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## The Plague of Fake News and the Intersection with Trademark

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THE PLAGUE OF FAKE NEWS AND THE INTERSECTION WITH TRADEMARK LAW

BY JOSHUA HUMPHREY<sup>1</sup>

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## I. INTRODUCTION

In 1988, the United States Trademark Association (USTA),<sup>2</sup> a pro-trademark advocacy group, testified before Congress that, under section 44(d) of the Lanham Act,<sup>3</sup> a foreign individual or entity could receive a priority date on their applications and effectively freeze out an American company.<sup>4</sup> Occurring in the shadow of the Toshiba-Kongsberg<sup>5</sup> scandal that stoked fears of Soviet power and the national fear that Japan's status as an economic powerhouse would eclipse the United States, the USTA convinced Congress that the United States was disadvantaged to civil law countries (the majority of which have trademark rights subsisting on registration rather than use).<sup>6</sup> Consequently, the Intent to Use ("ITU") registration system was born.<sup>7</sup> Prior to 1989 and the ITU legislation, federal trademark rights were gained in the United States through their use in interstate commerce; if there was no use, then a claimant could not prevent a third party from using the same mark.<sup>8</sup>

However, concern of foreign interlopers was more illusionary than tangible, and acted more as a xenophobic boogeyman for Congress.<sup>9</sup> If this was a pressing or contested issue, there would be extensive case law on the matter; however, academics during that time found only one case where this was an issue: *SCM Corp. v. Langis Foods Ltd.*<sup>10</sup> In that case, the Court of Appeals for the District of Columbia found that Langis Food Ltd., a Canadian company, maintained priority rights under section 44(d) for their trademark LEMON TREE after it was challenged by the United States company SCM Corp.<sup>11</sup>

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<sup>2</sup> In 1993, the USTA changed its name to the "International Trademark Association" (INTA) in order to "reflect the diversity of its membership" and now "almost two-thirds of [its] members are from outside North America." *History*, INTERNATIONAL TRADEMARK ASSOCIATION, <http://www.inta.org/History/Pages/History.aspx> (last visited Jan. 15, 2017).

<sup>3</sup> 15 U.S.C. § 1126(d). The right of priority is open to anyone under § 1126(d), i.e. "[a]ny person whose country of origin is a party to any convention or treaty relating to trademarks . . . to which the United States is also a party," meaning members of the trade-related aspects of intellectual property rights (TRIPs) agreement, for example, could benefit. *Id.* § 1126(b).

<sup>4</sup> Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 Wake Forest L.R. 827, 841–45 (2000).

<sup>5</sup> See Wende A. Wrubel, *The Toshiba-Kongsberg Incident: Shortcomings Of COCOM, And Recommendations For Increased Effectiveness Of Export Controls To The East Bloc*, AM. U. J. OF INT'L L. AND POL'Y 4(24) 241–273 (1989).

<sup>6</sup> Port, *supra* note 3 at 841. While the logic behind the adoption of the ITU system was largely based on xenophobia and perceived economic disadvantage, the USTA was perhaps using more of a backdoor to harmonizing with the world rather than based in any real fear of foreign interlopers in the U.S. trademark system. *Id.* at 843.

<sup>7</sup> *Id.* at 841.

<sup>8</sup> *Id.* at 835.

<sup>9</sup> *Id.* at 855–56.

<sup>10</sup> *Id.*

<sup>11</sup> *SCM Corp. v. Langis Foods, Ltd.*, 539 F.2d 196, 201–02 (D.C. Cir. 1976); Port, *supra* note 3 at 855–57. "[T]he real horror story," as Port describes, "would have been if SCM had been able to cancel Langis' trademark LEMON TREE in the United States based on the prior use of four months." *Id.* at 857.

In light of the fact that Langis was a Canadian company, a literal neighbor to the United States, and that SCM was the clear “interloper,”<sup>12</sup> USTA’s claim was likely a blatant attempt to use a non-issue to spearhead a move to an ITU system.<sup>13</sup> Were USTA to make a similar ungrounded claim today, it might be quickly branded as “fake news,” “made-up stuff, masterfully manipulated to look like credible journalistic reports that easily spreads online to large audiences willing to believe the fictions and spread the word.”<sup>14</sup>

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<sup>12</sup> Port, *supra* note 3 at 858.

<sup>13</sup> *Id.* at 861.

<sup>14</sup> Angie Drobnic Holan, *2016 Lie of the Year: Fake News*, POLITIFACT (Dec. 13, 2016 5:30 p.m.), <http://www.politifact.com/truth-o-meter/article/2016/dec/13/2016-lie-year-fake-news/>. Perhaps, however, the USTA would just be accused of having their own “alternative facts.” Mary Norris, *A Small Point of Usage Concerning Those ‘Alternative Facts’*, THE NEW YORKER (Jan. 23, 2017 3:40 PM), <http://www.newyorker.com/culture/culture-desk/a-small-point-of-usage-concerning-those-alternative-facts>.

At the close of the Obama administration and the beginning of the Trump administration, the United States embroiled itself in a debate surrounding fake news: what caused it, how to define it, whether it was a new phenomenon, and who, exactly, should be blamed.<sup>15</sup> It had such an impact that “post-truth” was proclaimed as the 2016 “Word of the Year” by the Oxford Dictionaries.<sup>16</sup> “Post-truth” is that which is “relating to or denoting circumstances in which objective facts are less influential in shaping public opinion than appeals to emotion and personal belief.”<sup>17</sup> Basically, that truth of any kind is now “irrelevant.”<sup>18</sup> As Oxford Dictionaries noted, in 2005, Stephen Colbert coined a similar concept, “truthiness,” “the quality of seeming or being felt to be true, even if not necessarily true.”<sup>19</sup> Where the Founding Fathers feared we would lack the essential information to make informed decisions about our elected officials,<sup>20</sup> the problem now seems to have inverted itself; instead, we have too much information, much of it is indiscernible from facts, and we rely upon the wrong (or comforting) information in our decision making.<sup>21</sup>

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<sup>15</sup> Holan, *supra* note 13.

<sup>16</sup> Neil Midgley, *The Word of the Year 2016 is...*, OXFORD DICTIONARIES, <https://en.oxforddictionaries.com/word-of-the-year/word-of-the-year-2016> (last visited Feb. 11, 2017). Other contenders for 2016 Word of the Year included “woke” (“alert to injustice in society, especially racism”), “alt-right” (an ideology characterized by “rejection of mainstream politics and by the use of online media to disseminate deliberately controversial content”), and perhaps connected most strongly to post-truth, when breathless stories of scary clowns dominated the news cycle, “coulrophobia” (“extreme or irrational fear of clowns”). *Id.* For more on the spike in scary clown sightings and arrests, see Camila Domonoske, *Coulrophobics beware: America’s Creepy Clown Problem Continues*, NPR.ORG (Oct. 6, 2016 4:13 PM), <http://www.npr.org/sections/thetwo-way/2016/10/06/496850197/coulrophobics-beware-americas-creepy-clown-problem-continues>.

<sup>17</sup> Midgley, *supra* note 15.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* Colbert’s segment now seems uncomfortably prescient; with lines like, “We are divided between those who think with their head and know with their heart.” Colbert seems to warn us of the 2016 future where truth and facts could not hold as the center of debate. *The Colbert Report: Stone Phillips*, (Comedy Central television broadcast Oct. 17, 2005).

<sup>20</sup> AFTER THE PEOPLE VOTE: A GUIDE TO THE ELECTORAL COLLEGE 48 (John C. Fortier ed., 2004). One of the reasons the electoral college was chosen for determining the presidency was that the delegates feared that the people would simply not have the information they needed to make an informed decision, and instead favor those “favorite sons” that were well-known, with the result that “large-state candidates would always win the presidential pluralities.” *Id.* Substitute “favorite” for “famous” and perhaps we see the same problem rearing its head today that the founders feared but hoped to prevent.

<sup>21</sup> See *infra* Part II(c).

Even though the USTA could not be called a journalistic organization,<sup>22</sup> their loose conception of facts as applied to trademark advocacy would leave them vulnerable to such characterizations in today's current cultural and political climate, perhaps regardless of the reality. If that were not enough, 81% of voters on either side of the political spectrum think voters on the opposite side cannot even agree on basic facts to reach consensus.<sup>23</sup> Instead, the facts of the other side—or even just shoddy reporting—is labeled outright as “fake news.”<sup>24</sup> The term morphed into an easy way to dismiss or discredit anything an opponent said, even if the underlying facts were from a neutral source.<sup>25</sup>

In relation to the introduction of the ITU system, whether or not there was actually an issue to combat was irrelevant; rather, what felt true rather than what was the actual issue won the day and altered the landscape of the law.<sup>26</sup> In the current political climate, misinformation and appeals to emotion have the potential to shape law in a dramatic fashion.<sup>27</sup>

This essay will explore the way that fake news is facilitated by our intellectual property law. Part II will explain, in further detail, the history of fake news, cite recent examples, and detail the psychological underpinnings which have allowed it to flourish. Part III describes how fake news intersects with trademark law and touches upon its implications in the copyright realm. Part IV discusses more traditional tools available for the combat of fake news through litigation by trademark holders. Part IV also explains the website registration system that, while easy to use for the registrant, fails as the first line of defense against fake news and instead makes it far too easy for one to infringe on a trademark. While this may be good for the consumer in the short-term, its long-term effects are beginning to take shape.

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<sup>22</sup> See INTERNATIONAL TRADEMARK ASSOCIATION, <http://www.inta.org/Pages/Home.aspx> (last visited Jan. 31, 2017).

