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# COURTS, TRADEMARKS, AND THE ICANN GOLD RUSH: NO FREE SPEECH IN TOP LEVEL DOMAINS

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In recent years, the Internet Corporation for Assigned Names and Numbers (ICANN) expanded top-level domains, such as .com, .net, and .org, to include a very wide variety of new terms. One of the new options is .sucks. This Article examines the potential for conflict when trademark holders seek to protect their mark in the context of the .sucks domain. There is a temptation to see this issue in terms of consumers' free speech rights pitted against corporate interests. However, the recent privatization of ICANN does not bode well for promoting consumers' First Amendment rights in domain name battles.

## I. INTRODUCTION

In 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) began an expansion of top-level domain names (TLD), such as .com, .net, and .org. that was without precedent.<sup>1</sup> Hundreds of new options became available, all subject to particular processes and fees that ICANN controls.<sup>2</sup> One of the new options is .sucks.<sup>3</sup> The attraction of the .sucks

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1. Benjamin Boroughf, *The New Dot Context: How to Mitigate Trademark Concerns in ICANN's New gTLD Program*, 10 ISJLP 85, 86 (2014).

2. *Id.*

3. Rick Spence, *Feds Called in to Settle 'Dot-Sucks' Domain Controversy in U.S. and Canada*, FIN. POST (Apr. 13, 2015, 2:09 PM), <http://business.financialpost.com/entrepreneur/feds->

domain is substantial for the consumer who wishes to publish a so-called “gripe site,” a website designed to express a consumer’s complaints about a company’s business practices.<sup>4</sup> Herein lies the potential clash between consumers, or consumer groups, who claim First Amendment Freedom of Speech protection in choosing their domain name, and corporations who claim trademark protection.<sup>5</sup> A consumer might want to express a negative opinion about a business, contributing an opinion to the marketplace of ideas. However, that consumer could be denied the domain name that expresses their opinion or risk facing a trademark lawsuit. Does the First Amendment take a side in the dispute?<sup>6</sup> At first glance, free speech arguments hold some weight. However, this Article demonstrates that the privatization of regulatory power, in the form of ICANN, has mooted any free speech claim.

In Section II, we conduct a brief review of ICANN’s role in domain name allocation, while in Section III we review court decisions that evaluated the expressive element of a domain name. Section IV examines the relevance of First Amendment doctrine to the regulation of domain names. In Section V, we review the few cases where courts have found First Amendment violations in domain name disputes. Finally, in Section VI, we look at the aftermath of ICANN’s .sucks invention.

## II. WHAT IS ICANN? HOW DOES IT CONTROL INTERNET DOMAINS?

ICANN is a non-profit public benefit corporation headquartered in Los Angeles.<sup>7</sup> The mission of ICANN is to “ensure the stable and secure operation of the Internet’s unique identifier systems . . . .”<sup>8</sup> In order to better un-

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called-in-to-settle-dot-sucks-domain-controversy-in-u-s-and-canada [https://perma.cc/KH7E-UQAK].

4. WEB GRIPE SITES, <http://www.webgripesites.com/> [https://perma.cc/M7KZ-ASTK].

5. U.S. CONST. amend 1.

6. *Id.*

7. *Section 24.1 Offices*, ICANN, <https://www.icann.org/resources/pages/governance/by-laws-en> [https://perma.cc/H9Y6-8UQX] (last amended Jun. 18, 2018).

8. *Id. at Section 1.1. Mission.*

derstand ICANN's mission, it is helpful to understand the origins of the organization, and how ICANN interacts with the Internet's Domain Name System (DNS) and TLDs.<sup>9</sup>

The DNS provides the useful letter address convention for website addresses.<sup>10</sup> The DNS system offers a sophisticated, yet user-friendly way to map an Internet Protocol (IP) address to a domain name.<sup>11</sup> This allows a user to connect with the easy-to-use domain name, rather than typing the underlying IP address.<sup>12</sup> The third part of any domain name, to the right of the final dot, is called the top-level domain name or TLD.<sup>13</sup> Any other TLD, other than one reserved for a country or territory, is known as a generic TLD (gTLD).<sup>14</sup> For example, in the web address [www.apple.info](http://www.apple.info), “.info” is the gTLD. Originally, ICANN delegated ownership of .info to a registrar as the result of a successful application process.<sup>15</sup> The letters occupying the middle part of a website address, such as “apple” in our example, are known as the second-level domain (SLD).<sup>16</sup> Registrars package gTLDs with SLDs in nearly infinite combinations and resell them into the marketplace as website addresses such as [buffer.academy](http://buffer.academy), [wyoroad.info](http://wyoroad.info), and [calculators.law](http://calculators.law).<sup>17</sup>

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9. Justin T. Lepp, *ICANN's Escape From Antitrust Liability*, 89 WASH. U. L. REV. 931, 932–36 (2012).

10. The DNS translates the domain name into the related IP address to connect the related website. The DNS also allows email delivery to the intended recipient. See *ICANN Acronyms and Terms*, ICANN, <https://www.icann.org/icann-acronyms-and-terms/icann-acronyms-and-terms/en/nav/A> [<https://perma.cc/TY8Y-F72F?type=image>] (last amended Jun. 18, 2018).

11. Jude A. Thomas, *Fifteen Years of Fame: The Declining Relevance of Domain Names in the Enduring Conflict Between Trademark and Free Speech Rights*, 11 J. MARSHALL REV. INTEL. PROP. L. 1, 7–8 (2011)

12. *Id.*

13. *Id.* at 8.

14. *Id.*

15. Jacob H. Rooksby, *Defining Domain: Higher Education's Battles For Cyberspace*, 80 BROOK. L. REV. 857, 864–65 (2015). ICANN provides a database known as WHOIS to look up the registered domain owner for any generic domain. Using this database, one may look up the ownership of [vw.info](http://vw.info), [vw.com](http://vw.com), [vw.net](http://vw.net) etc. See *ICANN's Domain Name Registration Lookup*, ICANN, <https://lookup.icann.org/> [<https://perma.cc/L7EC-DAKH>].

16. Thomas, *supra* note 11, at 8.

17. *Social Media Academy*, BUFFER.ACADEMY, <https://buffer.academy> [[HTTPS://PERMA.CC/G5YZ-K8CM](https://perma.cc/G5YZ-K8CM)]; *Wyoming Travel Information Service*, WYDOT,

ICANN was created in California in 1998 at the behest of the U.S. government during the Clinton administration<sup>18</sup> to take control of critical administrative functions of the Internet.<sup>19</sup> These functions include linking specific TLDs to specific numbers.<sup>20</sup> It is significantly easier to use a domain-based address, like [www.lmu.edu](http://www.lmu.edu), than to use the numerical address that the network is designed to use, in this case for example, 34.209.43.181. This simplification is achieved through the Internet Assigned Numbers Authority (IANA).<sup>21</sup> Until recently, ICANN performed the IANA duties for the U.S. government under contract with the National Telecommunications and Information Administration (NTIA).<sup>22</sup> Through IANA, the U.S. government exercised some control over ICANN, making the contract between NTIA and ICANN politically sensitive.<sup>23</sup> Congress, worried about a loss of American power over the Internet, questioned allowing the NTIA contract to expire.<sup>24</sup> However, the Obama administration supported its expiration—and the Department of Commerce and ICANN developed a transition plan for

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<https://wyoroad.info> [<https://perma.cc/4NTJ-DPP4>]; LEGAL CALCULATORS, <https://calculators.law> [<https://perma.cc/388E-XCWX>]. For more on possible strings in the domain name, see *ICANN, Delegated Strings*, ICANN, <https://newgtlds.icann.org/en/program-status/delegated-strings> [<https://perma.cc/6TY3-NQ39>].

