Bosley Medical Institute v. Kremer: The Winds Shift to Protect Cybergripers and a Circuit Split Blows into Town

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THE WINDS SHIFT TO PROTECT CYBERGRIPIRES 
AND A CIRCUIT SPLIT BLOWS INTO TOWN

INTRODUCTION

As today’s consumers are becoming more technology-savvy, an increasing number are turning to the Internet to air their complaints about Corporate America’s products and services. In other words, “[c]onsumer protests against big business are going digital.” The following scenario is all too familiar to 80% of Fortune 1000 companies: Mr. and Mrs. Consumer decide to purchase and use Big Corporation’s product. When that product does not live up to the Consumers’ expectations, they create an Internet site to complain about it using Big Corporation’s registered trademark or a part of the trademark as their website’s domain name. The Consumers’ website does not offer any goods for sale, nor are any advertisements available on their website. The site is merely used for unflattering commentary about Big Corporation’s product – in other words, the site is used for “cybergriping”. Big Corporation subsequently sues the Consumers for trademark infringement based on the use of its trademark in the site’s domain name. Whether Big Corporation prevails in suit against the Consumers depends on where the suit is filed.

A key element of traditional trademark infringement Big Corporation must prove is that the Consumers’ unauthorized use of

1. See, e.g., Robert Trigaux, Gripe.com, ST. PETERSBURG TIMES, Jan. 31, 1999, at 1H (Estimating “more than half of the Fortune 1000 companies have encountered some type of Web site critical of their business.”).
2. Id.
3. Id. (“More than 80% of Fortune 1000 companies are victims of some type of trademark misuse on the Internet . . . ”).
4. See generally, Christopher Quinn, Gripe Site is Sued by the Griped-About, CHI. TRIB., Oct. 24, 2004, at 7G.
5. Id.
7. Id.
8. See generally, Quinn, supra note 4, at 7G.
9. See infra Part IV.
its trademark occurred in connection with the sale, offering for sale, distribution, or advertising of goods or services.\textsuperscript{10} The Courts of Appeal for the Second, Third, Fourth and Eighth Circuits have held that this requirement is satisfied because the Consumers’ websites may prevent or hinder Internet users from accessing Big Corporations’ services on its own website.\textsuperscript{11} Accordingly, in these jurisdictions, the Consumers would be found liable for trademark infringement.\textsuperscript{12} In the Court of Appeals for the Sixth Circuit, and due to the recently decided case of \textit{Bosley Medical Insitute, Inc. v. Kremer},\textsuperscript{13} in the Court of Appeals for the Ninth Circuit, the mere fact that the Consumers’ website dissuades viewers of their website from using Big Corporations’ services on its own website is not enough to meet the “use in connection” requirement of traditional trademark infringement.\textsuperscript{14} Consequently, the Consumers would not be found liable for classic trademark infringement in these jurisdictions.\textsuperscript{15} These two approaches are the centerpieces in the debate over whether or not cybergrippers who maintain websites critical of trademark holders’ products or services that employ a registered trademark as the domain name, without more, are liable for trademark infringement.\textsuperscript{16}

Part I of this Comment provides a general overview of cybergripping and trademark infringement.\textsuperscript{17} Further, it pays close attention to the various legal recourses available to a trademark holder and the interplay between these available infringement causes of action with each other and the First Amendment right to Free Speech.\textsuperscript{18} Part II discusses the different approaches taken by the Circuit Courts of Appeal when confronted by infringement suits

\textsuperscript{10} See PETA v. Doughney, 263 F.3d 359, 364 (4th Cir. 2001).
\textsuperscript{11} See, e.g., \textit{PETA}, 263 F.3d 359 (4th Cir. 2001); Coca-Cola Co. v. Purdy, 382 F.3d 774, 789 (8th Cir. 2004).
\textsuperscript{12} See, e.g., \textit{Jews for Jesus v. Brodsky}, 159 F.3d 1351 (3d Cir. 1998).
\textsuperscript{13} \textit{Bosley Med. Inst., Inc. v. Kremer}, 403 F.3d 672 (9th Cir. 2005).
\textsuperscript{14} \textit{See id. at 679-80; Taubman Co. v. Webfeats}, 319 F.3d 770, 778 (6th Cir. 2003).
\textsuperscript{15} \textit{See Taubman}, 319 F.3d at 778; \textit{Bosley}, 403 F.3d at 679-680.
\textsuperscript{17} See infra Part I.
\textsuperscript{18} See infra Part I.A-B.
against cybergripers.\textsuperscript{19} Part III discusses the new approach adopted by the Ninth Circuit Court of Appeals in \textit{Bosley Medical Institute v. Kremer}.\textsuperscript{20} Part IV examines the widening circuit split caused by the decision in \textit{Bosley}.\textsuperscript{21} Finally, Part V analyzes which approach to cybergriping cases is better from the perspective of the accurateness of the underlying concepts of the Internet upon which the opposing decisions rest.\textsuperscript{22} Part V concludes by arguing that because the Ninth Circuit’s conception of the Internet is the most accurate the approach taken by the Ninth Circuit in \textit{Bosley} has the added benefit of being consistent with the purposes of trademark law.\textsuperscript{23}

I. CYBERGRIPING AND TRADEMARK INFRINGEMENT: AN OVERVIEW

A. Cybergriping Generally

The scenario between the Consumers and Big Corporation mentioned above describes the quintessential case of “cybergriping,” which occurs “when a consumer creates a web page on the Internet to voice an opinion (usually a negative one) about a particular product, company, or service.”\textsuperscript{24} Further, as illustrated above, a disgruntled consumer typically engages in an “unauthorized use of famous marks in [the] [w]eb site’s domain name[].”\textsuperscript{25} Unlike the practice of “cybersquatting”—using famous marks in a web site’s domain name with the intent “to profit from the unauthorized use of a mark by holding a domain name hostage from the owner of a mark”—the cybergriper’s sole intent in using the mark in the domain name is generally “to aid in the dissemination of a negative message about the mark owner.”\textsuperscript{26}

\textsuperscript{19} See infra Part II.
\textsuperscript{20} See infra Part III.
\textsuperscript{21} See infra Part IV.
\textsuperscript{22} See infra Part V.
\textsuperscript{23} Id.
\textsuperscript{26} Id. at 272-73.
The problem with cybergripping from the trademark holder’s perspective is that the unauthorized use of its mark in a domain name constitutes infringement that misleads or confuses the public about the products associated with their mark.\(^{27}\) Additionally, trademark owners fear that the unauthorized use of their mark in domain names degrades the capacity of the famous mark to identify and distinguish their goods or services, a practice known as trademark dilution.\(^{28}\) These results are particularly bothersome to trademark holders because trademarks generally “help customers select goods of a known quality with low transaction costs, and they operate as symbols of . . . [the mark holder’s] goodwill.”\(^{29}\) Many trademark holders think that cybergripping disparages their mark and want potential cybergrippers to know that they take this denigration seriously.\(^{30}\) Hence these fears often lead trademark holders to file suit against cybergrippers.\(^{31}\)

B. Legal Recourses for Trademark Holders

Trademark holders can “protect the uniqueness of their brand identity by enforcing the federal property rights granted to them” under the Lanham Act.\(^{32}\) Under the Act, trademark holders can bring claims against cybergrippers for infringement due to consumer confusion,\(^{33}\) unfair competition,\(^{34}\) and trademark dilution.\(^{35}\) Moreover, claims for trademark infringement on the Internet can also

\(^{27}\) See RONALD J. MANN & JANE K. WINN, ELECTRONIC COMMERCE 67 (2d ed. 2005).


