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TVEyes and the Future of Technotainment

By Scott J. Sholder

I. Introduction

Several months have passed since the Second Circuit handed down its decision in *Fox News Network, LLC v. TVEyes, Inc.*,[1] and the various stakeholders are undoubtedly settling into the new reality concerning the boundaries of fair use. The court confirmed in *TVEyes* that its earlier decision in *Authors Guild v. Google, Inc.*[2] set the outer limits of fair use when it comes to duplication of copyright-protected materials for indexing and searching purposes. Whether it is seen as a victory or a setback, *TVEyes* represents the current state of the law in one of the most copyright-intensive jurisdictions in the country (encompassing the seat of the media and publishing industries).[3]

With the recent explosion in the availability of digital content, including photographs, movies, television, short-form videos and clips, music, and games, and the proliferation of new platforms and technologies for the use, exploitation, and sharing of such content, the potential impact of *TVEyes* is substantial.

II. A Quick Recap: Previously on *TVEyes*…

This article will explore some of the broader practical implications of the Second Circuit's *TVEyes* decision. First, however, a brief summary of the facts is in order.

TVEyes—a for-profit media/technology company—offered a fee-based service that allowed clients to "sort through vast quantities of television content to find clips that discuss items of interest to them" by way of, among other functions, search, archive, and watch features.[4] A judge in the Southern District of New York held that these functions constituted fair use of the plaintiff's programs,[5] but on appeal (which concerned the watch, downloading, archiving, and sharing functions but not the searching/indexing feature), the Second Circuit disagreed. The court of appeals noted that while TVEyes' copying of content and its provision of a "watch" service could be considered at least somewhat "transformative" under the first fair use factor,[6] the transformative character did not outweigh the fourth fair use factor—the impact on the market and potential market for the copyrighted works.

Specifically, the court found that TVEyes "essentially republishe[d] [copyrighted] content unaltered from its original form"[7] on a commercial basis and "undercut[] Fox's ability to profit from licensing searchable access to its copyrighted content to third parties."[8] Consumers clearly were willing to pay for a service that aggregated, indexed, and provided a searchable database of creative content. TVEyes therefore "deprive[d] Fox of revenue that properly belongs to the copyright holder," exceeding the boundaries set by *Authors Guild*.[9] Despite recent case law holding that transformative use is the most important fair use factor, the *TVEyes* court seemed to return to the earlier view that market harm is "the single most important element."

III. I'll Take Door Number Four: The Significance of the Court's Focus on Market Harm

Potential market harm, in the form of lost licensing opportunities, is the most relevant effect of services like TVEyes, not just legally but from a real-world standpoint in a modern digital environment full of content that can be indexed, searched, and consumed in a variety of ways. The strategic approach that Fox News took in the case—not appealing the district court's fair use ruling on TVEyes' indexing and searching functions, likely because they are fair uses under *Authors Guild*—may, at least tacitly, have opened a door to an *Authors Guild*-style exception for the indexing and searching of all sorts of media while, at the same time, limiting what else can be done without a license.

The dividing line, at least for the time being, is clear: third parties (i.e., technologists) can offer only limited utilitarian organizational functions vis-à- vis content they do not own, whereas content owners are, of course, free to do much more. TVEyes clearly knew that those two buckets of rights would be far more useful (and profitable) if combined. Now the question is whether coders and copyright holders can work together, above board, and still turn a profit.

A. DIY Network: Content Owner Internal Development

In the current digital environment, copyright owners will want to offer convenience and customizability for audiences looking for ways to sift through the endless amount of content available online. Content owners like Fox News, record labels with vast catalogues of digital master sound recordings, digital image libraries, and video game developers can develop indexing and searching tools as well as functionalities like sharing and downloading and charge a fee based on the value of their content and that of the services offered. *TVEyes* preserved for copyright owners the market opportunity to act as one-stop shops.

The photography and digital image licensing industry is a model of this marriage of content and technology. Aggregators of video footage, film clips, photographs, and

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other visual imagery such as Getty Images, Shutterstock, and Corbis, invested millions of dollars in the last decade digitizing and indexing their licensed content to be easily searchable, accessible, and available on-demand.[10] Their content is paid for through licensing arrangements with content owners and is offered to users for fees that vary based on the type of content and the type of license available, with royalties shared with contributors. In 2015 the market for licensing audiovisual content was valued at $550 million globally for video footage alone.[11] A ruling in favor of TVEyes in connection with its "watch" function and associated features would have endangered this established—and steadily growing—business model.

But this solution may not work for everyone. This is where teamwork comes in handy.

B. "We will add your biological and technological distinctiveness to our own": Tech/Content Synergies[12]

Internal technology development is not the only way to harness the power of search. *TVEyes* leaves the door open for synergy and partnerships between content companies and technology developers. Indeed, this arrangement seems far more likely; tech companies do not necessarily want to deal in content, and content companies do not necessarily want to deal in tech. The logical answer is for these players to work together to create market opportunities for profitable and desirable technology-driven content, which is just what the *TVEyes* court's focus on market impact allows for.

The court's holding that TVEyes' non-search functionalities supplanted the market for licensed content forces the historically opposed tech and creative industries closer together. A tag-team approach, while encouraged by *TVEyes*, is not a new concept. Indeed, the district court noted that Fox News already licensed its video clips through a clip-licensing agent called ITN Source, Ltd. that "maintains a library of over 80,000 Fox News video clips which its customers can search using keywords" and that earned Fox News approximately $2 million in licensing fees.[13]

This type of business model makes sense: choosing the type of content that is most appropriate for a particular function or audience and pulling that content in with permission of the content owners for the mutual benefit of all. It is a far more nuanced approach than the cavalier strategy of pulling in all content in a specific medium without a license and hoping for the best in a fair-use gunfight. Indeed, this type of arrangement could have resulted had TVEyes partnered with Fox News, thereby making TVEyes even more viable.

As discussed below, the melding of tech and content through legally sound licensing arrangements and cooperation between content owners and aggregators, on the one hand, and technology and software developers, on the other hand, appears to be the future that *TVEyes* predicted.

IV. Role Models: Developments in Content-Based Technology

A few recent developments demonstrate the business possibilities in the post-*TVEyes* world of technology-content fusion. While there are surely many other examples out there, the proliferation of artificial intelligence (AI) and user-generated content (UGC) apps incorporating existing creative materials provide solid examples of where the technotainment world may be headed.

> *"We routinely consult with Alexa, Google, and Siri, and commentators have observed that these and other types of AI will likely have very real effects on our consumption of content in the near future, especially when it comes to TV and movies."*

A. "I am feeling much better now":[14] HAL 9000 Is in Control of Your TV

Tech giants like Amazon, Google, and Apple are at the forefront of the AI movement. We routinely consult with Alexa, Google, and Siri, and commentators have observed that these and other types of AI will likely have very real effects on our consumption of content in the near future, especially when it comes to TV and movies.[15] In a column for *Deadline*, Arvin Patel, the chief intellectual property officer at TiVo and former chief IPO officer at Technicolor, made several predictions that are fully compatible, from a business, technological, and historical standpoint, with the legal direction in which the *TVEyes* decision is steering entertainment and media.

First, he predicted that AI "will eliminate the need for traditional programming guides and DVRs by pushing content to the appropriate output device at the perfect time for consumption."[16] This remarkable technology will also be able to predict what you want to watch and will recommend new content based on historical viewing habits and the preferences of social media connections.[17]

Patel's second salient prediction is that AI "will be able to automatically compile user-generated content and content from other sources to create new streams of content that take[] personalization to a new level. In the future, AI will make it possible to create real-time, custom-curated streams of content that are tailored just for you."[18]

Without the ability to intelligently compile, index, and search, as well as copy, distribute, share, record, and store this carefully collated material, the TV-based AI of the future would either falter or become fodder for expensive lawsuits. Patel's vision of the future of individualized content delivery requires cooperation between technology and content and is a natural extension of *TVEyes'* preservation of market opportunities for copyright owners.

B. "I'm ready for my close-up":[19] Musical.ly and the Ever-Growing UGC Movement

Another area ripe for the synergies set in motion by *TVEyes* is UGC, especially in the smartphone app space. Take musical.ly (which was just recently rebranded as Tik Tok, but for purposes of this article, will be referred to by its prior moniker). Touting itself as "a global video community" that "make[s] it easy for you to . . . make your own short videos . . . that you can share with the world," musical.ly allows users to "[a]dd your favorite music or sound to your videos for free."[20] The app allows users to edit their videos using "free music clips and sounds" from "the hottest tracks in every genre" and even "create[s] featured music playlists for you."[21] And, of course, the music database in the app itself is indexed and searchable.