18. Julia Pohl & Luciano Morganti, *The Internet Corporation for Assigned Names and Numbers (ICANN): Origins, Stakes and Tensions*, CAIRN.INFO (2012), [http://www.cairn.info/article.php?ID\\_ARTICLE=RFEA\\_134\\_0029](http://www.cairn.info/article.php?ID_ARTICLE=RFEA_134_0029) [<https://perma.cc/C9Z6-6TPT>].

19. *Id.*

20. *Id.*

21. Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187, 198 (2000).

22. *ICANN Acronyms and Terms*, *supra* note 10.

23. See *Stakeholder Perspectives on ICANN: The .SUCKS Domain and Essential Steps to Guarantee Trust and Accountability in the Internet's Operation: Hearing Before the Subcomm. on Courts, Intellectual Prop., and the Internet of the Comm. on the Judiciary H.R.*, 114th Cong. 1 (2015).

24. See *id.*; see also LENNARD G. KRUGER, CONG. RESEARCH SERV., 7-5700, THE FUTURE OF INTERNET GOVERNANCE: SHOULD THE U.S. RELINQUISH ITS AUTHORITY OVER ICANN? (2015); Cecilia Kang & Jennifer Steinhauer, *Ted Cruz Fights Internet Directory's Transfer; Techies Say He Just Doesn't Get It*, N.Y. TIMES (Sept. 15, 2016), <https://www.nytimes.com/2016/09/16/us/politics/ted-cruz-internet-domain-names-funding.html> [<https://perma.cc/6YE2-TF4H>].

the IANA function, moving IANA from NTIA to ICANN.<sup>25</sup> This plan, the Affirmation of Commitments, was signed in 2009.<sup>26</sup>

On October 1, 2016, ICANN assumed the authority to perform the IANA functions on its own.<sup>27</sup> ICANN accomplishes those functions through an ICANN-controlled affiliate known as Public Technical Identifiers (PTI).<sup>28</sup> In the last twenty-five years, the U.S. government has gradually privatized the key administrative functions that are foundational to the Internet.<sup>29</sup> Through its IANA functions, ICANN controls the essential directory that is the backbone of the internet. These functions include maintaining a registry of technical IP's, administering the DNS Root System, and allocating the Internet numbering system.<sup>30</sup>

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25. For a full review of the history of this plan, see generally A. Michael Froomkin, *Almost Free: An Analysis of ICANN's Affirmation of Commitments*, 9 J. TELECOMM. & HIGH TECH L. 187 (2011).

26. See generally *id.*

27. On October 1, 2016, the IANA functions were privatized and fully assumed by ICANN. See Letter from Lawrence Strickling, Assistant Sec'y for Comm. & Info. of DOC to Dr. Stephen Crocker, Chairman of the Bd. of Dirs. of ICANN, ICANN (Jan. 6, 2017), <https://www.icann.org/en/system/files/correspondence/strickling-to-crocker-06jan17-en.pdf> [<https://perma.cc/7AGN-MUF2>]; see generally *Stewardship of IANA Functions Transitions to Global Internet Community as Contract with U.S. Government Ends*, ICANN (Oct. 1, 2016), <https://www.icann.org/news/announcement-2016-10-01-en/> [<https://perma.cc/X997-NELD>]; Susmita Baral, *Who Controls the Internet? U.S. Government Hands Over Control to ICANN*, INT'L BUS. TIMES (Oct. 3, 2016, 4:03 PM), <http://www.ibtimes.com/who-controls-internet-us-government-hands-over-control-icann-2425491> [<https://perma.cc/5UVM-BS8V>]; Robert Sanders, *The U.S. Government No Longer Controls The Internet*, BUS. INSIDER (Oct. 4, 2016, 6:09 PM), <https://www.businessinsider.com/the-us-government-no-longer-controls-the-internet-2016-10> [<https://perma.cc/3G5V-QXBX>]; Grant Gross, *ICANN Transition Moves Forward Despite Last-Minute Attempt To Block It*, PCWORLD (Oct. 3, 2016, 7:47 AM), <https://www.peworld.com/article/3126482/icann-transition-moves-forward-despite-last-minute-attempt-to-block-it.html> [<https://perma.cc/SUQ6-TYHS>].

28. *Public Technical Identifiers*, ICANN, <https://pti.icann.org/> [<https://perma.cc/Z275-3G7Z>].

29. Nelson Drake, *Going Rogue: The National Telecommunications And Information Administration's Transfer of IANA Naming Functions to ICANN*, 3 ADMIN. L. REV. ACCORD 83, 84 (2018).

30. *ICANN Acronyms and Terms*, *supra* note 10.

The number-assigning element of IANA requires ICANN to control the DNS system of domain addresses.<sup>31</sup> The DNS system is similar to the phone-book for the telephone system—a guide to names of owners of the associated numbers.<sup>32</sup> Like a telephone company’s control over telephone numbers, ICANN controls new Internet domains and supervises their registration.<sup>33</sup>

In the mid-1990s, the Internet offered only seven possible gTLD options, most of which were limited to particular types of organizations, such as institutions of education, government, or military: .edu; .com; .net; .org; .gov; .mil; and .int.<sup>34</sup> At the time, it was thought highly unlikely that any new gTLDs would be needed.<sup>35</sup> When ICANN was created in 1998, assignment and control of the gTLDs became ICANN’s most visible activity to the everyday Internet user.<sup>36</sup> ICANN inherited a small number of gTLDs at its creation, and for a time expansion proceeded slowly. In January 2012, the Internet contained just twenty-two assigned gTLDs, including restricted ones such as .gov and .mil.<sup>37</sup>

ICANN creates and releases gTLDs into the marketplace by delegating them to registry owners through a complex approval and delegation process completed in occasional application rounds.<sup>38</sup> A recent round of applications was accepted by ICANN in 2012.<sup>39</sup> This was the beginning of a massive

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31. Pohl & Morganti, *supra* note 18.

32. *Id.*

33. Alice Wang, *Diversifying the Domain Name Governance Framework*, 32 BERKELEY TECH. L.J. 137, 144–45 (2017).

34. J. Postel, *Domain Name System Structure and Delegation*, NETWORK WORKING GROUP (Mar. 1994), <http://www.rfc-editor.org/rfc/rfc1591.txt> [<https://perma.cc/E53C-XL9M>].

35. *Id.*

36. Jacqueline Lipton & Mary Wong, *Trademarks and Freedom of Expression in ICANNs New gTLD Process*, 38 MONASH UNIVERSITY L. REV., 1, 188, 192 (2012).

37. *Id.*

38. See *Planning for Future gTLD Application Rounds*, ICANN (Nov. 17, 2014), <https://features.icann.org/planning-future-gtld-application-rounds> [<https://perma.cc/4X9Q-L6SF>].

