



by **JERRY ABELES**

COURTS MUST WEIGH THE CLAIMS OF TRADEMARK HOLDERS AGAINST THE RIGHTS OF DOMAIN NAME REGISTRANTS

DOMAINS IN THE BALANCE

LIKE TRADEMARKS and copyrights, domain names have become a part of the intellectual property rights portfolio of many businesses. Commercial and noncommercial uses of domain names may violate statutory or common law, and legal action can wrest control of a domain name from someone who uses it for improper or illegal purposes. At the same time, it may be perfectly legal for an individual or company to acquire rights to a domain name even if the name is a well-recognized trademark that belongs to someone else.

Acquiring a domain name is typically simple and inexpensive. Through services such as GoDaddy, anyone can register a domain name for as little as \$2.99 per year. If the desired name is already registered to someone else but is not being used, the owner may be willing to sell it. Pricing for active domain names varies widely, from a few dollars to multiple millions.¹

While acquisition of a domain name is easy, there are several ways that the use of a domain name can result in liability even if the name is acquired properly. Successful claims for cybersquatting, trademark infringement, false advertising under the Lanham Act, and conversion have been brought against individuals and companies that lawfully acquired domain names. On the other hand, if a domain's owner makes no effort to monetize it (for example by selling products or services through the domain or trying to

sell the domain to the trademark holder) courts have found that domain name owners have no legal liability even when the domain name includes a trademark or a personal name.

The Coca-Cola trademark can be used as an example. The mark is unquestionably one of the most recognized and valuable marks in the world.² Nevertheless, if a person or company other than Coca-Cola had registered and used the domain name *cocacola.com* before the real Coca-Cola Company acquired it, that would not have been inherently improper or illegal.³

How a domain name is used determines its propriety and the owner's potential liability. If the owner of *cocacola.com* offered to sell the domain name to the Coca-Cola Company, the owner could run afoul of the Anticybersquatting Consumer Protection Act (ACPA).⁴ By the same token, if the domain owner offered Pepsi advertising space on the site or tried to sell the domain name to Pepsi for Pepsi's advertising purposes, that use would likely constitute trademark infringement or a Lanham Act violation.

On the other hand, if the domain owner used the domain name *cocacola.com* in good faith on

Jerry Abeles is a partner in the complex business litigation department in the Los Angeles office of Arent Fox LLP. He represented the defendant in *Palermo v. Underground Solutions, Inc.*

a Web site for noncommercial purposes only—perhaps to describe the history of the creation of Coca-Cola or to provide facts regarding the connection between childhood obesity and sweetened carbonated beverages—it is unlikely that the Coca Cola Company, as the trademark holder, would have a legal basis to challenge that use.

The owner of a domain name has a protectable property right in the name. In *Kremen v. Cohen*,⁵ the plaintiff had the foresight

ing favorably about pipe made from HDPE, a competing material.⁸

Palermo filed suit in the Southern District of California, alleging that Underground Solutions registered the domain name *genepalermo.com* and supplied “written content and photographs that purport to show the ‘facts’ about HDPE piping,” including that it is “dangerous to use, highly fragile, and prohibitively expensive to fix.” Palermo’s complaint was based on his claim that the

sored, or approved Defendant’s product, fusible PVC.”¹⁰

The court reached the same conclusion in connection with the state law misappropriation of likeness claim, under Civil Code Section 3344, which requires a showing that commercial use of one’s identity resulted in injury. Further, the court rejected Palermo’s Section 17200 claim for lack of standing, as he submitted no evidence that he had suffered any injury from the existence of the site. As

In *Nissan Motor Company v. Nissan Computer Corporation*, the defendant computer store derived its name from its owner, Uzi Nissan, who used his name for several businesses and registered the domain name *nissan.com* in 1994. Five years later, in addition to advertising his store’s products, the defendant started advertising for automobile-related products and services on the *nissan.com* site. The plaintiff automobile manufacturer then sued for dilution under the Federal Trademark Dilution Act.

to register *sex.com* in 1994, before the then-sole domain registrar Network Solutions started charging for registrations. The defendant, called “con man Cohen” by the Ninth Circuit, convinced Network Solutions, through use of a forged letter, that the plaintiff had assigned the rights to the domain name to him. Without undertaking any investigation, Network Solutions transferred the domain name to Cohen, who in turn launched “a lucrative online porn empire.” The plaintiff obtained an uncollectible judgment against Cohen, so he asserted claims against Network Solutions, including a claim for conversion. The district court rejected the claim, ruling that the tort of conversion did not apply. The Ninth Circuit reversed, observing, “Negligent or not, it was Network Solutions that gave away Kremen’s property.”⁶

Cases that have considered the use or misuse of domain names often focus on whether the site has a private or commercial purpose. If there is no competitive advantage or anti-competitive purpose, courts have sometimes upheld the use of domain names that comprise others’ trademarks or even personal names.

