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Noncommercial Use Of Trademark As Domain Name Legal

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HAIR TODAY, GONE TOMORROW: NONCOMMERCIAL USE OF A TRADEMARK AS A DOMAIN NAME IS NOT INFRINGEMENT UNDER THE U.S. TRADEMARK (LANHAM) ACT

By David R. Ellis, Attorney at Law
Largo, Florida

In April 2005, a federal appeals court in California ruled that the noncommercial use of a trademark as the domain name of an Internet website is not actionable under the U.S. Trademark (Lanham) Act, where the website contained consumer commentary about the products and services represented by the mark. Bosley Medical Institute, Inc. v. Bosley Medical Group, No. 04-55962 (9th Cir. Apr. 4, 2005). The Ninth Circuit Court of Appeals upheld the district court's dismissal of the trademark owner's trademark infringement and dilution claims, concluding that the consumer's use of the mark was not "in connection with the sale of goods or services" and therefore was "noncommercial."

The court rejected the argument that the commercial use requirement was established because the website was aimed at preventing other consumers from obtaining or using the plaintiff's goods and services, expressly rejecting the reasoning of the Fourth Circuit in People for the Ethical Treatment of Animals v. Doughney, 263 F.2d 359 (4th Cir. 2001). The court did, however, restore the plaintiff's claim under the Anticybersquatting Consumer Protection Act for further adjudication.

The plaintiff, Bosley Medical, is in the business of providing surgical hair transplantation, restoration, and replacement services to the public. Bosley owned the registered trademark BOSLEY MEDICAL, having used the mark since 1992, and registered it with the United States Patent and Trademark Office in January 2001. Since its adoption of the trademark, Bosley had spent millions of dollars on advertising and promotion throughout the United States and the rest of the world.

The defendant, Michael Kremer was a dissatisfied former patient of Bosley. Unhappy with the results of a hair replacement procedure performed by a Bosley physician, he sued Bosley for medical malpractice but the suit was eventually dismissed. In January 2000, "in a bald-faced effort to get even," Kremer purchased the domain name www.BosleyMedical.com and started a website that was highly uncomplimentary of the plaintiff. Bosley then sued Kremer for trademark infringement, dilution, unfair competition, cybersquatting, and various state law claims, plus a libel claim that was eventually settled.

In his defense to the trademark claims, Kremer argued that his use of the Bosley Medical name was noncommercial and thus not actionable as infringement under the Lanham Act. The appeals court agreed, ruling that the noncommercial use of a trademark as the domain name of a website — the subject of which is consumer commentary about the products and services represented by the mark — does not constitute infringement under the Lanham Act.

In an earlier case in the Second Circuit, it was held that the "use in connection with the sale of goods and services" requirement of the Lanham Act does not require any actual sale of goods and services. United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86 (2d Cir. 1997). Thus, the proper inquiry was whether Kremer offered competing services to the public. Kremer was not Bosley's competitor; he was their critic. Therefore, his use of Bosley's mark was not in connection with a sale of goods or services — it was in connection with the expression of his opinion about Bosley's goods and services.

The court said that the Lanham Act was expressly enacted to be applied in commercial contexts, but it does not prohibit all unauthorized uses of a trademark. Kremer's use of the Bosley mark would not mislead consumers into buying a competing product, nor was Kremer capitalizing on the good will Bosley had established in its mark. Any harm to Bosley would arise not from a competitor's sale of a similar product under Bosley's mark, but from Kremer's criticism of their services. The court said that Bosley could not use the Lanham Act either as a shield from Kremer's criticism, or as a sword to shut him up.

As to the plaintiff's cybersquatting claim under the Anticybersquatting Consumer Protection Act, however, the court said that this raised a different issue, namely whether Kremer had a "bad faith intent to profit" from the use of the plaintiff's trademark in his domain name, such as by making an extortionate offer to sell the BosleyMedical.com name and website site to the plaintiff. Because discovery regarding that claim had not been completed, and the issue itself was not within the scope of the summary judgment motions, the appeals court said that the district court had erred in granting summary judgment to Kremer as to cybersquatting.

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