39. Akram Atallah, *A “Grand” Milestone: New gTLD Program Reaches 1,000th Delegation*, ICANN (May 25, 2016), <https://www.icann.org/news/blog/a-grand-milestone-new-gtld-program-reaches-1-000th-delegation> [<https://perma.cc/2FRK-PSE8>].

expansion of gTLD domains.<sup>40</sup> The benefits of expansion were that domain names would become more content specific, while pressure on the .com domain would ease.<sup>41</sup> In 2016, ICANN celebrated a “milestone” as it hit 1,000 gTLD approvals.<sup>42</sup> By 2018, ICANN had introduced more than 1,200 newly-assigned gTLDs into the Internet.<sup>43</sup>

ICANN asserts that the expansion of the DNS through the gTLD application program is intended to “enhance competition, innovation and choice.”<sup>44</sup> Those are the benefits to the market from expansion of the DNS. Although ICANN does not explicitly mention the benefits of DNS expansion to ICANN itself, one of them is clearly monetary: the net auction proceeds to ICANN from the 2012 gTLD round were reported to be \$233 million as of December 2016.<sup>45</sup>

The expansion of the Internet made the rise in naming disputes inevitable. For instance, in 1999, Congress decided to regulate cybersquatting, the practice of buying a domain that includes a famous or trademarked name for the purpose of profiting from a later sale of the site to the owner of the name.<sup>46</sup> Also in 1999, ICANN created the Uniform Domain-Name Resolution-Policy (UDRP) in large part to resolve naming disputes.<sup>47</sup> The UDRP was created as an international, non-territorial forum to resolve domain

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40. David J. Cottrell, *ICANN's gTLD Expansion: Internet Innovation, Hijinks, and IP Headaches*, NYU LAW: JIPEL BLOG (Nov. 18, 2014), <https://blog.jipel.law.nyu.edu/2014/11/icanns-gtld-expansion-internet-innovation-hijinks-and-ip-headaches/> [<https://perma.cc/Z7PN-A6N5>].

41. *Id.*

42. Atallah, *supra* note 39.

43. Doug Isenberg, *What is a 'New gTLD'?*, GIGALAW (Feb. 28, 2018), <https://giga.law/blog/2018/2/28/what-is-a-new-gtld> [<https://perma.cc/2D3J-R3QE>]; *see generally ICANN gTLD Program Statistics*, ICANN (June 13, 2012), <https://newgtlds.icann.org/en/program-status/statistics> [<https://perma.cc/M48Q-VNXX>].

44. *ICANN Quarterly Stakeholder Call*, ICANN, <https://www.icann.org/en/system/files/files/quarterly-report-15feb17-en.pdf> [<https://perma.cc/D8C4-QEWE>].

45. *Id.*

46. Oliver R. Gutierrez, *Get Off My URL: Congress Outlaws Cybersquatting in the Wild West of the Internet*, 17 SANTA CLARA HIGH TECH. L.J. 139, 161–66 (2000).

47. *See Uniform Domain-Name Dispute-Resolution Policy*, ICANN, <https://www.icann.org/resources/pages/help/dndr/udrp-en> [<https://perma.cc/DA2T-KVNM>].



claims made by the owner of a famous name or trademark.<sup>48</sup> The UDRP process is notoriously friendly to trademark holders. For instance, one report claims that 86% of outcomes favor complainants.<sup>49</sup>

One of the implications of the UDRP process is that the domain name is valuable because it communicates an idea or cognitive association in the mind of the reader.<sup>50</sup> In other words, domain names look like speech.

### III. IS THERE SPEECH IN A DOMAIN NAME?

The utility of any First Amendment argument in relation to domain names will inevitably depend on whether the domain name is speech or a form of expression.<sup>51</sup> U.S. courts have struggled to develop a clear answer.<sup>52</sup>

In 1999, a year when fewer than ten gTLDs existed, a federal district court decided that a domain name was not expressive speech.<sup>53</sup> Per the court, the plaintiff's free speech claim failed because it had "not met the burden of demonstrating that the three letter top level domain portion of an Internet domain name is expressive speech."<sup>54</sup> The court saw the domain name as analogous to a phone number.<sup>55</sup> More precisely, the court equated the top-level-domain to the 1-800 part of a telephone number; for instance, it "is

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48. *Id.*; see also, Gerald Levine, *Is the UDRP Biased in Favor of Trademark Owners?*, 88 N.Y. ST. B.A. J. 18 (2016).

49. Annemarie Bridy, *Notice and Takedown in the Domain Name System: ICANN's Ambivalent Drift into Online Content Regulation*, 74 WASH. & LEE L. REV. 1345, 1357 (2017).

50. One particular example of this is the use of a celebrity's name in a domain name, a practice that implicates trademark concerns. Jacqueline D. Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes*, 65 WASH. & LEE L. REV. 1445, 1458–62 (2008).

51. See generally Eugene Volokh, *Symbolic Expression and the Original Meaning of the First Amendment*, 97 GEO. L.J. 1057 (2009) (discussing the historical understanding of the First Amendment in the context of evolving speech and expression concerns).

52. See, e.g., *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 577 (2d Cir. 2000).

53. *PGMedia, Inc. v. Network Solutions, Inc.*, 51 F. Supp. 2d 389, 390 (S.D.N.Y. 1999).

54. *Id.*

55. *Id.*

simply a routing instruction that helps computers find each other.”<sup>56</sup> This choice of language indicates that court saw the domain name as a mere technical element in web operations.

In *Jews for Jesus v. Brodsky*, the religious organization, Jews for Jesus, sought to enjoin defendant Brodsky from using a domain name “jewsfor-jesus.org,” which was remarkably similar to their protected mark.<sup>57</sup> Relying on trademark law, the District Court for the District of New Jersey granted a preliminary injunction.<sup>58</sup> The court also held that the “dispute does not implicate rights granted by the First Amendment of the United States Constitution.”<sup>59</sup> Relying on *Planned Parenthood Fed’n of Am. v. Bucci*,<sup>60</sup> it noted that the defendant’s use in a domain name of the plaintiff’s mark “was not part of communicative message but instead was source identifier.”<sup>61</sup> Thus, the court concluded that no First Amendment rights were implicated in the dispute.<sup>62</sup>

However, in a case in which a federal district court found that a web page, rather than a domain, was protected by the First Amendment, the court left the door open to the idea that a domain name could be protected as well.<sup>63</sup> The defendant, Andrew S. Faber, hosted a website called “Bally Sucks” that criticized the business practices of the fitness company Bally.<sup>64</sup> Alleging trademark infringement, trademark dilution and unfair competition, Bally sued Faber in the U.S. District Court.<sup>65</sup> The court granted Bally’s motion for

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56. *Id.* at 408.

57. *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 286–87 (D.N.J. 1998).

58. *Id.* at 288.

59. *Id.* at 286–87.

60. *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 WL 133313 at \*10 (S.D.N.Y. Mar. 24, 1997).

61. *Jews for Jesus*, 993 F. Supp. at 287 n.1 (citing *Bucci*, 1997 WL 133313, at \*35–39).

62. *Id.*

63. *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998); see also Oscar S. Cisneros, *Bally Total Fitness Holding Corp v. Faber*, 15 BERKELEY TECH L.J. 229, 238–39 (2000).

64. *Faber*, 29 F. Supp. 2d at 1162.