Musical.ly has already been around for a couple of years, and it claims to have reached 200 million users and half of American teenagers as of April 2017.[22] But, presumably because of its license agreements with major record labels,[23] users of this hugely successful app can do far more than search through a static music database. Along with adding music to their homemade video clips, users can edit their clips, livestream,[24] and share their videos including the incorporated music clips.[25]

A 2017 partnership with Apple Music took the integration to an even higher level, allowing Musical.ly users to stream full-length songs (as opposed to 15-second clips) from Apple Music's catalog "directly within the Musical.ly app, with the further option to save particular songs to their own playlists within Apple Music and access Musical.ly-branded playlists via the streaming service as well."[26] The users' videos, themselves, are still limited to clip-based usage, but users with Apple Music subscriptions will have access to "any 15-second section from [any] full-length track [on Apple Music] within the app with which to create their videos."[27]

Ever-growing platforms like Musical.ly represent the future of the mobile app entertainment space. While Musical.ly pre-dated the *TVEyes* decision, it is consistent with the values embodied in the decision, and its immense popularity, rapid expansion and integration with other major brands, and stability as a favorite Millennial and Generation Z pastime show how much success technologists and content owners can achieve together when they each recognize the market opportunities and combine their talents and knowledge toward a common goal.

V. Conclusion: "Onward, and Yon-ward!"[28]

The future of tech-fueled media and entertainment is bright, exciting, and coming soon to an LED screen near you. While the law is notoriously slow to catch up with technology, in the case of *TVEyes* it was at least remotely punctual, and so perhaps for once the two can walk side by side, at least for a little while, until this technotainment revolution is rendered obsolete or unless the Supreme Court takes the case and decides differently.[29] Despite its seemingly timely nature, those on the hard copy-right may not like *TVEyes*, as it left intact the unchallenged search and indexing uses as fair under *Authors Guild*, while those on the far copy-left may dislike the decision because it did not go far enough to encourage the advancement of technology. However, the ruling is consistent with the direction in which the tide of major players is already headed. With the rise of AI and the explosion of interactive entertainment apps, zealots on either side may be wise to simply ride the wave—at least until it becomes necessary to jump the shark.

Endnotes

1. *Fox News Network, LLC v. Tveyes, Inc.*, 883 F.3d 169 (2d Cir. 2018).
2. 804 F.3d 202 (2d Cir. 2015) (holding that mass copying of books for purposes of limited text searching was fair use).
3. Cowan, DeBaets, Abrahams & Sheppard LLP drafted an amicus brief in this case on behalf of American Photographic Artists, American Society of Media Photographers, Digital Media Licensing Association, National Press Photographers Association, and Professional Photographers of America, in support of Fox News Network ("CDAS Amicus Br.").
4. *TVEyes*, 883 F.3d at 175.
5. The district court held that download, e-mailing, and certain watch-related functions were not fair use. *See id*. at 173.
6. Copying "enables TVEyes's clients to isolate from the vast corpus of Fox's content the material that is responsive to their interests, and to access that material in a convenient manner." *Id*. at 174. Similar to the Sony "Betamax" case, the court noted that TVEyes' watch function was also akin to time- and place-shifting, and "certainly qualifies as technology that achieves the transformative purpose of enhancing efficiency," and so was "at least somewhat transformative." *Id*. at 177-78.
7. *Id*. at 178.
8. *Id*. at 180.
9. *Id*. at 174.
10. *See* CDAS Amicus Br. at nn.15-16.
11. *See id*. n.2.
12. Star Trek: First Contact. Perf. Jeff Coopwood. Dir. Jonathan Frakes. Paramount Pictures, 1996.
13. *See Fox News Network, LLC v. TVEyes, Inc.*, 43 F. Supp. 3d 379, 387 (S.D.N.Y. 2014).
14. 2001: A Space Odyssey. Perf. Douglas Rain. Dir. Stanley Kubrick. Metro-Goldwyn-Mayer, 1968.

15. Arvin Patel, *Artificial Intelligence Will Be Hollywood's Next Big Star*, Deadline.com (July 20, 2018), https://deadline.com/2018/07/artificial-intelligence-hollywood-next-star-arvin-patel-commentary-1202427191/.

16. *Id*.

17. *See id*.

18. *Id*.

19. Sunset Boulevard. Perf. Gloria Swanson. Dir. Billy Wilder. Paramount Pictures, 1950.

20. iTunes Store, https://itunes.apple.com/US/app/id835599320/id835599320.

21. *Id*.

22. Dan Rys, *Musical.ly, Apple Music Ink New Partnership, With More to Come*, Billboard (Apr. 28, 2017), https://www.billboard.com/articles/business/7776302/musically-apple-music-partnership.

23. Dan Ryes, *Fresh Off a Big Funding Round, Musical.ly Signs Its First Major Label Deal with Warner Music*, Billboard (June 29, 2016), https://www.billboard.com/articles/business/7423281/warner-music-group-deal-musical-ly.

24. Todd Spangler, *Musical.ly's Live.ly Is Now Bigger Than Twitter's Periscope on iOS (Study)*, Variety (Sept. 30, 2016), https://variety.com/2016/digital/news/musically-lively-bigger-than-periscope-1201875105/.

25. iTunes Store, https://itunes.apple.com/US/app/id835599320/id835599320.

26. *Id*.

27. *Id*.

28. Nature Cat. Perf. Taran Killam. Spiffy Pictures, 2015.

29. TVEyes is currently in the process of petitioning the Supreme Court for a writ of certiorari to review the decision. See Eriq Gardner, *Fox News Taken to Supreme Court in Potential Blockbuster Case*, Hollywood Reporter (Aug. 1, 2018), https://www.hollywoodreporter.com/thr-esq/fox-news-taken-supreme-court-potential-blockbuster-case-1131466.

Gone But Not Forgotten: Court of Appeals Clarifies Liability for Deletion of Copyright Management Information

By Mark S. Kaufman

I. Introduction

In *Stevens v. CoreLogic, Inc.*,[1] the Ninth Circuit affirmed a ruling that the defendants did not violate section 1202 of the Copyright Act, which prohibits the intentional deletion of copyright management information (CMI), on the ground that the defendants lacked the requisite intent to infringe. CMI claims have become an increasingly popular quiver in the bow of plaintiffs seeking to recover for unauthorized use of their work online—a frequent subject of litigation in district courts in the Second Circuit. Notably, unlike a claim for copyright infringement, section 1202 authorizes statutory damages in the absence of copyright registration. *Stevens* represents an important appellate decision underscoring the statutory "state of mind" limitation on such claims. As *Stevens* makes clear, deletion of CMI is only actionable if done knowing that it likely will cause further infringement.

II. Section 1202(b)

Section 1202(b)(1) of the Copyright Act provides: "No person shall, without the authority of the copyright owner or the law . . . intentionally remove or alter any copyright management information . . . knowing, or . . . having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any" copyright.[2]

Section 1202(b)(3) provides: "No person shall, without the authority of the copyright owner or the law . . . distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law, knowing, or . . . having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any" copyright.[3]

As for remedies for a violation section 1202, section 1203(b)(5) provides that a court in its discretion may award attorneys' fees to the prevailing party, while section 1203(c)(3)(B) allows a plaintiff to recover (as an alternative to actual damages) statutory damages ranging from $2,500 to $25,000.[4] As noted, unlike section 412 of the Act, which requires timely registration to be eligible for statutory damages for infringement,[5] section 1203 contains no such requirement.

III. The Dispute

The plaintiffs in *Stevens* were photographers hired by real estate agents to take photographs of houses for sale. The photographs were licensed to the agents, with the copyrights retained by the photographers. Because the photographs were digital, they contained metadata—i.e., data about the image that is not visible on the image but is embedded in its computer-readable file. In addition to metadata that is generated automatically, some metadata—such as a caption and the image's author and a copyright notice—can be added manually. Section 1202 prohibits the removal or alteration of CMI, including the title, author, copyright owner, and other information provided in a copyright notice,[6] which metadata typically contains.

CoreLogic, the defendant, sells software to multiple real estate listing services, that enables real estate agents to share information about properties. To reduce each image's size—in order to reduce needed storage capacity, facilitate computer display, and help images load faster—the software saves a copy of each photo, reduces the number of pixels, deletes the original, and saves the new image. In this process, each photo's metadata is deleted.

CoreLogic's software does not detect, recognize or remove visible CMI, such as watermarks, from photographs. Thus, the plaintiffs objected only to deletion of the metadata.

IV. The District Court Proceedings

The photographers sued CoreLogic in the Southern District of California for violating section 1202(b). After receiving the initial complaint, CoreLogic modified the software to copy EXIF metadata[7] and restore it to images, but the plaintiffs contended that the software continued to remove IPTC metadata.[8] The district court granted summary judgment in favor of CoreLogic, and the plaintiffs appealed.