\(^{31}\) See id.


\(^{33}\) The Lanham Act is the Congressional legislation that established a uniform federal standard for trademark protection. See generally 15 U.S.C. §§ 1114, 1125, 1127 (2000).


be brought under the portion of the Lanham Act designated as the Anti Cybersquatting Protection Act (ACPA). Finally, trademark holders can arbitrate to enjoin the use of their mark under Internet Corporation for Assigned Names and Numbers’ (ICANN) Uniform Domain Name Dispute Resolution Policy (UDRP).

C. Interconnection Between the Different Causes of Action

One of the chief purposes of trademark law is “to recognize the right of the consumer to get the product he wants without being deceived.” Thus, many courts have held that “[t]he core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products.” Accordingly, when filing suit against cybergrippers, trademark holders often bring claims for trademark infringement due to consumer confusion under both 15 U.S.C. §§ 1114 and 1125(a). “Section 1114 creates a cause of action for owners of registered marks against any person who makes an unauthorized use of the mark”, while §1125(a) operates as a federal unfair competition regulation for both registered trademarks and unregistered common law trademarks.

Despite the semantic differences between § 1114 (federal trademark infringement) and §1125(a) (federal unfair competition), violations of both of these sections of the Lanham Act are measured by identical standards. Moreover, in most cybergripping cases, courts “analyze likelihood of confusion under § 1114 and § 1125(a) simultaneously.” To prove trademark infringement under both §§ 1114 and 1125(a), the trademark holder must show that:

38. 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE §1.03(8)(a) (Anne Gilson Lalonde & Karin Green, eds., LexisNexis 2006).
40. See Lefcort, supra note 25, at 274.
41. Id.
43. Lefcort, supra note 25, at 275.
(1) that it possesses the mark; (2) that the defendant used the mark; (3) that the defendant's use of the mark occurred "in commerce"; (4) that the defendant used the mark "in connection with the sale, offering for sale, distribution, or advertising" of goods or services; and (5) that the defendant used the mark in a manner likely to confuse consumers.\textsuperscript{44}

Currently, the Circuit Courts of Appeal disagree over what is required to satisfy the fourth element.\textsuperscript{45}

D. Trademark Infringement and Free Speech Collide—Why it Matters What Use is Deemed a "Use in Connection With"

Although a plethora of claims are available to a trademark holder under the Lanham Act, that Act only regulates use of a trademark that is deemed commercial speech.\textsuperscript{46} The very fact that the Lanham Act covers only commercial speech renders the Act constitutional.\textsuperscript{47} The commercial speech requirement ensures that the Lanham Act does not run afoot of constitutional free speech protections because commercial speech is entitled to lesser protections under the First Amendment right of free speech.\textsuperscript{48} If a court finds that use of a mark is not commercial, that use is outside the purview of the Lanham Act and is necessarily protected by the First Amendment.\textsuperscript{49} In traditional trademark infringement suits brought under §1114 and §1125(a), the determination of whether the use of the mark is commercial requires a court to consider whether the use of the mark is in connection with the use of goods or services.\textsuperscript{50} Thus, in classic trademark infringement suits against cybergrippers, if the unauthorized use of a

\textsuperscript{44} PETA v. Doughney, 263 F.3d 359, 364 (4th Cir. 2001).
\textsuperscript{45} See infra Part III.
\textsuperscript{46} See Taubman Co. v. Webfeats, 319 F.3d 770, 774 (6th Cir. 2003).
\textsuperscript{47} See id.
\textsuperscript{49} See id.
\textsuperscript{50} See Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 677 (9th Cir. 2005) (noting that a district court must focus on whether the use of a mark is in connection with the sale of goods rather than whether the use was in commerce in cases of trademark infringement).
registered mark is found not to be in connection with the sale or advertising of goods or services, the use is not commercial, and is protected by the First Amendment - the cybergriper can continue using the registered mark in the domain name of a website critical of the mark holder.  

II. REVIEW OF CASE LAW IN WHICH “USE IN CONNECTION WITH” IS CONSIDERED

Prior to the Ninth Circuit Court of Appeals decision in Bosley, the Courts of Appeals for the Third, Fourth, Sixth and Eighth Circuits each considered what constitutes use of a mark in connection with sale, offering for sale, distribution, or advertising of goods or services in cybergripping cases. Further, District Courts in the Second Circuit have extensively considered the issue. This section reviews the various approaches to cybergripping cases taken by the various Circuit Courts of Appeal. Because the District Courts in the Second Circuit decided the earliest cases dealing with the use in connection with requirement of §§ 1114 and 1125(a), those cases will be discussed first.

1. Second Circuit Jurisprudence (Issue Considered by the District Courts Only)

In Planned Parenthood Federation of America, Inc. v. Bucci, the Unites States District Court for the Southern District of New York became one of the first federal courts to hear a trademark

51. See Taubman, 319 F.3d at 775-76.
52. See, e.g., Coca-Cola Co. v. Purdy, 382 F.3d 774 (8th Cir. 2004); Taubman Co. v. Webfeats, 319 F.3d 770 (6th Cir. 2003); PETA v. Doughney, 263 F.3d 359 (4th Cir. 2001); Jews for Jesus v. Brodsky, 159 F.3d 1351 (3d Cir. 1998).
54. See infra Part II.1-5.
infringement case against a cybergriper. In that case, an antiabortion activist registered the domain name “plannedparenthood.com” and subsequently set up a website antithetical to the plaintiff’s well-known reproductive views. The plaintiff, as owner of the “Planned Parenthood” mark and operator of its own website, www.ppfao.org, filed suit against the antiabortion activist alleging trademark infringement under, inter alia, §§ 1114, 1125(a) of the Lanham Act. The plaintiff ultimately sought to enjoin the activist from using the domain name plannedparenthood.com.

