

FHH Telecom Law
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Protecting Your Trademark With Just a Click
On-line trademark registration helps overcome cyber squatters

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The maddening thing about technology is it makes almost everything in life easier and harder at the same time. Nearly every administrative personal and business task imaginable can now be accomplished online, from paying bills to renewing vehicle registrations and drivers' licenses to completing your holiday shopping. Broadcast stations have certainly benefited from this through electronic filing of applications via the FCC website. One of the earliest online systems adopted by the FCC was the "Call Sign Registration and Authorization System" which lets broadcast licensees reserve and transfer call signs in a matter of moments. That's it, right? Point, click and go about your business. Anybody in the world can now identify your broadcast station through four easy letters.

But what if others want in? It has often been said that trademarks represent the "blood, sweat, and tears" of the business aspect of an enterprise. Given the amount of time, money and effort that go into promoting a station's call sign as the primary identifier of the business, that station is donating a lot of bodily fluids if others are easily able to incorporate call letters into their marketing efforts.

And the "lawless" Internet is the perfect place for someone to try. After all, call signs are short, often catchy, and carry a high rate of recognition in the local market. A radio or television station really only needs one website, right? At the low, low rate of \$35 per year, by utilizing the technology-driven simplicity of registering a first-come, first-served domain name over the Internet, isn't it worth it to register a variation of a prominent call sign such as the call plus frequency or call plus station slogan? There is no requirement that the registrant actually use the domain name to create or maintain a website and, in the early days of the Internet, serious compensation was paid – \$100,000 for "television.com", for instance – for the rights to very high profile domain names. With a relatively slim chance of being caught, it's worth taking that chance, no?

Broadcast businesses need to police unauthorized use of station call signs and other general business identifiers on a regular basis. Two cases involving trademark infringement through the unauthorized registration of call signs as domain names are particularly illuminating. In one, a radio station in New York used an alternative dispute resolution process to have the rights to two domain names incorporating the station's call sign (www.wevd.com, www.wevd.net) transferred back to the station licensee. These domain names were registered by a former freelance producer who often bought time on the station to broadcast restaurant reviews. He then kindly offered the domain names

back to the station in exchange for free airtime during the next five years' "drive time."

The second case is even more frightening. Tennessee station WNRQ used the same procedure to attempt to wrest its call sign from a domain name registrant who was using it to advertise penis and breast enhancement supplements, personal ads, and links to other websites containing sexually explicit materials. Not the sort of thing you want your listeners to encounter when they go searching for your latest contest or station-sponsored events in the community, is it?

The good news is that the Internet Corporation for Assigned Names and Numbers (ICANN), which administers domain names around the world, recognized the danger of allowing anyone in the world to register multiple domain names at a very low price. It is to combat the activities of unscrupulous "cyber squatters" that the "Uniform Dispute Resolution Policy" was created. This is a streamlined, paper-only arbitration process that serves as an alternative to court litigation when unauthorized registration of a domain name is alleged to infringe a federal trademark. In addition to being relatively cheap (usually under \$1000 to file a case to be heard by an arbitrator, plus attorney fees) and rapid, a complainant is spared the need to go overseas to prosecute a claim of trademark infringement in the country in which the domain name registrant is located, and victory will result in transfer of the domain name within 10 days of an arbitrator's final order.

More importantly, as opposed to the general federal court standard that amounts to little more than "I'll know it when I see it," the arbitration process is rather concrete and easy to follow. In order to compel transfer of a domain name, the person filing the complaint must show that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

The person registering the domain name has no legitimate right to that name; and

3. The domain name has been registered and used in bad faith.

The burden rests with the person bringing the complaint to demonstrate that each of these factors is present. With regard to demonstrating registration in bad faith, this often involves evidence of an attempt by the domain name registrant to sell the trademarked name for a profit, to prevent the trademark owner from using the trademark or to disrupt the trademark owner's business or even piggyback off the trademark for commercial gain. Evidence of the lack of legitimate right to the domain name will often rest on a demonstration that the domain name was never used by the registrant prior to the existence of a controversy over the name, as well as the lack of any connection between the domain name registrant and the trademarked term, other than the registration at issue.

By far and away the most straightforward element of this simple arbitration procedure should be the first one: a federally registered trademark is all the evidence needed to meet this requirement. This is the key difference between the two cases discussed above:

WEVD was victorious because it had obtained federal registration for its call sign. WNRQ fell at this first hurdle because it did not have such protection; the station's licensee was forced to demonstrate that its consistent and public use of the call sign amounted to the existence of a common law trademark. The arbitrator disagreed with the station's claim that it met this standard, stating:

“The granting of a distinctive call sign by the Federal Communications Commission is not a substitute for the granting of a registered trademark by the U.S. Patent and Trademark office. Given the size and population of the United States, there must be many thousands of radio stations with many permutations of letters in their various call signs.”

While the station admittedly offered only scant evidence – in the form of a few “airchecks” to support its claim that it was widely known as “WNRQ” – one thing is clear: the station would not have been required to produce any evidence other than the single-paged trademark registration in order to prove this element, a savings of significant time and money if it had only obtained federal trademark protection for its call sign.

The better news – and, yes, technology is to be lauded once again – is that protecting yourself in this manner is easier than ever. An application for federal trademark protection can be filed online in about an hour for a one-time filing fee of \$325.00. Trademark protection is retroactive to the date of first use of the mark, meaning that even a company that finds itself embroiled in a confrontation over a domain name can (and should) file the trademark registration application after becoming aware of a cyber squatter to assert primacy over the mark. Because a trademark is considered (intellectual) property, it can be transferred in the event that the station is sold or the call sign itself is transferred to a new owner.

Thus, business owners should consider registering their most important commercial identifiers, such as a call sign in the case of a broadcast station or trade names in the case of other businesses, as insurance against spending much more to protect the mark later on when a cyber squatter comes along and tries to shake the business down. It should also engage in regular policing of the Internet, searching for its own call letters, using the “Whois” registry of domain names and owners, and simply typing variations of its call sign into the address bar on its Internet browser in order to remain vigilant against improper uses of a protected mark as an Internet domain name. These searches will prove well-worth the hour or so that is required each month.

We have significant experience in these matters and can assist you in protecting this valuable piece of property. For more information, contact Kevin M. Goldberg (the attorney who represented WEVD in the victorious arbitration discussed above) or the attorney at Fletcher, Heald & Hildreth with whom you usually work .