<sup>23</sup> PEW RES. CTR., *In Presidential Contest, Voters Say 'Basic Facts,' Not Just Policies, Are in Dispute* (Oct. 14, 2016), [http://www.people-press.org/2016/10/14/in-presidential-contest-voters-say-basic-facts-not-just-policies-are-in-dispute/?utm\\_source=adaptivemailer&utm\\_medium=email&utm\\_campaign=16-10-14%20panel%20election%20report&org=982&lvl=100&ite=413&lea=66827&ctr=0&par=1&trk=](http://www.people-press.org/2016/10/14/in-presidential-contest-voters-say-basic-facts-not-just-policies-are-in-dispute/?utm_source=adaptivemailer&utm_medium=email&utm_campaign=16-10-14%20panel%20election%20report&org=982&lvl=100&ite=413&lea=66827&ctr=0&par=1&trk=). As Pew points out, that Clinton and Trump supporters both agreed on this by a large margin is somewhat ironic. *Id.*

<sup>24</sup> See *infra* note 26.

<sup>25</sup> Danielle Kurtzleben, *With 'Fake News,' Trump Moves from Alternative Facts To Alternative Language* (Feb. 17, 2017, 8:27 PM), <http://www.npr.org/2017/02/17/515630467/with-fake-news-trump-moves-from-alternative-facts-to-alternative-language>.

<sup>26</sup> See Port, *supra* note 3 at 861–63.

<sup>27</sup> With the recent review of Executive Order 13769 by the Ninth Circuit, the emotional rhetoric and statements made by Donald Trump on the campaign trail may be used against the executive branch in a court of law: “It is well established that evidence of purpose beyond the face of the challenged law may be considered in evaluating Establishment and Equal Protection Clause claims.” *State of Washington, et. al v. Donald J. Trump*, No. 17-35105 (citing *Church of the Lukumi Babalu Aye, Inc. v. City of Hialeah*, 508 U.S. 520, 534 (1993)).

## II. THE PLAGUE OF FAKE NEWS

### A. Defining “Fake News”

As the center on fake news is proving nigh impossible to hold, it is important that a definition of the term be reiterated. “News” itself is the business of the dissemination of facts about current events, and the means by which the public engages in the debates of the day.<sup>28</sup> But “fake news” is not news. “Fake news” instead refers to news-like stories that are not designed to inform or educate, but rather engineered to appeal to our preconceived narratives about how the world works while also trading on the trademarked names of news sources in order to both cloak themselves in legitimacy and to be easily shareable on social media.<sup>29</sup>

A concrete description allows a barrier to be placed between what is “fake news” and what might be better characterized as conjecture, poor reporting, or biased opinion.<sup>30</sup> Online outlets like BuzzFeed and 24-hour news channels like CNN are ready to print or broadcast any news with the barest shreds of facts in order to be first,<sup>31</sup> and an accusation of “fake news” is easy to apply to any news outlet guilty of even the slightest mischaracterization.<sup>32</sup>

<sup>28</sup> *Infra* Part III.b.

<sup>29</sup> This is largely developed from Dr. Steven Novella’s definition: “[fake news outlets] have no genuine journalistic process or mechanisms of quality control. Their stories are made up fictions in the format of real news, optimized for click-bait. They are meant only to push emotional buttons in order to motivate clicks. Sometimes those emotional buttons are political.” Steven Novella, *Fake News*, NEW ENGLAND SKEPTICAL SOCIETY: NEUROLOGICA BLOG (Nov. 22, 2016), <http://theness.com/neurologicablog/index.php/fake-news/>.

<sup>30</sup> For example, while BuzzFeed’s decision to report and reproduce in full the unverified dossier from a former British intelligence official is ethically dubious, the report itself is still real even though it may contain falsehoods. Ken Bensinger et al., *These Reports Allege Trump Has Deep Ties To Russia*, BUZZFEEDNEWS (Jan. 10, 2017, 5:20 PM), [https://www.buzzfeed.com/kenbensinger/these-reports-allege-trump-has-deep-ties-to-russia?utm\\_term=.kboOjvBPr#.kboOjvBPr](https://www.buzzfeed.com/kenbensinger/these-reports-allege-trump-has-deep-ties-to-russia?utm_term=.kboOjvBPr#.kboOjvBPr). But eagerness to be first in the news market makes the news breaker a target for accusations of “fake news” when the breaking story is unverified or developing. See Logan, *infra* note 30 at 206 (describing the incentives placed upon journalists).

<sup>31</sup> See *id.* Before the rise of 24-hour news networks, print journalism had days or weeks to investigate news stories, ample time to find out what happened, report on the reaction, and for reasoned analysis. David A. Logan, *All Monica, All the Time: The 24-hour News Cycle and the Proof of Culpability in Libel Actions*, 23 U. of ARK. AT LITTLE ROCK L. REV. 201, 202–04 (2000). But the current business model of news merged entertainment and information dissemination, creating an atmosphere where weeks or months long cycle occurs in a condensed timeframe. *Id.* at 204. This creates different incentives within journalism rather than simple, unbiased reporting, like the need to fill column and air space; the need to be first or be left behind the competition; and the constant search for the big story at the expense of smaller ones. *Id.* at 206.

<sup>32</sup> For example, what might better be deemed as simply mistakes or shoddy reporting are smeared with the label of “fake news,” such as the case of Zeke Miller, who reported that the bust of Martin Luther King Jr. was missing from the Oval Office in a tweet, and within an hour corrected it. David Emery, *Bust Dust-Up*, SNOPE.COM (Jan. 21, 2017), <http://www.snopes.com/mlk-bust-oval-office/>. But by the time the damage had already been done, the false reporting repeated, and President Trump used it as an example of “dishonesty” in the media. *Id.* Similarly, when BuzzFeed rushed to publish a 35-page dossier they had not verified or corroborated, they opened themselves up to defamation claims from other businesses and entities mentioned within the dossier. David Kravets, *A kitten becomes Exhibit 41 in defamation suit against BuzzFeed over Trump dossier*, ARS TECHNICA (Mar. 30, 2017), <https://arstechnica.com/tech-policy/2017/03/kitten-becomes-exhibit-41-in-defamation-suit-against-buzzfeed-over-trump-dossier/>.

### B. *The 2016 Fake News Epidemic*

[A]s the vilest Writer has his Readers, so the greatest Liar has his Believers; and it often happens, that if a Lie be believ'd only for an Hour, it has done its Work, and there is no farther occasion for it. Falsehood flies, and the Truth comes limping after it; so that when Men come to be undeceiv'd, it is too late; the Jest is over, and the Tale has had its Effect...<sup>33</sup>

Leading up to election day in 2016 and the aftermath, there is what has been described as a “fake news epidemic.”<sup>34</sup> Now, the backlash against fake news has commenced, where the problem is either downplayed<sup>35</sup> or purveyors of fake news or fake news skeptics have turned the term upon others, using it to attack traditional news sources.<sup>36</sup> The problem is not necessarily with fake news itself, which has always been with us in some capacity,<sup>37</sup> but with its intersection with greed and the quirks of human psychology, all of which are amplified by our online lives.

<sup>33</sup> Jonathan Swift, *From Thursday November 2, to Thursday November 9*, THE EXAMINER 2 (1710).

<sup>34</sup> See Dan Merica, *Hilary Clinton calls fake news ‘an epidemic’ with real world consequences*, CNN POLITICS (Dec. 9, 2016, 2:36 PM ET), <http://www.cnn.com/2016/12/08/politics/hillary-clinton-fake-news-epidemic/>. This has led to concrete incidences such as “Pizzagate,” wherein a man went into a Washington, D.C. pizzeria with an assault rifle looking to investigate a suspected child sex operation. Kevin Bohn, Daniel Allman, & Greg Clary, *Gun-brandishing man sought to investigate fake news story site, policy say*, CNN (Dec. 5, 2016, 2:48 PM), <http://www.cnn.com/2016/12/04/politics/gun-incident-fake-news/>. Pizzagate was “a fictitious online conspiracy theory,” but the suspect was spurred into action from what he read online that circulated widely. *Id.* This type of conspiracy thinking also intersects with more amorphous influences such as state-led propaganda efforts by Russia. Craig Timberg, *Russian propaganda effort helped spread ‘fake news’ during election, experts say*, THE WASHINGTON POST (Nov. 24, 2016), [https://www.washingtonpost.com/business/economy/russian-propaganda-effort-helped-spread-fake-news-during-election-experts-say/2016/11/24/793903b6-8a40-4ca9-b712-716af66098fe\\_story.html?utm\\_term=.a13db077a62b](https://www.washingtonpost.com/business/economy/russian-propaganda-effort-helped-spread-fake-news-during-election-experts-say/2016/11/24/793903b6-8a40-4ca9-b712-716af66098fe_story.html?utm_term=.a13db077a62b).

<sup>35</sup> A. Barton Hinkle, *The Fake Epidemic of Fake News*, REASON.COM (Nov. 23, 2016), <http://reason.com/archives/2016/11/23/the-fake-epidemic-of-fake-news> (explaining that “fake news” is not a new phenomenon, that mainstream media has participated in it either through their own folly or as mouthpieces for agiprop, but this should also be contrasted against those news organizations that are always striving to correct their own record when false claims are made).

<sup>36</sup> Callum Borchers, *The latest trend: Fake fake news allegations*, THE WASHINGTON POST (Nov. 23, 2016), <https://www.washingtonpost.com/news/the-fix/wp/2016/11/21/the-latest-trend-fake-fake-news-allegations/> (explaining the tendency to throw the “fake news” criticism back at the critic of fake news). This occurred again during Donald Trump’s January 11<sup>th</sup>, 2017, press conference, where he accused CNN of being “fake news” and Buzzfeed of being a “failing pile of garbage.” Lukas I. Alpert, *Trump Takes Aim at Media Outlets for ‘Fake News’*, WALL STREET JOURNAL (Jan. 11, 2017), <http://www.wsj.com/articles/trump-takes-aim-at-media-outlets-for-fake-news-1484163504>.

Demarcating fake news from just plain shoddy journalism is a real problem; while you have “traditional news” sources that adhere to journalistic standards, our culture has also embraced news sources that have definite bias baked into them unapologetically. For a logical breakdown of various types of news sources, including the difference between fake news and real news, see Steven Novella, *supra* note 26.

<sup>37</sup> See Uberti *infra* note 37.