In granting the plaintiff’s request for a preliminary injunction, the court found that the defendant’s use of the mark satisfied § 1114’s requirement that the mark be used in connection with the distribution or advertising of goods or services for three reasons. First, the court gave much credence to the fact that Bucci’s website promoted the sale of an antiabortion book. Second, the court found it relevant that the website communicated that abortion was morally wrong. Most importantly, however, the court found that the defendant’s use of the plaintiff’s mark in a domain name was in connection with the distribution of services “because it is likely to prevent some Internet users from reaching the plaintiff’s own Internet web site.” In other words, the mere fact that “[p]rospective users of plaintiff’s services who mistakenly access defendant’s web site may fail to continue to search for plaintiff’s own home page, due to anger, frustration, or the belief that plaintiff’s home page does not exist” was sufficient for the court to find that the “use in connection with” requirement of § 1114 was satisfied.

57. See Planned Parenthood, 42 U.S.P.Q.2d at 1435.
58. Id.
59. Id.
60. Id.
61. Id.
62. Id.
63. Planned Parenthood, 42 U.S.P.Q.2d at 1435.
64. Id.
Consistent with its finding of § 1114’s “use in connection with” requirement, the court summarily rejected Bucci’s First Amendment defense.\textsuperscript{65} Following the precedent established by the Second Circuit in \textit{Yankee Publishing Incorporated v. News America Publishing Incorporated},\textsuperscript{66} Bucci argued that his use of the plaintiff’s mark was entitled to First Amendment protection because his use of the mark was part of a communicative message, and not as identification as to the source of the product.\textsuperscript{67} The court concluded otherwise, finding that “[by] using the mark as a domain name and home page address and by welcoming Internet users to the home page with the message ‘Welcome to the Planned Parenthood Webpage!’ defendant identifies the web site . . . as being the product . . . of plaintiff” and hence the defendant’s use of the mark was not part of a communicative message.\textsuperscript{68}

The United States District Court for the Western District of New York decided whether a cybergriper met the “use in connection with” requirement of § 1114 in \textit{OBH, Inc. v. Spotlight Magazine, Inc.}\textsuperscript{69} There, the plaintiff owned the registered trademark “The Buffalo News” and maintained a web site for its wholly owned subsidiary, The Buffalo News, at www.buffnews.com.\textsuperscript{70} The defendant registered the domain name “thebuffalonews.com” and created a website parodying The Buffalo News, which provided a public forum for criticism of the newspaper.\textsuperscript{71}

Following the pattern of the mark holder in \textit{Planned Parenthood}, the plaintiff sued the defendant cybergriper for trademark infringement in violation of the Lanham Act under, \textit{inter alia}, § 1114 and 1125(a).\textsuperscript{72} The plaintiffs sought and the court granted a preliminary injunction enjoining the defendants from using

\begin{itemize}
\item \textsuperscript{65} See \textit{id}.
\item \textsuperscript{66} Yankee Publ’g, Inc. v. News Am. Publ’g, Inc., 809 F. Supp. 267 (S.D.N.Y. 1992).
\item \textsuperscript{67} \textit{Planned Parenthood}, 42 U.S.P.Q.2d at 1435.
\item \textsuperscript{68} \textit{id}.
\item \textsuperscript{69} OBH Inc. v. Spotlight Magazine, Inc, 86 F. Supp. 2d 176 (W.D.N.Y. 2000).
\item \textsuperscript{70} \textit{id} at 181.
\item \textsuperscript{71} \textit{id} at 182-83.
\item \textsuperscript{72} \textit{id} at 184.
\end{itemize}
"thebuffalonews.com" domain name.\textsuperscript{73} In granting the preliminary injunction, the court cited \textit{Planned Parenthood} with approval, holding that the defendant used the mark "in connection with" goods or services because his website was "likely to prevent or hinder Internet users from accessing plaintiffs' services on plaintiffs' own web site."\textsuperscript{74} The court in \textit{OBH} also cited \textit{Planned Parenthood} with approval when it rejected the defendant's First Amendment defense.\textsuperscript{75}

2. \textit{Third Circuit Jurisprudence}

Shortly after \textit{Planned Parenthood} was decided, the United States District Court for New Jersey had the opportunity to determine what constitutes the "use in connection with" requirement under § 1114 in \textit{Jews for Jesus v. Brodsky}.\textsuperscript{76} In that case, the plaintiff, a nonprofit organization, owned the service mark "Jews for Jesus,"\textsuperscript{77} and maintained a website, www.jews-for-jesus.org.\textsuperscript{78} The defendant, Brodsky, a "vocal opponent" of the plaintiff's views,\textsuperscript{79} created the Internet site "jewsforjesus.org" critical of the plaintiff organization,\textsuperscript{80} and was subsequently sued by the plaintiff for trademark infringement.\textsuperscript{81}

The court ultimately found that Brodsky's use of Jews for Jesus's mark was in connection with goods or services under § 1125(a) and granted the plaintiff's request for a preliminary injunction against Brodsky's use of its mark.\textsuperscript{82} In so doing, the court primarily relied on the \textit{Planned Parenthood} court's rationale in determining that the similarity of the domain name used by Brodsky to Jews for Jesus' mark was "likely to, prevent some Internet users from reaching the

\textsuperscript{73} \textit{Id.}
\textsuperscript{74} \textit{OBH}, 86 F. Supp. 2d at 186.
\textsuperscript{75} \textit{Id.} at 197.
\textsuperscript{77} \textit{Id.} at 288.
\textsuperscript{78} \textit{Id.} at 290.
\textsuperscript{79} \textit{Id.}
\textsuperscript{80} \textit{Jews for Jesus}, 993 F. Supp. at 291.
\textsuperscript{81} \textit{Id.} at 287.
\textsuperscript{82} \textit{Id.} at 309-13.
Internet site of the Plaintiff Organization . . . [and] . . . [a]s such, . . . [Brodsky's] . . . conduct . . . [was] 'in connection with goods and services' . . . ."\textsuperscript{83} Notably, on appeal by Brodsky, the Third Circuit Court of Appeals endorsed the district court's reasoning by affirming its disposition of the case without an opinion.\textsuperscript{84}

