

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

Nos. 04-2011, 04-2122

CHRISTOPHER LAMPARELLO,

Appellant/Cross-Appellee,

v.

JERRY FALWELL, et al.,

Appellees/Cross-Appellants.

On Appeal from the United States District Court
For the Eastern District of Virginia

**BRIEF OF AMICI CURIAE AMERICAN CIVIL LIBERTIES UNION
AND AMERICAN CIVIL LIBERTIES UNION OF VIRGINIA
IN SUPPORT OF APPELLANT CHRISTOPHER LAMPARELLO**

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INTEREST OF *AMICI CURIAE*

The American Civil Liberties Union (ACLU) is a nationwide, nonprofit, nonpartisan organization with over 400,000 members that is dedicated to preserving the principles of liberty and equality embodied in the Constitution and this nation's civil rights laws. The ACLU of Virginia is one of its state affiliates. One of the ACLU's most fundamental goals is the protection of the freedom of speech under the First Amendment, and the organization has been at the forefront of defending free speech on the Internet. *Amici* have appeared before this Court on numerous occasions, both as direct counsel and as *amicus curiae*.

STATEMENT OF THE CASE

Appellants adopt the Statement of the Case set forth in the Appellant's brief.

STATEMENT OF FACTS

Jerry Falwell ("Falwell") is an internationally known religious figure with controversial positions on many social and political issues. Among other things, Falwell is well known for his view that homosexuality is prohibited by the Bible. Falwell has an official website with the domain name falwell.com.

Christopher Lamparello ("Lamparello") is repulsed by Falwell's views on homosexuality, and has set up a website at fallwell.com devoted to criticizing those

views. Lamparello does not offer any goods or services for sale on the site and receives no revenue from it. At the top of the fallwell.com website is a prominent disclaimer stating: *“This website is NOT affiliated with Jerry Falwell or his ministry. If you would like to visit Rev. Falwell's website, you may click [here](#).”* When a viewer clicks on the word “here,” he is directed Falwell’s official site.

SUMMARY OF ARGUMENT

Lamparello’s fallwell.com site is an example of the Internet’s immense power to allow ordinary citizens to criticize the great and powerful. Not surprisingly, those targeted by these sites have looked for ways to shut them down. In this case, Falwell has sued Lamparello under various provisions of the Lanham Act to prevent him from using Falwell’s mark in his domain name. Lawsuits of this type threaten to undermine the power of the Internet as a universal soap box. It is of vital importance that courts fulfill their responsibility as defenders of free speech by rigorously applying First Amendment principles to claims of trademark infringement on the Internet.

Lamparello’s use of the fallwell.com domain name deserves the highest First Amendment protection. To begin with, Lamparello’s website is purely noncommercial, a fact that weighs in his favor in two related ways. First, noncommercial speech has only a tangential relationship to the purposes of the

trademark laws – protecting a producer’s investment in its mark and allowing consumers to be confident of the source of products. Second, Lamparello’s website constitutes “core” political speech under the First Amendment, and is not subject to the same degree of regulation as commercial speech.

Moreover, Lamparello’s domain name serves important communicative purposes that have traditionally received First Amendment protections. Like the title of a book, a domain name describes the contents of a website. Domain names also can locate a web site at the point in virtual “space” where it is most likely to reach its intended audience.

This Court’s earlier decision in *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001) (*PETA*), does not require a contrary result. The present case is distinguishable from the *PETA* case in a number of relevant ways. Further, *PETA* was decided entirely on statutory grounds; no First Amendment claim was raised or considered. To the extent that *PETA* can be read as allowing the Lanham Act to trump the First Amendment interests in domain names, it should be reconsidered in light of recent legal and technological development.

ARGUMENT

I. THE DEMOCRATIZING FEATURES OF THE INTERNET PRESENT UNIQUE OPPORTUNITIES FOR INDIVIDUALS TO BE HEARD ON MATTERS OF PUBLIC CONCERN.