News and media has always been obsessed and duped by fake news-or rather, hoaxes and sensational stories.<sup>38</sup> A hoax involving life on the moon enraptured readers of *The New York Sun* in 1835.<sup>39</sup> In 1874, *The New York Herald* reported the untrue story that animals escaped the Central Park Zoo, ran amok, and killed New Yorkers.<sup>40</sup> The murders in Whitechapel at the close of the 19<sup>th</sup> century by Jack the Ripper are the first example of the newspaper industry taking a story and using its sensationalist and salacious nature and turning it into a vehicle to sell newspapers.<sup>41</sup> Even the news of the Jefferson era was highly partisan; parties had their own newspapers, and it was up to the reader to separate the truth from the fiction.<sup>42</sup>

A respected, trusted news media is the more recent invention.<sup>43</sup> Journalistic norms emerged in the mid-twentieth century, and corresponded with a decrease in incidents of hoaxes and other fake stories.<sup>44</sup> Objective news is the newer, bolder business model.<sup>45</sup> While hoax-based and sensationalistic reporting could still be found in the pages of such tabloids as the *National Enquirer*, objective news reporting seemed to be the dominant form until the rise of digital news delivery.<sup>46</sup>

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<sup>38</sup> David Uberti, *The real history of fake news*, COLUMBIA JOURNALISM REVIEW (Dec. 15, 2016), [http://www.cjr.org/special\\_report/fake\\_news\\_history.php](http://www.cjr.org/special_report/fake_news_history.php).

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

<sup>41</sup> Thomas Walker, *Jack the Ripper – the First Media Murderer*, HISTORIC NEWSPAPERS, <http://www.historic-newspapers.co.uk/blog/jack-the-ripper-the-first-media-murderer/> (last visited Feb. 2, 2017).

<sup>42</sup> Uberti, *supra* note 37.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> Jacob Soll, *The Long and Brutal History of Fake News*, POLITICO MAGAZINE (Dec. 18, 2016), <http://www.politico.com/magazine/story/2016/12/fake-news-history-long-violent-214535>.

<sup>46</sup> *Id.*

In the last decade, access to information by Americans skyrocketed through use of the Internet and social media. Seventy-nine percent of online Americans are Facebook users,<sup>47</sup> and four-in-ten Americans get their news online.<sup>48</sup> Staffs at newspapers have lost 20,000 positions in the last twenty years, a decline of 39%.<sup>49</sup> There were 126 fewer daily newspapers in 2014 as compared to 2004.<sup>50</sup> The news economy is shifting to digital consumption: 32% of people aged 18-29 get their news from social networking sites, and 34% from news websites and apps rather than through print or television.<sup>51</sup>

Coupled with this, our education practices do not seem to be preparing students and adults to evaluate the media they do consume.<sup>52</sup> One study examined students from middle school through college and gauged their ability to tell real news stories from fake news or advertisements.<sup>53</sup> The authors wrote that, though “digital natives” might be able to use social media with ease, “when it comes to evaluating information that flows through social media channels, they are easily duped.”<sup>54</sup>

The problem with fake news has been laid at the feet of social media.<sup>55</sup> As print media and journalism was once a breeding ground of false stories and hoaxes before it developed self-correcting procedures,<sup>56</sup> so too the digital frontier may need to develop its own watchdogs and standards.

<sup>47</sup> Shannon Greenwood et al., *Social Media Update 2016*, PEW RES. CTR. (Nov. 11, 2016), at 2, [http://assets.pewresearch.org/wp-content/uploads/sites/14/2016/11/10132827/PI\\_2016.11.11\\_Social-Media-Update\\_FINAL.pdf](http://assets.pewresearch.org/wp-content/uploads/sites/14/2016/11/10132827/PI_2016.11.11_Social-Media-Update_FINAL.pdf).

<sup>48</sup> Amy Mitchell et al., *The Modern News Consumer*, PEW RES. CTR. (July 7, 2016), at 4, [http://assets.pewresearch.org/wp-content/uploads/sites/13/2016/07/08140120/PJ\\_2016.07.07\\_Modern-News-Consumer\\_FINAL.pdf](http://assets.pewresearch.org/wp-content/uploads/sites/13/2016/07/08140120/PJ_2016.07.07_Modern-News-Consumer_FINAL.pdf)

<sup>49</sup> Michael Barthel, *State of the News Media 2016: Newspapers: Fact Sheet*, PEW RES. CTR. (June 15, 2016), at 4, <http://assets.pewresearch.org/wp-content/uploads/sites/13/2016/06/State-of-the-News-Media-Report-2016-FINAL.pdf>.

<sup>50</sup> *Id.* see also Soll, *supra* note 44.

<sup>51</sup> Mitchell et al., *supra* note 47 at 20. Fake news, however, has also been something of a boon for journalism in the aftermath of the 2016 election, as people recognized that there might be some benefit to a delay in news reporting rather than the immediate and sometimes incorrect reporting that goes on right after an event occurs. The New York Times itself gained 41,000 subscriptions after Trump’s election. Dylan Byers, *New York Times Adds 41,000 subscriptions after Trump’s Election*, CNN <http://money.cnn.com/2016/11/17/media/nytimes-subscription-rise/>. (Nov. 17, 2017, 2:30 PM).

<sup>52</sup> See *Evaluating Information: The Cornerstone of Civic Online Reasoning*, STAN. HIST. EDUC. GROUP 4 (2016), <https://sheg.stanford.edu/upload/V3LessonPlans/Executive%20Summary%2011.21.16.pdf>; Camilla Domonosoke, *Students Have “Dismaying” Inability To Tell Fake News From Real, Study Finds*, NPR (Nov. 23, 2016, 12:44 AM), <http://www.npr.org/sections/thetwo-way/2016/11/23/503129818/study-finds-students-have-dismaying-inability-to-tell-fake-news-from-real>.

<sup>53</sup> STAN. HIST. EDUC. GROUP, *supra* note 51.

<sup>54</sup> *Id.*

<sup>55</sup> Sam Biddle, *Facebook, I’m Begging You, Please Make Yourself Better*, THE INTERCEPT (Nov. 10, 2016, 11:15 AM), <https://theintercept.com/2016/11/10/facebook-im-begging-you-please-make-yourself-better/>. But Facebook is also a business. Their primary responsibility is to maximize profits for their shareholders, not necessarily making the news-consuming public more savvy about what they read. Kartik Hosanger, *Blame The Echo Chamber on Facebook, But Blame Yourself, Too*, WIRED (Nov. 25, 2016, 7:00 AM), <https://www.wired.com/2016/11/facebook-echo-chamber/>.

<sup>56</sup> Uberti *supra* note 37. In the 1830’s, some newspapers adopted a business model that tended to mislead consumers and led to the “most memorable media fakes in American history”. Snopes.com, Politifact, and other websites that view their mission as fact-checkers and skeptics are already providing some check on blatant falsehoods within the internet.

However, some blame also lies with consumers; although Facebook's algorithm shows users what it thinks they want to see, it is selecting those news stories from amongst friend circles.<sup>57</sup> Americans have been slowly sorting themselves into communities who think and act alike, and this leads to communities that are consistently more polarized in their views.<sup>58</sup> "What had happened . . . wasn't a simple increase in political partisanship, but a more fundamental kind of self-perpetuating, self-reinforcing social division."<sup>59</sup>

This is not only a problem of ignoring content that is ideologically different from your political beliefs and challenges your biases; there are legitimately fake news stories out there that are disseminated to vast swathes of people before they are debunked, if they even get to that point.<sup>60</sup> The Jonathan Swift quote that begins this section recognized the tendency of lies traveling faster than truth in the seventeenth hundreds, and—surprise—the quote has been attributed to a variety of different writers and thinkers throughout its 300-year history.<sup>61</sup>

The threat for trademark holders is that the fake news industry seems to be a lucrative one. For example, teens in the Macedonian town of Veles manufactured news stories by registering domain names designed to sound like real news outlets where, in reality, they were entirely made up.<sup>62</sup> There is a financial incentive to do this in a town where the opportunities for young people are at a minimum.<sup>63</sup>

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<sup>57</sup> Hosanger, *supra* note 54.

<sup>58</sup> BILL BISHOP, *THE BIG SORT* 5–6 (2008). This process occurs not as a concerted effort to move to a community that is politically-affiliated, but rather people move into communities by a process of self-sorting, looking for a particular schools, churches, or civic organizations. *Id.*

<sup>59</sup> *Id.* at 6.

<sup>60</sup> See Sydell, *infra* note 63.

<sup>61</sup> *A Lie Can Travel Halfway Around the World While the Truth is Putting On Its Shoes*, QUOTE INVESTIGATOR (July 13, 2014), <http://quoteinvestigator.com/2014/07/13/truth/#note-9363-1>.

<sup>62</sup> See Craig Silverman & Lawrence Alexander, *How Teens In The Balkans Are Duping Trump Supporters With Fake News*, BUZZFEED (Nov. 3, 2016, 7:02 PM), [https://www.buzzfeed.com/craigsilverman/how-macedonia-became-a-global-hub-for-pro-trump-misinfo?utm\\_term=.uvZOZkJrZ#.kdwz4rpx4](https://www.buzzfeed.com/craigsilverman/how-macedonia-became-a-global-hub-for-pro-trump-misinfo?utm_term=.uvZOZkJrZ#.kdwz4rpx4).

<sup>63</sup> *Id.* Reportedly, a hit of a popular post on Facebook could garner as much as \$3,000 a day. *Id.* Due to the questionable nature of fake news in general, this figure should be viewed skeptically.

Compare this with an investigative report by NPR, which tracked down a California-based purveyor of fake news, Disinfomedia.<sup>64</sup> Disinfomedia is run by Jestin Coler, who also owns such sites as NationalReport.net,<sup>65</sup> USAToday.com.co, and WashingtonPost.com.co.<sup>66</sup> Coler's method is to hire writers and have them write a fake news story aimed toward a specific demographic that gets placed on a legitimate-sounding website.<sup>67</sup> Coler's staff then shares the new story on Facebook, where it is then shared indiscriminately and racks up ad revenue.<sup>68</sup> Fake news can also spread through speculative social media posts by regular people when such posts are noticed and re-disseminated on the greater web and by news sources with wider audiences.<sup>69</sup> While Facebook, as of this writing, is crafting systems to combat the spread of fake news,<sup>70</sup> the spread of fake news, in part, owes its success to human psychology.

