

Chapter 1: The Legal-Sized Envelope

May 19, 2001

No Good Deed Goes Unpunished

If they hadn't started out by threatening me, I probably would have just given them the damn thing.

But they were lawyers. I guess they couldn't help themselves.

It was a typical spring Saturday¹ afternoon in Dallas, high near 90 degrees,² not yet hot enough to make me cranky (so there goes that excuse). In my mailbox, nestled among the credit card bills and the computer magazines, I spied an envelope (legal-sized, which turned out to be appropriate) with a return address that identified the senders as Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski. As doctors and accountants typically don't string quite that many names together, I suspected that I was being contacted by a gaggle of lawyers.

The return address indicated that the good people at GKGSA&C were located in Birmingham, Michigan, a city I knew to be a northern suburb of Detroit. I didn't have any relatives in that area, so I doubted that they were contacting me because someone had left me a sizable inheritance. And the letter was addressed to WebFeats, a professional

¹ OK, I didn't really remember the day of the week, I looked it up in The Virtual Perpetual Calendar (VPCalendar.net), a remarkable resource that was created in 1995 by Mark Smith, who says that he's been interested in perpetual calendars since the one he "found when a child in the telephone book." (I assume that it was the calendar that was in the telephone book, not Mark.)

² I found this historical weather information and a wealth of other data in online version of The Old Farmer's Almanac (Almanac.com/weatherhistory).

name that I use for my Internet activities, suggesting that the letter was business-related rather than personal.

Even though I was not accustomed to being contacted by lawyers, I wasn't especially concerned about the letter. After all, I didn't have any clients or friends (or enemies, as far as I knew) in Michigan; it seemed unlikely that anyone there would have hired a group of lawyers to harass or threaten me.

But when I opened the envelope, I discovered that that's exactly what had happened. Here's what it said:

Dear Sir/Madam:

We represent The Taubman Company in intellectual property matters. Our client owns and uses the trademark THE SHOPS AT WILLOW BEND, in connection with its shopping malls and related services. The trademark is the subject of U.S. Trademark Registration No. 2,400,909, for mark THE SHOPS AT WILLOW BEND. Our attention has been directed to a website maintained by you, www.shopsatwillowbend.com, incorporating our client's mark in the domain name, and featuring photographs and various information relating to the mall on the website.

So far, I knew exactly what they were talking about – but you may not, so let me explain.

The Taubman Company, on whose behalf the law firm was contacting me, is one of the largest developers of shopping malls in the U.S. At the time that I received the letter, Taubman was putting the finishing touches on The Shops at Willow Bend, an impressive new mall that would soon open in Plano, a Dallas suburb. The new mall

would be located only a few miles from my home in Dallas, and I eagerly anticipated its arrival – so eagerly, in fact, that I had decided to create a website about it when I had first learned of Taubman’s plans two years earlier.

When I was ready to select a domain name for my website, I noticed that Taubman had registered TheShopsAtWillowBend.com,³ so I decided to create my website at ShopsAtWillowBend.com (without “The”) – although it wasn’t the exact name of the mall, I figured that it was close enough so that people would be able to remember it easily.

(Although a comprehensive explanation of Internet terminology is well beyond the scope of this book, I should provide at least a cursory explanation of what a domain name is. If you create a website and you want it to have a name, you can register a “domain name” with one of several hundred Internet registrars,⁴ and that domain name becomes the heart of your web address. For example, consider this web address:

<http://www.ThisBookSucks.com/GoodStuff/RightHere.html>

In this example, the domain name is **ThisBookSucks.com**, and that’s the only part you have to register. Each domain name is unique – once you’ve registered it, it’s your exclusive property, and nobody else can use it as their domain name.⁵)

³ They seem to have abandoned that name in favor of the more manageable ShopWillowBend.com.

⁴ A list of registrars is maintained online at www.InterNIC.net/regist.html.

⁵ For a more thorough explanation of domain names (or of any other technical terms that you may find in this book), check out the amazing Wikipedia (en.Wikipedia.org), which describes itself as “a free-content encyclopedia in many languages that anyone can edit.”