In *Palermo v. Underground Solutions, Inc.*, the plaintiff was a self-proclaimed “internationally recognized expert” in the plastic piping industry who “has become a champion for certain types of [plastic] piping.”⁷ His promotion of plastic pipe—rather than competing products made from ductile iron, steel, or concrete—was not unequivocal. Rather, Palermo routinely gave presentations “highlighting the risks associated with using fused PVC,” a product developed and sold exclusively by Underground Solutions, while speak-

“content of this website is completely inimical to the views that Dr. Palermo maintains and has publicly espoused throughout his career.”⁹

Based on the content on the *www.genepalermo.com* site, Palermo asserted Lanham Act claims for false designation of origin and false association, misappropriation of likeness, and unfair competition under Business and Professions Code Section 17200. The court examined the Web site, which does not mention Palermo’s name or the products or services of Underground Solutions. Rather, the site contains links to 14 instances of HDPE pipe failures, including descriptions of the failure mode and the costs that municipal purchasers paid to repair or replace HDPE pipe.

The court rejected Palermo’s motion for preliminary and permanent injunctions, primarily due to the absence of a commercial use for the Web site, an element of Palermo’s claims. The court noted that while Underground Solutions sells Fusible PVC pipe, a product that competes with HDPE pipe, Palermo himself does not sell HDPE pipe or any product. Nor did Palermo submit any evidence that Underground Solutions earned revenue from the Web site, which does not mention the company or any of its products. The site listed no products for sale, had no links to any other site, did not collect information from visitors, and did not contain advertising. Based on that evidence, the court concluded that for the Lanham Act claim, “the facts in the record are not sufficient to show that a visitor to the website would believe that Gene Palermo originated, spon-

such, there was a lack of probable success on the merits, so the court denied the motion for injunctive relief.”¹¹

Only nine days after the Southern District’s decision in *Palermo*, a decision from the Central District of California that involved personal names being used as domain names was decided the other way. In *Branca v. Mann*, the plaintiffs, executors of Michael Jackson’s estate, sued multiple defendants who created domain names—including *michaeljacksonsecretvault.com* and *MJ-gives.com*—that displayed the singer’s copyright-protected songs and videos.¹² As in *Palermo*, the plaintiffs’ claims included false designation of origin under the Lanham Act and misappropriation of likeness under Civil Code Section 3344.1, although only a cybersquatting claim related to the domain names. The court granted the plaintiffs’ motion for summary judgment on the cybersquatting claim based on “undisputed evidence that Defendants intended in bad faith to profit from use of Jackson’s name, by registering multiple domain names containing his name or the initials ‘MJ’ to sell Jackson-related products.”¹³

The *Palermo* and *Branca* decisions were consistent with the Ninth Circuit’s holding in *Bosley Medical Institute, Inc. v. Kremer*.¹⁴ *Bosley Medical* is a registered trademark of the plaintiff, which provides hair restoration services. Michael Kremer was dissatisfied with the services provided by *Bosley*, so he created *bosleymedical.com*. On the site, Kremer published information that was highly critical of *Bosley*, including a summary about a district attorney investigation into the com-

MCLE Test No. 228

The Los Angeles County Bar Association certifies that this activity has been approved for Minimum Continuing Legal Education credit by the State Bar of California in the amount of 1 hour.