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<sup>64</sup> Laura Sydell, *We Tracked Down A Fake-News Creator In the Suburbs. Here's What We Learned*, NPR (Nov. 23, 2016, 3:31 PM), <http://www.npr.org/sections/alltechconsidered/2016/11/23/503146770/npr-finds-the-head-of-a-covert-fake-news-operation-in-the-suburbs>.

<sup>65</sup> See NATIONAL REPORT, <http://nationalreport.net/> (last visited Feb. 9, 2017).

<sup>66</sup> USAtoday.com.co and WashingtonPost.com.co are unavailable at their domain names, but WashingtonPost.com.co's previous version is accessible through the Internet archive. WASHINGTON POST, <http://web.archive.org/web/20150314191355/http://washingtonpost.com.co/> (last visited Feb. 11, 2017). See also Sydell, *supra* note 63.

<sup>67</sup> Sydell, *supra* note 63.

<sup>68</sup> *Id.*

<sup>69</sup> Sapna Maheshwari, *How Fake News Goes Viral: A Case Study*, N.Y. TIMES, <http://www.nytimes.com/2016/11/20/business/media/how-fake-news-spreads.html> (last visited Feb. 11, 2017).

<sup>70</sup> Saqih Shah, *Facebook's Fake News Tools Are Coming To Germany First*, DIGITAL TRENDS (Jan. 15, 2017 4:52 PM), <http://www.digitaltrends.com/social-media/facebook-fake-news-germany/> (detailing Facebook's release of tools to combat fake news in advance of the German election). Facebook began looking into the problem of fake news in December. Mike Isaac, *Facebook Mounts Effort to Limit Tide of Fake News*, N.Y. TIMES (Dec. 15, 2016), <https://www.nytimes.com/2016/12/15/technology/facebook-fake-news.html>.

### C. *Psychological Underpinnings of Fake News*

#### 1. *Motivated Reasoning*

When a belief that is “central” to a person’s identity is challenged, that person will resist accepting the information and changing their mind.<sup>71</sup> When these central beliefs are challenged, people engage in “motivated reasoning” in the attempt to defend those beliefs.<sup>72</sup> Motivated reasoning results in “shredding logic, discarding inconvenient facts, [and] making up facts as necessary...”<sup>73</sup> Other common indicators include cherry-picking facts and using “subjective judgments as necessary without any consideration for internal consistency.”<sup>74</sup> When faced with counterevidence related to deeply-held beliefs and “protected values,” subjects show more resistance than with those beliefs or values that are more negotiable.<sup>75</sup>

#### 2. *Confirmation Bias and the Dunning-Kruger Effect*

Working in tandem with – and closely related to – motivated reasoning is confirmation bias. Confirmation bias is “a tendency to search for or interpret information in a way that confirms one’s preconceptions, leading to statistical errors.”<sup>76</sup> This also involves “ignoring, forgetting, or explaining away information that contradicts our existing beliefs.”<sup>77</sup>

The spread of fake news during the 2016 election owes a great amount of its success to confirmation bias. The story posted by the fictitious Denver Guardian reporting that an FBI agent who leaked Clinton emails had been killed was credulously believed because similar narratives already existed, which allowed people to believe the story wholesale without stopping to consider whether or not it was credible.<sup>78</sup>

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<sup>71</sup> Jonas T. Kaplan et al., *Neural correlates of maintaining one’s political beliefs in the face of counterevidence*, 6 SCI. REP. 1 (Dec. 23, 2016), <https://www.nature.com/articles/srep39589.pdf>.

<sup>72</sup> See generally *id.*

<sup>73</sup> Steven Novella, *More Evidence for Motivated Reasoning*, NEW ENGLAND SKEPTICAL SOCIETY: NEUROLOGICA BLOG (Jan. 3, 2017), <http://theness.com/neurologicablog/index.php/more-evidence-for-motivated-reasoning/>.

<sup>74</sup> *Id.*

<sup>75</sup> Kaplan, *supra* note 70 at 5–6.

<sup>76</sup> *Confirmation Bias*, SCIENCE DAILY, [https://www.sciencedaily.com/terms/confirmation\\_bias.htm](https://www.sciencedaily.com/terms/confirmation_bias.htm) (last visited Feb. 9, 2017).

<sup>77</sup> Steven Novella, *The Power of Confirmation Bias*, NEW ENGLAND SKEPTICAL SOCIETY: NEUROLOGICA BLOG, (Dec. 4, 2012), <http://theness.com/neurologicablog/index.php/the-power-of-confirmation-bias/>. In this way, it is closely related to motivated reasoning. See *supra* Part II.c.i.

<sup>78</sup> Sydell, *supra* note 63.

Confirmation bias enables another common psychological tendency, the Dunning-Kruger effect: “[T]hose with limited knowledge in a domain suffer a dual burden: Not only do they reach mistaken conclusions and make regrettable errors, but their incompetence robs them of their ability to realize it.”<sup>79</sup> As an example, one study by Dunning and Kruger involved an assessment of students’ knowledge of American Standard Written English, asking them to “rate their overall ability to recognize correct grammar, how their test performance compared with that of their peers, and finally how many items they had answered correctly on a test.”<sup>80</sup> Students that scored the lowest on test performance overestimated their abilities and their raw scores.<sup>81</sup>

Confirmation bias and the Dunning-Kruger effect therefore feed off one another in the marketplace of ideas. We look for information that reflects our point of view, and then act on it in overconfident ways even though we may only be partially schooled in that domain.

### 3. Source Amnesia

When people recall facts but cannot remember where they initially came from, it is referred to as “source amnesia.”<sup>82</sup> Trademark law itself could be viewed from the perspective of the long fight against source amnesia from an economic perspective: we want to know where and how we got a product, so we can get that product again.<sup>83</sup> The trademark thus serves as a shorthand-if we know the trademark, we can find it on the product we want to buy. But it is difficult for us to remember where facts came from without a concerted effort.<sup>84</sup>

Going back to the example of Disinfomedia, where did the information about the death of the FBI agent that released the Clinton emails come from? Years later, readers will not remember exactly *where* it came from, but we will remember it as a “fact” despite it being a total fabrication. Instead, a reader might remember the fact as coming from a Denver newspaper like the Denver Post, which is a registered trademark.<sup>85</sup>

These psychological traps are fertile ground for fake news, hoaxes, and sensational stories to find purchase.

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<sup>79</sup> Jason Kruger and David Dunning, *Unskilled and Unaware of It: How Difficulties in Recognizing One’s Own Incompetence Lead to Inflated Self-Assessments*, 77 J. OF PERSONALITY AND SOC. PSYCHOL. 1132 (1999), [http://psych.colorado.edu/~vanboven/teaching/p7536\\_heurbias/p7536\\_readings/kruger\\_dunning.pdf](http://psych.colorado.edu/~vanboven/teaching/p7536_heurbias/p7536_readings/kruger_dunning.pdf).

<sup>80</sup> *Id.* at 1125.

<sup>81</sup> *Id.*

<sup>82</sup> Steven Novella, *Skeptical Questions Everyone Should Ask*, NEUROLOGICA (Dec. 19, 2016), <http://theness.com/neurologicablog/index.php/skeptical-questions-everyone-should-ask/>.

<sup>83</sup> See Port, *supra* note 3 at 888–89; *infra* Part III.A.

<sup>84</sup> See Novella, *supra* note 81.

<sup>85</sup> DENVERPOST.COM, Registration No. 3757497.

### III. IMPLICATIONS IN INTELLECTUAL PROPERTY LAW

#### A. *Trademark Law*

Under the Lanham Act, a trademark is “any word, name, symbol, or device, or any combination thereof” used by an individual or entity “to identify and distinguish his or her goods . . . from those manufactured or sold by others . . . .”<sup>86</sup> Trademarks are therefore an “indicia of source,” and one of the economic theories behind the function of a trademark is that it reduces transactional costs.<sup>87</sup> A primary and essential transaction cost is that of information; the trademark assists in “reduc[ing] the specific knowledge consumers must master before making purchases.”<sup>88</sup>

An additional purpose of the trademark system is “protecting the goodwill developed by the trademark holder.”<sup>89</sup> Closely aligned with this is the need to prevent consumer confusion.<sup>90</sup> If a consumer is confused, the consumer can be deceived, therefore resulting in the consumer buying something they did not intend to buy.<sup>91</sup> Trademarks are also the domain of unfair competition laws—the trademark system is intended “to require entities to compete fairly.”<sup>92</sup> That is, while the costs for new entrants in the market is kept low, trademark law is also intended to prevent those new market entrants from “passing off” their goods as if they were the goods of the trademark owner.<sup>93</sup>

The purveyors of fake news present a four-fold problem that intersects with the stated purposes of trademark law. First, fake news increases the knowledge consumers need to make a buying decision. Meaning that for every fake news story consumed, the knowledge deficit to make an informed decision increases, and can only be countered through an additional article or source that debunks the fake news source. Likely, this is more than just one article, as fake news narratives play upon central, deeply-held beliefs, becoming entrenched through the need to engage in motivated reasoning and confirmation bias.<sup>94</sup>

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<sup>86</sup> 15 U.S.C. § 1127.

<sup>87</sup> Port, *supra* note 3 at 889.

<sup>88</sup> *Id.* at 888.

<sup>89</sup> *Id.* at 896.

<sup>90</sup> *Id.*

<sup>91</sup> Port, *Id.* at 896.

<sup>92</sup> *Id.* at 897.

<sup>93</sup> Port, *supra* note 3, at 896–97.

<sup>94</sup> See generally Kaplan *supra* note 70.