65. *Id.*

summary judgment.<sup>66</sup> The District Court concluded that “Faber is using Bally’s mark in the context of a consumer commentary to say that Bally engages in business practices which Faber finds distasteful or unsatisfactory. This is speech protected by the First Amendment.”<sup>67</sup>

The critical point is that the court evaluated the case in terms of both First Amendment issues and trademark issues: “Moreover, even if Faber did use the mark as part of a larger domain name, such as ‘ballysucks.com’, this would not necessarily be a violation [of trademark] as a matter of law.”<sup>68</sup> The Bally court concluded that “applying Bally’s argument would extend trademark protection to eclipse First Amendment rights. The courts, however, have rejected this approach by holding that trademark rights may be limited by First Amendment concerns.”<sup>69</sup> The court was willing to find speech in the domain name and to entertain the possibility of First Amendment issues arising out of that speech.<sup>70</sup>

David C. Najarian, writing three years after the Bally case, argued that domain names are in fact expressive and as such are relevant to the goals of the First Amendment.<sup>71</sup> In that context, he saw trademark claims as a threat to First Amendment values, as they stifle communication in a developing medium.<sup>72</sup> However, Najarian acknowledged that domain names face an uphill battle in terms of gaining recognition as speech.<sup>73</sup> “Courts have failed to recognize and accept an expressive component in domain names,” Najarian explained, and “trademark law now favors trademark holders, at the expense of domain name registrants.”<sup>74</sup>

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66. *Id.* at 1168.

67. *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1167 (C.D. Cal. 1998).

68. *Id.* at 1165.

69. *Id.* at 1164 (citation omitted).

70. *Id.* at 1165.

71. David C. Najarian, *Internet Domains and Trademark Claims: First Amendment Considerations*, 41 J.L. & TECH. 127, 130–31 (2001).

72. *Id.*

73. *Id.*

74. *Id.* at 130.

Najarian believes “that the First Amendment should limit trademark protections,”<sup>75</sup> yet courts have hesitated to go that far. To make that step, courts would have to be willing to consider a domain name as a form of speech. In other words, courts could find the name contains an expressive message. While the label “speech” is important, the label “First Amendment-protected speech” raises the critical question to be resolved.

#### IV. TOP LEVEL DOMAINS IN THE CONTEXT OF THE FIRST AMENDMENT

New domain names began to proliferate once ICANN instituted an expansion of gTLD options.<sup>76</sup> As domain names increase and diversify, the number of interested parties expands, and the result means more disputes over domain name territory. When the domain name alone is likely to cause controversy, like .sucks, the stakes are raised for all parties. In February 2015, the gTLD .sucks gained ICANN approval.<sup>77</sup> To gain control of any .sucks domain, a company has to pay an annual registration fee to the registrar of the entire .sucks TLD.<sup>78</sup> For instance, iowafarmbureau.sucks and trudeau.sucks both exist online in 2019.<sup>79</sup> The first domain redirects to the official site of the Iowa Farm Bureau, and the second site features political commentary about the Prime Minister of Canada.<sup>80</sup> The Iowa Farm Bureau

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75. *Id.* at 127.

76. Rooksby, *supra* note 15, at 866–68.

77. ICANN, *Delegated Strings*, ICANN, *supra* note 17.

78. Wang, *supra* note 33, at 144.

79. The URL <http://www.iowafarmbureau.sucks> automatically redirects to <https://www.iowafarmbureau.com>. The critique of Prime Minister Trudeau is located at Liars Suck <http://www.trudeau.sucks>.

80. *Id.*

decided to use the .sucks domain to prevent the development of a gripe site at that address.<sup>81</sup> This pre-emptive strategy is not unusual.<sup>82</sup>

Consider this hypothetical: Bugbites, a consumer interest group critical of the car maker Volkswagen, registers the name vw.sucks.<sup>83</sup> This hypothetical vw.sucks web site features endless criticism of Volkswagen products and scathing attacks about the so-called “Dieselgate” controversy. The VW trademark owner, Volkswagen of America Inc., could seek to take control of vw.sucks through avenues provided by ICANN, including the UDRP. If Bugbites were to lose, either in an ICAAN dispute resolution forum or in a U.S. court, it could make the argument that it had been deprived of free speech rights.

Interest groups such as Bugbites assert their free speech rights all the time, and the opportunity to do so in the form of the domain name itself is valuable to them.<sup>84</sup> At first glance, the free speech approach has strong appeal. The content of vw.sucks promotes precisely the kind of robust debate the First Amendment protects.<sup>85</sup> The domain name reinforces the point. Bugbites would assert that its free speech rights include use of the domain name vw.sucks—that the domain name is expressive and central to its message. From the Bugbites perspective, regulation by ICANN in the form of denial of access to the domain is a violation of its free speech. However, the First Amendment is predicated on the risks of government control of speech. This is where the Bugbites position faces a significant hurdle.

From the perspective of Volkswagen, or any trademark holder, domain name regulation by ICANN is not the same as government regulation. It is

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81. The authors’ exploration of these sites was facilitated by Google (enter search term “site:.sucks”) and by the vendor of the domain (Vox Populi) at [www.get.sucks](http://www.get.sucks). See *Why .Sucks?*, .SUCKS <https://www.get.sucks> [<https://perma.cc/5VCW-2HT2>].

82. For example, the Center of Science and Industry, a science museum and research center located in Columbus, Ohio, has adopted <http://www.cosi.sucks> to redirect to <https://cosi.org>, and fast food vendor, Wendy’s, has adopted the same strategy with <http://www.wendys.sucks>.

83. At one point in June 2019, an inquiry at [www.get.sucks](http://www.get.sucks) indicated that the domain name vw.sucks was available for \$2,000 per year.

84. One indication of the popularity of gripe sites is a website devoted to indexing gripe sites. See, e.g., WEB GRIPE SITES, *supra* note 4.

85. Successful First Amendment claims have been made by controversial speakers in cases involving Nazis in *National Socialist Party v. Skokie*, 432 U.S. 43 (1977); racial intimidation in *R.A.V. v. St. Paul*, 505 U.S. 377 (1992); and the regulation of advertisements in *44 Liquormart, Inc. v. R.I.*, 517 U.S. 484 (1996).

private regulation of speech. Such regulation may be subject to statutory rules, but ICANN decisions are not subject to speech claims based on the First Amendment. Courts have not limited private regulation of speech.<sup>86</sup> In general, there is no First Amendment protection against private regulation because the First Amendment only limits government action.<sup>87</sup> The Constitution does not “prohibit private citizens from interfering with the speech rights of other citizens.”<sup>88</sup> Stories about workplace regulation in the popular press reinforce the fundamental rule: free speech rules apply only when the government acts.<sup>89</sup>

There are many examples of private regulation of speech that fall outside the reach of the First Amendment. In particular, overtly political speech in a public place can be shut down when the censor asserts property rights. For example, in the 1970s and 1980s, the Supreme Court examined the issue of shopping mall owners prohibiting political speech in the form of leafleting and picketing at shopping malls in *Hudgens v. NLRB* and *Pruneyard Shopping Center v. Robins*.<sup>90</sup> The Court in *Hudgens* held that “while statutory or common law may in some situations extend protection or provide redress against a private corporation or person who seeks to abridge the free expression of others, no such protection or redress is provided by the Constitution itself.”<sup>91</sup> Similarly, in *Robins*, the Court concluded that “when a shopping

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86. Examples discussed below include speech restrictions by shopping mall owners. See, e.g., *Pruneyard Shopping Ctr. v. Robins*, 447 U.S. 74 (1980); *Hudgens v. NLRB*, 424 U.S. 507 (1976).

87. Jonathan Peters, *The “Sovereigns Of Cyberspace” and State Action: The First Amendment’s Application - Or Lack Thereof - To Third-Party Platforms*, 32 BERKELEY TECH. L.J. 989, 990–96 (2017).