- The owner of a domain name does not have a protectable property right in the name if it includes a trademark that the domain owner does not own.
True.
False.
- Owners of a domain name that includes a trademark they do not own may be liable for cybersquatting if they seek in bad faith commercial gain from use of the name.
True.
False.
- Owners of a domain name that includes a trademark they do not own can be liable for trademark infringement if they seek commercial gain from use of the name.
True.
False.
- The owner of a domain that uses the name of a celebrity without permission will likely violate the Anticybersquatting Consumer Protection Act (ACPA).
True.
False.
- If the owner of coca cola.com does not own the Coca-Cola trademark but offers to sell the domain name to the Coca-Cola Company, the owner will likely be held in violation of the ACPA.
True.
False.
- In *Kremen v. Cohen*, the Ninth Circuit held that the plaintiff did not have a viable claim for conversion against a domain registrar that assigned ownership of a domain that he owned to a con man.
True.
False.
- Owners of a domain name that includes a trademark they do not own may commit trademark infringement by offering a competitor of the trademark holder advertising space on the site.
True.
False.
- In *Palermo v. Underground Solutions, Inc.*, the court found sufficient evidence to support Lanham Act claims.
True.
False.
- In *Palermo*, the court rejected Palermo's motion for injunctions based on the absence of commercial use of the Web site in question.
True.
False.
- In *Branca v. Mann*, the court found sufficient evidence to support Lanham Act claims.
True.
False.
- Palermo* and *Branca* are inconsistent with the Ninth Circuit's decision in *Bosley Medical Institute, Inc. v. Kremer*.
True.
False.
- In the *Bosley Medical* case, the Ninth Circuit found a Lanham Act violation.
True.
False.
- In *Nucal Foods, Inc. v. Kaye*, the court found a bad-faith intent to profit from registration of a domain name that included a trademark that the domain holder did not own.
True.
False.
- In *Nissan Motor Company v. Nissan Computer Corporation*, the Ninth Circuit upheld an injunction prohibiting a computer store owner from advertising the sale of automotive products on his nissan.com Web site.
True.
False.
- In the *Nissan Motor* case, the Ninth Circuit ruled that under the Federal Trademark Dilution Act, injunctive relief is available for noncommercial use of a trademark.
True.
False.
- In the *Nissan Motor* case, the Ninth Circuit also found that a permanent injunction implicated the First Amendment.
True.
False.
- In *West Coast Corvettes, Inc. v. MV Marketing, Inc.*, evidence of customer confusion contributed to a grant of injunctive relief.
True.
False.
- In the *West Coast Corvettes* case, the court did not find bad faith in the defendant's use of the name in question to divert Web traffic away from the plaintiff's site.
True.
False.
- Academy of Motion Pictures Arts and Sciences, Inc. v. GoDaddy.com, Inc.* concerns advertising revenue from Web sites that include a trademark.
True.
False.
- In the *GoDaddy.com* case, the court accepted the defendant's defense that as a domain name registrar, it was immune from suit under the ACPA.
True.
False.



Name _____

Law Firm/Organization _____

Address _____

City _____

State/Zip _____

E-mail _____

Phone _____

State Bar # _____

INSTRUCTIONS FOR OBTAINING MCLE CREDITS

- Study the MCLE article in this issue.
- Answer the test questions opposite by marking the appropriate boxes below. Each question has only one answer. Photocopies of this answer sheet may be submitted; however, this form should not be enlarged or reduced.
- Mail the answer sheet and the \$20 testing fee (\$25 for non-LACBA members) to:

Los Angeles Lawyer
MCLE Test
P.O. Box 55020
Los Angeles, CA 90055

Make checks payable to Los Angeles Lawyer.

- Within six weeks, Los Angeles Lawyer will return your test with the correct answers, a rationale for the correct answers, and a certificate verifying the MCLE credit you earned through this self-assessment activity.
- For future reference, please retain the MCLE test materials returned to you.

ANSWERS

Mark your answers to the test by checking the appropriate boxes below. Each question has only one answer.

- True False

DOUBLE BILLING APPROVED!

Earn 6.5 hours of MCLE credit while taking traffic school (live or) online.



MCLE 4 LAWYERS
CALIFORNIA TRAFFIC SCHOOL

www.mcle4lawyers.com

(310) 552-5382

DMV license no. TVS 1343 - Since 1997

GREG DAVID DERIN - MEDIATOR & ARBITRATOR

HONESTY • FAIRNESS • COMMITMENT • CREATIVITY • EXCELLENCE



AREAS OF EXPERTISE:

- Entertainment and Intellectual Property
- Contract and Business Torts
- Employment
- Real Property
- Corporate and Partnership

"Power Mediator" - *The Hollywood Reporter*, ADR SuperLawyer™
Faculty - *Harvard Negotiation Institute* (2004-2012)
Fellow - *Chartered Institute of Arbitrators*