The Internet has been described as a "vast democratic for[um]," *Reno v. ACLU*, 521 U.S. 844, 868 (1997), which gives average users an unprecedented ability to join a worldwide discussion and debate on a range of subjects "as diverse as human thought." *Id.* at 852. The Internet is a relatively new and powerful medium in which anyone "can become a town crier with a voice that resonates farther than it could from any soapbox." *Id.* at 870. It should come as no surprise that individuals who previously had limited avenues for publishing their opinions to a wide audience have used this worldwide platform to express their views on politics, social issues, movies, and everything else. For decades, Jerry Falwell, as a public figure with a vast number of followers and a strong media draw, has been able to disseminate his views to millions. Only since the inception of the Internet have Christopher Lamparello and others like him had access to even a remotely comparable audience.

Individuals and corporations who have been objects of disparagement on the Internet have been quick to use the Lanham Act to try to stop the flow of criticism. Though the Internet should not be immune to trademark laws, such laws should not be used to silence this new form of criticism and other protected online speech.

See generally, Sorgen, Rebecca S. , *Trademark Confronts Free Speech on the Information Superhighway: “CyberGrippers” Face a Constitutional Collision*, 22 Loy. L.A. Ent. L. Rev. 115 (2001); Note, Keith Blackman, *The Uniform Domain Name Dispute Resolution Policy: A Cheaper Way to Hijack Domain Names and Suppress Critics*, 15 Harv. J.L. & Tech. 211, 246-55 (Fall 2001); Marcelo Halpern & Ajay K. Mehrotra, *From International Treaties to Internet Norms: The Evolution of International Trademark Disputes in the Internet Age*, 21 U. Pa. J. Int’l Econ. L. 523, 558-59 (2000). Courts have a responsibility to preserve the freedom of speech in this powerful new medium.

II. LAMPARELLO’S DOMAIN NAME IS PROTECTED BY THE FIRST AMENDMENT.

A. The First Amendment Strictly Limits the Use of Trademark Law to Regulate Non-Commercial Speech.

The basic objectives of trademark law are to “encourage product differentiation, promote the production of quality goods, and provide consumers with information about the quality of goods.” *CPC Intern., Inc. v. Skippy Inc.*, 214 F.3d 456, 461 (4th Cir. 2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)). Trademark protection “quickly and easily assures a potential customer that *this* item--the item with this mark--is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.”

Qualitex, 514 U.S. at 164. It accomplishes this by ensuring that well established marks are not used by competitors in confusing or misleading ways.

As applied to commercial speech, trademark law poses few constitutional problems. The Supreme Court “ha[s] recognized the commonsense distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech.” *Central Hudson Gas & Elec. Corp. v. Public Service Comm’n*, 447 U.S. 557, 562, (1980) (citation and internal quotation marks omitted). In many instances, commercial speech may be regulated in ways that would be impermissible if the regulation were applied to noncommercial expression. *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995). “The government may ban forms of [commercial] communication more likely to deceive the public than to inform it.” *Central Hudson*, 447 U.S. at 563 (citation omitted). “[W]hen the particular content or method of the advertising suggests that it is inherently misleading or when experience has proved that in fact such advertising is subject to abuse, the States may impose appropriate restrictions. Misleading advertising may be prohibited entirely.” *In re R.M. J.*, 455 U.S. 191, 203 (1982).

Even truthful, non-misleading commercial speech may be regulated, if the regulation is sufficiently related to a substantial government interest. “First, the restriction must directly advance the state interest involved; the regulation may not

be sustained if it provides only ineffective or remote support for the government's purpose. Second, if the governmental interest could be served as well by a more limited restriction on commercial speech, the excessive restrictions cannot survive.” *Central Hudson*, 447 U.S. at 564.

In general, trademark law accords with the standards for regulation of commercial speech. It promotes the informational value of commercial speech by ensuring that trademarks are not used to mislead consumers about the source of a product. “Limited to this core purpose – avoiding confusion in the marketplace – a trademark owner’s property rights play well with the First Amendment.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (2002).

