

## Don't Forget the Gripe Site

Every day businesses and individuals establish a presence on the Internet by purchasing an Internet domain name and setting up a web site. Perhaps you have recently done so. Typically, the domain name you have purchased is identical or closely related to the name of your company or primary product or service. You may assume that by purchasing a domain name matching your business name or product, you have secured the relevant domain names for your business or product. You may be surprised to learn that while you have obtained a domain name to match your business name, someone else may purchase variations of your domain name, including those which are less than flattering. Those same elements that allow the creation of numerous legitimate sites—the ease and low cost of purchasing a domain name and setting up a website, together with the proliferation of domain name extensions—provide unprecedented opportunities to a disgruntled employee or unhappy customer to generate bad publicity in cyberspace by establishing a gripe site. The negative publicity created by the gripe site is compounded when prominent search engines pick it up or when it is discussed in printed publications. This article discusses how this practice exists within the confines of the law.

### I

A gripe site is a web site created and maintained by someone other than the owner or user of a particular name or mark, that gripes publicly about that owner's ideas, service or product. The gripe site is supposedly created to publicize a specific wrong by describing a version of the facts which supports a gripe. The site might center on a

single transaction or could be a bulletin board inviting others to post their complaints about the same company or product. Some examples include a mockup of PETA's activities (before PETA established a site), equifaxeatspoop.com, and capellauniversitysucks.us. While trademark owners aggressively protect their rights (which must be done), they are sometimes unable to force the gripe site's closure. In addition, the aggressiveness of those owners in protecting their valuable marks often fuels the gripe sites owner's attacks and generates greater publicity of the gripe site's existence.

### II

Many people are under the impression that if you own a trademark or use a particular name in connection with your product or business, no one else can use that mark or name as a domain name. Like so much else, it depends. Trademark law, and to some degree unfair competition laws, seek to prevent confusion among products and services. If a consumer recognizes a product because that product carries a distinctive mark, another should not be allowed to confuse the public by using that mark and capitalizing on that hard-earned recognition. If you sell a dark soda called Pepsi, the public may reasonably think that your product is in fact a Pepsi product and will buy your soda for that reason. You would be using Pepsi's trademark to confuse the public, enriching yourself and injuring Pepsi.<sup>1</sup> This is what the law seeks to protect.

However, unauthorized use of a mark or name is not always trademark infringement or unfair competition. First, free speech allows a great deal of latitude in one's public expression (provided that is all it is), even where the

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gripe site's domain name is identical to a mark. Second, variations of a domain name which are different enough to prevent confusion can provide venues in cyberspace for public expression without infringing a trademark. Adding the word "sucks" or "sux" to a name is particularly popular—www.fordreallysucks.com must keep Ford executives up at night. Nonetheless, neither free speech nor obvious variations are always enough to shield a gripe site from claims of infringement. We now turn to how a gripe site intersects with the law.

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### III

A key element in determining the legal viability of a gripe site is whether the gripe site generates commercial activity or benefit for its owner. Whether a gripe site is a money making venture, by selling products, hosting advertisements, providing links to other commercial sites for a fee, or even by offering for sale the domain name itself (or putting a price on the site's closure), can make a real difference in whether the gripe site stays or goes. The reason why this matters is the reason why gripe sites are allowed to survive.

Gripe site owners typically rely on two principal arguments in response to claims of infringement. First, as the entire purpose of the gripe site is to voice an opinion about a service or product, the gripe site is protected free speech. Second, that the gripe site's use of a mark is a "fair use" of the mark.<sup>2</sup> Using a gripe site for any commercial activity, however, undermines both of those arguments and may very well lead to the gripe site's closure and the forced transfer of the gripe site domain name to the owner of the mark. Thus, a griper who, for example, generates revenue through linking cannot avail himself of free speech and/or fair use defenses.

The intent of a griper can also play a role. Free speech and fair use offer no support to a griper that has no gripe but instead uses another's very well known mark hoping to gain access to that large audience. This can also be true where a griper establishes a site solely to injure a mark's owners by diverting traffic away from the owner's legitimate site or by

buying multiple domain names which are all related to the infringed mark. This kind of conduct is often referred to as bad faith which is a consideration when determining the legality of a gripe site.<sup>3</sup>

As mentioned earlier, domain names ending in "sucks" are popular. As a string of cases brought before a World Intellectual Property Organization ("WIPO") panel

involving National Westminster Bank ("NatWest") illustrate, using the word sucks in a domain name, and griping about a service (or product) is not a free pass allowing the gripe site to survive. In that case, the point of the site was not to discuss gripes but to damage the mark and its owner. Thus, although there was no commercial activity, the claim of free speech was insufficient as it was obvious that the griper intended nothing more than to injure and tarnish NatWest and its marks; free speech was not the objective. This, among other things, supported the panel's finding that the gripe site was established in bad faith. In addressing generally the tension between free speech and bad faith, the panel stated that the griper was free to establish a site which would not infringe on or be confusing with that mark, and provide a forum for free speech.

Although there have been many gripe-site cases heard before WIPO panels and in Federal court, uniformity in WIPO and court decisions are only now beginning to develop. Clearly, many issues must be considered prior to commencing or defending a gripe site related claim. For more detailed information, or to discuss the particulars of your case, please contact us at (212) 765-4567 or [info@thesilberlawfirm.com](mailto:info@thesilberlawfirm.com).

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1. From a damages perspective, it is important to note that Pepsi is not only injured by the loss of that sale. If, for example, your product was of poor quality, the consumer's impression of Pepsi will be damaged and that consumer may no longer buy Pepsi products.

2. Very briefly, a defense of fair use is one where someone who uses another's protected mark claims that although the mark is protected, that particular use does not infringe the mark. Some examples include using a protected mark as an obvious parody or for inclusion in a school textbook.

3. In certain narrow circumstances under the law, bad faith may be the only issue considered.