88. John Q. Mulligan, *Huppert, Reilly, and the Increasing Futility of Relying on the First Amendment to Protect Employee Speech*, 19 WM. & MARY BILL RTS. J. 449, 461 (2010).

89. See Alina Tugend, *Speaking Freely About Politics Can Cost You Your Job*, N.Y. TIMES (Feb. 20, 2015), [http://www.nytimes.com/2015/02/21/your-money/speaking-about-politics-can-cost-you-your-job.html?\\_r=0](http://www.nytimes.com/2015/02/21/your-money/speaking-about-politics-can-cost-you-your-job.html?_r=0) [<https://perma.cc/84KH-BJFB>]; see also, Ari Shapiro, *Can Bosses Do That? As It Turns Out, Yes They Can*, NPR (Jan. 29, 2010, 12:00 AM), <http://www.npr.org/templates/story/story.php?storyId=123024596> [<https://perma.cc/B6BA-F76T>].

90. *Hudgens v. NLRB*, 424 U.S. 507 (1976); *Pruneyard Shopping Ctr. v. Robins*, 447 U.S. 74 (1980).

91. *Hudgens*, 424 U.S. at 513.

center owner opens his private property to the public for the purpose of shopping, the First Amendment to the United States Constitution does not thereby create individual rights in expression.”<sup>92</sup>

A more recent example of private regulation of speech is *Manhattan Community Access Corp. v. Halleck*,<sup>93</sup> a 2019 case involving a private non-profit corporation operating a public-access television channel.<sup>94</sup> Manhattan Community Access had aired a video created by Halleck and received complaints about its content.<sup>95</sup> It then refused to re-air the video, and suspended Halleck from all their services and facilities.<sup>96</sup> Halleck alleged a violation of First Amendment rights in the denial of access to public access channels.<sup>97</sup> The Supreme Court ruled that the corporation was not a state actor and therefore could not be sued for violating the First Amendment.<sup>98</sup>

The state action doctrine has exceptions that include situations where a government agency participates as a member of a private organization.<sup>99</sup> The key question is the degree of entanglement with the organization: if the government is “pervasively entwined” in organization leadership, it has crossed the line into state action.<sup>100</sup> A small degree of entanglement, however, does not cross the threshold.<sup>101</sup> This is the case with ICANN: the key transition document, the Affirmation of Commitments, does not support the concept

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92. *Pruneyard*, 447 U.S. at 81 (reference omitted).

93. *Manhattan Cmty. Access Corp. v. Halleck*, 139 S. Ct. 1921 (2019).

94. *Id.* at 1924.

95. *Id.* at 1927.

96. *Id.*

97. *Id.*

98. *Id.* at 1934; see also Amy Howe, *Opinion Analysis: Court Holds that First Amendment Does Not Apply to Private Operator of Public-Access Channels*, SCOTUSBLOG (Jun. 17, 2019, 6:09 PM), <http://www.scotusblog.com/2019/06/opinion-analysis-court-holds-that-first-amendment-does-not-apply-to-private-operator-of-public-access-channels/> [https://perma.cc/WE3F-G73U].

99. See Geoffrey A. Manne et al., *A Conflict of Visions: How the 21st Century First Amendment Violates the Constitution’s First Amendment*, 13 FIRST AMEND. L. REV. 319, 331–32 (2018).

100. *Id.*

101. See *id.*

that ICANN is a government agency,<sup>102</sup> nor that it is “pervasively entwined” with such an agency.<sup>103</sup> The technology community understood the affirmation to initiate a severing of the relationship between the United States Department of Commerce (DOC) and ICANN.<sup>104</sup>

The trademark holder’s argument is similar to those of shopping mall owners: the provision of a web domain is a matter of private commerce between the domain owner and the purchaser. A domain is easy for the public to access, just as a shopping mall is easy to access. The sale of the domain is facilitated by ICANN policy—none of the parties are government actors or agents. Therefore, there are no First Amendment protected rights at stake.<sup>105</sup> In effect, the owner of the gTLD .sucks is free from free speech restraint in the allocation of sites within that domain. This argument is nevertheless date sensitive. Prior to 2009, the government held a critical role in the power granted to ICANN.<sup>106</sup> The Affirmation of Commitments, signed in September 2009, initiated a divorce process between ICANN and the DOC that ended in 2016.<sup>107</sup> To emphasize the formality of the break, the NTIA posted a signed “[c]loseout [c]ontract” document to the web in October of

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102. The Affirmation of Commitments is explicit—ICANN promises in section 8 “to operate as a multi-stakeholder, private sector led organization with input from the public, for whose benefit ICANN shall in all events act. ICANN is a private organization and nothing in this Affirmation should be construed as control by any one entity.” See *Affirmation of Commitments by the United States Department of Commerce and the Internet Corporation for Assigned Names and Numbers* 1–2 (Sept. 30, 2009), [http://www.ntia.doc.gov/files/ntia/publications/affirmation\\_of\\_commitments\\_2009.pdf](http://www.ntia.doc.gov/files/ntia/publications/affirmation_of_commitments_2009.pdf) [<https://perma.cc/G7AM-7SWD>] (This is how the business of altering gTLDs is left in ICANN control, and this is how ICANN claims to be outside the US government).

103. Manne et al., *supra* note 98, at 331–32.

104. Eileen Yu, *US Government Finally Lets ICANN Go*, ZDNET (Sept. 30, 2009, 8:49 AM), <https://www.zdnet.com/article/us-government-finally-lets-icann-go> [<https://perma.cc/QVH3-C8G2>].

105. See Manne et al., *supra* note 98, at 320–23 (“Under the Constitution’s negative conception of liberty, I have the right to kick you out of my home for something as menial as saying the word ‘broccoli,’ and this would not violate your right to free speech.” And “the First Amendment itself does not require that the government provide opportunities for speech, or defend against private action.”).

106. See Michael Froomkin, *Wrong Turn In Cyberspace: Using ICANN To Route Around The APA and The Constitution*, 50 DUKE L.J. 17, 82–85 (2000).

107. See *IANA Functions Transitions as Contract with U.S. Government Ends*, *supra* note 27.



2016.<sup>108</sup> However, trademark holders do have to bear in mind caselaw that, at first glance, asserts a First Amendment dimension to domain names. That caselaw is the subject of the next section.

## V. COURTS FINDING A FIRST AMENDMENT VIOLATION

Federal court rulings between 1998 and 2000 saw little importance in the domain name itself. Instead, the focus of First Amendment concern was on site content. After 2000, domain names became a focus of attention, as noted by commentator Jude Thomas in his 2011 review of trademark law.<sup>109</sup> Thomas identified five cases where the courts held in favor of First Amendment rights for domain name owners, all set within his review of the theoretical connection between trademark disputes, gripe sites (such as vw.sucks), and the First Amendment.<sup>110</sup> His analysis rested on three well-understood, non-controversial assertions.<sup>111</sup> The first was that free speech values and trademark law values have a “rocky relationship”—one promotes speech protection, the other promotes speech restriction.<sup>112</sup> The second was that the classic justifications for promoting free speech include “the search for truth,” “encouraging individual autonomy through self-expression” and “enabling democratic self-rule.”<sup>113</sup> Finally, critical speech is vital: “American jurisprudence has historically been firmly protective of those who engage in speech that is of a critical nature. Such protection has been particularly generous in those instances in which the target of the criticism is a business or public figure.”<sup>114</sup>

Thomas goes on to argue that “most” courts see the need for constitutional protection of expressive speech in critical or pejorative domain

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108. See *IANA Functions Contract*, NTIA (Oct. 21, 2016), <https://www.ntia.doc.gov/page/iana-functions-purchase-order> [<https://perma.cc/2GBM-NM6G>]. Media coverage of the transition focused on opposition from Republican members of Congress (fearful of a loss of U.S. power). See Gross, *supra* note 27.

