

Designing Your **Web Site** to **Avoid** Copyright and Trademark **Problems**



by Andrew Berger, counsel, Tannenbaum Helpen Syracuse & Hirschtritt

Web site design is big business but may also expose the designer to big problems. If you choose the wrong domain name, post material on a site that infringes another's trademark, or link to a site that you know contains pirated material, you and your client may be subjected to embarrassing and expensive litigation. Below are some suggestions to avoid that.

Domain Name Selection

You need to choose a domain name that is both distinctive and noninfringing. That will not be easy. Most distinctive names are already registered.

But first some naming basics. Domain names are composed of two parts: (1) a descriptive name ending in a dot called the second-level domain, and (2) the suffix following the dot called the top-level domain. For instance, the site amazon.com contains the descriptive name or second-level domain "amazon" and the top-level domain "com." The descriptive name may combine letters, numbers, and some typographical symbols but no apostrophes or spaces.

Three of the seven top-level domains are open to commercial users: com, net, and org. The other four (edu, gov, mil, and Interactive) are restricted to certain entities. The manager for Internet addresses, the Internet Corporation for Assigned Names and Numbers (ICANN), in response to pressure from business groups, may soon be adding some new top-level domains.

Naming Guidelines

After you have selected a possible name, search the Web site of one of the more than 90 domain name registrars to see if the name is available. If the name is already registered or warehoused by someone else, the search result will list similar names that you may register. For instance, search for the name Nike and the registrar will tell you that similar sounding names like "aboutnike.com" and "nikebusiness.com" are available. But before you register, keep the following guidelines in mind:

1 If you choose a domain name that is the same or confusingly similar to another famous or distinctive trademark, here is what might happen: You invite litigation from the trademark owner under a federal statute called the Anti-Cybersquatting Consumer Protection Act or arbitration under ICANN's dispute resolution policy.

You will lose the case and your domain name to the owner of the mark if a court finds you selected that name to compete or drain business from the mark by confusing potential customers about the source or sponsorship of your site. For instance, if your site sell shoes made by a Nike competitor, don't pick the name "nikebusiness.com" since a court is likely to determine you picked that name to draw Nike customers and switch them to your brand.

Even if you do not compete with the mark, you may lose the domain name if you have never conducted business under that name, if it is not the name of a person associated with your company, or if you try to sell your domain name to the mark for financial gain. For example, Volkswagen was able to take the domain name "VW.net" away from Virtual Works, Inc. since that company had never conducted business under that domain name, had no trademark or other rights in the initials "VW," and confused Volkswagen customers by using that domain name.

2 If your domain name is also your name, you may be able to continue to use it, even though it is the same as another's famous mark. But the court may set some conditions on your use. Thus, Mr. Uzi Nissan, the owner of a computer business, was permitted to use the domain name "nissan.com" so long as he did not use his site to display any automobile-related information or advertising and posted a notice on the top of his home page disclaiming affiliation with the Japanese automaker Nissan.

3 You may also be able to use a domain name that is similar to another's trademark so long as your purpose is to criticize the mark's business. For instance, a court refused to shut down a site named "ballysucks," dedicated to complaints about Bally's fitness business. The court found that a reasonably prudent person would not mistake that site for the official Bally site. Similarly, a court declined to close down a site called "lucentucks.com" because no consumer would confuse it with a site sponsored by Lucent.

What May I Put On My Site: Some Questions and Answers

Once you've selected and registered a noninfringing domain name, what can you post on your site? Designers want their designs to generate acclaim not lawsuits. The following series of questions and answers may help designers achieve that objective.

Q: Do I risk copyright infringement if I scan an eye-catching photograph and post it on my site without first obtaining the consent of the copyright owner?

A: You may. You will need authorization from the copyright owner unless the photograph is in the public domain or you justify your use as "fair use." Works in the public domain are those works not protected by copyright and free for all to use. Copyrighted works fall into the public domain by either the passage of time or the failure to observe copyright formalities. Fair use arises when you use copyrighted material for certain purposes such as criticism, news reporting, teaching, scholarship, or research. Before you conclude that material is in the public domain or protected by fair use, you may want to get some expert help since these are tricky areas.