V. Ninth Circuit Ruling

On appeal, the Ninth Circuit noted that section 1202 requires evidence that the defendant knows, or has a reasonable basis to know, that its actions "will induce, enable, facilitate, or conceal" infringement,[9] and it found that the plaintiffs had failed to prove this mental state requirement. The plaintiffs' argument was that because CoreLogic's software impaired the metadata method of identifying an infringing photograph, an infringer *might*

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be able to use the photos without detection. The court found that this "simply identifies a general possibility that exists whenever CMI is removed," which it referred to as a "generic approach [that] doesn't wash."[10]

Rather, the court held, a plaintiff bringing a section 1202(b) claim "must make an affirmative showing, such as by demonstrating a past 'pattern of conduct' … that the defendant was aware of the *probable* future impact of its actions."[11] The court noted that the legislative history indicated that to be held liable, the defendant must know or have a reasonable basis to know that removing or altering CMI, or distributing works without CMI, *will* aid infringement. It therefore held the plaintiff must show more than simply that the removal of CMI metadata eliminates a method of finding and identifying infringing images. Rather, to survive summary judgment the plaintiff must provide evidence that future infringement *was likely to occur* because of the removal or alteration of CMI.

In this case, the court found that because the plaintiffs had failed to provide any specific evidence that CoreLogic's removal of CMI undermined that the plaintiffs' copyright policing efforts, the statutory intent/causation standard was not met. Indeed, one plaintiff testified at his deposition that he had not known that metadata was preserved when a photo was posted on the internet. In addition, the plaintiffs had failed to prove that CoreLogic's distribution of real estate photos "induced, enabled, facilitated or concealed an infringement." The court noted that they had not identified a single instance of infringement, let alone the necessary pattern of conduct, caused by the software's automated removal of the CMI. Thus, the court held that they had failed to demonstrate that removing the metadata "will," in the predictive sense the statute requires, make it easier to infringe without detection.

VI. Conclusion

Although $2,500 to $25,000 in statutory damages plus attorneys' fees, and the fact that the allegedly infringed work need not be registered, may tempt potential plaintiffs to bring claims under section 1202, requiring plaintiffs to demonstrate that the defendant knew or had reason to know that removal of CMI would "induce, enable, facilitate, or conceal" infringement of the plaintiff's work establishes a potentially significant hurdle to recovery.

The Ninth Circuit made clear in *Stevens* that mere knowledge that CMI was removed is not enough to establish liability. Notably, with sparse appellate precedent on section 1202, the court relied solely on its own reading of the statutory language and the legislative history.[12] It will be interesting to see whether other courts follow its lead and construe the statute in the same manner.

Endnotes

1. *Stevens v. CoreLogic, Inc.*, 893 F.3d 648 (9th Cir. 2018).
2. *Id.* § 1202(b)(1).
3. Section 1202(a) also prohibits one from "knowingly and with the intent to induce, enable, facilitate, or conceal infringement (1) provide copyright management information that is false, or (2) distribute or import for distribution copyright management information that is false."
4. 17 U.S.C. § 1203.
5. 17 U.S.C. § 412.
6. 17 U.S.C. § 1202(b)-(c).
7. Exchangeable Image File Format (EXIF) is used by almost all digital cameras to store information about the camera's settings used to capture a digital image. *Stevens*, 893 F.3d at 652.
8. "IPTC" refers to the metadata standards of the International Press Telecommunications Council, which standards "can include, for example, the title of the image, a caption or description, keywords, information about the photographer, and copyright restrictions." *Stevens*, 893 F.3d at 652.
9. *Id.* § 1202(b)(3).
10. 893 F.3d at 655.
11. *Id.* (emphasis added).
12. There are very few appellate decisions addressing section 1202. *See Gordon v. Nextel Comms.*, 345 F.3d 922, 926-27 (6th Cir. 2003) (finding no proof to contradict assertion that defendants' personnel believed that poster received for promotional purposes had been cleared for use in television commercials, such that use of such image was not done "knowing" that CMI had been removed; also, no evidence that defendant had any reason to know that the removal would facilitate or conceal any infringement; affirming summary judgment for defendants); *Murphy v. Millenium Radio Grp. LLC*, 650 F.3d 295, 305 (3d Cir. 2011) (holding that CMI is not restricted to automated copyright protection or management systems; vacating granting of summary judgment); *Friedman v. Live Nation Merch., Inc.*, 833 F.3d 1180 (9th Cir. 2016) (reversing grant of summary judgment on ground that only material difference between defendant's products and authorized versions was that [visually discernible] CMI was missing, such that plaintiff might be able to demonstrate defendant had intentionally removed CMI from the copied version).

Will a Survey Enhance the Chances of Winning Your Trademark Infringement Case?

By James T. Berger

I. Introduction

Is it worth doing a likelihood-of-confusion survey for a trademark infringement case? Is it going to help win the case? This is a question survey experts get all the time. Thanks to some recent academic studies and an analysis of the *Daubert* environment, we have some guidance on this issue.

II. Surveys v. Direct Evidence

Shari Seidman Diamond, Northwestern University Professor of Law and Psychology and research professor of the American Bar Association, and David J. Franklyn, director of the McCarthy Institute for IP and Technology Law at the University of San Francisco School of Law, have co-authored *Trademark Surveys: An Undulating Path*, published in the Texas Law Journal (June 28, 2014). The article discusses several studies aimed at gauging the success rates of lawsuits that make use of consumer surveys.

Diamond and Franklyn set the stage for the analysis by discussing surveys versus other forms of evidence. They point out that trademark law considers three main types of evidence for evaluating the likelihood of confusion: (1) survey evidence; (2) direct evidence; and (3) argument by inference. They point out that direct evidence is often considered the strongest form of evidence. It includes testimony by confused consumers or misdirected letters. Unfortunately, it may be difficult to obtain direct evidence. Often a junior user has just begun to market its product when the senior user brings an infringement action to prevent consumer confusion. In such cases, direct evidence of confusion is unlikely to exist because consumers who otherwise may have been confused may not be aware of the deception because the products have not yet appeared in the marketplace, or advertising for such products has not yet been created.

The alternative to direct evidence is survey evidence, which can measure whether a significant number of relevant consumers are likely to be confused by a mark. As Diamond and Franklyn point out, courts have long accepted survey evidence performed by qualified survey experts. A survey assessing likelihood of confusion exposes the allegedly infringing mark to consumers and measures their reactions. Among the factors to be considered in designing a survey are the identity of relevant consumers, the nature of the mark, and how consumers encounter the mark in commerce. Over time, courts and researchers have come to recognize that many likelihood-of-confusion surveys attempt to establish causation. When causation is a factor, the survey often requires appropriate control groups or control questions. The issue of a "control" survey or "control" question has become a crucial factor in evaluating the worth of a survey focusing on causation.

Dozens of scholars have examined court decisions to assess the role of surveys. Diamond and Franklyn single out Graeme W. Austin (Victoria University of Wellington), who studied cases over a 10-year period between 1993 and 2003 and found that surveys were introduced in 57.4% of trademark cases that went to final judgment. Diamond and Franklyn conclude that surveys "may not be ubiquitous in reported cases involving allegations of likelihood of confusion, but they frequently play a central role in the progress of the trademark and deceptive advertising litigation before cases appear in court opinions." They note that surveys "are most likely to be commissioned when other evidence in the case is equivocal," which is "precisely when they are most likely to influence decisions." They call surveys "valuable tools in trademark litigation even when they are not deployed in trial" because they "provide an important reality check on mark evaluation and effective leverage in settlement negotiations." Surveys also "help inform clients and shape strategy with insight into actual consumer perceptions and their legal significance."

Diamond and Franklyn review a number of studies that address whether surveys play a major role in the success or failure of the lawsuit.

A. Beebe Study

The first study discussed by Diamond and Franklyn was performed by Barton Beebe in 2006. At the time of the study, Beebe was associate professor at the Benjamin N. Cardozo School of Law. He identified 331 published opinions in all 13 circuits between 2000 and 2004 that made use of likelihood-of-confusion surveys. Diamond and Franklyn write that Beebe's findings showed that survey evidence "thought by many to be highly influential, is in practice of little importance." Beebe found that only 65 (20 percent) of the 331 opinions he studied discussed survey evidence, while only 34 (1 percent) credited the survey evidence. Although the rulings in 70 percent of those cases credited the survey, those 24 cases represented only 7 percent of the opinions he studied."

According to Diamond and Franklyn:

> [Beebe's] finding that similarity of marks is the single most important factor makes

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> intuitive sense. When marks are extremely similar, the situation borders the realm of counterfeiting and free riding, which usually tends to overpower other factors. But Beebe also identified two other influential factors: the defendant's intent when it favored a likelihood of confusion, and the proximity of the parties' goods when that factor disfavored a likelihood of confusion. He also concluded that the intent and actual confusion factors "exert an inordinate degree of influence" on the outcome of the rest of the factors. Moreover, the similarity of the marks and defendant intent were weighted so strongly by judges that they could trigger a finding of confusion despite the outcomes of any other factors. In essence, Beebe theorized that judges essentially looked at just a few factors to decide infringement and then rationalized the rest in order to obtain a coherent outcome.