Second, the prevalence of fake news creates an aura of distrust in all news, not just the fake news. This is the domain of trademark dilution.<sup>95</sup> Trademark dilution erodes the goodwill of those with valid trademarks, such as the New York Times<sup>96</sup> or the Washington Post,<sup>97</sup> and is particularly insidious if there is purposeful infringement of the trademark to appear like a legitimate news source. For example, when Disinfomedia uses a site like “WashingtonPost.com.co,” it is directly infringing on the trademark in an attempt to trade on the goodwill of the trademarked publication, but diminishes the reputation of the Washington Post as a result.

In addition to stealing and diluting the goodwill from established news publications, fake news also exploits goodwill. Social media platforms such as Facebook and Twitter have their own trademark goodwill that develop over a period of use. In particular, Facebook’s mark is so ubiquitous that it is approaching iconic status if it has not already achieved it.<sup>98</sup> Almost everyone knows and uses (or has used) Facebook.<sup>99</sup> This results in a goodwill toward Facebook that is particularly high. What occurs then is that Facebook bleeds goodwill into whatever is posted on it; that could be an event, a photo from vacation, or a random musing posted by a friend.<sup>100</sup>

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<sup>95</sup> *Infra* Part IV.B.

<sup>96</sup> THE NEW YORK TIMES, Registration No. 0227904.

<sup>97</sup> THE WASHINGTON POST, Registration No. 1665831.

<sup>98</sup> “Iconic,” in trademark terms, suggests that the mark has reached such a level that it is becoming a cultural property, and has gained “an existence separate from any source identifying function.” Port, *supra* note 3 at 894. The First Circuit described this as marks that have become “truly prominent and renowned.” I.P. Lund Trading Aps & Kroin v. Kohler Co., 163 F.3d 27, 46 (1st Cir. 1998) (citing 3 McCarthy § 24.91). This goes to examination of all the factors for famous marks under the FTDA, wherein the distinctiveness of the mark “should be much greater for a famous mark than for merely distinctive marks.” DAVID WELKOWITZ, TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW 191 (2002 with 2011 supplement). See further discussion on trademark dilution *infra* Part IV.B.

<sup>99</sup> In *Quarter 3 of 2016*, it was estimated by Statista that Facebook had 1.79 billion active users. Number of monthly active Facebook users worldwide as of 4th quarter 2016 (in millions), STATISTA, <https://www.statista.com/statistics/264810/number-of-monthly-active-facebook-users-worldwide/> (last visited Feb. 10, 2017).

<sup>100</sup> An additional component of the Dunning-Kruger effect, that experts underestimate their skills in comparison to their peers, has certain implications here; not only does Facebook bleed goodwill into posts, but we assume our friends are knowledgeable and would not share something blatantly false. See Dunning and Kruger, *supra* note 78 at 1131. The solution, therefore, might be to find more knowledgeable friends. But the problem is, do you have the requisite expertise to recognize that your new friends are actually more knowledgeable?



While this goodwill may be a good thing with Aunt Beatrice's photo from the Spam Museum,<sup>101</sup> it becomes problematic when a social media platform such as Facebook carries a fake news source. The goodwill also bleeds over into the fake news source, as if Facebook approves the content. When Mark Zuckerberg claimed that Facebook is a tech, not a media company, he seemingly ignored the fact that the genre his technology exists within is called "social media."<sup>102</sup> In many ways, they have assumed and cannibalized the role of traditional publishers in our media. And, in turn, Facebook's trademark is diluted and its credibility damaged in the wake of the prevalence of fake news.

Third, because of the confusion engendered by fake news, consumers are led to be deceived in their purchases. The 2016 election could be viewed as a trademark war; Trump and Clinton are both established personalities and brands, and all the news surrounding them was aimed at either building up or tearing down their personality marks. However, the presence of fake news creates false signals and red herrings, and thus discerning true from untrue and making a purchasing decision based upon it nearly impossible.

Fourth, where fake news passes itself off as legitimate news organizations by using their trademarked names, it is potentially violating unfair competition laws.<sup>103</sup> Just as it is unfair to make and sell a fake Prada bag, so too is it unfair to make and sell fake Washington Post news.

### B. Copyright Law

Fake news not only impacts trademark law, it raises implications within the realm of copyright law. The Constitution enables Congress to advance the sciences and useful arts, which serves as the primary basis of copyright.<sup>104</sup> Ostensibly, the purpose of copyright is the dissemination of information to the purposes of expanded knowledge and a greater informed citizenry.<sup>105</sup> Fake news disrupts the purpose of copyright law by its presence in the marketplace of ideas by disseminating blatantly false ideas. And, paradoxically, it is better protected under the law.

There are three standard elements to gain copyright protection. Under § 102 of the Copyright Act, protection subsists "in original works of authorship fixed in a tangible medium of expression, now known or later developed."<sup>106</sup> First, it must be fixed in a tangible medium for "more than a transitory duration."<sup>107</sup> Second, it must be original to the author, independently created with "at least some minimal degree of creativity."<sup>108</sup>

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<sup>101</sup> SPAM MUSEUM, <http://www.spam.com/museum> (last visited Oct. 6, 2008).

<sup>102</sup> Charles Warner, *Fake News: Facebook is a Technology Company*, FORBES (Nov. 27, 2016, 10:29 PM), <http://www.forbes.com/sites/charleswarner/2016/11/27/fake-news-facebook-is-a-technology-company/#487bdacf8e1d> (last visited May 8, 2017).

<sup>103</sup> "Unfair methods of competition in or affecting commerce, and unfair or deceptive acts or practices in or affecting commerce, are hereby declared unlawful." 15 U.S.C. 45(a)(1).

<sup>104</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>105</sup> JULIE E. COHEN, ET AL., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 7 (4th ed. 2015).

<sup>106</sup> 17 U.S.C. § 102(a).

<sup>107</sup> *Id.* § 101; *See*, *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008) (finding 1.2 seconds in a buffer fails to meet the requirements of "transitory duration").

<sup>108</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

However, the third requirement is negative: copyright protection does not extend to “any idea procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>109</sup> Facts may be freely copied, for example, but the expression in which they are contained is not.<sup>110</sup>

In a similar vein, news—that is, the information about current events—is a fact and is recognized as “common property.”<sup>111</sup> This was not always the case, as courts during the 1800s “routinely found infringement of fact-based works, such as maps, charts, road-books, directories, and calendars, on the basis of the copying of their factual content, and concluded that the industry of plaintiffs in gathering and presenting facts should be protected under copyright law.”<sup>112</sup> This eventually gave way to the “creativity-based view of originality” as courts came to the conclusion that facts aren’t the original creation of the author.<sup>113</sup> It remains, however, that news and facts require costs to gather and distribute, and takes on a “quasi property” quality when parties seek “to make profits at the same time and in the same field.”<sup>114</sup> This has come to be known as the “hot-news” exception, and is available in cases where:

- (i) a plaintiff generates or gathers information at a cost; (ii) the information is time-sensitive; (iii) a defendant's use of the information constitutes free riding on the plaintiff's efforts; (iv) the defendant is in direct competition with a product or service offered by the plaintiffs; and (v) the ability of other parties to free-ride on the efforts of the plaintiff or others would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened.<sup>115</sup>

In simpler terms, the plaintiff must prove that the defendant is benefiting directly from the plaintiff's sweat equity.

Paradoxically, a purveyor of fake news has a potentially stronger copyright than those engaged in the real news. The fake news is fixed—usually in the format of a website or social media post from which it is then shared across other social media platforms. But unlike the news, it is the realm of fiction and reflects the originality requirement. And, of course, it is typically non-factual.

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<sup>109</sup> 17 U.S.C. § 102(b).

<sup>110</sup> CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 66 (2d Cir. 1994).

<sup>111</sup> Intl. News Serv. v. Associated Press, 248 U.S. 215, 235 (1918).

<sup>112</sup> Robert F. Brauneis, *The debate over copyright in news and its effect on originality doctrine*, INTELLECTION PROPERTY PROTECTION OF FACT-BASED WORKS 39, 39 (2009).

<sup>113</sup> *Id.*

<sup>114</sup> *Intl. News Serv.*, 248 U.S. at 236.

<sup>115</sup> Natl. Basketball Ass'n v. Motorola, Inc., 105 F.3d 841, 845 (2d Cir. 1997).

In *Feist*, Rural inserted into their phonebook four fictitious numbers in order to detect blatant copying of the phone numbers they compiled, which Feist copied when they integrated numbers from Rural's phonebook into their own.<sup>116</sup> The fictitious numbers could be considered copyrightable, but the other factual numbers were not.<sup>117</sup> Fake news is thus inverted news: rather than many facts that are sometimes peppered with conjecture or false reporting, the false reporting or conjecture surround one or two vague facts or non-facts.

Just as in *Feist*, the fictitious is copyrightable and facts are able to flow more freely for the sake of public discourse. But in this case, the fictitious flows more freely, perhaps buoyed by a commitment to untruth and our own psychology. Facts, however, remain solidly behind, hampered by their inability to tell a comforting lie.

#### IV. TRADEMARK INFRINGEMENT, DILUTION, AND DOMAIN REGISTRATION

Facts will always be valued and will buoy to the top with, hopefully, time. Lies, however, need to be contained before they run amok. Fake news can be combated through the use of legal mechanisms traditionally used to combat trademark confusion and trademark dilution, but also by altering domain registration conduct. This is a small component in the battle against fake news, and is largely dependent on how the purveyor of fake news acts to catch the eye of the consumer.

##### A. Likelihood of Confusion

Fake news sources cause a likelihood of confusion among registered trademarks. Likelihood of confusion is “the likelihood that the consumer will be confused, misl[e]d, or deceived regarding the source or origin of the goods or services.”<sup>118</sup> This need not be actual, only the mere likelihood that the consumer will be confused.<sup>119</sup> Federal circuits have developed many different tests to gauge likelihood of confusion, but the 2<sup>nd</sup> circuit's test in *Polaroid Corp. v. Polarad Electronics* is heavily favored.<sup>120</sup>

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<sup>116</sup> 499 U.S. at 343–44.