3. Fourth Circuit Jurisprudence

The Fourth Circuit Court of Appeals considered what the "use in connection with requirement" under § 1114 and 1125(a) entails in trademark infringement suits against cybergripers when it decided \textit{PETA v. Doughney}.\textsuperscript{85} In that case, the plaintiff, the animal rights group People for the Ethical Treatment of Animals (PETA) sued Michael Doughney, operator of the website www.peta.org, for trademark infringement under § 1114 and for unfair competition under § 1125(a).\textsuperscript{86} PETA was the owner of the registered "PETA" mark.\textsuperscript{87} Doughney employed PETA's mark to maintain a website on behalf of the fictional group "People Eating Tasty Animals," an organization that served as "a resource for those who enjoyed eating meat, wearing fur and leather, hunting, and the fruits of scientific research."\textsuperscript{88} The defendant's website, like those at issue in the cases considered by the Second and Third Circuits, was completely antithetical to the plaintiff's views.\textsuperscript{89}

PETA sought to enjoin Doughney's use of its mark in his domain name, and initially won summary judgment on the issue by the district court.\textsuperscript{90} Doughney appealed, but the Fourth Circuit affirmed the lower court's finding that Doughney's use of the mark was in connection with goods or services as required under §§ 1114 and

\textsuperscript{83} \textit{Id.} at 309.
\textsuperscript{84} See Jews for Jesus v. Brodsky, 159 F.3d 1351 (3d Cir. 1998).
\textsuperscript{85} See \textit{PETA v. Doughney}, 263 F.3d 359, 359 (4th Cir. 2001).
\textsuperscript{86} \textit{Id.} at 362-63.
\textsuperscript{87} See \textit{id.} at 365.
\textsuperscript{88} \textit{Id.} at 363 (internal quotation marks omitted).
\textsuperscript{89} See generally \textit{id.} at 362 ("PETA 'is dedicated to promoting and heightening public awareness of animal protection issues and it opposes the exploitation of animals for food, clothing, entertainment and vivisection.'").
\textsuperscript{90} \textit{Id.} at 363-64.
1125(a). The Fourth Circuit noted that to use a mark in connection with goods or services, a defendant-cybergriper “need not have actually sold or advertised goods or services” on his website. Rather, the defendant-cybergriper “need only have prevented users from obtaining or using [the mark holder’s] goods or services, or need only have connected the website to others goods or services.” The former result was achieved, the court noted, by the mere possibility that Doughney’s use of PETA’s mark in the domain name of his website was “likely to prevent some Internet users from reaching [PETA’s] own Internet web site.” In coming to this conclusion, the court cited, and indeed relied on, the reasoning in both Planned Parenthood and OBH with approval, despite the fact that at the time PETA initially filed suit, it did not operate a website.

4. Eighth Circuit Jurisprudence

In 2004, the Court of Appeals for the Eighth Circuit decided Coca-Cola Co. v. Purdy. Although an Anti-Cybersquatting Protection Act case, the Eighth Circuit cited the Fourth Circuit’s rationale from PETA with respect to the “use in connection with” requirement for trademark infringement under the Lanham Act with approval in finding that the defendant was liable to the plaintiff for cybersquatting.

5. Sixth Circuit Jurisprudence

In deciding Taubman Co. v. Webfeats in 2003, the Court of Appeals for the Sixth Circuit declined to follow the precedent established by Planned Parenthood and its progeny by refusing to

91. See PETA, 263 F.3d at 365-66.
92. Id. at 365.
93. Id.
94. Id.
95. See id. (noting “the same reasoning [as in Planned Parenthood and OBH] applies here.”).
97. Coca-Cola Co., 382 F.3d 774.
98. Id. at 783, 787-88.
hold that the unauthorized use of a registered trademark in a domain
name alone is sufficient to meet the “use in connection with”
requirement under § 1114.99 In Taubman, the defendant, a
professional website designer, maintained an informational website
with a domain name consisting of the plaintiff’s registered
trademark.100 The plaintiff sued the defendant for trademark
infringement under the Lanham Act, and the district court
subsequently granted the plaintiff’s request for a preliminary
injunction.101 When the suit was initially brought, the defendant had
links on his website to his girlfriend’s T-shirt business and his own
website company.102

On appeal by the defendant, the Sixth Circuit reversed the grant of
preliminary injunction in favor of the plaintiff.103 The court reasoned
since the defendant had removed the hyperlinks to the commercial
businesses’ websites prior to the district court’s grant of the
preliminary injunction, he did not use his website in connection with
the advertising of goods and services in an ongoing manner, as
required for a preliminary injunction to be granted, and hence the
Lanham Act could not be properly invoked.104 Moreover, the court
expressly rejected the rationale used by Planned Parenthood and its
progeny by rejecting the plaintiff’s argument that “all cybergriping
cites are per se commercial and ‘in connection with the sale of
goods’.”105 In breaking with the precedent established by the other
Circuit Courts of Appeal, the court noted that the unpublished district
court decision in Planned Parenthood “is not binding on this
Court . . . .”106

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99. Taubman Co. v. Webfeats, 319 F.3d 770, 772 (6th Cir. 2003).
100. Id.
101. Id.
102. Id.
103. Id.
104. Id. at 775.
105. Taubman, 319 F.3d at 777.
106. Id.
III. NEW NINTH CIRCUIT JURISPRUDENCE—BOSLEY MEDICAL INSTITUTE V. KREMER

The 2005 Court of Appeals for the Ninth Circuit decision in Bosley Medical Institute v. Kremer protects the use of another’s trademark by a cybergriper. In that case, the defendant, Michael Kremer, was a dissatisfied user of the plaintiff’s hair restoration services. Due to his dissatisfaction, Kremer obtained the domain name bosleymedical.com, even though the plaintiff owned the registered trademark "Bosley Medical," and subsequently posted negative information about the plaintiff on his website. Kremer’s website did not link to any of the plaintiff’s competitors’ websites, nor did it offer any goods or services for sale. The website did, however, link to another complaint website owned by Kremer, which in turn linked to a chat room that contained advertisements of the plaintiff’s competitors’ products. In a now all too familiar pattern, and because of the precedent established in the Fourth Circuit in trademark infringement suits against cybergriper, the plaintiff mark holder subsequently sued Kremer for trademark infringement.