310.552.1062 ■ www.derin.com

1925 CENTURY PARK EAST, LOS ANGELES, CALIFORNIA 90067

MEDIATORS SERVING LITIGATORS

Seasoned Litigators

Extensive experience representing plaintiffs and insured defendants

Trusted Mediators

Focusing on the core interests driving the dispute

Cost-Effective

Half Day \$1,200 | Full Day \$2,400



STEVEN M. SEPASSI
Attorney | Mediator
Personal Injury
Business Disputes
Insurance Litigation

LET'S SETTLE YOUR CASE

**SPECIALTY PROGRAM
PERSONAL INJURY
CASES**
\$500 flat fee for a 3 hour session
Visit our websites for details



MITCHELL M. TARIGHATI
Attorney | Mediator
Personal Injury
Real Estate Disputes
Employment Litigation

www.stevesepassi.com

818.887.2000

www.mitchtarighati.com

pany's practices and a link to the full investigative report. Significant to the court's consideration were the facts that "Kremer earns no revenue from the website and no goods or services are sold on the website. There are no links to any of Bosley's competitors' websites."¹⁵

Bosley sued for Lanham Act violations, including trademark infringement and cybersquatting. The Ninth Circuit agreed that the infringement claims were properly dismissed by the trial court. Noting that infringement claims "are subject to a commercial use requirement," the appellate court pointed to Supreme Court authority that "made it clear that trademark infringement law prevents only unauthorized uses of a trademark in connection with a commercial transaction in which the trademark is being used to confuse potential consumers." As there was no commercial use made of the Bosley Medical trademark, there was no Lanham Act violation. Finding that the only harm suffered by Bosley arose "from Kremer's criticism of their services," the court concluded that "Bosley cannot use the Lanham Act either as a shield from Kremer's criticism, or as a sword to shut Kremer up."¹⁶

Commercial use is not an element of a cybersquatting claim, so the lack of a commercial use does not bar such a claim.¹⁷ There does, though, have to be a showing of a bad-faith intent to profit from the use of the domain name that includes another's trademark.¹⁸ Bad faith is typically shown through evidence that the site is not being used or that the owner has offered to sell the domain name to the trademark holder. For example, in *Nucal Foods, Inc. v. Kaye*,¹⁹ the plaintiff, owner of the Cal Eggs common law trademark, attempted to register the domain name caleggs.com. When doing so, plaintiff discovered the domain name was already owned by the defendant. The plaintiff sent a cease-and-desist letter to the defendant. The defendant refused but offered to sell the domain name to the plaintiff for \$500,000. The plaintiff brought suit under the ACPA, alleging that the defendant registered the caleggs.com domain name in bad faith. The defendant failed to answer, and, after entry of default, the plaintiff moved for default judgment. The court found that the defendant registered the domain name for no purpose other than to offer it for sale to plaintiff. This was sufficient to show a bad-faith intent to profit and warranted imposition of a permanent injunction, an order directing the transfer of the caleggs.com domain name to the plaintiff, and an award of statutory damages and attorney's fees.²⁰

One of the most challenging issues in domain-name disputes arises when two persons or companies have comparable rights to

the same domain name, and neither desires to use the name for anticompetitive purposes. This situation arose in *Nissan Motor Company v. Nissan Computer Corporation*.²¹ In that case, the defendant computer store derived its name from its owner, Uzi Nissan, who used his name for several businesses and registered the domain name nissan.com in 1994.²² Five years later, in addition to advertising his store's products, the defendant started advertising for automobile-related products and services on the nissan.com site. The plaintiff automobile manufacturer then sued for dilution under the Federal Trademark Dilution Act (FTDA),²³ domain name piracy, unfair competition, and trademark infringement and false designation of origin under the Lanham Act.²⁴ After the lawsuit was filed and the plaintiff had obtained a preliminary injunction, the defendant posted a link on www.nissan.com and www.nissan.net to another site, which contained information about the lawsuit, information critical about the auto manufacturer, and links to auto-related advertising.²⁵

The district court granted the auto manufacturer's motion for summary judgment and permanently enjoined the defendant from "posting commercial content, advertising, and disparaging remarks or negative commentary regarding Nissan Motor on www

.nissan.com or www.nissan.net; and placing links to other websites containing commercial content or disparaging remarks and negative commentary about Nissan Motor."²⁶ The district court concluded that the two sites were commercial because they contained disparaging remarks about Nissan Motor while drawing visitors interested in Nissan Motor based on the domain name.