According to Diamond and Franklyn, Beebe "ultimately concluded that judges were indeed short-circuiting the multifactor balancing test, relying on two or three of the factors (at least similarity of marks and proximity of goods in almost all cases) in a 'take the best' strategy." They suggest that judges "may evaluate factors to be consistent with the outcome they favor on other grounds" and that "faced with a persuasive survey that shows evidence of likelihood of confusion, the marks may appear more similar than they might have appeared in the absence of the survey." In that case, they argue, it "would not be the similarity of the marks, but rather the survey, that led to a finding of likelihood of confusion."

B. Sarel and Marmorstein Study

Diamond and Franklyn next address a study performed by Professors Dan Sarel and Howard Marmorstein of the University of Miami Business School. The Sarel/Marmorstein study was performed in 2009 to determine the effect of survey evidence in trademark infringement cases where the central issue was likelihood of confusion. They analyzed 126 cases decided between 2001 and 2006. In every case, the plaintiff possessed an "undisputed, valid trademark."

They used independent coders to evaluate whether the marks were similar and if the goods were sold in high or low proximity to one another. They also looked at whether the plaintiff had presented a survey and, if so, whether the court had accepted it. Their results differed dramatically from Beebe's. In approximately one-third of the studied cases, plaintiffs offered likelihood-of-confusion surveys, and the results suggest a substantial impact in cases in which the parties' marks or goods or services were dissimilar.

The Sarel/Marmorstein study showed that survey evidence increased the success rate on the likelihood-of-confusion issue by 24.2 percent. When the plaintiff introduced survey evidence for dissimilar products, the survey evidence increased the plaintiff's success in obtaining an injunction by about 60 percent. Where the marks were dissimilar, they found that it was almost impossible to obtain an injunction without a survey: Only 4 percent of plaintiffs were able to obtain an injunction without using a survey, while 61.5 percent obtained an injunction with a survey. If the court rejected the survey, no plaintiff succeeded in obtaining an injunction. Even where the goods and/or trademarks were similar, the admission of surveys increased the chances of winning by 17-20 percent.

C. Bird and Steckel Study

The most recent study was performed by University of Connecticut Professor Robert C. Bird and New York University Professor Joel H. Steckel. They analyzed 533 published cases from between 2000 and 2006. They found that only 16.6 percent of them discussed survey evidence, and from this they concluded that consumer surveys "are neither 'universally influential' nor 'used as often as some would imply.'"

* * *

These three studies show that surveys may be valuable, especially in securing an injunction. It is impossible to say definitively as a general matter whether a survey will or will not help win the case, and it bears noting that Diamond/Franklyn did not evaluate the quality of the survey—a key factor in its impact.

Another major factor in the value of a survey—its admissibility—is discussed below.

III. The *Daubert* Factors

Three major Supreme Court decisions have significantly changed the playing field in terms of the use of experts in performing surveys, writing reports, and testifying in depositions and at trial in intellectual property cases. The first case was *Daubert v. Merrell Dow Pharmaceuticals* in 1993, followed by *General Electric Co. v. Joiner* in 1997, and finally *Kumho Tire Co. v. Carmichael* in 1999. These three rulings are known as the "*Daubert* trilogy" or often simply "*Daubert*." A *Daubert* motion is pretrial motion to exclude as inadmissible the work product and/or testimony of an "unqualified" expert.

Daubert concerned the admissibility of scientific expert testimony; *General Electric* held that abuse of discretion is the proper standard of review of a trial court's decision as to whether expert testimony is admissible; and *Kumho Tire* held that the judge should function as a gatekeeper for all expert testimony, scientific and non-scientific. In *Daubert* the Court provided criteria for judges to use in determining whether scientific evidence is sufficiently reliable to be admissible:

1. Whether the research technique has general acceptance or is widely known or whether it has attracted only minimal support;
2. Whether standards and controls governing the application of the scientific methodology exist;
3. Whether the expert's methods or techniques can be tested, and, if so, whether such methods or techniques have been tested;
4. Whether the theory or technique has been subjected to peer review and publication; and
5. Whether the scientific technique has a known or potential rate of error.

Daubert is based on the rationale that juries do not understand the principles and nuances of scientific research and that if such opinions are highly subjective, the court should be able to keep them away from an impressionable jury. In practice, *Daubert* has opened the door to a great deal of motion practice that is not, in most cases, justified.

If the expert's findings are particularly damaging to one side, the obvious rationale for filing a *Daubert* motion is the chance the judge will eliminate the expert and his or her findings. Most judges view *Daubert* motions skeptically and carefully evaluate both the qualifications of the expert and his or her findings. It is very hard to exclude an expert who has had experience testifying and whose work has been accepted by the courts. Scientific research covers a wide area and many issues, and in complex litigation interpretations of the evidence vary from expert to expert. Moreover, there is no one method of conducting a survey. Since judges are not survey experts trained to perform scientific research, it is difficult to exclude an experienced survey research expert. In such cases, there generally is a survey and a report by the survey expert as well as a rebuttal report by another survey expert retained to analyze and provide a critique of the initial survey. It is not unusual for both sides to file *Daubert* motions. Most judges, who typically lack the knowledge to assess the merits of a survey, will not exclude a credible research effort and generally will rule instead that the survey expert and the critiquing expert should be subjected to "rigorous cross examination."

An important consideration in the application of *Daubert* is the background of the survey expert. Professor Shari Seidman Diamond, in "Reference Guide on Survey Research," which is part of the *Reference Manual for Scientific Evidence* published by Federal Judicial Center, spells out the required experience and education for a qualified survey expert. Some survey experts come from the social sciences with experience in psychology and sociology, while others come from the business and marketing disciplines.

The *Daubert* standards are, it should be noted, subject to debate. Complex litigation often requires creative solutions that involve the use of techniques never used previously. For example, the emergence of the internet as a research tool opens up myriad possibilities that were previously unavailable. Researcher and survey expert Gabriel Gelb has performed a number of highly effective surveys using internet technology. Such a technique arguably is "not widely known" and may have "attracted minimal support," in the language of *Daubert*. As for the "peer review and publication" criterion, there is, again, something of a "chicken or egg" issue: Clearly, a novel creative technique will be applied prior to being subjected to any peer review. Does that mean the technique lacks sufficient indicia of merit to be admissible?

Scientific research requires an understanding of the complex issues relating to the specific case, an understanding of relevant target markets, and a pragmatic willingness to try new or advanced methodologies to obtain accurate answers and data. The key is that such research should be scientific in nature and utilize those key principles of scientific research.

IV. Conclusion

Is it worth it to do a survey for a likelihood-of-confusion trademark case? Is it going to help win the case? The answer is a strong MAYBE. If the plaintiff has no other direct evidence, a survey may be mandatory. However, the survey must be performed by a survey expert with a track record. The survey has to conform to scientific research methodology and use an accepted protocol. The *Daubert* cloud hangs over any case using a survey expert.

16th Annual Women in IP Program

June 6, 2018 marked the Section's 16th Annual Women in Intellectual Property Law program. Some 100 women gathered at the New York office of Davis Wright Tremaine LLP to meet new people, reconnect with colleagues, and celebrate the accomplishments of women in the IP field. Among the impressive women I met were seasoned attorneys lending advice as well as new attorneys eagerly receiving it.

Program Chair Joyce Creidy of CompuMark/Clarivate Analytics began by encouraging members of the audience to recount their recent accomplishments. One woman related her team's registration of the smell of Play-Doh®. Another spoke about receiving her law school diploma, while working and caring for her 1-year-old daughter.

Panelists Roxanne Elings (Davis Wright Tremaine), Deirdre Clarke (Leason Ellis), Dr. Serena Farquharson Torres (Bristol-Myers Squibb), and Lena Saltos (URBN) shared their experiences as women in the legal field and spoke candidly about issues they faced, such as practicing law as a new mother, gender inequality, racial bias, rejection, and finding work during the financial crisis. They also offered advice on how to overcome setbacks and follow your passion.

Ms. Elings discussed role models. When she began practicing law in the 1980s, there was a lack of women attorneys to whom she could turn for advice. She described the struggle that came after the birth of her children with balancing time at work and at home. After speaking with the head of her firm, she managed to work out a flexible schedule. However, she said that while it worked for her in some ways, it worked against her in others, such as when it came time for bonuses. She also discussed diversity and stressed the importance of diversity of all kinds. She urged that in order to learn, we must look around, connect with one another, and lift each other up. She sits on the board of the most diverse private school in the United States and is a member of Davis Wright Tre-

maine's Project W, a project committed to helping women with career advancement, achieving equality in the workplace, and launching successful companies.