109. See generally Thomas, *supra* note 11.

110. *Id.* at 14 nn.14–15.

111. *Id.* at 10–12.

112. *Id.* at 10.

113. *Id.* at 11.

114. *Id.* at 11–12.

names.<sup>115</sup> By the same token, “[w]here expressive speech is not clear, as in <trademark+modifier.com> domain names, or where such speech is absent altogether, as in <trademark.com> domain names, tribunals have been more reluctant to extend these protections.”<sup>116</sup> To support this claim, Thomas cites five cases; however, all the cases were decided between 2000–2006.<sup>117</sup> As such, these cases preceded the government’s creation of a transition plan moving control to the private sector,<sup>118</sup> and the ultimate transition to exclusive ICANN control in 2016. Thomas does not address the government action issue, leaving the door open for this analysis. As discussed below, in three of the five cases cited by Thomas, the court itself failed to identify the government action that led to a violation of free speech rights.

In the first case, *Name.Space v. Network Solutions Inc.*, there is in fact government action.<sup>119</sup> The dispute arose in 1997 while the U.S. government held a key role in the development of the DNS system.<sup>120</sup> The National Science Foundation (NSF) had an agreement with Network Solutions Incorporated (NSI) through which the latter “was the sole registrar for new domain names under the .com, .org, .net, .edu, and .gov gTLDs.”<sup>121</sup> The NSF, a federal agency, was a named defendant in the case, along with NSI.<sup>122</sup> In a memorandum of agreement signed in 1998, the NSF specifically agreed to defend the Name.Space lawsuit, while the NSF was at that time transferring its administrative role regarding Network Solutions to the Department of Commerce.<sup>123</sup>

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115. *Id.* at 14.

116. *Id.*

117. *Id.* at 14 nn.47–48.

118. This is known as the Affirmation of Commitments 2009. *Affirmation of Commitments*, *supra* note 101; *see also* Yu, *supra* note 103; Maria Farrell, *Quietly, Symbolically, US Control of The Internet Was Just Ended*, *GUARDIAN* (Mar. 14, 2016), <http://www.theguardian.com/technology/2016/mar/14/icann-internet-control-domain-names-iana> [<https://perma.cc/75LG-T24Y>].

119. *Name.Space, Inc. v. Network Sols., Inc.*, 202 F.3d 573 (2d Cir. 2000).

120. Froomkin, *supra* note 105, at 57–63.

121. *Name.Space*, 202 F.3d at 577.

122. *Id.*

123. *Id.* at 579.

Given the government's role in contracting out DNS management and in defending the lawsuit, the existence of government action was indisputable.<sup>124</sup> NSI's role in domain management would eventually be taken over by ICANN, approximately one year after the dispute with Name.Space arose.<sup>125</sup> When Name.Space brought suit to force NSI to expand the list of domain names, it had no choice but to sue the NSF, the federal government, in addition to NSI.<sup>126</sup> With the federal government defending its role, it was not difficult for the court to see the application of First Amendment principles.<sup>127</sup> Name.Space lost its anti-trust and First Amendment claims in the trial court and in the Second Circuit.<sup>128</sup> Judge Katzmman, writing for the Court of Appeals, stated:

In short, while we hold that the existing gTLDs do not constitute protected speech under the First Amendment, we do not preclude the possibility that certain domain names and new gTLDs, could indeed amount to protected speech. The time may come when new gTLDs could be used for an expressive purpose such as commentary, parody, news reporting or criticism, comprising communicative messages by the author and/or operator of the website in order to influence the public's decision to visit that website, or even to disseminate a particular point of view.<sup>129</sup>

Anticipating that decisions on internet regulation were wading into ever-changing waters, Judge Katzmman noted that changes in the Internet happen at "lightning speed," while courts of law move slowly.<sup>130</sup> Given the

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124. *See id.* at 579–80.

125. For details on the origin of ICANN, see generally *ICANN's Early Days*, ICANN, <https://www.icann.org/en/history/early-days> [<https://perma.cc/6MV7-VU62>].

126. *See Name.Space*, 202 F.3d at 579–80.

127. *See id.* at 584–88.

128. *See id.* at 588.

129. *Id.* at 586.

130. *Id.* at 584.

rapid development of new frontiers on the web, the court was “wary of making legal pronouncements based on highly fluid circumstances, which almost certainly will give way to tomorrow’s new realities.”<sup>131</sup>

In the second case, *Taubman Co. v. Webfeats*, the Sixth Circuit found a government connection in the form of a preliminary injunction issued at trial.<sup>132</sup> Plaintiff Taubman had won an injunction which prevented Webfeats owner Henry Mishkoff from using a variety of complaint/gripe domain names, such as “taubmansucks.com.”<sup>133</sup> The court found that the use of the trademark in a domain name implicated free speech, specifically noting that the First Amendment protects critical commentary.<sup>134</sup> In the domain “taubmansucks.com,” there was no confusion about the author or their point of view.<sup>135</sup> According to the court, “Taubman concedes that Mishkoff is ‘free to shout ‘Taubman Sucks!’ from the rooftops . . . .”<sup>136</sup> Essentially, this is what he has done in his domain name. “The rooftops of our past have evolved into the internet domain names of our present.”<sup>137</sup> The court’s decision boiled down to protecting a “First Amendment right” of Mishkoff to criticize Taubman.<sup>138</sup> The Taubman court does not discuss the regulatory scheme that supports domain names, and so does not address the problem of ICANN or Department of Commerce control.<sup>139</sup>

The third case Thomas cited is a 2006 case, *Sunlight Saunas v. Sundance Sauna*.<sup>140</sup> Sunlight Saunas (“Sunlight”) and Sundance Sauna (“Sundance”) were competing companies engaged in vigorous competition,

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131. *Id.* at 584.

132. *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003).

133. *Id.* at 772.

134. *Id.*

135. *Id.* at 778.

136. *Id.* (citation omitted).

137. *Id.*

138. *Id.*

139. *See id.* at 770.

140. *Sunlight Saunas, Inc. v. Sundance Sauna, Inc.*, 427 F. Supp. 2d 1032 (D. Kan. 2006).

often involving derogatory comments about the rival's products.<sup>141</sup> Sundance created a website, sunlightsaunas--exposed.com, specifically to drive customers away from its rival.<sup>142</sup> Sunlight brought action alleging violation of the Lanham Act, the Sherman Act, trademark infringement, trademark dilution, cybersquatting, various business torts, and unfair competition.<sup>143</sup> The decision of the District Court for the District of Kansas relies on the Name.Space precedent in reaching the non-committal conclusion that a domain name "may constitute expressive speech."<sup>144</sup> Per the court, a domain name is not automatically excluded from, nor included within, the ambit of the First Amendment.<sup>145</sup>

The fourth case Thomas cited is *OBH v. Spotlight Magazine*, decided in 2000.<sup>146</sup> OBH owned and published a daily newspaper called The Buffalo News and registered a trademark under that name.<sup>147</sup> In conjunction with the paper, OBH operates two web sites: www.buffnews.com and www.buffalo.com.<sup>148</sup> Spotlight magazine published apartment rental guides in western New York, and engaged in a business dispute with OBH.<sup>149</sup> Subsequently, Spotlight registered the domain name www.thebuffalonews.com, using it as a parody site.<sup>150</sup> OBH brought an action alleging violations of the Lanham Act, trademark dilution and infringement under New York law.<sup>151</sup> The District Court for the Western District of New York also relied on *Name.Space*, citing as a general rule that "[w]hether a particular domain

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141. *Id.* at 1032.

