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### **Snake-Bit**

Jim Astrachan

The best cases are those where the big guy starts out a bully and ends up gettin' snake-bit. It even happens in trademark cases.

The Taubman Company is one big guy for sure, a developer of thousands of acres of commercial real estate all over the country. Like most folks, Taubman has no sense of humor when it believes that someone has ripped off its valuable trademarks or is using its marks in an unflattering manner. Enter Mr. Mishkoff, a resident of Carrollton, Texas and a recent recipient of the news that Taubman was planning to build a mega shopping center in Plano, Texas called the "Shops at Willow Bend." Upon learning of Taubman's plans, Mishkoff registered the domain name, "shopsatwillowglen.com." Mishkoff, a website designer, then created a web site with a map of the proposed shopping center and a list of each store that Taubman announced would be a tenant. He linked each tenant's site to his own site.

It didn't take Taubman long to learn of Mishkoff's deed and it demanded the release of the domain name. Mishkoff, perhaps a bit disengenously, claimed that his site was a 'non-official fan site' and that he was entitled to express his personal adulation for Taubman's development through his site.

Employing good judgment Mishkoff displayed on his site a prominent disclaimer that his site was not associated with Taubman, and he linked his site to Taubman's. Employing bad judgment he linked his site to his girl friend's custom tee-shirt business site and his own custom web site development business site. Then, employing good judgment he quickly removed the links to his site and his girl friend's site.

Taubman demanded that Mishkoff's site be torn down and his domain name relinquished. Mishkoff replied, "Why don't you buy my 'shopsatwillowglen.com' domain name?" Taubman sued.

Mishkoff, a pretty funny guy, reacted to Taubman's suit with humor and a keen eye for breaking news. First, he reported all activities related to Taubman's suit on his website. Every demand; every letter; every pleading. And, second, Mishkoff registered a passel of complaint domain names: taubmansucks.com; shopsatwillowbendsuck.com; theshopsatwillowbendsuck.com; willowbendmallsucks.com; and willowbendsucks.com. Any internet searcher looking for Taubman's new Texas property would likely find these sites, each linked to Mishkoff's original site carrying the story of Taubman's efforts to oppress Mishkoff's use of its marks.

Taubman's efforts to obtain injunctive relief were soon heard by a federal judge who, it appears, was rubbed the wrong way by Mishkoff's flippant actions. Ignoring both the merits and the First Amendment, this judge enjoined Mishkoff's use of the "shopsatwillowbend.com" domain. Soon after, the same judge heard and granted Taubman's motion to enjoin Mishkoff's use of the five complaint domain names.

Mishkoff appealed the injunctions contending that the court's prior restraint of his use of the domain names, given his non-commercial purpose, violated his Free Speech rights. True, he conceded, the Lanham Act allows regulation of speech, including prior restraint, but only where the speech is commercial and, if commercial, is misleading, false or illegal. He contended on appeal that the speech appearing on his web site was not commercial, or that if it was, his intent was not to create a commercial site.

Intent does not matter in Lanham Act cases as the Lanham Act is a strict liability statute. You violate it or you don't. If the site can be considered commercial, and if consumers are likely to be confused regarding whether Mishkoff's site was actually Taubman's, the site will need to come down. But once Taubman removed the links to his web development site and his girl friend's tee-shirt site the "shopsatwillowbend.com" site was no longer commercial, as it did not offer the sale of any product. This, despite Taubman's argument that Mishkoff's goal was to damage or interfere with the sale of Taubman's products and services.

Even if Mishkoff's site was subtly commercial, in that it linked to sites that sold services or products, the appellate court held that the prominent disclaimer Mishkoff placed on his site was sufficient to dispel any confusion. And because Mishkoff linked his site to Taubman's actual site the appellate court reasoned it would be hard to conclude that a reasonably astute visitor to Mishkoff's site would think his site was the official Taubman site.

In their appellate brief Taubman's lawyers conceded that Mishkoff was "free to shout "Taubman sucks! from the rooftops..." And that's exactly what Mishkoff did, albeit employing the electronic, international version of the rooftop crier - the Internet.

Is there a lesson here? Maybe. A big guy trying to muscle a little guy needs to exercise some restraint and plan its actions against the possibility that every bullying step it takes will be reported in detail on the little guy's website. A person versed in communications will have little trouble creating a story of public interest and driving viewers to that story. In the end, negotiation and tact may be far more effective than muscle. All this reminds me of the story of a Texas hunter who reached his hand down a gopher hole to grab a wounded grouse and was snake-bit on his thumb by a rattler. He just couldn't shake the critter loose and it really hurt him. A posse of Texas lawyers should have known better.

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