Ms. Clarke spoke about her journey from paralegal to associate. After working as a paralegal for seven years, she "felt she needed more" and applied to law school. After law school, she decided to take a contract paralegal position with Leason Ellis, where she immersed herself in the firm, including joining the firm's softball team. She was encouraged to lobby her boss for an associate position and is now coming up on her fifth year as an associate. "Potential employers can find a lot of reasons not to hire you. Present yourself in a way they see why they *should* hire you," she advised. Clarke also recommended finding a mentor who understands your strengths and weaknesses; creating a "board of directors" for yourself (a diverse group of people to help you make decisions); nurturing your career by learning, networking, and speaking on panels; giving back by joining groups focused on improving the field and helping new attorneys; and knowing what you bring to the table.

Ms. Torres' story began in Wisconsin, where her family owned a hair salon. While she considered joining the family business, her grades were stellar, so she applied to college and went on to earn her Ph.D. in biological chemistry. One auspicious day, she met two women patent lawyers who changed her life. They discussed patent law and, after the interaction and further research, she applied to law school. Torres encouraged the audience to consider that if you don't feel you have anything to share, you probably do and should not hesitate to share your journey in different venues, because if she had not met those two women, she would not be where she is today.

Torres also discussed how she encountered what she deemed to be racial bias when she found it difficult to build as substantial a workload as other associates. She also shared an important lesson she learned about salary negotiation: While being approached for a new role, she learned fortuitously that a male colleague with the same experience was making substantially more for the same job. She told

the audience that you have to know your worth, speak to your managers, and build your case.

Ms. Saltos shared how she came to practice IP law by following her love of art. Her first experience with IP was in law school, where she assisted a professor with research on trademark and art law. Focusing on firms with an art law group, she secured a summer associate position at Hughes Hubbard & Reed. When she graduated from law school, it was 2010 during the financial crisis, and she was staffed on the Lehman Brothers bankruptcy. While she found the workload daunting, she enjoyed working with such smart, driven people. She also found it exciting to work on such a relevant case. However, she was not practicing in her desired field: art law or IP.

As a second year associate, she asked for her first art law case. She relished handling the case on her own, including leading the deposition. Then, as a fourth-year associate, she was able to join the firm's trademark prosecution team. She soon began looking for IP-focused positions and finally landed a role at URBAN, managing the company's IP. She also fulfills her passion for the arts by sitting on the boards of many arts organizations. She advised the audience that it is important to develop outside interests and become involved in your community.

The program concluded with a dessert reception sponsored by CompuMark/Clarivate Analytics and a prize raffle, with gifts provided courtesy of Singer Sewing Company, Physique 57, Raised by Wolves, Revlon, L'Oreal, Inez.com, Steve Madden, Ralph Lauren, and Dry Bar.

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How to Litigate Against a Copyright Troll

By Stephanie Furgang Adwar

I. Introduction

Like an urban legend, I had long heard tales of the "copyright troll." Lawyers would talk about them in frustrated tones and warn other attorneys of their appearance. They worried that these trolls were changing the face of copyright litigation for the worse. In practice for almost 28 years, I had heard of the rumored troll but had not encountered one and assumed that the rumors were overblown. Until last year, that is.

Recent empirical studies show that the field of copyright litigation is increasingly being overtaken by "copyright trolls," roughly defined as plaintiffs (or their attorneys) who are "more focused on the business of litigation than on selling a product or service or licensing their [copyrights] to third parties to sell a product or service."[1] The paradigmatic troll plays a numbers game in which it targets hundreds or thousands of defendants, seeking quick settlements priced just low enough that it is less expensive for the defendant to pay the troll rather than defend the claim.[2]

I encountered my first copyright troll when a small mom and pop office-cleaning company came to me for assistance with a copyright infringement complaint it had received.[3] The complaint concerned the company's use of a photograph depicting a leaf dipping into water to illustrate that their cleaning services were "green." The company had placed numerous photographs on its website, most of which came from stock photo sites. The leaf photo, however, was downloaded from what the company believed was a free download site. Although the company immediately removed the photograph from its site, that did not stop the plaintiff photographer from pursuing the suit. Neither the fact that the infringement was unintentional nor that a similar photograph could have been acquired on a stock site for approximately $12 dissuaded the plaintiff's attorney from demanding thousands of times that amount to settle.

While that suit was pending, I was retained by another client (D#2) who was being sued by a different photographer represented by the same attorney. At the preliminary conference for D#2, we learned two things: (1) the plaintiff's counsel had filed more than 500 cases in the Southern and Eastern Districts of New York in the past two years; and (2) another judge in the district recently had ordered this attorney to file an order to show cause why a bond for costs and attorneys' fees should not issue. The judge in D#2's case, knowing of this order, directed the plaintiff do the same. Instead of filing the order to show cause, however, the plaintiff withdrew the suit with prejudice and re-filed it in another jurisdiction.

I then learned that the judge in the cleaning company case had, in another case, referred to plaintiff's counsel as a copyright "troll,"[4] making clear her skepticism about his practices. So I wrote to the court asking for its assistance in resolving the cleaning company case. The court, noting that plaintiff's counsel had misrepresented the history of the case and failed to serve the notice of preliminary conference, ordered the plaintiff's counsel to show cause why he should not be sanctioned. While the case did settle, counsel was sanctioned $2,000 and ordered to obtain four New York CLE ethics credits.

Thereafter, I was contacted from around the world by parties who had been named as defendants in suits filed by the same attorney and who, because of the sanction award, believed there was some magic means by which I could get this attorney sanctioned or get their case dismissed or at least withdrawn. However, because the facts of each matter differed, my opinions on how best to handle them differed, and many of them were faced with the unfortunate fact that there was no quick fix and that they likely were going to have to pay a significant amount of money to settle unless they decided to litigate.

II. Sizing Up the Case

Where the cost of litigation is high for both parties, reasonable settlements based upon reasonable claims are more likely to be negotiated. But trolls take these cases on contingency (with out-of-pocket costs usually paid by the client) and therefore are not concerned with their client's ability to pay their fees. There is thus less impetus to take a smaller settlement as well as less incentive for the plaintiff (who is not footing big bills) to come to the table. The troll knows that if the case starts to become financially uncomfortable for the defendant, the defendant might cough up more money to settle. The strategy often involves ambush: Trolls usually do not give notice of the claim before filing the summons and complaint. There is usually no cease and desist letter and no effort to reasonably settle the claim prior to litigation. Instead, the troll operates on the assumption that given the choice of a large payout to the infringed or a larger legal bill for litigation defense, the infringer is more likely to pay the plaintiff.

But there are a number of facts, discussed below, that must be analyzed when assessing a copyright case, and they can give the defendant the ability to negotiate a smaller settlement.

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A. When Did the Infringement Occur? When Did the Copyright Owner Register the Work?

Copyright infringement actions can be brought only in federal district court and only if the plaintiff has registered (or pre-registered) the copyright with the U.S. Copyright Office.[5] A copyright owner may file a registration application any time after completion of a work and during the term of copyright protection.[6] It is advisable to register the work either prior to publication or within three months after first publication so as to preserve the ability to recover statutory damages and attorneys' fees.[7] However, an author or other copyright owner can file an application for registration after publication and still be eligible for these remedies so long as the filing occurs prior to the infringement.[8]

Statutory damages ranging from $750 to $30,000 per work are available where the court finds the infringement not to be willful and can be increased to as much as $150,000 per work for willful infringement[9] or reduced to less than $200 if the infringer can prove it was not aware and had no reason to believe that its acts constituted infringement.[10] Statutory damages and attorneys' fees (which may be awarded to the prevailing party at the court's discretion) can be significant (depending on how many works are at issue) and must be considered prior to engaging in litigation.

However, if the plaintiff's work is not registered prior to the alleged infringement, the plaintiff only will be entitled to actual damages; statutory damages and attorneys' fees will not be available. Actual damages often will be de minimis, but the copyright troll may not know this.

In the cases I have handled, the plaintiff was not eligible for statutory damages or attorneys' fees, but that may not stop the copyright troll, who is working off a form complaint and may not have bothered to determine whether the use was prior to or after registration, from including a prayer for statutory damages. It often turns out that the claimed infringement occurred prior to the registration, which takes statutory damages and attorneys' fees off the table. This is therefore essential for the defendant to ascertain. The troll, who may do no due diligence and may bring a frivolous action worth a minuscule amount of money, does not fear Rule 11 or other sanctions because he knows it is more likely that the defendant will settle than move for sanctions. Most defendants will look to cut their losses, and the troll knows this.