The site I created was filled with all kinds of helpful information about the mall – what it was going to look like, where it was going to be located, what stores it would contain, and other interesting bits of data. (“*The Shops at Willow Bend* will feature a two-level parking deck with spaces for 6,358 cars – 2,925 spaces [46%] on the lower level, and 3,433 spaces [54%] on the upper level.”) I noticed that Taubman’s site included a depiction of the “Grand Court” and an area map; I downloaded those graphics and incorporated them into my site. (I was using their graphics to promote their mall, so I assumed that they wouldn’t mind.)

In case you were looking for Taubman’s site and happened to stumble across mine instead, my home page featured a prominent disclaimer at the top of the page in bold black letters in a bright green box:



This is an unofficial site. The official site is located at www.TheShopsAtWillowBend.com

The web address in the disclaimer served as a link to the official site – so if you wanted to visit Taubman’s site, you could get there with a single click.

As you may have noticed, the letter pointed out that “The Shops at Willow Bend” was not only the name of Taubman’s shopping mall, it was the *trademarked* name of Taubman’s shopping mall. Even without reading any further, I was guessing that I was about to learn that Taubman didn’t like the idea that I had “incorporated” their trademark into my domain name.⁶ And sure enough:

⁶ The more observant among you will notice that, despite the lawyers’ claim, my domain name did not actually “incorporate” Taubman’s trademark – it would be more accurate to say that my domain name was a subset of Taubman’s trademark. I’m not suggesting that my omission of the word “the” is significant

You are hereby advised that this use of our client's registered mark creates a likelihood of confusion as to a relationship with our client, in violation of federal and state trademark and unfair competition law, as well as a violation of the federal Anticybersquatting Consumer Protection Act.

As I suspected, the lawyers hadn't written to me because they liked my website.

Instead, they were accusing me of all kinds of horrible-sounding things:

- I was confusing people into believing that I had some kind of relationship to Taubman – this despite the striking disclaimer that dominated the top of my home page.
- I was unfairly competing with Taubman. (I was surprised to learn that I was competing with Taubman at all, unfairly or otherwise.)
- I had violated the Anticybersquatting Consumer Protection Act – which, although I like to keep up with issues relating to the Internet (even legal issues), was something with which I was totally unfamiliar.
- I was violating trademark law. Although I had only a high-level layman's understanding of what a trademark was, at least this was a term I recognized.

Since I had apparently run afoul of so many laws, I steeled myself for the inevitability that the next paragraph would inform me that I was in serious trouble. Which it did:

from a legal perspective, but I am suggesting that lawyers should be more attentive to the precise definitions of the words they employ, especially when they're leveling charges and making threats.

In order to avoid legal action, we hereby demand that you immediately discontinue all use of the above-referenced domain name and related website, and arrange for transfer of the domain name registration to our client. In the event legal action is commenced, we will seek all available remedies, including injunctive relief, increased damages in view of the willful nature of the infringement, and attorneys fees.

Please contact us immediately to indicate your intentions.

Very truly yours,
Julie A. Greenberg

At this point, I recognized that Ms. Julie A. Greenberg had sent me what lawyers like to call a “cease-and-desist” letter⁷ – or, in legal shorthand, a “C&D” letter. And as with all good C&D letters, this one basically said: You’re doing something that we don’t want you to do. So cut it out. Or we’ll sue you.

The main reason I recognized it as a cease-and-desist letter, by the way, was because I had once been on the sending end. One of my computer-consulting clients was a major national corporation, a name you’d probably recognize. Let’s call them the Really Big Company. When I added web development to my repertoire of services in the mid-1990’s, I immediately set out to convince the Really Big Company that they needed a website. It was a tough sell – at that time, most companies were clueless about what the Web could do for them. But I wore them down, and in late 1995 they finally gave me the go-ahead to create a website for them.

⁷ Miriam-Webster OnLine (MiriamWebster.com) says that both words mean the same thing – so in plain, non-legalese English, I had just received a “stop-and-stop” letter.