Q: What if one of my Web site subscribers uploads infringing material to my site. What are my responsibilities and obligations?

A: You have a few. To qualify for an exemption to liability under a new federal statute called the Digital Millennium Copyright Act (DMCA), you must: (1) not have known that the material was infringing; (2) post procedures on your site for victims of copyright infringement to notify you of infringement; and (3) immediately take down or remove the infringing material on request.

Q: May I link to anyone's site?

A: Linking is what the Internet is all about. At the same time, some sites require your permission before you may link to them, and some even require a linking agreement.

Q: Do I have liability if the site I link to contains infringing material?

A: You may, if you know that the linked site contains such material. For instance, hackers have created software that permits users to decrypt and copy data on DVDs. If you link to a site that you know contains this software, you may be liable for furthering or aiding infringement.

Q: May I deep-link to secondary pages on another's site?

A: Probably so. Commercial sites want visitors to "come in the front door" at the home page. Web sites place most banner ads there and key prices for those ads to the number of hits on the home page. But a recent court decision found that deep-linking was not a copyright violation since there was no deception involved in sending a visitor from one site to a secondary page on another.

Q: May I use another's trademark in my "meta tags"? (Meta tags are a type of HTML code designed to provide machine-readable information to search engines about the contents and display of a Web page.)

A: Not if your purpose is to hijack traffic from the mark's site to yours. But if you have a business relationship with the mark, such as you act as its authorized distributor, you can indicate that relationship in your meta tags. For instance, the former Playboy Playmate of the Year Terri Welles was permitted to use the words "playboy" and "playmate" in her meta tags since they fairly described and identified her achievements and relationship with *Playboy* magazine.

Q: May I "frame" or create a window on my Web page to view linked-to content on other sites?

A: Probably not. Framers often want the best of both worlds—to link visitors to content on another's site and then frame that content on their window. For instance, a news aggregator called Total News took news stories from other newspapers and framed them on its site, placing ads and the Total News logo above the frame. Total News stopped the practice in response to a suit by publishers who

Continued on page 13

Awards *Continued from page 8*

because they know that once that happens, they'll be able to control the sale of art to clients and the rights that artists have. Once we're dependent on them to get our work, we'll have no way of fighting back.

There's both bad news and good news. The bad news is that these people are spending hundreds of millions of dollars to buy their way into our business. The good news is that they're spending hundreds of millions of dollars to buy their way into our business. We have to realize if they're willing to make that kind of investment—unless we presume they're charitable institutions or we're looking for some way to contribute affordable artwork to needy corporations like Condé Nast and Time Warner—then these people see a huge future in selling the rights to our work. If they can see a future in selling the rights to our work, we

have to wonder why artists have given up any hope of a future. If there's money there for them; there's money there for us.

We have to find some way to compete on a scale the competition is forcing on us. How can any of us compete against the advertising budgets of Condé Nast and Getty? That's what we're going to have to spend the next couple of years trying to do, and we've got a very small window in which to do it. How can we do that? That's what we're going to be discussing over the next couple of years both within and without the Graphic Artists Guild. We have to recognize that we can compete, that we control the rights to our work, and that we can find some way to sell those rights. Most of us who came into this business did so because we saw some entrepreneurial way of making a living for ourselves, and I'm convinced we'll continue to find some way to do it.

With Thanks

Putting this event together is not easy, and we are grateful to our major sponsors: CCC, Crane and Co., Inc. for their generous contribution of the paper stock for all the designed components and, of course, to DK Holland Tracie Rosenkopf and Jim Hiesener of The Pushpin Group for designing them; Region 9A UAW, Serbin Communications, and The Workbook. I also want to thank our sister organizations and other advertisers who helped underwrite this event by taking ads in our dinner program: Allworth Press, American Illustration, ASJA, *Communication Arts*, *HOW*, Jellybean, NWU, *Step-by-Step Graphics*, VAGA, and the WGAE. Thanks also to Mary Bono and Lou Pollack who created the festive table decorations. I'm especially grateful to the Guild's PR Manager Tricia McKiernan, who picked up the reins for this event last January and rode it so admirably to the finish line. — Paul Basista ■

HOW Conference

Continued from page 14

between the Guild and the AIGA. Many designers were interested in advocacy and political/legislative issues. There was also a lot of interest from designers in cities where new Chapters are in the works.