B. How Was the Work Used?

After determining whether the plaintiff can potentially recover statutory damages and attorneys' fees, the next consideration is how much of the work was used and how it was used. Was the use a commercial one, i.e., in connection with sale of goods and services? Was the photograph used on a news or opinion website? These facts matter, as they bear on whether the use may be a fair use under § 107 of the Copyright Act. The fair use factors must be considered in assessing the value of the plaintiff's claim.

Another issue is whether the use was willful or whether the client was simply mistaken in believing it had the right to use the work. Many times the defendant will have used the work without realizing it was copyrighted—sometimes because he or she does not understand or even know about copyright law, sometimes because he or she obtained the work from a site touting itself as "royalty-free." Sometimes it will be because the defendants thought they owned the work or otherwise had a right to use it. It is important for purposes of negotiation to know into which category the use falls.

Where an infringing work is posted on an ISP, the ISP is protected from liability under the safe harbor provisions of the Digital Millennium Copyright Act (section 512 of the Copyright Act), which are designed to encourage copyright owners to send takedown notices to the ISP rather than immediately filing an infringement action. The plaintiff also may serve a subpoena on the ISP to determine the identity of the infringing party if the unauthorized copy is posted anonymously. If the plaintiff can identify the user who posted the infringed work, the plaintiff can sue the user for infringement even after the ISP has taken the photo down.

C. Who Is Your Client?

Another important question for a defense attorney to ask is "Who is my client?" It is important to understand the client's bottom line. Many defendants, especially those who believed the work to be royalty-free when they used it, want to fight. They want to be vindicated. Unfortunately, most individuals and small businesses simply cannot afford to fight on principle. And even though some of these claims seem relatively easy to defeat, doing so can cost more than the client expects. These are very sober matters and must be discussed at the start of the representation. A defense attorney must understand the client's financial position—what they can pay to settle and what they can and want to pay to fight. In the end, cost is the most important thing to almost every client.

D. What Is the Value of the Case?

Defense counsel also must consider the value of the case. Where statutory damages and attorney fees are not available, the defendant's exposure is limited to actual damages. Courts often use the past earnings by the plaintiff and/or the earnings of the defendant attributable to the use of the work to assess damages. The relevant questions are (1) What has the plaintiff earned previously from licensing the work? and (2) What did the defendant earn in using the work? If statutory damages are available, the court will take into account the actual damage figure as well as the culpability of the defendant and the nature of the use in setting an appropriate statutory award.

All of the above factors need to be taken into consideration in negotiating a settlement. Trolls usually have a set amount that they ask for at the outset. It usually is less than the defendant would have to spend in court but well more than the work is worth. If actual damages are small and statutory damages not available, these facts should assist in negotiating a smaller license fee.

III. Procedure

Trolls do not care if they bankrupt the defendant. They do not care if what they are asking for is well beyond a reasonable demand. It is important, as an effective advocate, to keep an eye on the conduct of the plaintiff's counsel. District court judges generally are unimpressed with the conduct of copyright trolls, who often fail to follow proper procedures because they assume the case will end in a default judgment or a settlement, or they will simply dismiss it without prejudice so that they can refile it at another time or in another court.

Defendant's counsel must be sure to advise the court of all relevant facts that mitigate the damages for which the defendant may be liable. It is always a good idea, in cases where statutory damages are not available and where actual damages will be far outweighed by the cost of litigation, to ask the court to order the plaintiff to show cause why a bond for costs and fees should not be issued. Rule 68 offers can also be made where only a small amount of money damages is in play. If the plaintiff loses or does not recover more than the Rule 68 offer, the court will force the plaintiff to pay the defendant's costs.

IV. Conclusion

Copyright trolls contend that they are helping artists protect their work, and it is true that many of these plaintiffs otherwise would not be able to afford to litigate. But the manner in which these often low-value cases are brought and prosecuted underscores the urgent need for a copyright small claims court.[11]

Endnotes

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The Emergence and Consolidation of a Jurisprudence of Domain Names

By Gerald M. Levine

I. Introduction: Claims in Search of a Remedy

One of the fallouts of disruptive inventions is the need for new laws to counter their unexpected consequences. As it concerned the internet, these consequences included a new tort of registering domain names identical or confusingly similar to trademarks and service marks with the intention of taking unlawful advantage of rights owners. Prior to 2000 the only civil remedy for "cybersquatting" or "cyber piracy" was expensive and time consuming plenary actions in courts of competent jurisdiction under national trademark laws. A stab at providing a simpler and quicker alternative for alleged cybersquatting had been implemented in 1995 by the then sole registry/registrar of domain names, Network Solutions Inc. (NSI).[1]

NSI's solution, which was heavily criticized by both rights holders and domain name registrants,[2] was to provide mark owners with a form of injunctive relief by suspending the domain name, arguably at the expense of domain name holders who were deprived of their "property" without due process. However, because only a court could determine the ultimate question of rights, NSI's limited solution garnered dismal ratings from rights holders. Before 2000, there had been a handful of Lanham Act cases in the United States for trademark infringement, dilution, and unfair competition in which courts had begun grappling with the new tort, distinguishing it from trademark infringement and beginning the task of identifying applicable principles and factors that would justify divesting registrants of their domain names.[3]

These disputes and the rising incidence of cybersquatting energized governments and intellectual property interests—working through the World Intellectual Property Organization (WIPO) in 1998-1999—to cooperate in establishing a mechanism for combating the new tort. WIPO's Final Report, published in April 1999 (WIPO Final Report) set out in great detail a series of recommendations for a supra-national online arbitral mechanism.[4] These recommendations were quickly transformed by the Internet Corporation for Assigned Names and Numbers' (ICANN) (created in 1998) into the Uniform Domain Name Dispute Resolution Policy (UDRP), which it implemented in October 1999.[5] Upon implementation of the UDRP, the NSI Policy instantly became history. Also in 1999, Congress enacted an amendment to the Lanham Act, the Anticybersquatting Consumer Protection Act (ACPA).[6]

It is important to underscore that an online dispute resolution proceeding under the UDRP is not a court case even though rights holders are granted affirmative relief against adjudicated cybersquatters. The UDRP is an even more powerful tool because domain name registrations are canceled or transferred to rights holders without court intervention or a right to appeal beyond the right to contest awards in courts of competent jurisdiction, which in the United States would be an action under the ACPA.

This article focuses on the emergence and development of a jurisprudence of domain names under the UDRP, pointing out some of the core principles and discussing the factors applied in distinguishing lawful from unlawful registration of domain names corresponding to trademarks.

II. Basic Ingredients of the Arbitral Process

Although rights holders were privileged in being granted a speedy and cost-effective means of adjudicating their domain name disputes, the WIPO Final Report put them on notice that their rights were no greater than what is granted under statutory law. It stated that the purpose of the proposed arbitral process "was not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere."[7] Rather, the goal was

> to give proper and adequate expression to the existing, multilaterally agreed standards of intellectual property protection in the context of the new, multijurisdictional and vitally important medium of the Internet....

Not only that, but it was

> not intended that the means of according proper and adequate protection to agreed standards of intellectual property should result in a diminution in, or otherwise adversely affect, the enjoyment of other agreed rights….

And, finally, the scope of the procedure was limited so that it was available

> only in respect of deliberate, bad faith, abusive, domain name registrations or "cybersquatting" and [was] not appli-

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cable to disputes between parties with competing rights acting in good faith.

There were two fundamental drivers for the emergence of a domain name jurisprudence. The first was the policy consensus described above: "[no] new rights [were created]"; the proposed arbitral regime was "not intended … [to] result in a diminution in, or otherwise adversely affect, the enjoyment of other agreed rights"; and it was "available only in respect to deliberate, bad faith, abusive, domain name registrations."

The second driver, also established in the WIPO Final Report, was that "[t]he decisions taken under the procedure would be made available publicly."[8] ICANN expressly directs providers servicing the arbitrations to publish decisions. This official requirement enables parties and panelists to access an accumulating database of reasoned decisions, not unlike the databases of common and statutory law decisions parties rely on in framing arguments in the courts. I will return to this in a moment, but the point to be emphasized is that the availability of easily accessible databases of rulings encourages reliance on past decisions as precedent, and as reliance grows, so does the jurisprudence.

When it came to transforming the WIPO proposals into the UDRP, the contending stakeholders submitted further comments aimed at influencing ICANN's final language in their favor: trademark owners "suggested that the definition should be expanded to include cases of either registration *or* use in bad faith, rather than both registration *and* use in bad faith," while individual and non-commercial interests "suggested changes in language that would narrow the scope of the definition of abusive registrations." They "sought to restrict the scope of the examples of bad-faith practices in paragraph 4(b) and . . . to expand the scope of the 'legitimate use' safe harbors in paragraph 4(c)."