Unfortunately, by that time the domain name ReallyBigCompany.com had already been registered by someone else.⁸

I did some quick research and discovered that ReallyBigCompany.com had been registered by a “web shop,” a company that developed websites – which, at the time, was what I was doing under the WebFeats name. As far as I could tell, the web shop had never actually used the name ReallyBigCompany.com, and I guessed that they had registered the name as part of an effort to win some business from the Really Big Company affiliate in... well, in a city that I won't name. I further guessed that the effort had failed, and that they'd probably agree to transfer ReallyBigCompany.com to my client if we asked them to do that. So I suggested to my client that they should let me call the web shop; I'd explain the situation to them, geek-to-geek, and I'd ask them if they'd transfer ReallyBigCompany.com to my client so I could develop a website at that address.

Thanks, my client said, but we'll have our lawyers send them a cease-and-desist letter. That's what we pay them for.

You can probably guess the rest. I never did read that particular C&D letter, but I suspect that it was overbearing and heavy-handed, which seems to be the way that attorneys are taught to write C&D letters in law school. And the guy who ran the web shop, incensed at being threatened for no good reason, basically told my clients what they could do with their cease-and-desist letter. I gave the guy a week to cool off, then I called him. I let him vent for ten minutes, commiserated with him (#&%\$@# lawyers!), waited

⁸ As I write this, the domain name ReallyBigCompany.com has not actually been registered by anyone. But by the time you read this, it probably will have been registered by someone who thinks that you'll check it out to see if anything's there. And unless someone who's associated with my agent or my publisher snaps it up before this book hits the streets, odds are that it'll be a porn site. So it goes.

for him to calm down, explained the situation to him, and asked him nicely if we could have ReallyBigCompany.com. Sure, he said, I'll take care of it tomorrow. And he did.

Now that I was the proud recipient of what I suspected was a nearly identical cease-and-desist letter of my very own, I was puzzled and angry. Why was Ms. Greenberg threatening me? Was this any way to begin a dialogue with a total stranger?

Here's the way I look at it: If your neighbor was playing his stereo too loudly, you'd probably knock on his door and ask him to turn down the volume. But I'm guessing that you wouldn't add, "Oh, and by the way, if you *don't* turn it down, I'm going to call the police and have them drag you off to jail." You might do that if this were a recurring problem, and you might do that if you didn't especially like your neighbor – but under normal circumstances, you wouldn't include a threat with your first request because (1) it's rude, and your mother raised you to be polite, and (2) it might well be counterproductive, in that your neighbor might actually crank *up* the volume just to make a point about your attitude.

But for some reason, many (most?) lawyers don't seem to feel that that the ordinary rules of simple courtesy apply to them. In fact, some lawyers probably feel that it is actually their professional responsibility to engage in behavior that would otherwise be considered to be overbearing and boorish. They might point to a comment in the Model Rules of Professional Conduct of the American Bar Association, which suggests that a lawyer should "take whatever lawful and ethical measures are required to vindicate a client's cause or endeavor"⁹ – and, of course, being rude is not unlawful (and it's probably not even unethical).

⁹ ABAnet.org/cpr/mrpc/rule_1_3_comm.html

However, if they're going to claim that their duty to their client excuses their lack of civility, they should keep reading. A few sentences later, the same comment concludes by noting, "The lawyer's duty to act with reasonable diligence does not require the use of offensive tactics or preclude the treating of all persons involved in the legal process with courtesy and respect." (So we can all thank the ABA for the fact that letters from lawyers are unfailingly courteous and respectful.)