There was a mixed result on appeal. The Ninth Circuit noted that under the FTDA, injunctive relief is available if the defendant makes commercial use of plaintiff's mark in commerce, while noncommercial use is excepted.²⁷ Dilution, noted the court of appeals, is different from and broader than trademark infringement, for "neither confusion nor competition is required" for a dilution claim.²⁸ Dilution protection, however, requires evidence that the mark is famous, meaning that the use of the mark by the diluter diminishes the value of the mark in identifying the product with which it is commonly associated. A mark that is not "famous"—that is, does not have "such powerful consumer associations that even non-competing uses can impinge on their value"—does not receive protection from dilution.²⁹ Because the record was "clouded" with dozens of uses of "Nissan"—as a common last name, the name of a month in the Bible, part of the trademark or trade

name for more than 190 unaffiliated businesses in the United States, plus thousands of domain names that include the word "Nissan"—the court found that the record "at a minimum raises a question whether the mark can be considered a famous mark eligible for dilution protection."³⁰ Based on this conclusion, the Ninth Circuit determined that the injunction based on dilution was improper, and sent the case back to the district court for further consideration of the issue.

The Ninth Circuit also found that the permanent injunction violated the First Amendment, because it was a content-based restriction on the defendant's speech rights. The court rejected Nissan Motor's contention that the domain name is a mere "source identifier" rather than communicative message and thus did not implicate the First Amendment.³¹ The court adopted the position taken by the Fourth Circuit that "trademarks [should] not be 'transformed from rights against unfair competition to rights to control language.'"³²

The Ninth Circuit found for the automobile manufacturer, however, on its trademark infringement claim, but only to the extent that the www.nissan.com site included links to automobile-related Web sites. The court upheld summary judgment for the auto man-



Where Theory and Practice Meet

Preparing students to serve the needs of clients and the legal profession through a focus on the theoretical and practical aspects of law.

INDEPENDENT / INNOVATIVE / INSPIRING
Learn more at www.CaliforniaWestern.edu

CALIFORNIA WESTERN
SCHOOL OF LAW | San Diego

Law Firms 4 Sale

Want to retire? Want to plan for your life after law!

See Ed Poll's website
www.lawbiz.com for the tools you need to make a transition.

Want to buy a practice?

Ed can help!
Call today **800.837.5880**

TRUST DEED FORECLOSURES

"Industry Specialists For Over 25 years"

At Witkin & Eisinger we specialize in the Non-Judicial Foreclosure of obligations secured by real property or real and personal property (mixed collateral). When your clients needs a foreclosure done professionally and at the lowest possible cost, please call us at:

1-800-950-6522

We have always offered free advice to all attorneys.

**& WITKIN
EISINGER, LLC**

RICHARD G. WITKIN, ESQ. ♦ CAROLE EISINGER

LET US HELP YOU OVERCOME THE HURDLES IN YOUR CIVIL DISPUTES

WOODARD | MEDIATION

- Professional Malpractice
- Construction Defects
- Probates/Trusts & Estates
- Personal Injury

*LA County Volunteer Probate Mediator of the Year
2010, 2011, 2012*

CALL (626) 584-8000

or visit us online

www.woodardmediation.com



Confidence At The Courthouse.

Business litigation is increasingly complex. That is why we believe valuation issues must be addressed with the same meticulous care as legal issues. Analysis must be clear. Opinions must be defensible. Expert testimony must be thorough and articulate. HML has extensive trial experience and can provide legal counsel with a powerful resource for expert testimony and litigation support.

**HIGGINS
MARCUS
& LOVETT**
BUSINESS VALUATION

For More Information Call 213-617-7775

Or visit us on the web at www.hmlinc.com

BUSINESS VALUATION • LOSS OF GOODWILL • ECONOMIC DAMAGES • LOST PROFITS

manufacturer on trademark infringement as to automobile-related advertisements, and summary judgment for Nissan Computer as to all other advertisements.³³