ICANN Staff rejected both positions. To trademark owners it pointed out that the WIPO report, the DNSO recommendation, and the registrars group recommendation "all required both registration *and* use in bad faith before the streamlined procedure would be invoked." In rejecting the individual and non-commercial interest, ICANN Staff explained that "[e]ven if none of the three circumstances [in paragraph 4(c) were] present, the administrative procedure would still not apply to a dispute where the domain-name holder can show its activities are otherwise legitimate."

Both WIPO in its Final Report and ICANN in its Second Staff Report (which implemented the UDRP) believed that decision-making under the proposed arbitral process "should lead to the construction of a body of consistent principles that may provide guidance for the future."[9] Whether or not "the construction of a body of consistent principles" was initially thought capable of leading to a jurisprudence, there has in fact emerged a "body of consistent principles [that is] provid[ing] guidance" for balancing the rights of disputants involved in cybersquatting claims. Emblematic of this emergence is WIPO's publication of an Overview of the law as it has developed, now in its third edition (2017), which it has appropriately denominated a "Jurisprudential Overview."[10]

Implicitly, the WIPO consensus accepted a proposition, endorsed by ICANN, that the later-produced Jurisprudential Overview accepts expressly, namely, that domain names can be identical or confusingly similar to trademarks yet lawfully registered as long as they are not targeting the complainants' marks.

III. Establishing Metes and Bounds of Parties' Rights

As part of the implementation process for the UDRP, ICANN entered into agreements authorizing service providers to appoint panelists to hear and decide complaints of cybersquatting (or "abusive registration of domain names" in WIPO's terminology).[11] Until panelists began filing their decisions, there was no detailed body of law addressing the issue of abusive registration apart from court decisions adjudicating trademark disputes. Panelists (principally drawn from litigation and trademark bars) were invited to establish one.

Panelists are authorized under Rule 15(a) to "decide a complaint on the basis not only of the statements and documents submitted and in accordance with the Policy [and] these Rules" but also of "*any rules and principles law that [they] deem[] applicable*" (emphasis added). They also had for guidance the WIPO Final Report, which emphasized that the proposed arbitral regime was not intended to suppress legitimate competition or to restrain commerce.

Panelists began with the tablets of general principles handed down from ICANN in the form of a minimalist Policy and set of procedural Rules, the meaning of which they were expected to unpack and elaborate upon in reasoned, publicly accessible decisions. It should surprise no one that once the process of construction got underway, other panelists began accepting, rejecting, adopting, refining, modifying, and citing as authority what they received and in so doing identified the principles, fleshed out the evidentiary demands, and compiled the factors for proving or rebutting cybersquatting.

There is never certainty that when a new legal process is set in motion, it will result in the emergence of a set of consistent principles and thence into a jurisprudence. To be successful, the process had to be at once predictable and consistent. The hope was that "with experience and time, confidence will be built up in the credibility and consistency of decisions made under the procedure, so that the parties would resort less and less to litigation."[12] This is precisely what has happened. In the words of one

Panel, the principles laid down by earlier Panels and the factors applied in assessing parties' rights are "worthy of some deference."[13]

Whether "some deference" comes under the rubric of consensus or precedent is not without controversy. Another panelist believes that "despite the undoubted value of prior decisions, it should not be forgotten that panelists are bound by the UDRP and the Rules made under the UDRP which requires a panel to make its decision in accordance with 'the Policy, these Rules and any rules and principles of law that it deems applicable.'"[14] This view notwithstanding, consensus and precedent have merged into a single concept. It is rare for Panels not to cite earlier decisions supporting their reasoning.

The point can be illustrated by examining five decisions filed within the first year of the UDRP. This is not to suggest that the jurisprudence stopped growing. Later decisions could as equally be cited for clarifying principles already identified, accepting them with tweaks, or creating new core principles to address different factual circumstances.

The first decided case in January 2000 involved <worldwrestlingfederation.com>.[15] The respondent defaulted but had contacted the complainant by e-mail three days after registering the domain name and "notified complainant of the registration and stated that his primary purpose in registering the domain name was to sell, rent or otherwise transfer it to complainant for a valuable consideration in excess of respondent's out-of-pocket expenses." His offer to sell the domain name to the rights holder—the first of the four circumstances of bad faith under paragraph 4(b) of the Policy—is a classic example of bad-faith registration. However, as the Panel further noted, it was "clear from the legislative history that ICANN intended that the complainant must establish not only bad faith registration, but also bad faith use." Thus the follow-up question: if the domain name is passively held, can there be bad faith use? The Panel's not entirely satisfactory answer was that the respondent "'used' the domain name as [that term is] defined in the Policy."

A better answer came a month later in the second decided case (2000-03) involving <telstra.org>.[16] The Panel explained that passive holding of a domain name can support a finding of abusive registration because "the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept." It explained that "[o]ccupying an entry in the DNS is 'use' . . . [because] it has a blocking function." While mere failure to maintain an active website does not automatically result in a finding of bad-faith use, the stronger the mark the less credibility a respondent has in claiming good faith. (The reverse is also true: the weaker the mark the more persuasive must be the evidence for cybersquatting.). The Panel concluded that "[g]iven the Complainant's numerous trademark registrations for, and its wide reputation in, the word <TELSTRA> … *it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name* <telstra.org>" (emphasis added).

The third case involved <telaxis.com> and <telaxis.net>.[17] Since the domain name registration predated the trademark, there could not, by definition, have been a registration in bad faith. In other words, rights holders of a post-acquired mark have no actionable claim for cybersquatting. At best the dispute involves "the competing rights and legitimate interests of two parties in the domain names." The Panel added that "[g]iven the nature of this dispute it is properly solved by…by litigation in a forum of competent jurisdiction."

The fourth case, number 16 to be decided (in March 2000) involved a dictionary word domain name, <allocation.com>.[18] The Panel determined that even if a domain name is identical to a trademark, the complainant still has to prove it was registered and is being used in bad faith. The *Allocation* case is particularly important in establishing investor rights to their domain names. Respondent-resellers prevail when they acquire domain names for their semantic rather than their trademark values. As the Panel aptly noted:

> The difficulty lies in the fact that the domain name allocation.com, although descriptive or generic in relation to certain services or goods, may be a valid trademark for others. This difficulty is expounded by the fact that, while 'Allocation' may be considered a common word in English speaking countries, this may not be the case in other countries, such as Germany.

Nevertheless, the complainant failed to prove bad-faith registration. The Panel held that the complainant failed to demonstrate the respondent "at the time of registration of the domain name allocation.com knew or should have known of the existence of the German trademark *Allocation*" and that there was "no evidence suggesting that the domain name allocation.com ha[d] been chosen by Respondent with the intent to profit or otherwise abuse Complainant's trademark rights."

In the fifth case, involving the descriptive phrase "smart design" (number 993 to be decided, October 2000), the Panel found the complainant at fault for overreaching its statutory rights and sanctioned it for "reverse domain name hijacking"[19] (RDNH). The question in this case was whether renewal of registration amounted to a new registration; if it did it could then be argued that the domain name postdated the mark. However, the facts supported the respondent's showing that it had rights or legitimate interests in the domain name and thus had not acted in bad faith. The Panel issued a scathing assessment of the complainant's claim that has been cited in many subsequent RDNH decisions:

> The Panel is unable to assess the Complainant's state of mind when the Complaint was launched, but in the view of the Panel the Complaint should never have been launched. Had the Complainant sat back and reflected upon what it was proposing to argue, it would have seen that its claims could not conceivably succeed. Even assuming that its potpourri of constructive and quasi-constructive bad faith arguments were valid, they all start from the renewal, the renewal being treated for these purposes as a re-registration.

These decisions established the following core principles: (1) the complainant must prove its claim with evidence that the respondent both registered and is using the domain name in bad faith; (2) such proof can be direct, circumstantial, or inferential based on the totality of evidence offered; (3) passive holding of well-known or famous marks is inferentially bad faith unless rebutted with a persuasive explanation; (4) marks composed of common terms and descriptive phrases demand more persuasive evidence from the complainant that the respondent had them "in mind" when registering the domain name; (5) rights holders of marks acquired after registration of corresponding domain names have no actionable claims under the UDRP; (6) renewal of registration is a continuation of registration rather than a new event that restarts the clock for measuring bad faith; and (7) overreaching rights will incur the sanction of reverse domain name highjacking.

So established are these core principles that it is unusual for panelists to depart from them.

IV. Emergence of a "Common Law" Jurisprudence

As these five early cases illustrate, UDRP jurisprudence emerged incrementally through acceptance and refinement of the initial core principles, flexible enough to be applied to both commonly encountered as well as new factual circumstances. One month after the *Allocation* case was decided, for example, in a case involving <eautoparts.com>[20] the Panel found that

> The weakness of the EAUTO trademark makes it difficult for Complainant to argue that Respondent lacks a legitimate interest in the domain name eautoparts.com. That is because this domain name eautoparts.com is descriptive of a business that offers, through the Internet, information about or sales of automobile parts, and it is inappropriate to give Complainant a wide monopoly over all domain names, even descriptive ones, that incorporate the mark EAUTO.