<sup>117</sup> See *id.* at 1295. Similarly, the town of Agloe was a fictitious place on a map made for the express purpose of catching copyright infringers—except that Agloe became a very real town for a time and thwarted a copyright claim. Robert Krulwich, *An Imaginary Town Becomes Real, Then Not. True Story*, NPR (Mar. 18, 2014, 4:43 PM), <http://www.npr.org/sections/krulwich/2014/03/18/290236647/an-imaginary-town-becomes-real-then-not-true-story>. Creating fake towns and other topographical tricks was a standard practice in cartography for the express purpose of catching thieves. Sarah Zhang, *The Fake Places That Only Exist to Catch Copycat Mapmakers*, GIZMONDO (Apr. 3, 2015, 12:00 PM), <http://gizmodo.com/the-fake-places-that-only-exist-to-catch-copycat-cartog-1695414770>.

<sup>118</sup> SHELDON W. HALPERN, ET AL., FUNDAMENTALS OF UNITED STATES INTELLECTUAL PROPERTY LAW: COPYRIGHT, PATENT, TRADEMARK, 323 (5th Ed., 2015).

<sup>119</sup> *Id.*

<sup>120</sup> *Id.* at 323–24.

Where the products are different, the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.<sup>121</sup>

The list is not exhaustive or dispositive, and courts are free to take other factors into account on a case-by-case basis.<sup>122</sup>

Perhaps the most analogous case law applicable to the question of fake news and trademark infringement is *Duluth News-Tribune v. Mesabi Publishing Company*. In *Mesabi*, plaintiff distributed the daily newspaper, the "Duluth News-Tribune," for at least 100 years in the Minnesota Iron Range.<sup>123</sup> An infringement case under the Lanham Act arose when defendant Mesabi began circulating a Saturday newspaper in the same geographic area entitled the "Saturday Daily News Tribune."<sup>124</sup>

The 8<sup>th</sup> Circuit, where *Mesabi* was decided, deals with trademark confusion by: evaluating the strength of the mark; their similarity; the "competitive proximity of the parties' products;" the defendant's "intent to confuse;" any "evidence of actual confusion;" and "the degree of care reasonably expected of potential customers."<sup>125</sup> On the strength factor where it was determined whether the plaintiff's mark could be afforded trademark protection, the mark was largely found to be descriptive, but had developed secondary meaning over its course of years and was therefore entitled to some level of protection.<sup>126</sup> Uncontested at trial, both papers were also in close proximity.<sup>127</sup>

Where the argument fell apart, however, was in the similarity of the parties' marks to each other. The court noted that "Duluth News-Tribune" was significantly different from "Saturday Daily News & Tribune" because of the presence of "Saturday" and the presence of the ampersand.<sup>128</sup> What the court found most convincing was that defendant had placed a blue banner on the paper stating: "Publication of the Mesabi Daily News, Virginia and Daily Tribune, Hibbing" under "Saturday Daily News & Tribune."<sup>129</sup>

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<sup>121</sup> Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961).

<sup>122</sup> *Id.*

<sup>123</sup> *Duluth News-Trib., a Div. of N.W. Publications, Inc. v. Mesabi Pub. Co.*, 84 F.3d 1093, 1095 (8th Cir. 1996).

<sup>124</sup> *Id.*

<sup>125</sup> *Duluth News-Trib.* 84 F.3d at 1096.

<sup>126</sup> *Id.* at 1096-97. Soon after the case was filed, plaintiff registered the trademark "Duluth News-Tribune." *Supra* note 2.

<sup>127</sup> *Id.* at 1097.

<sup>128</sup> *Id.* Mesabi included the ampersand in "Saturday Daily News & Tribune" as one way to mollify Plaintiff's concerns that their paper was infringing on the Duluth News-Tribune's mark, but plaintiff brought the action regardless. *Id.* at 1095.

<sup>129</sup> *Id.* at 1097.

Likewise, intent to confuse was not found because “Saturday Daily News & Tribune” was a “logical merger” of the “Daily News” and “Daily Tribune.”<sup>130</sup> Further, the merger of the papers also was a merger of the geographical area that the defendant *already covered*, and wasn’t a direct expansion into the area covered by the plaintiff.<sup>131</sup> Actual confusion was also minimal; the evidence submitted to the court—regarding “misdirected mail and phone calls”—was largely regarded as unreliable hearsay and *de minimis*.<sup>132</sup> The strongest evidence for actual confusion involved a letter plaintiff presented which had suggested editorial changes to an article that originally appeared in the defendant’s paper.<sup>133</sup> However, the court wanted evidence that “an appreciable number of ordinary purchasers [were] likely to be misled,” and did not find it.<sup>134</sup>

Finally, the court looked at the reasonably expected degree of care of potential consumers. While plaintiff made an argument that customers would be easily be misled because they typically exercise “minimal care” in selecting a low-cost newspaper, the court pointed out that the majority of the defendant’s customer base—92%—were not those buying newspapers off the stand, but home subscribers.<sup>135</sup> Ultimately the court confirmed that there was no trademark confusion.<sup>136</sup>

Disinfomedia used domain names that looked suspiciously like real news sources, like the Washington Post or the Denver Guardian,<sup>137</sup> the latter of which might be infringing on either the Denver Post or The Guardian.<sup>138</sup> However, the owners of the Washington Post trademark could bring a likelihood of confusion case against Disinfomedia to shut down said company or at least cause them to be more creative in how they formulate their domain names. First, while the Washington Post trademark is largely descriptive as the papers in *Mesabi*, is a business and name, it was founded in 1877 and has been in continuous circulation since then.<sup>139</sup> Further, it has several registered trademarks.<sup>140</sup> Second, the similarity of the marks are very close—WashingtonPost.com vs. WashingtonPost.com.co.<sup>141</sup> The marks are much closer than the marks in *Mesabi*, and there is no attempt to provide any disclaimer or differentiation by the infringer beyond the appellation of “.co.”<sup>142</sup>

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<sup>130</sup> Duluth News-Trib., 84 F.3d at 1097.

<sup>131</sup> *Id.*

<sup>132</sup> *Id.* at 1098.

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* at 1099.

<sup>135</sup> Duluth News-Trib., 84 F.3d at 1099.

<sup>136</sup> *Id.*

<sup>137</sup> Sydell, *supra* note 63.

<sup>138</sup> *Id.*

<sup>139</sup> *Washington Post Timeline*, THE WASHINGTON POST, <https://www.washingtonpost.com/apps/g/page/national/washington-post-co-timeline/374/> (last visited Feb. 10, 2017).

<sup>140</sup> The most current registration for The Washington Post dates to 1990. THE WASHINGTON POST, Registration No. 1665831. Meanwhile, the oldest dead registration goes all the way back to 1907. THE WASHINGTON POST, Registration No. 0066538.

<sup>141</sup> Sydell, *supra* note 63. It should be noted that “WashingtonPost.com.co” is no longer a valid address, but can be found on the Internet Archive. WASHINGTON POST, [washingtonpost.com.co](https://web.archive.org/web/20150711024535/http://washingtonpost.com.co/), <https://web.archive.org/web/20150711024535/http://washingtonpost.com.co/>

<sup>142</sup> This factor becomes more difficult if the claim against Disinfomedia is based on its infringement of the Denver Post or the Denver Guardian.

Considering that both exist in the digital realm, proximity is also close, separated only by a couple keystrokes in the digital marketplace. Potential for actual confusion between the two is also likely, particularly if someone just sees the headline and does not pay attention to the web address or the other headlines.<sup>143</sup>

Sophistication of the buyers refers to an evaluation of whether the purchase is more of an impulse buy or if the consumer uses “care and consideration in purchasing”<sup>144</sup> Confusion is more likely to be found where the purchases are inexpensive.<sup>145</sup> Since sharing on social media happens quickly and often without much consideration (perhaps only a perusal of the headline as it comes up in a social media feed), the sophistication factor is likely to be low.

The court examined the intent to confuse factor in *Mesabi*, they searched for alleged bad faith on the part of the defendant but found only the “logical merger” of two geographically proximate papers.<sup>146</sup> Bad faith intent to confuse is more prevalent here as the whole purpose of using the Washington Post’s mark in the first place was to trade off its goodwill and confuse a reader to navigate away to the fake Washington Post site for advertising dollars. The defendant’s good faith in adopting the mark is therefore considered to be minimal.<sup>147</sup>

Regardless of which circuit a claim is brought, trademark infringement can be a successful strategy in combating fake news if likelihood of confusion can be proved.

### B. Trademark Dilution

The goal of trademark dilution law is “to protect the ‘distinctive quality’ of the trademark.”<sup>148</sup> “The value is in the ‘aura’ of the mark, the fact that uniquely identifies one source, and the feelings it evokes from consumers about anything associated with that brand name.”<sup>149</sup>

<sup>143</sup> These include, but are not limited to, “Racially Motivated Shark Attacks Leave North Carolina Shaken” or “Gays Introduce Rainbow Flag Desecration Bill.” WASHINGTON POST, (July 11, 2015), [washingtonpost.com.co](https://www.washingtonpost.com/archive/local/2015/07/11/), <https://web.archive.org/web/20150711024535/http://washingtonpost.com.co/>.

<sup>144</sup> E. & J. Gallo Winery v. Consorzio del Gallo Nero, 782 F. Supp. 457, 464–65 (N.D. Cal. 1991).

<sup>145</sup> *Id.* In *Mesabi*, this factor was analyzed under “the degree of care reasonably expected of potential consumers.” Duluth News-Trib., a Div. of N.W. Publications, Inc. v. Mesabi Pub. Co., 84 F.3d 1093, 1099 (8th Cir. 1996). Since most consumers were subscribers, the court found the fact that low number of papers sold to ordinary buyers was insufficient to “create a genuine issue of fact regarding the likelihood that an appreciable number of customers [would] be confused.” *Id.*

<sup>146</sup> Duluth News-Trib., a Div. of N.W. Publications, Inc. v. Mesabi Pub. Co., 84 F.3d 1093, 1097–98 (8th Cir. 1996).

