



2000 K STREET, N.W.  
SUITE 600  
WASHINGTON, D.C. 20006  
TEL: 202-429-8970

[www.lermansenter.com](http://www.lermansenter.com)

November 20, 2003

## Cybersquatting: Prevention and Remedies for Broadcasters

Although the initial “land grab” for domain names on the Internet has subsided somewhat in recent years, domain name theft continues to be a significant problem for radio and television stations. Opportunistic domain name registrants continue to register trademarks, slogans, and other on-air identifiers of stations that have not adequately protected their intellectual property. These instances of domain name theft infringe the trademark rights of the station in question, mislead consumers as to the nature of the station’s programs, and can seriously damage a station’s reputation.

Many legal remedies are now available to fight this behavior, but the best option by far is to prevent it from happening in the first place. To this end, there are several steps that radio and television stations can take to protect themselves from becoming victims of cybersquatting. These include:

- implementing a domain name registration and maintenance plan that includes preemptive registration of domain names
- registering the station’s important trademarks, slogans, and other on-air identifiers with the U.S. Patent and Trademark Office
- keeping complete records of the trademarks, slogans, and other on-air identifiers used by the station
- being aware of the available legal remedies and pursuing them when necessary.

### Cybersquatting

Cybersquatting is the registering of, trafficking in, or use of domain names with a bad-faith intent to profit from the goodwill of another party’s trademark.

Cybersquatters often register domain names that incorporate a station’s call letters and/or slogans in order to misdirect the station’s listeners to their own or other Websites. These Websites are often pornographic and may tarnish the reputation that a station has worked



hard to develop.

In some cases, cybersquatters register a particular domain name simply to prevent a station from using it. Sometimes this is done by an individual who has no connection to the station; other times, it's a prank perpetrated by a competitor's employee, such as a news director or on-air personality. In still other cases, a cybersquatter may hold a domain name hostage in an attempt to extort a large sum of money from the station that owns the trademark.

### **Domain Name Registration and Maintenance Plan**

The best way to prevent becoming the victim of a cybersquatter is to create and implement a domain name registration and maintenance plan. This involves the following steps:

- Assemble an inventory of all trademarks, slogans, and other on-air
- identifiers used by the station, including combinations and variations of these marks (for example, not only WXYZ, but also 77WXYZ or WXYZTV7).
- Preemptively register these marks as domain names in all the top-level domains (TLDs) relevant to the station, such as .com, .net, .tv, .am, .fm, or .info. Determining which marks and which combination of marks should be registered (and in which TLDs) is a decision that should take both business and legal factors into consideration.

Centralize the administration of all domain name registration and maintenance. In particular, charge one or two people with responsibility for keeping track of all domain name registrations so that these registrations are not inadvertently allowed to expire. This should include instituting a rigorous docketing system that provides a station with adequate notice of all upcoming domain name renewal dates. Frequently, domain names that are allowed to expire quickly fall into the hands of cybersquatters, who use specially designed software to identify and then immediately register such domain names.

A station should maintain all domain names that use any valuable trademarks or on-air identifiers, regardless of whether the domain names are currently being used to link to the station's Website or are temporarily or permanently inactive. Allowing the registration of any domain name to lapse is an open invitation to cybersquatters. In addition, it is inexpensive to maintain these registrations (Network Solutions currently charges only \$19 per year for a five-year renewal), especially when compared to the costs of filing a complaint and the accompanying legal fees.

Register all domain names in the name of the station or parent company, never in the name of an individual. If registered in the name of an individual who eventually leaves the station, the domain name could travel with the ex-employee, leaving the station in a position of having a valuable asset controlled by an outside party.



Further, make certain that all domain name contact information is kept current. This will ensure that the station receives all correspondence relating to the domain name, especially vital information from the registrar that could affect the continued validity of the registration.