The district court held that Kremer’s use of the plaintiff’s mark was noncommercial, and entered summary judgment in favor of Kremer on the trademark infringement claims. The plaintiff appealed, and argued that Kremer’s use of its trademark was commercial in three ways. First, the plaintiff argued that because Kremer’s website contained hyperlinks to other commercial sites, his use was commercial. The court rejected this argument, basing its

107. See generally Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005).
108. Id. at 675.
109. Id. at 674-5.
110. Id. at 675.
111. Id.
112. See id. at 678 (noting that the plaintiff argued that Kremer’s use of its mark met the commercial use requirement because of the rationale employed in PETA).
113. Bosley, 403 F.3d at 674-75.
114. Id. at 675.
115. Id. at 677.
116. Id.
finding on the fact that the website at issue did not hyperlink to a site replete with advertisements, rather it hyperlinked to a site that hyperlinked to a site with advertisements. 117 This “second degree” hyperlinking was “too attenuated to render Kremer’s site commercial.” 118 For its second argument as to the commerciality of Kremer’s use, the plaintiff alleged that Kremer offered to sell it the BosleyMedical.com domain name. 119 Although the Ninth Circuit had previously held that a defendant’s commercial use was his attempt to sell the trademarks themselves, 120 the court rejected this argument because “there was no evidence that Kremer was trying to sell the domain name . . . .” 121

The plaintiff’s third and final argument as to the commercial use requirement was essentially the rationale that the Planned Parenthood line of cases relied upon to find cybergrippers liable for trademark infringement, stating that “Kremer used the mark ‘in connection with goods and services’ because he prevented users from obtaining the plaintiff’s goods and services.” 122 The court rejected this argument and held that the noncommercial use of a trademark as the domain name of a website that provides consumer commentary about the products and services represented by the mark does not constitute infringement under the Lanham Act. 123

Further, the court articulated its own test for determining whether the unauthorized use of a trademark constitutes a use in connection with goods or services—it noted “the appropriate inquiry is whether Kremer offer[ed] competing services to the public.” 124 The court concluded that because Kremer was the plaintiff’s critic, not its competitor, his use of the plaintiff’s mark was not in connection with a sale of goods or services. 125 Instead, Kremer’s use of the plaintiff’s

117. Id. at 677-78.
118. Bosley, 403 F.3d at 678.
119. Id.
120. See Panavision Int’l, L.P. v. Toeppen, 141 F.3d 1316, 1325 (9th Cir. 1998).
121. Bosley, 403 F.3d at 678.
122. Id. at 678.
123. Id. at 679.
124. Id. (emphasis in original).
125. Id.
mark was “in connection with the expression of his opinion about [the plaintiff’s] goods and services.”¹²⁶ The court concluded its discussion of the issue by noting that the Lanham Act does not prohibit this type of unauthorized use of a trademark. The plaintiff, the court said, could not “use the Lanham Act either as a shield from Kremer’s criticism, or as a sword to shut Kremer up.”¹²⁷

IV. THE CIRCUIT SPLIT WIDENS

A. Bosley Explicitly Disparages the Fourth Circuit’s Approach

In deciding Bosley, the Ninth Circuit was cognizant that its holding was contrary to Planned Parenthood and its progeny.¹²⁸ Specifically, the Ninth Circuit explicitly disparaged the Fourth Circuit’s approach in PETA when it noted that “[t]o the extent that the PETA court held that the Lanham Act’s commercial use requirement [was] satisfied because the defendant’s use of the plaintiff’s mark as the domain name may deter customers from reaching the plaintiff’s site itself, we respectfully disagree with that rationale.”¹²⁹ Moreover, the court was careful to explain why the Fourth Circuit’s approach in PETA was incorrect by stating that “[t]he PETA approach would place most critical, otherwise protected consumer commentary under the restrictions of the Lanham Act . . . [and] would encompass almost all uses of a registered trademark, even when the mark is merely being used to identify the object of consumer criticism.”¹³⁰ The court went on to explain that the PETA court’s broad view of the Lanham Act was not supported by the Act’s text or the history of trademark law in the United States.¹³¹

¹²⁶ Id. (emphasis in original).
¹²⁷ Bosley, 403 F.3d at 680.
¹²⁸ Id. at 679.
¹²⁹ Id.
¹³⁰ Id.
¹³¹ Id.
B. *The Fourth Circuit Sticks to Its Guns in Lamparello v. Falwell*

If the Ninth Circuit’s express disparagement of the Fourth Circuit’s approach to cybergrippers does not indicate the presence of a circuit split, the Fourth Circuit’s acknowledgement of the Ninth and Sixth Circuits’ contrary position in *Lamparello v. Falwell* certainly does. The plaintiff, the Reverend Jerry Falwell, was the holder of the “Falwell” common law mark. The cybergriper, Christopher Lamparello, registered the domain name www.fallwell.com after hearing Reverend Falwell express his views about homosexuality, and created a website at that domain name that contained criticisms of Falwell’s views. In a new twist, Lamparello filed suit against Falwell, seeking a declaratory judgment of noninfringement. Falwell counterclaimed, alleging trademark infringement under, *inter alia*, § 1114 and § 1125(a). “The district court entered summary judgment to...Falwell, enjoined Lamparello from using Falwell’s mark at www.fallwell.com, and required Lamparello to transfer the domain name to...Falwell.” Lamparello subsequently appealed the district court’s ruling to the Fourth Circuit.

The Fourth Circuit ultimately reversed the district court’s judgment because the there was “no likelihood of confusion” caused by Lamparello’s use of the mark. Although the resolution of the case did not rest on whether Lamparello’s use of Falwell’s mark was in connection with the sale of goods or services, the court acknowledged its view that perhaps the Lanham Act does not apply only to commercial speech. The court acknowledged that both the Sixth and Ninth Circuits held that trademark infringement under the Lanham Act can only apply to commercial speech, but explained that courts have been reluctant to define “in connection with [] goods or

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133. *Id.* at 311.
134. *Id.*
135. *Id.* at 312.
136. *Id.*
137. *Id.*
138. Lamparello, 420 F.3d at 312.
139. *Id.* at 314.
140. See *id.*
services” narrowly.\textsuperscript{141} Indeed, the court noted that it did not define that term narrowly in its own jurisprudence and cited PETA as support for that proposition.\textsuperscript{142} The court’s citation of PETA indicated that it was not backing down from its earlier determination that merely dissuading visitor’s to a cybergriping website from visiting the mark holders website constitutes “use in connection with the sale of goods or services.”\textsuperscript{143} However, the court ultimately decided that it did not need to resolve what constitutes commercial speech under the Lanham Act in this case.\textsuperscript{144}

C. Bosley’s Rationale Makes the Existence of a Circuit Split More Certain Because Taubman’s Facts Are Distinguishable From PETA’s Facts, Bosley’s Are Not

Prior to the resolution of Bosley, only the Sixth Circuit had disagreed with the Planned Parenthood line of cases.\textsuperscript{145} Moreover, some commentators think that Taubman can be distinguished from PETA and the Planned Parenthood line of cases because it did not involve cybergriping.\textsuperscript{146} The defendant’s website at issue in Taubman was characterized as a “fan site” by the defendant himself,\textsuperscript{147} and rather than criticize the plaintiff, the website provided information about the plaintiff’s mark.\textsuperscript{148} Commentators believe that the Sixth Circuit’s holding that declined to find the defendant liable for trademark infringement was largely due to the fact that the unauthorized use of the mark in the domain name resulted in a website that was friendly to the mark holder.\textsuperscript{149}