<sup>147</sup> The *Polaroid* factors in the Second Circuit include assessing “the quality of defendant’s product.” *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). However, this doesn’t seem to be a significant factor in the other circuits. Halpern, *supra* note 115 at 324–27. Regardless, a case in the Second Circuit should make mention of the gap in quality of the defendant’s product and the plaintiff’s, particularly when the gap is wide. See, for example, the attention-grabbing headlines at *supra* note 142.

<sup>148</sup> David Welkowitz, TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW 5 (2002 with 2011 supplement).

<sup>149</sup> *Id.*

Owners of famous marks are entitled to injunctive relief against those that engage in trademark dilution against the famous mark.<sup>150</sup> Trademark dilution is split into two separate categories: dilution by blurring and dilution by tarnishment.<sup>151</sup> Dilution by blurring “is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”<sup>152</sup> Dilution by tarnishment, meanwhile, “is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”<sup>153</sup>

Dilution by blurring or tarnishment is only available to those that own “famous marks.”<sup>154</sup> A mark is famous when “it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”<sup>155</sup> Roughly categorized as the famous mark’s “selling power,”<sup>156</sup> the court must then determine the fame of the mark using statutory factors, including:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.<sup>157</sup>

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<sup>150</sup> 15 U.S.C. § 1125(c)(1).

<sup>151</sup> *Id.* § 1125(c).

<sup>152</sup> *Id.* § 1125(c)(2)(B).

<sup>153</sup> *Id.* § 1125(c)(2)(C).

<sup>154</sup> *Id.* at § 1125(c)(1).

<sup>155</sup> *Id.* at § 1125(c)(2)(A).

<sup>156</sup> *Mead Data Central, Inc. v. Toyota Sales, U.S.A., Inc.*, 875 F.2d 1026 (2d Cir. 1989).

<sup>157</sup> 15 U.S.C. § 1125(c)(2)(A).

In *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, plaintiff NYC Triathlon's mark was considered famous through ten years of exclusive use; national and international promotion in major media outlets; and through sales success of \$2 million raised for various charities.<sup>158</sup> The Washington Post started in 1887 and was registered on the registry in some capacity since at least 1907 and most recently 1991, and as such, it qualifies for the 4<sup>th</sup> factor.<sup>159</sup> This gives us a better sense of the remaining factors—The Washington Post reports heavily on subjects regarding the federal government, and as such its reporting is widely read, both nationally and internationally, fulfilling the 3<sup>rd</sup> factor. To the 2<sup>nd</sup> factor, as of September 2015, The Washington Post had a print circulation of 330,000.<sup>160</sup> It is also working at being more media savvy in the digital age.<sup>161</sup> These later factors all give weight to the first factor: The Washington Post has had time to advertise itself over the last 130 years across the entire nation, to the point where its circulation is commented upon by third parties.<sup>162</sup> In comparison to *NYC Triathlon*, there is a good argument to be made that The Washington Post has a famous mark.

Although the court may consider “all relevant factors” to determine dilution by blurring, the statute lists six: “similarity between the mark or trade name and the famous mark”; “inherent or acquired distinctiveness of the famous mark”; “[t]he extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark”; “[t]he degree of recognition of the famous mark”; “[w]hether the user of the mark or trade name intended to create an association with the famous mark”; and “[a]ny actual association between the mark or trade name and the famous mark.”<sup>163</sup>

If the Washington Post can establish the famousness of its mark, The Washington Post is engaging almost exclusively in substantial use of the mark and it is highly recognized nationally as a news purveyor.<sup>164</sup> Therefore, Coler's business model used an association with the Washington Post's mark even though there was no association with that mark in reality.<sup>165</sup> Therefore, Coler is potentially engaging in dilution by blurring.

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<sup>158</sup> *N.Y. City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 321–22 (S.D.N.Y. 2010).

<sup>159</sup> See the discussion of The Washington Post's registered trademarks *supra* note 139.

<sup>160</sup> Average weekday individually paid print circulation of select newspapers in the United States as of September 2015 (in thousands), STATISTA, <https://www.statista.com/statistics/272790/circulation-of-the-biggest-daily-newspapers-in-the-us/> (last visited Feb. 11, 2017).

<sup>161</sup> Lucia Moses, *How The Washington Post grew digital subscriptions 145 percent*, DIGIDAY (July 12, 2016), <http://digiday.com/publishers/washington-post-grew-digital-subscriptions-145-percent/>.

<sup>162</sup> Ken Doctor, *Is The Washington Post Closing in on the Times?* POLITICO (Aug. 6, 2015, 9:27 AM), <http://www.politico.com/media/story/2015/08/is-the-washington-post-closing-in-on-the-times-004045>.

<sup>163</sup> 15 U.S.C. § 1125(c)(2)(B) (2012).

<sup>164</sup> *Supra* notes 159-160.

<sup>165</sup> See Sydel, *supra* note 63.



The statute regarding dilution by tarnishment, however, does not list any factors.<sup>166</sup> Trademark by tarnishment “generally arises when the plaintiff’s trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.”<sup>167</sup> Direct use of a plaintiff’s trademark on defendant’s goods that are of “shoddy” quality, such as counterfeit dresses, have been upheld by courts as examples of dilution by tarnishment.<sup>168</sup>

Similarly, DisinfoMedia used Washington Post’s mark explicitly to promote, not to counterfeit dress, but fake news, brought harm to the distinctiveness of the Washington Post’s famous mark. The works are of shoddy quality in general, made to attract viewers but not to function as objective journalism and inform the reader. Instead, if we were to invoke the concept of source amnesia, someone may remember they read a terrible article on Coler’s fake news site and attribute it to The Washington Post, thereby evoking unflattering thoughts about The Washington Post.

Trademark dilution is the avenue for those that possess famous marks.<sup>169</sup> While this serves well those who own them—such as large corporations—those that cannot prove the fame of their marks are unable to use it as a cause of action.<sup>170</sup> Instead, those owners of less well-known marks have access to other methods of defense.

### C. Domain Name Registration

Domain Name Registration throughout the world is coordinated by the international non-profit organization, the Internet Corporation for Assigned Names and Numbers (ICANN).<sup>171</sup> ICANN established the model for generic domain name registration, lowering the costs, but also lowering the barriers to registration.<sup>172</sup> ICANN effectively serves as a separate trademark registration system in and of itself, and there are very few barriers for a party to register a domain name that is similar to what a trademark holder already has.<sup>173</sup>

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<sup>166</sup> 15 U.S.C. § 1125(c)(2)(C) (2012).

<sup>167</sup> *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 43 (2d Cir. 1994).

<sup>168</sup> *See Diane Von Furstenberg Studio v. Snyder*, No. 1:06CV1356 JCC, 2007 WL 2688184, at \*4 (E.D. Va. Sept. 10, 2007).

<sup>169</sup> *See*, discussion on trademark dilution, *supra* Part IV.B; 15 U.S.C. § 1125(c)(1),(2).

<sup>170</sup> For example, “niche” fame of a mark within a community will not suffice; the mark’s fame must reach such a point as to be a “household name.” *Bd. of Regents, Univ. of Texas Sys. ex rel. Univ. of Texas at Austin v. KST Elec., Ltd.*, 550 F. Supp. 2d 657, 678–79 (W.D. Tex. 2008).

<sup>171</sup> Zohar Efroni, *Names as Domains, Names as Marks: Issues Concerning the Interface between Internet Domain Names and Trademark Rights*, in 3 *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE* 373, 375 (Peter K. Yu ed., 2007).

<sup>172</sup> *Internet Corporation for Assigned Names and Numbers*, ICANN, <http://archive.icann.org/tr/english.html> (last visited Jan. 29, 2017).

<sup>173</sup> KENNETH L. PORT, *TRADEMARK LAW AND POLICY* 467 (3d ed. 2013).

ICANN doesn't register domain names itself, but rather oversees a variety of registrars that register the site for the end user, the registrant.<sup>174</sup> The registrant—the customer who wants to register a domain name—contacts one of the almost a thousand registrars,<sup>175</sup> who then consults registry operators who checks the domain name against a master list.<sup>176</sup> In the situation where two registrants are competing for the use of a domain name, the first to complete the requirements with the registrar gets the domain name.<sup>177</sup>

The Internet's potential to connect people, businesses, customers, and clients is immediately apparent to trademark holders.<sup>178</sup> Courts recognized this too, as did “cybersquatters.”<sup>179</sup> “Cybersquatters are registrants who grasped the commercial value of domain names incorporating well-established trademarks.”<sup>180</sup> These registrants then attempt to capitalize on their cybersquatting by selling back the domain name to the trademark owner.<sup>181</sup>

As an example, the online news site, *The Intercept*,<sup>182</sup> has a registered trademark, serial no. 86185518.<sup>183</sup> Using the common registrar GoDaddy.com, twenty minutes, and \$20.18, a registrant can buy *theintercepts.com*, one letter off from *theintercept.com*. The GoDaddy terms of service, does not allow the use of ICANN's trademark logo and restricts on trademark and copyright infringement (on penalty of suspension) against others.<sup>184</sup> In the Domain Name By Proxy agreement, the registrant agrees that they are “using DBP's private registration services in good faith” and “have no knowledge of Your domain name infringing upon or conflicting with the legal rights of a third party or a third party's trademark or trade name.”<sup>185</sup> The Universal Terms of Service further states that the registrant can file a claim for a registered trademark if the registrant believes a violation is occurring (or someone can petition GoDaddy if the registrant themselves is violating trademarks).<sup>186</sup>

<sup>174</sup> *Domain Name Registration Process*, ICANN, <https://whois.icann.org/en/domain-name-registration-process> (last visited Jan. 29, 2017).

<sup>175</sup> *ICANN-Accredited Registrars*, ICANN, <https://www.icann.org/registrar-reports/accredited-list.html> (last visited Jan. 29, 2017).