Noncommercial speech, however, cannot be subjected to the same degree of regulation as commercial speech. When a plaintiff attempts to thwart the use of its trademark in a noncommercial setting, courts must be especially vigilant to ensure that the defendant’s right to free speech is not compromised. “Whatever is added to the field of [trademark] is taken from the field of free debate.” *New York Times v. Sullivan*, 376 U.S. 254, 272 (1964) (quoting *Sweeney v. Patterson*, 128 F.2d 457, 458 (1942), *cert denied*, 317 U.S. 678).

Additionally, the government interest in enforcing trademark law is at its lowest when noncommercial speech is involved. *See CPC Intern., Inc. v. Skippy Inc.*, 214 F.3d 456, 461 (4th Cir. 2000) (No governmental interest in prohibiting

noncommercial use of trademark, where the “trademark has not been used for any commercial gain, nor has the trademark been used in a way that confuses the public.”)

Lamparello’s site is wholly non-commercial. Nothing is sold or offered for sale, the sites contain no advertising, and readers are not solicited for funds. Lamparello has never profited from the site in any way, and appears to maintain it at his own personal expense. Lamparello is not a commercial competitor of Falwell’s, but a critic using the most convenient and powerful medium available to him. The only content on his site is criticism of Falwell. Lamparello has merely used Falwell’s marks to identify the target of his criticism and to accurately describe the contents of his web site.

The Supreme Court has recognized that criticism of public figures such as Falwell is an important exercise of free speech. “At the heart of the First Amendment is the recognition of the fundamental importance of the free flow of ideas and opinions on matters of public interest and concern.” *Hustler Magazine v. Falwell*, 485 U.S. 46, 50-51 (1988) “The sort of robust political debate encouraged by the First Amendment is bound to produce speech that is critical of those who hold public office or those public figures who are intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society at large.” *Id.* at 52 (internal quotation marks

and citation omitted).

Because Lamparello's website consists of protected, noncommercial speech, it is entitled to a high degree of First Amendment protection. At the same time, Lamparello's noncommercial speech does not implicate the purposes of trademark law: protecting consumers' expectations and producers' property rights. Under these circumstances, the Constitution does not allow Falwell's trademark claims to trump Lamparello's free speech rights.

B. Domain Names are a Type of Communication Protected by the First Amendment.

Domain names generally – and the domain name at issue in this case – can serve at least two kinds of communicative purposes. First, a domain name, much like the title of a book, can describe the contents of a website. Second, a domain name can locate a web site at the point in virtual “space” where it is most likely to reach its intended audience. The communicative import of domain names is entitled to substantial First Amendment protection.

1. Domain Names as Titles

Titles of books, films and other works are protected by the First Amendment, and a trademark owner has only limited power to prevent a speaker from using the mark as part of a title. The seminal analysis of titles as First Amendment speech is *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), in which

the famous actress and dancer Ginger Roger sued the producers of a film called “Ginger and Fred.” “The film tells the story of two fictional Italian cabaret performers . . . who, in their heyday, imitated Rogers and [Fred] Astaire and became known in Italy as ‘Ginger and Fred.’” *Rogers v. Grimaldi*, 875 F.2d 994, 99 -997 (2d Cir. 1989). Recognizing the significant communicative value of titles, the court held that titles do not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work..” 875 F.2d at 999. At least two other circuits have recently adopted the *Rogers* analysis. See *Mattel v. MCA Records*, 296 F.2d 894 (9th Cir. 2002) (applying *Rogers* analysis to find that a song called “Barbie Girl” did not infringe on Mattel’s “Barbie” trademark); *Parks v. LaFace Records* 329 F.3d 437, 449 (6th Cir. 2003) (adopting the *Rogers* standard because “the unmodified likelihood of confusion test applied to commercial products [is not] adequate to differentiate between those artists who choose titles for the purpose of legitimate artistic relevancy and those artists who choose misleading titles for the purpose of commercial gain”).