No such distinction can be made between Bosley and the Planned Parenthood line of cases.\textsuperscript{150} A simple comparison of Bosley and

\begin{itemize}
  \item Id.
  \item Id.
  \item Id. (internal quotation marks omitted).
  \item See Lamparello, 420 F.3d at 314.
  \item See generally Taubman Co. v. Webfeats, 319 F.3d 770 (6th Cir. 2003).
  \item See Lefcourt, supra note 25, at 285.
  \item Taubman, 319 F.3d at 772.
  \item Id.
  \item See Lefcourt, supra note 25, at 285.
  \item Compare Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005), with PETA v. Doughney, 263 F.3d 359 (4th Cir. 2001).
\end{itemize}
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PETA, for example, shows that both cases involve cybergripping—the defendant in Bosley used his website to complain about the plaintiff's hair restoration products, and the defendant in PETA used his website to mock the plaintiff organization's views.\(^{151}\) Thus, on similar facts, the Ninth and Fourth Circuit, respectively, came to opposite conclusions regarding whether the defendant cybergriper used the plaintiff's mark in connection with goods or services.\(^{152}\)

V. WHICH CIRCUIT'S APPROACH IS BETTER?

A. Bosley's Conception of the Internet and its Users is More Accurate

1. Competing Visions of the Internet

The capacity of the Internet to serve as an international exchange of ideas is one of its greatest virtues.\(^{153}\) Indeed, "[t]he Internet has provide[d] an unprecedented opportunity for individuals to disseminate information widely at a very low cost."\(^{154}\) This vision of the Internet as a free marketplace of ideas has "collided with a competing vision of the Internet as an enormous shopping mall... ."\(^{155}\) Under this view, the principle purpose of the World Wide Web is to serve as a commercial marketplace.\(^{156}\)

The decision in Bosley is superior to the Fourth Circuit's approach to these cases because it supports both the concept of the Internet as a free marketplace of ideas and the concept of the Internet as a commercial marketplace.\(^{157}\) On the one hand, the Ninth Circuit allowed the defendant to continue his use of the plaintiff's trademark

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151. See Bosley, 402 F.3d at 675; PETA, 263 F.3d at 363.
152. Compare Bosley, 402 F.3d 672 with PETA, 263 F.3d 359.
155. Travis, supra note 32, ¶ 3.
156. Brief for the Appellee at 40-41, Bosley Medical Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962).
157. See Bosley, 403 F.3d at 679 (holding that defendant's use of plaintiff's trademark was permissible because the use merely expressed an opinion about the plaintiff's services).
in the domain name of his website because his use was "in connection with the expression of his opinion about [plaintiff's] goods and services." Specifically, by stating that it did not wish to place "most critical, otherwise protected consumer commentary under the restrictions of the Lanham Act," the court implicitly recognized the importance of the Internet as a forum in which a wide range of information about a company must be available. On the other hand, by articulating a test for determining whether the unauthorized use of a trademark constitutes a use in connection with goods or services that hinged on "whether [the accused infringer] offers competing services to the public," the Bosley court recognized that the Internet could indeed be viewed as a commercial marketplace where corporations offer competing services or products to Internet users.

The Planned Parenthood line of cases, by contrast, supports only the concept of the Internet as a commercial marketplace because cybergriper infringement liability in those cases rests on the notion that visitors to the cybergriper's website want to partake of the mark holder's own goods or services on the mark holder's website. Inherent to the concept of the Internet as a shopping mall is the idea that Internet users search the web solely to find vendors of goods. In this framework, the "rule that only the owner of the trademark could use that mark as the domain name to denominate its website might be sensible." Under this model, the typical Internet user is always trying to buy something when online, and in the case in which a corporation "register[s] [its] competitor's name on the Internet, so

158. *Id.* (omission of emphasis).
159. *Id.*
161. *Bosley*, 403 F.3d at 679 (emphasis in original).
162. *See Travis, supra* note 32, ¶ 3. The Ninth Circuit was essentially acknowledging that the Internet could be a "huge shopping mall" but that is not its only function. *See* Ronnie Cohen & Janine S. Hiller, *Towards a Theory of Cyberspace: A Proposal for a New Legal Framework*, 10 RICH. J.L. & TECH. 2, ¶ 57 (2003) (arguing that because of the many types of activities that take place on the Internet, "[n]o one metaphor, or legal parallel, will reflect the myriad nature of this Internet.").
164. Brief for the Appellee at 40-41, Bosley Medical Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962).
165. *Id.* at 41.
that potential customers who enter that name will arrive at [its] site instead, [the corporation is] clearly creating confusion in an attempt to profit commercially.”¹⁶⁶ In other words, all of the elements of traditional trademark infringement could be met under this concept of the Internet.¹⁶⁷

2. The Concept of the Internet as Only a Commercial Marketplace is Flawed

The concept of the Internet as both a free marketplace of ideas and a commercial marketplace supported by Bosley is more accurate than the concept of the Internet as only a commercial marketplace for two reasons.¹⁶⁸ First, the model of the Internet as a commercial marketplace ignores the fact only one third of websites are run by business—that is, most websites are informational in nature.¹⁶⁹ To be sure, the growth of electronic commerce on the Internet since its inception has been explosive,¹⁷⁰ making it necessary for companies to have a website “to provide information, communication, goods, or services online” in order to stay viable.¹⁷¹ However, corporate websites make up only a small minority of all websites on the Internet.¹⁷² As one commentator put it: “The Internet is a mixed commercial, public, and social infrastructure.”¹⁷³ The conception of the Internet as only commercial marketplace does not take into account other types of websites present on the Internet—sites like

¹⁶⁸. See, e.g., Oscar S. Cisneros, Note, Bally Total Fitness Holding Co. v. Faber, 15 BERKLEY TECH. L.J. 229 (2000); Brief for the Appellee, Bosley Medical Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962).
¹⁷⁰. See Xuan-Thao N. Nguyen & Jeffrey A. Main, Taxing the New Intellectual Property Right, 56 HASTINGS L.J. 1, 4 (2004).
¹⁷¹. Id. at 6.
¹⁷². See Kelly, supra note 169.
web-logs (blogs), chat-rooms, and personal web-pages, for example, all of which can be non-commercial websites.

Second, and closely related to the idea that only a small fraction of Internet websites are commercial in nature, is the idea that Internet users surf the Internet for a variety of reasons. One study revealed that in the United States, only 44.5% of online users engage in commercial transactions. Indeed, "[c]onsumers use the Internet to exchange information, communicate, and conduct business." Additionally, the fact that "speech on the Internet ranges over every possible subject and mode of expression, including the serious, the frivolous, the gossipy, the erotic, the scatological, and the profound" supports the notion that the Internet cannot be viewed solely as a commercial marketplace. Consumers are not using the Internet merely to purchase goods.