142. *Id.* at 1045.

143. *Id.* at 1032.

144. *Id.* at 1057; *see also* Name.Space, Inc. v. Network Sols., Inc., 202 F.3d 573, 585–86 (2d Cir. 2000).

145. *Sunlight Saunas*, 427 F. Supp. 2d at 1057.

146. *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176 (W.D.N.Y. 2000).

147. *Id.* at 181.

148. *Id.* at 181–82.

149. *Id.* at 182.

150. *Id.*

151. *Id.* at 184.

name is entitled to protection under the First Amendment depends on the extent of its communicative message.”<sup>152</sup> The court found that the First Amendment does not protect customer deception by the defendants through trademark use.<sup>153</sup> Here, once again, the court did not discuss the absence of governmental action in regulating domain names. The only government action was a preliminary injunction issued in favor of the trademark holder.<sup>154</sup>

The last case, *Morrison & Foerster v. Wick*, in resolving a dispute relating to the law firm Morrison & Foerster, also cites *Name.Space*.<sup>155</sup> Defendant Brian Wick had registered “www.morrisonfoerster.com” and similar names, and had used the sites to criticize the firm.<sup>156</sup> Morrison & Foerster held the domain name www.mofo.com.<sup>157</sup> The firm alleged many violations of their rights against Wick, including cybersquatting and trademark infringement.<sup>158</sup> However, the court rejected a First Amendment defense offered by Mr. Wick and explained that “because Mr. Wick’s domain names merely incorporate Morrison & Foerster’s trademark, they do not constitute a protectable, communicative message. Whether a particular domain name is entitled to protection under the First Amendment depends on the extent of its communicative message.”<sup>159</sup> The court ordered the transfer of domain names held by Wick to the plaintiffs.<sup>160</sup>

The problem with *Wick* is the idea that when a domain name falls into communicative message territory, it is automatically subject to First Amendment protection. This is a misguided approach to speech that is inconsistent

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152. *Id.* at 197.

153. *Id.*

154. *Id.* at 187–88.

155. *Morrison & Foerster, LLP v. Wick*, 94 F. Supp. 2d 1125, 1135 (D. Colo. 2000).

156. *Id.* at 1127–28.

157. *Id.* at 1127.

158. *Id.* at 1128.

159. *Id.* at 1135.

160. *Id.* at 1134.

with the history of free speech doctrine.<sup>161</sup> Perjury and defamation both communicate messages; however, neither falls within the domain of constitutionally protected free speech.<sup>162</sup> Even when the message is legitimate, the context of its display remains critical. When the members of the Gay Lesbian Bisexual Group of Boston insisted on marching uninvited in a St. Patrick's Day parade, a unanimous Supreme Court ruled against them.<sup>163</sup> While participation in the parade was clearly a form of speech, it could not be forced onto the message that the organizers of the Boston St. Patrick's Day parade wanted to present.<sup>164</sup> Again, per the Court, it is within the power of a private organization to control the content of its speech.<sup>165</sup>

More importantly, the absence of government action in the case of a gripe site losing its domain name should trump any question about communicative messages. None of the cases that rely on *Name.Space* acknowledges that the federal government in 2000 held a key role in administering the DNS system. Likewise, none of these cases could anticipate the implications of the 2016 handover to ICANN.

Jacqueline Lipton, writing in 2006, proposed a way to accommodate the interests of gripe site owners with the interests of trademark holders by emphasizing the segregation of domains.<sup>166</sup> This approach entails protecting the trademark owner's use of the "trademark".com domain, and presuming as a matter of law that "trademark".sucks will be easily understood to be a gripe site.<sup>167</sup> Lipton believes that "[d]eveloping mechanisms that facilitate free speech in the domain space is an important next step in the emerging

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161. See generally THOMAS L. TEDFORD & DALE A. HERBECK, FREEDOM OF SPEECH IN THE UNITED STATES (3d ed. 1985).

162. For more on defamation, see *id.* at 80–87. For more on perjury, see *United States v. Alvarez*, 567 U.S. 709, 720 (2012).

163. *Hurley v. Irish-American Gay*, 515 U.S. 557 (1995).

164. *Id.* at 576 (“[W]hen dissemination of a view contrary to one’s own is forced upon a speaker intimately connected with the communication advanced, the speaker’s right to autonomy over the message is compromised.”).

165. See *id.* at 572–74.

166. Jacqueline Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and The First Amendment in Cyberspace*, 84 WASH. U. L. REV. 1327, 1361 (2006).

167. See *id.* at 1364, 1372–73.

framework for Internet regulation.”<sup>168</sup> Lipton suggests that differing presumptions about trademark.com and trademark.sucks domains would be grounded in a policy that respects the critical criterion of consumer confusion.<sup>169</sup>

A few years after Lipton’s article, the .sucks domain name is a reality and the U.S. government no longer has a role in domain name registration. The absence of government regulatory power creates an impenetrable obstacle to any First Amendment claims. The net effect of the privatization of the internet is that trademark holders retain the upper hand in control of domain names.

## VI. AFTERMATH: UNANTICIPATED CONSEQUENCES

To gain control of any .sucks domain, an individual or company has to pay an annual registration fee to the registrar of the entire .sucks TLD.<sup>170</sup> As of 2019, Canadian-based firm Vox Populi owns the .sucks domain, and has been selling various iterations of it—for example, taylorswift.sucks.<sup>171</sup> Popular fast food chain Wendy’s has opted to buy wendys.sucks, a site that redirects to Wendy’s official customer comment page.<sup>172</sup> Those who already own a trademark were allowed a “sunrise” period to buy the relevant domain name in advance of a public sale.<sup>173</sup> In some cases, prices in the sunrise

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168. *Id.* at 1374.

169. *Id.* at 1372–73. One purpose of the protection of trademark rights is the prevention of customer confusion. *See also id.* at 1330–31.

170. Brian Fung, *From Google.sucks to HillaryClinton.sucks, Here are the Biggest .sucks Domains That Have Been Taken*, WASH. POST (June 30, 2015, 8:20 AM), <https://www.washingtonpost.com/news/the-switch/wp/2015/06/30/what-do-hillary-clinton-marvel-and-uber-have-in-common-their-sucks-sites-have-all-been-taken/> [<https://perma.cc/7QFC-VJVG>].

171. Popular singer Taylor Swift took more pre-emptive action by acquiring taylorswift.porn, and taylorswift.adult. *See* Roger Kay, *Sega of .Sucks Domain Generates Laughter, Agony*, FORBES (June 29, 2015, 9:17 AM), <https://www.forbes.com/sites/rogerkay/2015/06/29/saga-of-sucks-domain-generates-laughter-agony/#769e35e2f95a> [<https://perma.cc/R2T6-5B3G>]; *see also* Doug Camilli, *Celebs, Firms Grabbing Dot-Rude-Word Domain Names*, MONTREAL GAZETTE (Mar. 25, 2015), <https://montrealgazette.com/entertainment/celebrity/doug-camilli-celebs-firms-grabbing-dot-rude-word-domain-names> [<https://perma.cc/5LD9-3QMF>].