Internet domain names act as source identifiers when the domain name is the name of the entity that controls the site. For example, the website at <http://www.jonathanfranzen.com/> belongs to the well-known author Jonathan

Franzen, and the site at <http://www.naacp.org/> is run by the NAACP. But other domain names serve *not* to identify the source of the site, but to identify its subject matter, just like the title of a book or a film. *See, e.g.* <http://www.billclinton.org> (containing information about the former President and a link to send him “greetings/well-wishes,” but which “has no affiliation with the Clintons, the DNC, or any political organization); <http://www.georgeclooney.org> (“fan site” with information about actor George Clooney); <http://www.romanpolanski.com> (a “tribute” to director Roman Polanski that is “unaffiliated with [Roman Polanski] or his representatives”).

Because “the nature of domain names is not susceptible to . . . a uniform, monolithic characterization,” *Name Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 585 (2000), courts should consider domain names in the context of the entire website to determine the purpose and effect of the domain name.

In this case, the domain name fallwell.com precisely describe the contents of the website, which is all about Falwell and his ideas about gays and lesbians. There is no suggestion that Falwell is the source of the website. To the contrary, the site contains a prominent disclaimer that states: “*This website is NOT affiliated with Jerry Falwell or his ministry.*”

Because the domain name in this instance acts as a title, it should be analyzed within the *Rogers v. Grimaldi* framework. Under the first prong of that

test, the domain name is plainly relevant to the underlying website. Under the second prong, the domain name does not expressly mislead the reader about the source of the website. As the *Rogers* court explained, “some titles -- such as ‘Nimmer on Copyright’ and ‘Jane Fonda’s Workout Book’ – explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work.” *Rogers*, 875 F.2d at 999. The domain name equivalent of such a title might be, for example, www.falwellofficialsite.com. The domain name fallwell.com, by contrast, certainly indicates that the site is *about* Falwell, but the name is completely neutral on the question of whether the site is *from* Falwell. And the content of the website itself instantly makes clear that it is *not* from Falwell. Under the *Rogers v. Grimaldi* analysis, the domain name is protected by the First Amendment and may not constitute a trademark violation.

2. Domain Names as Locations

A speaker’s choice of location often has expressive significance. “In some situations the place represents the object of protest, the seat of authority against which the protest is directed. In other situations, the place is where the relevant audience may be found.” *Galvin v. Hay*, 374 F.3d 739, 747 (9th Cir. 2004) (quoting *Wolin v. Port of N.Y. Auth.*, 392 F.2d 83, 90 (2d Cir. 1968)). “The First Amendment protects the right of every citizen to reach the minds of willing

listeners and to do so there must be opportunity to win their attention." *Heffron v. Int'l Soc'y for Krishna Consciousness, Inc.*, 452 U.S. 640, 654 (1981) (citations and internal quotation marks omitted.) *See also City of Ladue v. Gilleo*, 512 U.S. 43, 57 (1994) (noting that "a person who puts up a sign at her residence often intends to reach *neighbors*, an audience that could not be reached nearly as well by other means.") (emphasis in original); *Weinberg v. City of Chicago*, 310 F.3d 1029 (7th Cir. 2002) (Location outside stadium has First Amendment significance for seller of books hostile to the team manager; "Blackhawk fans are a fundamentally different market than the market for bookstore readers or Internet users.")

The Internet exists not in physical space but in virtual space. Domain names, like physical locations, are a principal means of targeting an intended audience. Lamparello wishes to reach individuals who are interested in Falwell and provide them with critique of Falwell's point of view. By using a version of Falwell's name in his domain name, Lamparello can grab the attention of Internet browsers who are looking for information about Falwell. It is as if Lamparello were standing on a public sidewalk outside Falwell's church holding a sign saying "Falwell is wrong about homosexuality." He would attract the attention of individuals heading toward the building, but would not prevent anyone from entering.