Over the years, this line of reasoning has been followed in numerous decisions. *Eauto, LLC* has been cited as authority in dozens of cases (as have the *Telstra* and *Allocation* cases).

Similarly, in holding complainants accountable for abuse of the UDRP, once a clearly articulated analysis was presented, RDNH became a more common response to complainant overreaching. A three-member Panel in case number 2000-1151 (2001) cited *Smart Design* approvingly as well as noting an earlier case in which no sanction was imposed because "the Policy was so new."[21]

Nevertheless, nine years after the Panel in first held that complainants had the burden of proving conjunctive bad faith, it had second thoughts.[22] In renouncing its earlier construction of the Policy, the Panel reasoned that his colleagues "seem to have largely overlooked the language of the Policy regarding the respondent's representations and warranties." The Policy creators (the Panel believed) never intended a result that allows registrants who have registered disputed domain names in good faith to take advantage of and prosper from complainants' emergent reputations.

Instead of the traditional approach interpreting the representations provision (Paragraph 2 of the UDRP) as applying to the date of the registration of the domain name, the new construction proposed imposing on respondent a continuing obligation of lawful use. The Panel rested its new construction on the proposition that for certain kinds of opportunism, registrants should forfeit their registrations for disputed domain names regardless of whether they were registered in good faith. The theory is referred to as "retroactive bad faith registration."

Retroactive bad faith was immediately attacked as undermining predictability and consistency, and (although it took several years of decisions) it has become a dead end. The concern for preserving these twin principles was expressed by many Panels even before retroactive bad faith became an issue. In this regard, two decisions were important markers in the history of the jurisprudence: *Time, Inc*. (2001)[23] and *PAA Laboratories* (2004).[24]

In *Time*, the majority held that a decision "should consist of more than, '[i]t depends [on] what panelist you draw.'" In *PAA Laboratories,* the Panel (sympathetic to the concept of retroactive bad faith even before it was announced but resistant to accepting it) stated that "the Panel wishes to clarify that its decision under this element is based on the need for consistency and comity in domain name dispute 'jurisprudence'. Were it not for the persuasive force of the cited decisions, this Panel would have expressed the view that paragraph 2 of the Policy demonstrates that references to "registration" in the Policy were probably intended to be references to 'registration or renewal of registration.'"

As a later Panel put it in 2016: "If a consensus developed that a line of prior decisions had reached the wrong result, and if panels generally adopted a new approach on an issue, this Panel also would be open to considering whether a new approach was appropriate, both substantively under the Policy and in order to promote consistency." The Panel's emphasis on consistency is a significant factor in its arguing against changing current law, which construes "'evidence of the registration and use of a domain name in bad faith' . . . merely [as] an evidentiary presumption which may be rebutted on a full consideration of all the circumstances of the case."[25]

V. Conclusion

The cases cited above illustrate that the emergence and growth of a domain name jurisprudence came about, and is still evolving, in a manner similar to the common law through a deliberative process that includes parties and representatives in their pleadings and arguments (to which only decisions-makers have access) and that is most clearly apparent in Panel decisions as they approve, comment on, criticize, or cite earlier decisions for their own conclusions.

As domain name jurisprudence has grown in depth and complexity, it has subsumed the Policy and Rules. What this means in a practical sense is that parties and their representatives must first look at the jurisprudence to understand the current state of the law and only secondarily at the language of the Policy and Rules. It is the ongoing construction of the Policy and Rules that ultimately settles whether a party's submission succeeds or fails in a UDRP proceeding.

Endnotes

1. Network Solutions' Domain Name Dispute Policy Statement Revision 02 (last modified Sept. 9, 1996. The Policy is no longer available online but a copy is attached as an Appendix to Steven A. McAuley, *The Federal Government Giveth and Taketh Away: How NSI's Domain Name Dispute Policy (Revision 02) Usurps a Domain Name Owner's Fifth Amendment Procedural Due Process*, 15 J. Marshall J. Computer & Info. L. 547 (1997).
2. Its shortcomings are described in Carl Oppedahl, *Analysis and Suggestions Regarding NSI Domain Name Trademark Dispute Policy*, Vol. 7, Issue 1, Article 7 (1996); and the Steven A. McAuley article, *supra* note 1.
3. *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, 40 U.S.P.Q. 2d 1479 (W.D. Wash. 1996) (adult entertainment site at domain name candyland.com is tarnishment of CANDYLAND trademark for children's games; motion for preliminary injunction granted); *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227 (N.D. Ill. 1996) (The court characterizing the defendant as a "spoiler" who prevented the trademark holder from doing business on the internet under its trademark name unless it paid the Respondent's fee); *Panavision International v. Toeppen*, 141 F.3d 1316, 46 U.S.P.Q. 2d 1511 (9th Cir. 1998) ("Toeppen's intention to arbitrage the 'intermatic.com' domain name constitutes a commercial use.").
4. *The Management of Internet Names and Addresses: Intellectual Property Issues, Final Report of the World Intellectual Property Organization Internet Domain Name Process* (April 30, 1999) (hereafter, "Final Report").
5. *CANN Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy, Paragraph 4.1(c): The Current Question Is the Form of the Implementation Documents, not the Nature of the Policy Itself*. In Santiago, the Board adopted a Uniform Dispute Resolution Policy based on the final report of WIPO, the consensus recommendation of the DNSO, the recommendation of the group of approximately 20 registrars that had prepared implementation documents for a voluntary policy, and a significant number of written and oral comments.
6. 15 U.S.C. §1125(d) (Cyberpiracy Prevention).
7. *Id.*, Paragraph 34.
8. WIPO Final Report, Paragraph 153.
9. *Id.*, Paragraph 149(v).
10. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), http://www.wipo.int/amc/en/domains/search/overview3.0/.
11. WIPO Final Report,¶ 170.
12. *Id.* ¶153.
13. *Nikon, Inc. v. Technilab. Inc.*, D2000-1774 (WIPO Feb. 26, 2001).
14. Private conversation with panelist Neil A. Brown, QC, referring to Rule 15(a).
15. *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, D99-0001 (WIPO Jan. 14, 2000).
16. *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000) (an inference will be drawn from respondent's choice of name when "it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by respondent that would not be illegitimate").
17. *Telaxis Communications Corp. v. William E. Minkle*, D2000-0005 (WIPO Mar. 5, 2000).
18. *Allocation Network GmbH v. Steve Gregory*, D2000-0016 (WIPO Mar. 24, 2000).
19. *Smart Design LLC v. Hughes*, D2000-0993 (WIPO Oct. 18, 2000).
20. *EAuto, L.L.C. v. EAuto Parts*, D2000-0096 (WIPO Apr. 9, 2000).
21. *Goldline International, Inc. v. Gold Line*, D2000-1151 (WIPO January 4, 2001) (<goldline.com>) citing *Smart Design*, *supra* note 19, and *Loblaws, Inc. v. Presidentchoice.inc/ Presidentchoice.com*, AF-0170a to 0170c (eResolution, June 7, 2000).
22. *City Views Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE*, D2009-0643 (WIPO July 3, 2009) (<mummygold.com>). The new construction was announced in this case, although the Panel denied the complaint. The same Panel later applied this new construction to grant the complaint in *Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, D2009-0786 (WIPO Aug. 19, 2009).
23. *Time Inc. v. Chip Cooper*, D2000-1342 (WIPO Feb. 13, 2001) (<lifemagazine.com>).
24. *PAA Laboratories GmbH v. Printing Arts America*, D2004-0338 (WIPO July 13, 2004).
25. *Kids & Us English, S.L. v. Target Success.Com, Incorporated*, D2016-0356 (WIPO Apr. 8, 2016) (<kidsandus.com>) responding to the argument that the traditional "approach can lead to outcomes which some WIPO panels have considered unjust." It would only be "unjust" if an owner of a later acquired mark were entitled to a domain name corresponding to its mark, but that is not the law and to assert it would give the mark owner more rights than the law grants.

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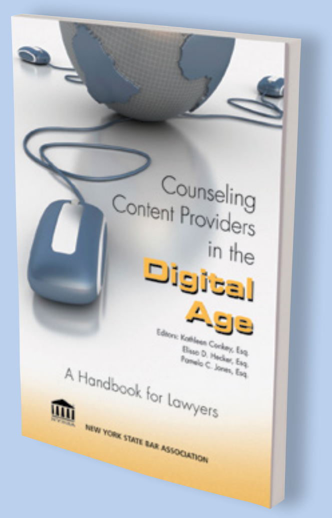

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