172. *See* WENDY’S, <http://www.wendys.sucks> [<https://perma.cc/N5TK-G378>].

173. Kay, *supra* note 170.



period were very high relative to the norm; this fact prompted some to argue that the entire scheme was an elaborate form of extortion.<sup>174</sup>

When ICANN approved and delegated the .sucks gTLD, it was caught off guard by the methods used by Vox Populi to sell sites.<sup>175</sup> Trademark owners objected to the high prices in the sunrise process.<sup>176</sup> Concerns about the Vox Populi approach led to a request by ICANN to the Federal Trade Commission to investigate the possibility that trade regulations had been violated.<sup>177</sup> The FTC did not investigate.<sup>178</sup> Instead, it recommended that ICANN change its practices.<sup>179</sup> Vox Populi responded with an attack on ICANN, asserting that all Vox Populi practices were legal and that ICANN had defamed Vox Populi.<sup>180</sup> Surprisingly, despite all the controversy in business circles about the ethics of buying and selling .sucks domains, it is not yet on the list of most disputed domain names in the new expanded gTLD

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174. See Spence, *supra* note 3; see also Brian J. Winterfeldt et al., *What To Do About the .Sucks New gTLD*, KATTEN (Mar. 23, 2015), <https://katten.com/what-to-do-about-the-SUCKS-new-gTLD> [<https://perma.cc/M688-U2ZK>].

175. Spence, *supra* note 3.

176. *Id.*

177. Spence, *supra* note 3.

178. See *FTC Dodges ICANN Request for Guidance on Legality of .Sucks Pricing*, WASH. INTERNET DAILY (Warran Commc'n News), May 29, 2015.

179. See *id.*; see also Roberta L. Horton & Michael E. Kientzle, *New Domain Name Registry Asks Trademark Owners to Pay Up*, ARNOLD & PORTER LLP (Apr. 29, 2015), <https://s3.amazonaws.com/documents.lexology.com/d8a1fe86-4e3b-4fb5-8953-55b8f649ff69.pdf> [<https://perma.cc/KL2J-9UN9>]; see also Andrew Allemann, *FTC to ICANN on .Sucks: Yeah, We Told You This Would Happen*, DOMAIN NAME WIRE (May 28, 2015), <https://domainnamewire.com/2015/05/28/ftc-to-icann-on-sucks-yeah-we-told-you-this-would-happen/> [<https://perma.cc/9K76-Y758>].

180. See *Vox Populi Registry Says "Enough" About .Sucks Accusations*, CIRCLEID (May 11, 2015, 6:21 PM), [http://www.circleid.com/posts/20150511\\_vox\\_populi\\_registry\\_says\\_enough\\_about\\_sucks\\_accusations/](http://www.circleid.com/posts/20150511_vox_populi_registry_says_enough_about_sucks_accusations/) [<https://perma.cc/EQ4X-U5QE>].

world.<sup>181</sup> Vox Populi is open to selling more .sucks domains, as visitors to <https://get.sucks/> can attest.<sup>182</sup>

The Vox Populi controversy is another example of how the norm of rapid change in the world of technology creates difficulty for policy makers and policy enforcers.<sup>183</sup> The ability of courts in particular, and jurisprudence in general, to keep up with the evolution of the Internet has been tested in numerous ways.<sup>184</sup> Lightning speed development of the Internet gave rise to the need for a regulatory body such as ICANN.<sup>185</sup> The unique power of ICANN in relation to domain names puts it in a very peculiar place regarding popular understandings of free speech.<sup>186</sup> In the Affirmation of Commitments, ICANN promised to remain headquartered in the United States.<sup>187</sup> This provision provides for an interesting potential conflict between global

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181. See Doug Isenberg, *Here Comes the New gTLD Domain Name Disputes*, GIGALAW (Dec. 9, 2015), [https://giga.law/blog/2015/12/09/here-come-the-new-gtld-domain-name-disputes/\[https://perma.cc/F2YZ-2X8S\]](https://giga.law/blog/2015/12/09/here-come-the-new-gtld-domain-name-disputes/[https://perma.cc/F2YZ-2X8S]); see also Doug Isenberg, *Domain Name Disputes Break Two Records in 2017*, GIGALAW (Jan. 3, 2018), <https://giga.law/blog/2018/1/3/domain-name-disputes-break-two-records-in-2017> [<https://perma.cc/8Y4U-YTZF>].

182. See *Why .Sucks?*, *supra* note 81.

183. Stephen M. Johnson, *The Internet Changes Everything: Revolutionizing Public Participation And Access To Government Information Through The Internet*, 50 ADMIN. L. REV. 277, 295–305 (1998); YU-CHE CHEN, *MANAGING DIGITAL GOVERNANCE: ISSUES, CHALLENGES, AND SOLUTIONS* (2017).

184. One example is the problem of search results that highlight an unrepresentative part of a person's life, thereby permanently damaging public perception of the person. See MEG LETA JONES, CTRL + Z: THE RIGHT TO BE FORGOTTEN (2016). Likewise, issues arise under general policies designed to protect individuals regarding data collected by Google. See Adam Satariano, *Google Is Fined \$57 Million Under Europe's Data Privacy Law*, N.Y. TIMES (Jan. 21, 2019), <https://www.nytimes.com/2019/01/21/technology/google-europe-gdpr-fine.html> [<https://perma.cc/J76N-MH7Y>].

185. Kathleen E. Fuller, *ICANN: The Debate Over Governing the Internet*, 1 DUKE L. & TECH. REV. 0002, 6–8 (2001); see also Peter Holsen, *ICANN'T Do It Alone: The Internet Corporation for Assigned Names and Numbers and Content-Based Problems on the Internet*, 6 MARQ. INTELL. PROP. L. REV. 147, 151–53 (2002).

186. One example of the policy issues ICANN faces is the suggestion that internet domains be zoned so that adult/pornographic sites can be easily identified and segregated. See Holsen, *supra* note 184, at 160–62.

187. See *Affirmation of Commitments*, *supra* note 101.

internet policy set by ICANN and U.S. internet policy preferences determined by Congress.<sup>188</sup>

## VII. CONCLUSION

There are good reasons to believe that domain names have expressive content. Nevertheless, the marketplace is full of material that has expressive content. That fact alone does not require that all sellers are bound by First Amendment rules. As control over domain names is now held exclusively by the private entity ICANN, albeit a not-for-profit entity, the logic of First Amendment free speech doctrine simply does not apply to the actions of ICANN or Vox Populi. If Vox Populi does not want to sell vw.sucks to Bugbites, it does not have to. No person or group can claim that the denial of a .sucks address is a violation of a constitutional right. Statutory rights are another matter. It remains to be seen if Congress will venture into these waters in an attempt to provide some haven for future gripe sites.

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188. When ICANN cut its ties to the U.S. government in 2016, Congressional reaction included concern over the geopolitical consequences. A Texas Senator worried that a lack of “U.S. oversight will open the door to authoritarian governments taking control of the internet.” Laura Sydell, *Republicans Say Obama Administration Is Giving Away The Internet*, NAT’L PUB. RADIO (Sep. 26, 2016, 3:41 PM), <https://www.npr.org/sections/alltechconsidered/2016/09/26/495396014/republicans-say-obama-administration-is-giving-away-the-internet> [<https://perma.cc/WSB7-TA3C>].