Viewers of such a sign would not be confused about whether Falwell himself endorsed the message, and neither are viewers of the fallwell.com website. The very first thing that visitors to Lamparello's website see is a message disclaiming any association with Falwell and providing a link to Falwell's own site. Moreover, most people looking for information about Falwell would not reach the fallwell.com site directly, but would first use an Internet search engine like Google. If such a person mistakenly typed "Fallwell" into Google, the first thing he would see is the message "Did you mean: Falwell." Clicking on "Falwell" generates a new search using "Falwell" as the search term, allowing a "lost" viewer to re-orient himself. Following that message, the viewer would see a listing for Lamparello's website, as follows:

[Jerry Falwell's anti-gay preaching and writing causes death, pain ...](#)
Jerry Falwell is wrong about gay and lesbian people.
[www.falwell.com/](#) - 11k - [Cached](#) - [Similar pages](#)

Thus, even before ever reaching Lamparello's site, it is perfectly clear to the viewer that the site is not sponsored by Falwell, and is instead critical of him. While the fallwell.com domain name allows viewers to "grab" viewers interested in Falwell, it does nothing to deter people from Falwell's own site or other sites dealing with Falwell.¹

¹ Indeed, Lamparello's site arguably *helps* interested viewers to get to Falwell's site, as it redirects people who may misspell his name. See *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 634 (6th Cir. 1996) (Travel agency using phone number 1-800-HOLIDAY, one digit away from Holiday Inn number 1-800-HOLIDAY, did not *cause* confusion, but "may have

Since Lamparello's choice of domain name – like a choice of location – helps him to reach the particular segment of the population at whom his message is directed, it is entitled to First Amendment protection.

III. THE *PETA* CASE SHOULD BE RECONSIDERED AND, IN ANY EVENT, IS DISTINGUISHABLE FROM THE PRESENT CASE.

In *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001) (*PETA*), this Court considered a website with the domain name www.peta.com. The site purported to belong to an organization called People Eating Tasty Animals, and made fun of PETA's animal rights views. Considering only the domain name and not the content on the site, the Fourth Circuit held defendants liable for infringement and dilution because the domain name might cause confusion by web users expecting to find the real PETA's web site at that address. While superficially similar to the present case, *PETA* is actually quite different in a number of ways. Additionally, *PETA* should be revisited in light of recent developments in law and technology.

A. The Present Case is Distinguishable from *PETA*.

As the Appellant has persuasively explained (Appellant's Br. at 26-27, 34), this case is different from *PETA* on numerous dimensions. For example, *PETA*

helped dispel the confusion by answering calls that would have gone unanswered and informing the customers of their error"); *Taubman Co. v. Webfeats*, 319 F.3d 770, 777 (6th Cir 2003) (noting that website using plaintiff's mark in the domain name did not cause confusion because disclaimer redirected interested persons to plaintiff's official website.)

defendant had registered multiple domain names and suggested that peta.com was for sale to *PETA*. The peta.com domain name did not describe a website *about* PETA, as Lamparello's website is about Falwell. And the peta.com website failed to include a prominent disclaimer or a prominent link to the official PETA website, and thus "prevented users from obtaining or using PETA's goods or services." 263 F.3d at 365.

B. *PETA* Should be Reconsidered.

Since *PETA* was decided, most circuits considering trademark law as it applies to domain names have reached very different conclusions than were reached in that case. The use and sophistication of Internet search engines has increased greatly. Further, the *PETA* decision was based purely on interpretation of the Lanham Act, and did not consider the First Amendment dimensions of domain names. For all of these reasons, this Court should revisit the *PETA* decision.

The most significant aspect of *PETA* was its insistence on considering the domain name in isolation, rather than the website as a whole, when determining if the use of the PETA trademark was confusing. The *PETA* court acknowledged that "the website's content makes it clear that it is not related to PETA." 263 F.3d at 366. The defendant's use of the mark was nonetheless confusing because the message on the website was not conveyed simultaneously with the message of the

domain name. “The domain name conveys the first message, the second message is conveyed only when the viewer reads the content of the website.” *Id.* Therefore “an internet user would not realize that they were not on an official PETA web site until after they had used PETA’s Mark to access the web page www.peta.org.” *Id.* at 366-67 (quoting the district court).