### Available Legal Remedies

If, despite having taken these steps, a station nonetheless falls prey to a cybersquatter, several legal remedies are available. In addition to the traditional legal remedies for trademark infringement, stations can now bring a cause of action in federal court under the Anticybersquatting Consumer Protection Act, 15 U.S.C. §1125(d), a statute enacted in November 1999 to target the bad-faith registration of domain names that incorporate well-known trademarks. The Internet Corporation for Assigned Names and Numbers (ICANN) has also developed a less expensive and more streamlined administrative remedy called the Uniform Domain Name Dispute Resolution Policy. The UDRP requires domain name registrars to transfer a domain name registration to a complainant after a finding by an administrative panel. Unlike with civil litigation, the UDRP does not provide for monetary damages, but it does offer a quick and highly effective means for securing the transfer of an improperly registered domain name.

Under the UDRP, the owner of a trademark can obtain the transfer of a domain name that incorporates that mark if it can demonstrate all of the following four factors:

- It has established trademark rights in the claimed mark.
- The domain name is identical or confusingly similar to the complainant's trademark.
- The domain name registrant lacks a legitimate interest in the domain name.
- The domain name was registered in bad faith.

Of these factors, the most critical are the bad faith of the domain name registrant and the complaining party's rights in the claimed trademark.

The UDRP lists a non-exclusive set of criteria for determining whether a domain name has been registered in bad faith. These include:

- circumstances indicating that the domain name registrant acquired the domain name primarily for purposes of selling, renting, or otherwise transferring the domain name to the trademark owner or a competitor of the trademark owner
- registration of the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, coupled with a pattern of such conduct by the registrant
- registration primarily for purposes of disrupting the business of a competitor



- registration of the name to intentionally attract, for commercial gain, Internet users to the registrant's Website by creating a likelihood of confusion with the complainant's mark.

Assuming the domain name was indeed registered in bad faith, gathering the evidence to prove the existence of one or more of the factors listed above should be relatively easy.

### **Proving Trademark Rights**

For radio and television stations, the more difficult issue is usually proving their rights to a particular trademark, including their call letters or on-air identifiers. This is because these stations often do not register their marks with the U.S. Patent and Trademark Office or relevant state authorities, despite the fact that evidence of a trademark registration, and in particular a federal trademark registration, constitutes strong evidence of a party's rights to a particular mark.

Stations should, therefore, register their call letters and current on-air identifiers and slogans with the PTO, or at least with the state trademark authority, whenever possible. Taking these steps before a problem arises greatly increases a station's ability to quickly enforce its trademark rights and strengthens its position in a UDRP or other legal proceeding.

Without evidence of a federal and/or state registration, the party claiming rights to the trademark must provide documentary evidence to establish its common-law rights in the mark—that is, rights in the trademark acquired through continuous and exclusive use. (Indeed, it is useful to provide such evidence even if the mark in question has been registered.) Such evidence can include printouts from station Websites, references to the station and its trademark in the general and/or industry press, and copies of awards and testimonials the station may have received from industry, charitable, and local organizations specifically referring to the station and its mark. Advertising samples and evidence of expenses incurred promoting a particular mark also help. When the infringing domain name comprises the station's call letters, copies of Arbitron reports and relevant FCC records are also useful.

It can be difficult, however, to assemble sufficient evidence when a station fails to keep records of this kind of information. In anticipation of potential trademark and domain name disputes, it is therefore critical that stations keep such information on file. Having these records on hand will greatly facilitate the preparation of a UDRP or other legal complaint, thereby saving stations considerable time and money.

Many stations fail to adequately protect their valuable trademarks and slogans until a serious problem arises, and this lack of attentiveness can result in substantial legal complications and costs. The better approach is to register and vigorously maintain a station's trademark and domain name inventories before a problem arises. Although this does not guarantee that a third party will not incorporate a station trademark in a domain



name, it certainly strengthens the station's position in the event of such an occurrence and significantly improves the likelihood of prevailing in any legal dispute that may arise.

*Louis Levy is an attorney at Lerman Senter PLLC, where he specializes in trademark and unfair competition law; llevy@lermansenter.com; 202.416.6748.*