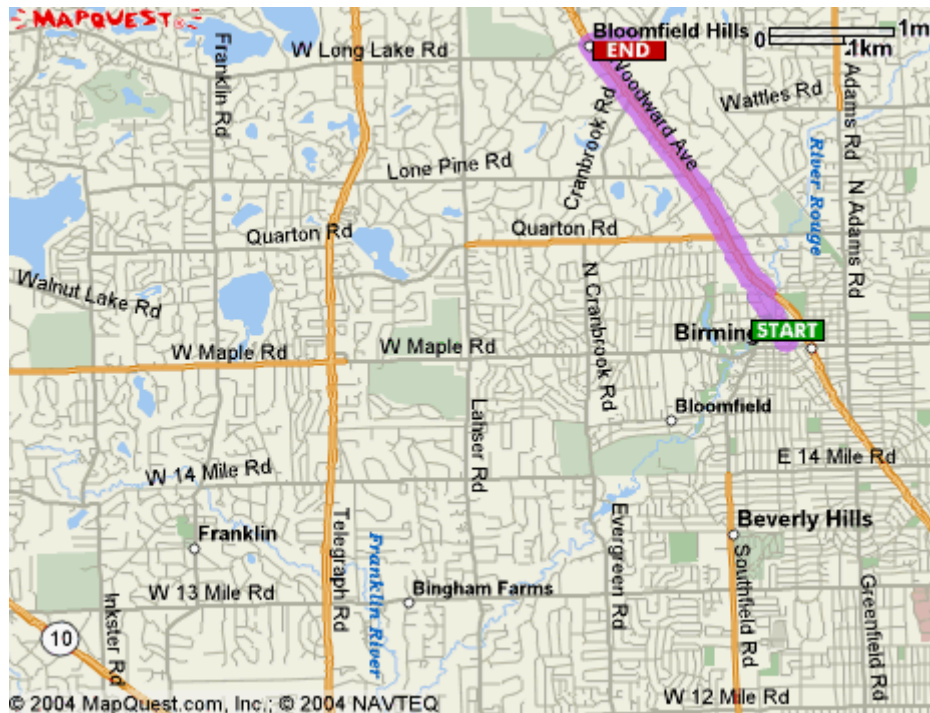
The most bizarre aspect of the situation was that she was threatening me for creating a website that actually promoted her client's mall!

Would you be angry if someone threatened you because you tried to help them?

Me too.

Donna Weighs In

I showed the letter to Donna, my girlfriend, not only because I thought that it might elicit a “poor baby” or two, but because she had grown up only a few miles from the law firm’s office – and, in fact, only a few miles from the offices of The Taubman Company, the client on whose behalf Julie Greenberg was threatening me. Before I showed Donna the letter, I went to the MapQuest.com website and plotted the route between the law office (labeled “START” on the map below) and the offices of The Taubman Company (“END”); Donna had lived in Franklin, which you’ll spot near the lower-left corner of the map.



[Note: I'll need permission from Mapquest to use their map.]

As I had hoped, Donna was curious about the map; although she wasn't familiar with either The Taubman Company or the law firm of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, she was very familiar with the area, and she enjoyed the opportunity to reminisce about the time that she had lived there.

But when I started to rant about lawyers and their threatening letters, Donna was nonplussed. "Why don't you just give it to them?" she suggested. "You have other fish to fry."

Although I was loath to admit it, Donna had a point. I had big plans for the website when I had first conceived of it. I would attend the groundbreaking ceremonies and write about them on the website. I would visit the construction site from time to time to document its progress. I would create an online discussion group so that people could exchange opinions and information about the mall. I would develop an interactive map of the mall, perhaps accompanied by a virtual-reality tour...

The actual (non-virtual) reality was that I had done none of those things. Instead, I had created a serviceable but undistinguished website. Work (and play) kept getting in the way of my good intentions. It's nice to have hobbies, but I'm also fond of earning a living, and I always seemed to have something to do that had a higher priority than creating a whiz-bang, state-of-the-art website about The Shops at Willow Bend.

In other words, as Donna pointed out, I had other fish to fry.

So, to answer Donna's question: Why didn't I just give it to them?

"I'll think about it," I said.

Which I did.

And one of the things I thought about was that it probably would be helpful to have more information about the reality behind the accusations that Julie Greenberg had made – which meant that this would be a good time to do some research into cybersquatting and trademark laws.

Trademarks and Me

Even before I Googled¹⁰ it, I thought that I had at least an elementary understanding of what a trademark was.