Thus, the rationale in the Planned Parenthood line of cases finding that the "use in connection requirement" is met because a visitor to the cybergripping website may be deterred from visiting the mark holder's own website and thereby prevented from obtaining the mark holder's goods or services is flawed. It rests on an inaccurate conception of the Internet as only a commercial marketplace.

177. See Frischmann, supra note 173, at 1018 (noting that websites such as blogs, chat-rooms, and personal webpages contain "noncommercial, speech-oriented information.").
178. Nguyen & Main, supra note 170, at 6 ("Consumers use the Internet to exchange information, communicate, and conduct business.").
180. Nguyen & Main, supra note 170, at 6.
182. Id. at 23 (noting that the public is using the Internet "for public communication, debate, gossip, and every possible form of exchange of information.").
184. See infra Part V.A.1.
There is simply no empirical foundation for the claim that the public views the Internet as a place solely to obtain goods and services from vendors. In fact, one study revealed just the opposite—the public views the Internet as library, or source of information.\textsuperscript{185} Moreover, the \textit{Planned Parenthood} rationale completely disregards the possibility that a visitor to a cybergripping website may have gone to that site for the express purpose of debating some issue, commenting on the product or corporation, engaging in other political or non-political discourse, researching the product or corporation, learning about the product or corporation, or even educating others about the product or corporation.\textsuperscript{186} There is therefore no reason to assume that the typical Internet user is only trying to buy something when online; he is likely trying to do a host of other things.\textsuperscript{187} The Ninth Circuit’s decision in \textit{Bosley} fully recognizes this possibility by allowing uses of trademarks in Internet domain names when such use is “in connection with the \textit{expression of [an] opinion} about [a markholder’s] goods and services,”\textsuperscript{188} while also recognizing the possibility that Internet users sometimes buy goods and services over the Internet.\textsuperscript{189}

3. \textit{Commercial Marketplaces Require Competition}

The Ninth Circuit’s acknowledgement that the Internet functions as both a commercial marketplace and a marketplace of ideas is superior to the Fourth Circuit’s flawed conception of the Internet as a simple commercial marketplace for yet another reason.\textsuperscript{190} In any

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\item \textsuperscript{185} \textit{See} http://www.markle.org/downloadable_assets/accountabilitychl.pdf, at 20-25 (last visited Oct. 21, 2005).
\item \textsuperscript{186} \textit{See} Frischmann, \textit{supra} note 173, at 1017 (noting that these are all reasons for surfing the Internet).
\item \textsuperscript{187} \textit{See} Brief for the Appellee at 41, Bosley Medical Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962).
\item \textsuperscript{188} \textit{Bosley}, 403 F.3d at 679 (emphasis added).
\item \textsuperscript{189} \textit{See id.} (recognizing that some corporations use their competitors trademarks in domain names to try to compete with the competitor-markholder for sales).
\item \textsuperscript{190} \textit{See} Andrea M. Matwyshyn, \textit{Of Nodes and Power Laws: A Network Theory Approach to Internet Jurisdiction Through Data Privacy}, 98 NW. U.L. REV. 493 (2004). Prof. Matwyshyn notes: It is impossible in many instances to ferret out the commercial and noncommercial aspects of Internet communications. Personal websites of individuals are interspersed among websites proposing bilateral commercial transactions and websites with
competitive marketplace, lively debate about a corporation’s products and services provides an economic incentive for that corporation to provide quality goods or services that ultimately creates goodwill in its mark.\textsuperscript{191} If corporate America quashed websites critical of its goods and services, this incentive would be lessened.\textsuperscript{192} Moreover, the chance of trademarks serving as instruments of misinformation and consumer fraud, as opposed to sources of reliable information, would increase.\textsuperscript{193} In a sense, cybergripping websites can “serve as a ‘watchdog’ in the industry, which will encourage the industry as a whole to provide better service to customers.”\textsuperscript{194} Thus, even mark holders favoring the Internet as a commercial marketplace benefit from a variety of websites that are both complimentary and critical of it.\textsuperscript{195} It necessarily follows that any decision resting only on a conception of the Internet as a commercial marketplace is flawed because the most effective competitive markets create an environment in which ideas compete, and the truth prevails.\textsuperscript{196}

In other words, in order to create an efficient commercial marketplace on the Internet, one has to acknowledge that the Internet is also a marketplace of ideas where ideas compete.\textsuperscript{197} Under this rubric, even false information about a corporation on a cybergripping website would be beneficial to the commercial marketplace because consumers would be well informed.\textsuperscript{198} If a consumer were limited to viewing a corporation’s own advertisements about itself on the Web, he would not be able to make an informed decision about whether or not to purchase the corporation’s goods or services, creating an inefficient commercial marketplace.\textsuperscript{199}

\begin{quote}
interactive functions for groups such as bulletin boards and chatrooms, all of which may end up serving as a basis for both commercial and noncommercial exchanges.
\end{quote}

\textit{Id.} at 504.

191. See Cisneros, supra note 168, at 239.
192. See id.
193. See Travis, supra note 32, § 113.
195. See id.
197. See id.; see also Cohen & Hiller, supra note 162.
198. See Kelley, supra note 29, at 379.
199. See generally id.
By holding that the noncommercial use of a trademark as the domain name in a cybergripping website does not constitute infringement under the Lanham Act and permitting cybergripping websites to exist, the Bosley court’s decision not only spurs corporations to provide quality goods and services, it also allows consumers to be well informed. The Planned Parenthood line of cases, by contrast, does neither. The rationale in those cases permits a mark holder to “prevent others from using a mark to criticize or make fun of a company.” Indeed, the very fact that trademark infringement suits against cybergripers who do not use the mark in connection with the sale of goods may be successful in the Second, Third, and Fourth Circuits “may have a chilling effect on speech that happens to involve trademarks” that would result in both a less competitive market and less informed consumers. Neither the conception of the Internet as a commercial marketplace nor the conception of the Internet as a marketplace of ideas is furthered by this result.

B. Reigning in the Overbroad Application of Trademark Law

Not only does the Bosley court’s decision rest on a more accurate vision of the Internet, this aspect of the Ninth Circuit’s decision has the salutary effect of preventing the court from stretching trademark law beyond its traditional purposes. This section first reviews the general theory of overbroad application of trademark law, and then shows how the Bosley court’s conception of the Internet prevents such an overbroad application.

