.L. Bean* if the speech/work is noncommercial, the fact that it is a parody seems superfluous.¹¹⁸

V. Conclusion

Applying the *Cliffs Notes* test in a flexible manner is consistent not only with the Second Circuit’s subsequent application of the test, but also with the universal maxim that confusion should be assessed by looking at allegedly infringing use as a whole. However, applying this more flexible test likely would not have changed the result in *PETA*. There can be little doubt, especially after Doughney’s concession that even he believed the domain name caused confusion.

note 9, § 23:28. See also *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993); *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 117 (2d Cir. 1984); *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976); *Dr. Suess Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1570 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394 (9th Cir. 1997).

114. 886 F.2d 490 at 495-97, *applying* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Notably, the *Cliffs Notes* court applied this balancing test even where the speech was considered commercial.

115. See note 52, *supra*.

116. See note 50, *supra*.

117. *Id.*

118. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32-33 (1st Cir.) (explaining that the application of the Maine anti-dilution statute to non-commercial speech takes it “far beyond the frontiers of commerce and deep into the realm of expression”), *cert. denied*, 483 U.S. 1013 (1987). See also *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992) (holding that First Amendment protection is not dependent on whether a work is parody). The *L.L. Bean* decision is ambiguous about whether parody (particularly commercial parody) could possibly be a defense in itself. 811 F.2d at 33-34 (suggesting that parody is worthy of First Amendment protection and rejecting the district courts application of the “no alternative avenues” test). The First Circuit’s test elevates the importance of determining whether speech is commercial or non-commercial, militating for a clear standard in this area. Cf. Warren, *supra* note 83 (discussing the need for a clear standard).

It therefore would not have been unreasonable to find that a significant risk of confusion, together with Congress's clear policy statement in the ACPA against cybersquatting outweighed the interest in free speech. Nevertheless, as this Note argues, an overly rigid reading of *Cliffs Notes* should not be used as a prophylactic measure to prevent a court from reaching these important constitutional issues.