Taking the word literally, I assumed that a trademark was a “mark” of your “trade” – in other words, the name of your business or some other phrase or image that you use to identify it. Once you’ve spent a lot of time and/or money establishing the reputation of your company, it would be blatantly unfair for someone else to capitalize on your efforts by using your trademark to try to fool consumers into thinking that they were doing business with you. For example, you could legally open your own hamburger stand, even though other companies have already done so – but I assumed that it would be a violation of trademark laws if you called your hamburger stand “McDonald’s” or festooned it with golden arches.

Although I had never been involved in any kind of trademark litigation, I did know how aggravating it could be to have someone try to capitalize on your success. Several years earlier, a friend of mine had complimented me on the full-page advertisement I had run on the back page of a local newspaper. Since I had run no such ad, I tracked down a copy of the newspaper and flipped to the back cover – where, to my surprise, I found an ad for a web shop by the name of “Web’d Feat.” Since my web shop was named WebFeats, I understood my friend’s confusion. And if my friend had been confused, it seemed likely to me that potential clients might be confused as well. This did not strike me as a desirable situation.

¹⁰ As you probably know, “to Google” is the new verb that has largely replaced the unwieldy phrase, “to look something up on the pre-eminent Internet search engine Google.com.”

I immediately fired off a letter to the gentleman who was doing business as Web'd Feat. "I have worked too long and too hard to establish a respected business identity," I said, "to risk having that identity confused with that of anyone else." We exchanged a few notes, and he finally agreed to stop doing business in the Dallas area under a name that could be so easily confused with the name of my business. (In the interest of full disclosure, I should mention that I did threaten him with legal action – but not until more than two months had passed and we had exchanged more than half a dozen notes without making any progress.)

I should point out that I didn't really mind the fact that someone was using a name that was very close to my name. What I did mind was that someone was using a name that was very close to my name *and* doing it in the very same city where I had been working to establish my business. Even if he had been doing business under the *exact* same name I was using, I wouldn't have complained if he hadn't been doing it right here in my backyard.

Does that last sentence strike you as a little self-serving? Can I prove that I wouldn't have complained about someone doing business as "WebFeats" (or something very similar) as long as they weren't located in Dallas?

As it happens, I can – because more than a few web shops have been calling themselves WebFeats (or something very similar) for nearly as long as I've been doing business under that name. Here's a sampling:

WebFeat (WebFeat.org)

Webfeats (Webfeats.net)

WebFeat (WebFeat.com)

Web Feat (Web-Feat.com)

WebFeats! (Web-Feats.com)

Web-Feat Designs (Web-Feat.net)

WebFeats Design (WebFeatsDesign.com)

WebFeat-Hosting (WebFeat-Hosting.co.uk)

As far as I've been able to determine, I registered WebFeats as a domain name before any of these folks registered their domain names. And yet not only have I not threatened any of them, I haven't even contacted them for any reason whatsoever. (A couple of them have contacted me to ask if I might be interested in selling my domain name. I'm not.)

The point I'm trying to make in my roundabout way is that, even if you believe in the concept of trademarks strongly enough to threaten to sue someone who tries to take advantage of yours, that doesn't necessarily imply that you have to threaten and/or sue everyone who registers a domain name that's strikingly similar to your trademark.

Trademarks 101

As I reminded myself many times over the next 21 months, I could have spared myself a lot of trouble by simply giving in to Julie Greenberg's demands and turning ShopsAtWillowBend.com over to her client. Any other course of action would, at the very least, require me to spend some time researching trademark and cybersquatting laws – and as Donna had succinctly reminded me, I had a lot of other seafood that was positively begging to be breaded and cooked in hot oil.

But what if Julie was just blowing smoke? What if I wasn't breaking any laws after all?

After Googling around the Web for a while, I stumbled across the Legal Information Institute (LII)¹¹, a stunningly comprehensive resource that describes itself as “a research and electronic publishing activity of the Cornell Law School.” I followed a link to “Law About” and then a link to “Intellectual Property,” where I was given a list of topics that included copyrights and patents... and trademarks. When I selected the “Trademark” link, I was taken to a page entitled “Trademark Law: An Overview,” which was just what I was looking for.