200. Bosley Medical Inst. v. Kremer, 403 F.3d 672, 679 (9th Cir. 2005).
201. See generally Cisneros, supra note 168, at 239; Kelley, supra note 29 at 379.
203. Lemley, supra note 166, at 1712.
204. Id.
205. See generally Cisneros, supra note 168; Kelley, supra note 29.
206. See generally Cisneros, supra note 168; Kelley, supra note 29.
207. See supra Part V.A.
208. See infra Part V.B.
209. See infra Part V.B.1.
210. See infra Part V.B.2.
1. Background: The General Theory of Overbroad Trademark Law

Critics of modern trademark law often decry the fact that courts are extending the Lanham Act to “suppress social, political, or artistic speech that happens to include the trademark.”\textsuperscript{211} This overbroad application of trademark law leads to findings of infringement even when the unauthorized use of a trademark does not confuse the consuming public or destroy the trademark holder’s incentive to invest in product quality.\textsuperscript{212} In other words, courts are systematically ignoring the traditional justifications for the application of trademark law in favor of protecting trademark rights.\textsuperscript{213}

This expansive application of trademark law is especially troubling because trademark law traditionally balances free speech interests by protecting only against the misuse of trademarks that leads to mistaken purchasing decisions, not against general confusion.\textsuperscript{214} Moreover, because trademarks are often the most effective way to invoke the image of their owners, they are a vital part of the public vocabulary.\textsuperscript{215} Thus, as many leading commentators suggest, “[r]ules restricting the use of well-known trademarks may . . . restrict the communication of ideas.”\textsuperscript{216} In these scenarios, when a parody or criticism incorporating the unauthorized use of a mark has no commercial intent related to the misuse of the mark, First Amendment concerns must disallow claims of infringement.\textsuperscript{217}

\textsuperscript{211} Lemley, supra note 166, at 1713.
\textsuperscript{212} Id.
\textsuperscript{213} Travis, supra note 32, ¶ 12.
\textsuperscript{216} Id. at 196.
2. Bosley Refuses to Detach Trademark Law From Its Traditional Moorings

The result in Bosley represents a growing awareness that overbroad application of trademark law at the expense of First Amendment concerns is not supported by “the history of trademark laws in this country.”218 By refusing to read the Lanham Act to “encompass almost all uses of a registered trademark, even when the mark is merely being used to identify the object of consumer criticism,”219 the court recognized the idea that the Lanham Act “does not prohibit all unauthorized uses of a trademark.”220 This result is correct because the defendant in Bosley was “not [plaintiff’s] competitor[,] he [was] their critic.”221 Accordingly, no consumer confusion could result from visiting the defendant’s site because he was offering no goods for sale, and the traditional justification for trademark protection did not exist.222 Importantly, if the Bosley court had viewed the Internet solely as a commercial marketplace, the court could have found consumer confusion existed, because on this view of the Internet, Internet users search the web solely to find vendors of goods.223 The consuming public would thus likely be confused because it would buy whatever product it was searching for from someone other than the mark holder.224 Furthermore, the conception of the Internet as only a commercial marketplace does not leave room for the possibility that the Internet is an informational resource, so it would not matter under this rubric that Kremer was Bosley’s critic; all uses of a trademark on the Internet would be proscribed by the Lanham Act.225

Moreover, the test articulated by the Ninth Circuit determines whether the unauthorized use of the trademark constitutes

218. Bosley Medical Inst. v. Kremer, 403 F.3d 672, 679 (9th Cir. 2005).
219. Id.
220. Id.
221. Id.
222. Id. at 679-80.
223. See Brief for the Appellee at 40-41, Bosley Medical Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962).
224. See supra Part V.A.
225. See supra Part V.A.
commercial speech entitled to lesser First Amendment protections by focusing on whether the use proposes a commercial transaction. In the concept of the Internet as only a commercial marketplace, this inquiry would be meaningless, as all uses of the mark on the Internet would propose a commercial transaction. The Planned Parenthood line of cases presumes commercial speech by holding that “potential harm to a commercial entity renders the offending conduct commercial.” Under this view, and consistent with the Internet as a commercial marketplace, all negative product review is commercial, regardless of free speech concerns. By rejecting this view, the Ninth Circuit has ensured that First Amendment concerns are not trampled on by overbroad application of trademark law—if and only if the unauthorized use of the mark constitutes commercial speech, the Lanham Act may constitutionally proscribe it. If, on the other hand, the unauthorized use of the mark constitutes consumer commentary, the First Amendment protects it. This result is consistent with the traditional trademark law rationale of only protecting against uses of a mark that may confuse consumers who are trying to engage in commercial transactions, and with the view of the Internet as both a marketplace of ideas and a commercial marketplace. Only the concept of the Internet as a marketplace of ideas even admits to the possibility that consumers use the Internet for commercial commentary.

227. See supra Part V.A.
229. See id.
231. See id. (noting when “trademark laws are used to proscribe uses of trademarks in noncommercial speech, free speech implications rise in importance”).
232. See Brief Amici Curiae of Intellectual Property Law Faculty in Support of Affirmance at 6, Bosley Med. Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005) (No. 04-55962) (“Under the Lanham Act’s infringement provision, confusion with the plaintiff’s mark must arise in a commercial context to be actionable.”).
233. See supra Part V.A.
CONCLUSION

The Ninth Circuit, in deciding *Bosley Medical Institute v. Kremer*, widened the circuit split between the Courts of Appeals concerning what behavior by a cybergriper satisfies the “use in connection with” requirement of traditional trademark infringement.\(^{234}\) As a result, depending on their jurisdiction, cybergrippers may or may not be liable for traditional trademark infringement when they use a trademark in the domain name of a website that is critical of a trademark holder’s goods or services, but does not offer any goods or services for sale.\(^{235}\)

The Ninth Circuit’s resolution of *Bosley* is superior to the method employed by the other Circuit Courts of Appeal for two reasons.\(^{236}\) First, the Ninth Circuit’s disposition of *Bosley* is founded on a more accurate representation of the Internet than the cybergripping case law in the Second, Third, and Fourth Circuits.\(^{237}\) Second, because the Ninth Circuit embraced a more accurate representation of the Internet, it has ensured that these cases do not stretch trademark law past its traditional purposes.\(^{238}\) Thus, the *Bosley* approach benefits both corporate mark holders and consumers.\(^{239}\) For these reasons, the Ninth Circuit reached the correct result when it decided *Bosley*.

Anita Bhushan

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\(^{234}\) *See supra* Part IV.
\(^{235}\) *See supra* Part III – IV.
\(^{236}\) *See supra* Part V.
\(^{237}\) *See supra* Part V.A.
\(^{238}\) *See supra* Part V.B.
\(^{239}\) *Id.*