In contrast, other courts have considered the domain name in conjunction with the website to determine whether a trademark is used in a confusing manner. For example, in *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004), the court held that Nissan Computer did not infringe on Nissan Motor’s trademark by using the domain name nissan.com to advertise non-automobile-related goods, because “an “auto-seeking consumer would realize in one hot second that she was in the wrong place and either guess again or resort to a search engine to locate Nissan Motor’s site.” *Id.* at 1019. *See also Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir. 2003) (domain name shopsatwillowbend.com not confusing because the defendant had “placed a conspicuous disclaimer informing customers that they had not reached [plaintiff’s] official mall site” and had “placed a hyperlink to [plaintiff’s] site within the disclaimer.” *Northland Insurance Co. v. Blaylock*, 115 F.Supp.2d (D. Minn. 2000) (domain name northlandinsurance.com not confusing because “[i]t is immediately apparent that defendant’s site bears no relationship to plaintiff’s business other than as a source of consumer criticism of

plaintiff's business.”)

For a number of reasons, it makes sense to look at both the domain name and the website in order to determine whether the use of a trademark in a domain name is confusing. First, it is exceedingly unlikely that anyone would be confused by a domain name alone. As noted above, web users typically use search engines to find web sites of interest. The search engines generate a list of web sites containing a title and sentence or two from the site. This is generally enough to eliminate any potential confusion *before* a person even enters the website. If a person does accidentally land on the wrong site, it takes a matter of seconds to correct the error using a search engine or, in this case, a link to the other website. A domain name is not confusing by itself, it is confusing, or not, based on its relationship with the content of the site.

Moreover, focusing on individual words cannot yield a fair understanding of any kind of speech, because “a phrase gathers meaning from the words around it.” *General Dynamics Land Systems, Inc. v. Cline*, 124 S.Ct. 1236, 1246 (2004) (internal quotation marks and citations omitted). Thus, in a host of other First Amendment contexts, courts have insisted in looking at the speech as a whole – rather than small pieces of it – to determine whether the speech is constitutionally protected. *See, e.g., Miller v. California*, 413 U.S. 15, 24 (1973) (Determination of obscenity requires court to consider “whether the work, taken as a whole, lacks

serious literary, artistic, political, or scientific value"); *Adventure Communications, Inc. v. Kentucky Registry*, 191 F.3d 429,441 (4th Cir. 1999) (When elements of commercial and noncommercial speech are combined, “the commercial or noncommercial character of the speech is determined by the nature of the speech taken as a whole” (internal quotation marks and citation omitted); *Stroman v. Colleton County School Dist.*, 981 F.2d 152, 157 (4th Cir. 1992) (In determining whether teacher’s speech was “on a matter of public concern” protected by the First Amendment, the district court erred by “divid[ing] his letter into discrete components to conduct a constitutional analysis on each.”; “the proper approach is to consider the letter as a single expression of speech to be considered in its entirety.”) Like these other kinds of speech, Internet domain names and the websites they reference should be considered “as a whole” for First Amendment purposes.

Lamparello’s speech, as a whole, is not confusing. The domain name fallwell.com accurately describes the subject matter of the site. The site prominently disclaims any affiliation with Falwell and directs viewers to his official site. The use of fallwell.com is protected by the First Amendment and is not a trademark violation.

CONCLUSION

For the reasons stated above, *amici* urge this Court to hold that Lamparello's online criticism of Falwell is protected by the First Amendment, and to reverse the judgment of the district court.

Respectfully submitted,

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Dated: November 24, 2004

CERTIFICATE OF SERVICE

I certify that on this 24th day of November, 2004, I served two copies of the foregoing document by first class mail, postage prepaid, upon the following counsel of record:

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