A long-running dispute between competing Corvette restorers resulted in a preliminary injunction when one company used the other's trademark as a domain name to direct traffic to the infringer. In *West Coast Corvettes, Inc. v. MV Marketing, Inc.*, West Coast Corvettes had registered its name as a trademark, and used westcoastcorvette.com (singular Corvette) as its site.³⁴ Its competitor, "Corvette Mike," registered the domain westcoastcorvettes.com to redirect traffic to corvettemike.com. The plaintiff presented undisputed evidence of actual confusion by a customer and the media, plus evidence that the defendant had offered to sell the domain to the plaintiff. Based on that evidence, the U.S. District Court for the Central District of California issued a preliminary injunction, finding that the plaintiff was likely to prevail on the merits of its cybersquatting claim. Evidence presented at the preliminary injunction hearing showed that the defendant had registered and used the infringing domain, which consisted only of the plaintiff's mark; the plaintiff's mark was distinctive; the defendant's domain name was confusingly similar to the plaintiff's mark; and the defendant had a bad faith intent to profit from the plaintiff's mark by 1) having no independent intellectual property rights to the name, 2) using the name to divert Web traffic away from the plaintiff, and 3) offering to sell the domain name.³⁵

An unusual commercial "use" of a domain name arose in *Academy of Motion Pictures Arts and Sciences, Inc. v. GoDaddy.com, Inc.*³⁶ GoDaddy operates a parked pages service, whereby it monetizes domain names registered by its customers by either pointing the customers' domain names to a GoDaddy affiliate page that contains advertising, for which GoDaddy alone collects revenues, or placing advertisements directly on the customers' pages.³⁷ The plaintiff brought claims for cybersquatting and unfair business practices, alleging that hundreds of the Web sites included in the parked pages service include plaintiff's trademarks of Oscar, Oscars, Oscar Night, Academy Award, and Academy Awards in the domain names. While the court found that there was a triable issue of fact whether the five marks were famous, the court rejected the defendant's defense that as a domain name registrar, it was immune from suit under the ACPA. The court concluded that the parked pages service was distinct from the registration services provided by GoDaddy, and that GoDaddy both used and trafficked in the domain names employed by that service, taking the company outside

the registration services safe harbor.³⁸ Given the facts that other domain name registrars engage in similar commercial practices and the ACPA provides a safe harbor for registrars, and given the highly lucrative nature of the practice, it is likely that GoDaddy will ask the Ninth Circuit to review the trial court's decision.

As the use of domain names becomes more clever and varied, courts will have to become more creative in balancing and interpreting the various constitutional and statutory considerations involved. ■

¹ The most expensive domain name is insure.com, which reportedly was purchased in 2009 for \$16 million. See <http://most-expensive.com/domain-name> (accessed June 26, 2013).

² Coca-Cola ranked third on a list of the world's most valuable brands compiled by *Forbes*. See *Apple Tops List of the World's Most Powerful Brands*, FORBES (Oct. 22, 2012).

³ "The mere registration of a domain name does not constitute a commercial use," so no Lanham Act liability attached. *Academy of Motion Picture Arts and Sciences v. Network Solutions, Inc.*, 989 F. Supp. 1276, 1279 (C.D. Cal. 1997); see also *Panavision Int'l, L.P. v. Toeppen*, 141 F. 3d 1316, 1324 (9th Cir. 1998).

⁴ 15 U.S.C. §1125(d). See also *Bosley Medical Inst., Inc. v. Kremer*, 403 F. 3d 672, 680 (9th Cir. 2005) (citing *DaimlerChrysler v. The Net Inc.*, 388 F. 3d 201, 204 (6th Cir. 2004) ("[C]ybersquatting occurs when a person other than the trademark holder registers the domain name of a well known trademark and then

attempts to profit from this by either ransoming the domain name back to the trademark holder or by using the domain name to divert business from the trademark holder to the domain name holder.").

⁵ *Kremen v. Cohen*, 337 F. 3d 1024 (9th Cir. 2003).

⁶ *Id.* at 1035.

⁷ *Palermo v. Underground Solutions, Inc.*, 2012 WL 3134255, at *1 (S.D. Cal. Aug. 1, 2012).

⁸ An HDPE pipe manufacturer paid Palermo to give the presentations, but Palermo did not disclose that financial arrangement. *Underground Solutions* did, which resulted in a separate defamation claim that the trial court rejected. See *id.* at *7-8.

⁹ *Id.* at *1.

¹⁰ *Id.* at *4.

¹¹ *Id.* at *4-6.

¹² *Branca v. Mann*, 103 U.S.P.Q. 1993, 2012 WL 3263610, at *1 (C.D. Cal. Aug. 10, 2012).

¹³ *Id.* at *6.

¹⁴ *Bosley Medical Inst., Inc. v. Kremer*, 403 F. 3d 672 (9th Cir. 2005).

¹⁵ *Id.* at 675.