<sup>176</sup> *Domain Name Registration Process*, *supra* note 170.

<sup>177</sup> Efroni, *supra* note 171 at 376.

<sup>178</sup> *Id.* at 375.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.*

<sup>181</sup> *Id.* There are many subcategories of cybersquatters, including “cyberpirates” (those that “incorporate marks in their domain names to attract traffic and divert users from their intended destination, making profits from the inadvertent ‘hits’”); “typosquatters” (those that “indulge in the activity of registering domain names that incorporate marks in a few variations”); and “pseudo-cybersquatters” (those that “merely hold domain names without operating any Web sites”). *Id.* at 377.

<sup>182</sup> *THE INTERCEPT*, <https://theintercept.com>, (last visited Feb. 11, 2017).

<sup>183</sup> *THE INTERCEPT*, Registration No. 86,185,518.

<sup>184</sup> Domain Name Registration Agreement, GODADDY (Nov. 29, 2016), [https://www.godaddy.com/Agreements/ShowDoc.aspx?pageid=REG\\_SA](https://www.godaddy.com/Agreements/ShowDoc.aspx?pageid=REG_SA).

<sup>185</sup> Domain Name Proxy Agreement, GODADDY (Nov. 23, 2016), [https://hk.godaddy.com/en/agreements/showdoc.aspx?pageid=DOMAIN\\_NAMEPROXY](https://hk.godaddy.com/en/agreements/showdoc.aspx?pageid=DOMAIN_NAMEPROXY).

<sup>186</sup> GoDaddy Universal Terms of Service Agreement, GODADDY (Mar. 3, 2017), <https://www.godaddy.com/agreements/ShowDoc.aspx?pageid=utos>.

These terms are all buried within 70 pages of legalese, and the normal registrant will not bother to read any of it with an eye for trademark violations or contact a lawyer for review. But during this process, there was no check by a gatekeeper. With some government and industry cooperation, new domain names could be checked against the USPTO's database and flagged for possible infringement. This could prevent examples like "Washingtonpost.com.co" from either registering an infringing domain name or alternatively, send a message alerting the current trademark holder to the possible infringement.<sup>187</sup>

The conflict between trademark law and domain names is a natural outgrowth of trademarks as a geographically-limited indicator of source and the nature of the Internet as a global platform.<sup>188</sup> The nature of both systems is divergent; where trademark seeks to reduce confusion and foster goodwill in consumers, domain names are constructed primarily to simplify the DNS system of address numbers.<sup>189</sup> And where trademark can support the same mark in multiple jurisdictions or territories by different uses for the same or similar types of goods, domain names are a one-stop address for one registrant.<sup>190</sup>

Congress has recognized the potential for malfeasance done by cybersquatting. The Anti-Cybersquatting Consumer Protection Act (ACPA) was enacted in 1999 and amended the Lanham Act to state that a person can be held liable in a civil action if they, in bad faith, register, traffic, or use a domain name that is identical or confusingly similar to that mark or has a bad faith intent to profit from the mark.<sup>191</sup> The law further lists nine non-exhaustive factors<sup>192</sup> for indicating bad faith intent, and includes a safe-harbor provision.<sup>193</sup> The plaintiff in such a bad faith intent to profit claim may elect to seek up to \$100,000 in damages.<sup>194</sup>

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<sup>187</sup> An individual can only register a domain name and a top-level domain to go with it (ie. Com.co). Then a user would have to setup a server called "Washingtonpost" to create the full URL Washingtonpost.com.co. See Jeff Tyson, *How Internet Infrastructure Works*, HOWSTUFFWORKS, <http://computer.howstuffworks.com/internet/basics/internet-infrastructure7.htm> (last visited Apr. 22, 2017).

<sup>188</sup> Efroni, *supra* note 167, at 377.

<sup>189</sup> *Id.* at 378.

<sup>190</sup> *Id.*

<sup>191</sup> 15 U.S.C. § 114(2)(D)(iii).

<sup>192</sup> *Id.*, § 1125(d)(1)(B)(i).

<sup>193</sup> *Id.*, § 1125(d)(1)(B)(ii). "Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful".

<sup>194</sup> *Id.*, § 1117(d).

Also available as a tool is ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP).<sup>195</sup> Incorporated into registration agreements between registrants and registrars, it is the standard dispute resolution mechanism when issues arise over registration of a domain name.<sup>196</sup> As such, a domain name registration may be cancelled, transferred, or changed through the process.<sup>197</sup> Specifically, UDRP §4(a)(i) lists as an "applicable dispute" the requirement to submit to an administrative proceeding if "your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights."<sup>198</sup>

While it would seem easy for trademark holders to simply step up and more aggressively enforce the ACPA or the procedure available to them through UDRP, allowing the domain name system to register similar marks to trademark holders without even a cursory check beyond the good will of the registrant—thereby allowing those registrants the time to do damage to the trademark owner and American discourse—is problematic. To reduce the harm, one solution is revamping domain registration and aligning their goals with one another. Our current system offers little by way of gatekeeping, and instead relies on the public and companies to do the policing of the system. By the time a trademark holder is made aware that a registrant is engaging in trademark confusion, dilution, or cybersquatting, it might be too late to alter the course of such damage.

#### D. Fair Use Defenses

Jestin Coler stated multiple times in his interview with NPR that his initial idea for the Disinfomedia platform was to undermine the alt-right, specifically by "publish[ing] blatantly false or fictional stories" with the point of denouncing them later as fiction.<sup>199</sup> Later, speaking about one of his outlets, the National Report, he called it "satire."<sup>200</sup>

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<sup>195</sup> *Uniform Domain Name Dispute Resolution Policy*, ICANN, <https://www.icann.org/resources/pages/policy-2012-02-25-en> (last visited Jan. 29, 2017).

<sup>196</sup> *Id.* at § 1.

<sup>197</sup> *Id.* at § 3. This is usually through court order from a competent jurisdiction or a decision of an administrative panel.

<sup>198</sup> *Id.* at §4(a)(i).

<sup>199</sup> Sydell, *supra* note 63. If Coler ever followed through on this action is a question the article never answers.

<sup>200</sup> *Id.*

There are many satirical websites, such as The Onion.<sup>201</sup> However, if a reader were not familiar with The Onion,<sup>202</sup> the Onion's website gives no overt indications of their satirical nature beyond the ludicrous headlines<sup>203</sup> and copy.<sup>204</sup> Similarly, The National Report's masthead lists itself as "America's #1 Independent News Source."<sup>205</sup> Either publication could argue that making overt references to their satirical nature ruins the joke.

Trademark law allows for a variety of fair use defenses to trademark infringement. This includes descriptive marks used descriptively,<sup>206</sup> nominative fair use,<sup>207</sup> and as parody and satire.<sup>208</sup> However, marks and domain names may be used for parody purposes, provided it is only to "the extent the original work must be referenced in order to accomplish the parody . . . ."<sup>209</sup>

Coler could attempt to mount a fair use defense regarding those marks Disinfomedia used explicitly, like that of the Washington Post. But it does not seem that Coler's intent was to parody the Washington Post, but to parody the types of stories that he believes right-wing media produces.<sup>210</sup> However, The Washington Post is regarded as a trusted *liberal* news source, and is distrusted by those leaning conservative.<sup>211</sup> If the goal was to parody the left-wing media, The Washington Post would be a more apt target.

Trademark owners therefore should take specific note of possible parody or satire defenses before they prepare for defense or trial.

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<sup>201</sup> THE ONION, [www.theonion.com](http://www.theonion.com) (last visited Feb. 11, 2017).

<sup>202</sup> THE ONION AMERICA'S FINEST NEWS SOURCE, Registration No. 2450947;

<sup>203</sup> Examples include "Explanation of Board Game Rules Peppered With Reassurances That It Will Be Fun" and "Man Spends Whole Day Dreading Fun Activity He Signed Up For." THE ONION, <http://www.theonion.com/> (last visited Jan. 29, 2017).

<sup>204</sup> The Onion's masthead lists itself as "America's Finest News Source." *Id.* For a first-time visitor not in on the joke, this could be misleading and possibly humorous if they decide to credulously share the story on social media.

<sup>205</sup> NATIONAL REPORT, <http://nationalreport.net/> (last visited Jan. 29, 2017). On the front page, the National Report states, "[a]s of January 2017, iColer Media will no longer be publishing National Report. Special thanks to those who have contributed as well as those who have followed the site. Your support is truly appreciated." Perhaps the joke ceased to be funny as well as lucrative.

<sup>206</sup> U.S. Shoe Corp. v. Brown Group, 923 F.2d 844 (2d Cir. 1990).

<sup>207</sup> See Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171, 1175-6 (9th Cir. 2010). "In a trademark infringement case where a nominative fair use defense is raised, a court asks whether (1) the product was readily identifiable without use of the mark; (2) defendant used more of the mark than necessary; or (3) defendant falsely suggested he was sponsored or endorsed by the trademark holder."

<sup>208</sup> Lyons Partn. v. Giannoulas, 179 F.3d 384 (5th Cir. 1999).

<sup>209</sup> *Id.* at 388 (5th Cir. 1999).

<sup>210</sup> See Sydell, *supra* note 63.

<sup>211</sup> See *Trust Levels of News Sources by Ideological Group*, PEW RES. CTR. [http://www.journalism.org/2014/10/21/political-polarization-media-habits/pj\\_14-10-21\\_mediapolarization-01/](http://www.journalism.org/2014/10/21/political-polarization-media-habits/pj_14-10-21_mediapolarization-01/) (last visited Feb. 26, 2017).

## V. CONCLUSION

Fake news represents the most recent iteration of hoaxes and sensationalist—and sometimes satirical—reporting. As we begin to counter its effect in the technological, digital, and legal realms, fake news will evolve further. This is a process that is taking shape in the daily news media. It is up to those operating in the trademark realm to be aware of these further changes and be prepared to use existing law to their advantage, and look for ways to improve the law so that both trademark owners and consumers are not so easily fooled.

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