On the “Overview” page, I learned that something called the “Lanham Act” is the federal law that protects trademarks. I learned that, under the Lanham Act, I could be guilty of trademark infringement if I were to:

“...use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or

¹¹ www.law.Cornell.edu

advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;”¹²

But my website was non-commercial. I wasn’t selling, offering to sell, distributing, or advertising goods or services of any kind. And because of the disclaimer that dominated my home page, my site was unlikely to cause confusion with Taubman’s site.

OK, so it didn’t look like I was a trademark infringer – but could I be a cybersquatter?

A search for information about cybersquatting brought me to Mama-Tech,¹³ the whimsically named domain of attorney of Diane Thilly Cabell, who serves as the Director of Clinical Programs of something called “The Berkman Center for Internet & Society” at Harvard Law School.¹⁴ According to its mission statement, the purpose of The Berkman Center is “to explore and understand cyberspace, its development, dynamics, norms, standards, and need or lack thereof for laws and sanctions.”

I was certainly interested in learning more about the laws of cyberspace, and I had even been threatened with sanctions, so Mama-Tech looked like the place for me. And sure enough, on a page entitled “Trademark Cyberpiracy Protection,” I found the text of the Anticybersquatting Consumer Protection Act (ACPA), one of the laws that Julie Greenberg had accused me of violating.

¹² US Code, Title 15, Chapter 22, Subchapter III, Section 1114, paragraph (1)(a)

¹³ Mama-Tech.com

¹⁴ Cyber.Law.Harvard.edu

The ACPA basically said that I was a cybersquatter if I registered a domain name that was confusingly similar to a trademark – but only if I had “a bad faith intent to profit from that mark.” Well, I had to admit that my domain name (ShopsAtWillowBend.com) was more than a little similar to Taubman’s trademark (TheShopsAtWillowBend.com). But not only did I not have a “bad faith” intent to profit from the situation, I had no intent to profit from the situation in any way whatsoever!

Clearly, I had a decision to make.

If I refused to relinquish ShopsAtWillowBend.com, I might get sued, which would surely waste a large chunk of my time – and if I lost, it could eat up a good-sized chunk of my money as well. As I’ve said, the domain name was not as important to me as I thought it was going to be when I had first registered it. So why not just give it up and avoid the hassle?

On the other hand, my admittedly cursory investigation into trademarks and cybersquatting had led me to believe that, despite Julie Greenberg’s claims to the contrary, I might not actually be breaking any laws. If I suspected that Julie was making empty threats but gave in to her demands anyway, I might tell myself that I was just trying to avoid an unnecessary hassle, but wouldn’t I really be doing it because I was afraid of her? And doesn’t giving in to bullies only encourage them?

What would you have done?

I may not have provided enough details about the situation for you to answer that question with any confidence, so let’s simplify it: Let’s say that you own something, it’s not an item that’s especially valuable or important to you, someone contacts you and says that the property is legally theirs, not yours, and that they’ll sue you if you don’t give it to

them – and although you don't think that they're right, you're not sufficiently familiar with the legalities of the situation to be 100% certain. Would you consider it to be a matter of principle to fight to hold on to something that you think is yours, even if it's something to which you're not overly attached? Would you give it to them to avoid wasting your time fighting over something that you don't even especially want to hold on to in the first place? Would you try to find some middle ground between those two extremes?

After thinking it over, I decided that, if I were going to give up the domain name, I'd like to see some evidence that I would be breaking the law if I held on to it.

Although I was at least moderately confident that I had understood the implications of the laws that I had read, I'm not quite conceited enough to believe that I had mastered all of the intricacies of trademark law in a few minutes of surfing the Web. What I needed was access to an intellectual property attorney, someone to whom I could ask a few pointed questions about where I stood in relation to the law.

Luckily for me, an intellectual property attorney had contacted me less than a week earlier, so I knew exactly whom to ask.