¹⁶ *Id.* at 676, 680.

¹⁷ *Id.* at 680-81.

¹⁸ 15 U.S.C. §1125(d).

¹⁹ *Nucal Foods, Inc. v. Kaye*, 2013 WL 1680643 (E.D. Cal. Apr. 17, 2013).

²⁰ *Id.*, findings and recommendations adopted in full, with additional analysis, at Case 2:12-cv-02754-KJM-AC, ECF 18 (E.D. Cal. June 25, 2013).

²¹ *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F. 3d 1002 (9th Cir. 2004).

²² *Id.* at 1006.

²³ 15 U.S.C. §1125(c).

²⁴ 15 U.S.C. §1114.

²⁵ *Nissan Motor Co.*, 378 F. 3d at 1008.

²⁶ *Id.* at 1109.

²⁷ *Id.* at 1010 (citing 15 U.S.C. §1125(c)(4)(B)).

²⁸ *Id.* at 1011 (citing *Avery Dennison Corp. v. Sumpton*, 189 F. 3d 868, 873 (9th Cir. 1999)).

²⁹ *Id.* (citing *Avery Dennison*, 189 F. 3d at 875).

³⁰ *Id.* at 1014.

³¹ *Id.* at 1016.

³² *Id.* at 1017 (citing *CPC Int'l, Inc. v. Skippy Inc.*, 214 F. 3d 456, 462 (4th Cir. 2000)).

³³ *Id.* at 1019.

³⁴ *West Coast Corvettes, Inc. v. MV Marketing, Inc.*, 2012 WL 1401433 (C.D. Cal. Apr. 23, 2012).

³⁵ *Id.* at *7-9; see also *eAdGear, Inc. v. Liu*, 2012 WL 2367805 (N.D. Cal. June 21, 2012) (granting application for default judgment on claims for false designation of origin, trademark dilution, and cyberpiracy, upon showing of likely confusion between plaintiff's trademark and domain, eadgear.com, and defendant's domain, eadgear.ca); *International Oddities, Inc. v. Domestic Oddities Wholesale Distrib. LLC*, 2012 WL 3656529 (C.D. Cal. Aug. 23, 2012) (stipulated permanent injunction against defendants' further use of domesticoddities.com and similar domains, which were confusingly similar to plaintiff's domain internationaloddities.com); *Facebook, Inc. v. Banana Ads LLC*, 2013 WL 1873289 (N.D. Cal. Apr. 30, 2013) (Defendants maliciously registered dozens of domain names similar to plaintiff's trademark through "typosquatting," with domains such as facbeok.com, facebkkk.com, and favebooo.com.).

³⁶ *Academy of Motion Pictures Arts and Sciences, Inc. v. GoDaddy.com, Inc.*, CV 10-3738 ABC (CWx) (C.D. Cal. 2010).

³⁷ *Id.*, Order Re: (1) Plaintiff's Motion for Partial Summary Judgment; and (2) Defendants' Motion for Summary Judgment, ECF No. 491 (June 21, 2013), at 4.

³⁸ *Id.* at 15.

NORIEGA CHIROPRACTIC CLINICS, INC.

JESS T. NORIEGA, D.C.

Is proud to announce the opening of our Lynwood location

SERVICING: SOUTHGATE • BELLFLOWER • CUDAHY • NORTH LONG BEACH • WATTS

LYNWOOD HEALTH CENTER

11123 LONG BEACH BLVD.
LYNWOOD, CA 90262
(310) 604-6940

HUNTINGTON PARK
HEALTH CENTER
3033 E. Florence Ave.
Huntington Park, CA 90255
(323) 582-8401

ONTARIO HEALTH
SERVICES
602B N. Euclid Ave.
Ontario, CA 91764
(909) 395-5598

WHITTIER HEALTH
SERVICES
13019 Bailey Ave. Suite F
Whittier, CA 90601
(562) 698-2411

MONTEBELLO HEALTH
CENTER
604 North Monetebllo Blvd.,
Montebello, CA 90640
(323) 726-8818

SOUTH CENTRAL
HEALTH CENTER
4721 S. Broadway Blvd.
Los Angeles, CA 90037
(323) 234-3100

HIGHLAND PARK
HEALTH CENTER
5421 N. Figueroa St.
Highland Park, CA 90042
(323) 478-9771

1•800•NORIEGA

Personal Injury cases accepted on lien basis.

1•800•667•4342