We were able to hand out hundreds, if not thousands, of brochures, applications, and national newsletters, and we signed up 15 new members on the spot. We can expect to see more new members in the next few weeks after designers return home and get a chance to read through the materials they picked up.

The conference was a great event: for learning, for networking, for building community within the design profession. On behalf of the Guild, I'd like to thank Bryn Mooth, editor of *HOW* magazine, for the publication's support of Guild issues. I hope the Guild can play an even stronger role in next year's conference in San Francisco. I hope to see you there! ■

Lauri Baram, a graphic designer, is a founding member and current national representative of the Guild's Albany Chapter. She is a member of the Graphic Design Issues and the Certification committees.

Web Design

Continued from page 3

claimed the frames confused users about the origin of the information in the window. To avoid litigation, you should sign a framing agreement with the site whose content you want to frame.

Q: *May search engines key their banner ads to direct viewers to competitors of the site the viewers are seeking to find?*

A: Yes, a court recently permitted Excite and Netscape to key their banner ads to pornographic sites whenever visitors used "playboy" or "playmate" in their search requests. The court said there was no evidence that customers would be sufficiently confused over the relationship between Playboy and a pornographic site.

Q: *Is there any problem with the use of "cookies"?* (Cookies are small files that may be placed on your hard disk for recordkeeping purposes.)

A: Not yet. No cases or legislation presently prohibit the practice of giving a cookie to a visitor. But in the terms and conditions on your site, you should advise your visitors what personal information you collect,

what you do with that information, and the procedures you follow to allow visitors to either correct that information or prohibit its collection. Internet privacy is of growing concern, and legislation governing the privacy policies of commercial sites may be in the offing.

Q: *Who owns my Web site design?*

A: You do, unless your design is a "work for hire." A work for hire arises in two instances when you create a design: (1) for your employer in the course of your employment or (2) as a freelance artist and you then transfer the copyright to your client by a signed contract specifically stating the design is a work for hire. Otherwise, the design is yours; and you can use it again and again. ■

© 2000 by Andrew Berger. The information contained in this article is for informational purposes only and is not meant to be construed as legal advice. Before any action is taken based on any information herein, you should consult with legal counsel. Those wishing further information about the contents or cases mentioned in this article should contact Andrew Berger at 212.702.3167 or berger@tanhelp.com.

New Chapters

Continued from page 5

this summer.

The campaign in Minneapolis is evolving, with frequent meetings continuing to be well attended. Several local members have assumed organizing roles, and the campaign continues to build a strong foundation for a Twin Cities Chapter.

Events during the next few months will be instrumental in determining each campaign's success. Thus far, a strong level of commitment and excitement accompany each campaign, and success appears guaranteed for these groups of hard-working volunteers. ■

ANNOUNCING! ILLUSTRATION MARKETPLACE • NOVEMBER 1ST, 2000

Join us at a new and exciting location in the heart of historic Chelsea: Metropolitan Pavilion North, 4th Avenue at 19th Street, New York City (New York City's premier exhibition facility; one large, well-lit grand ballroom on the ground floor) \$245.00 for a single table space (30'x30') • \$439.00 for a double table space (30'x75')

Join us for our 10th annual Illustration portfolio show! Because it improves every year, we expect this show to surpass all others. We host 140 Guild Illustrators and invite over 7,000 plus art directors and art buyers from advertising agencies, newspapers, magazines and book publishers, in record companies and Internet companies. We also send you the mailing list after the show so you can follow up with the people you connected with. If you are a Guild member illustration, fill out the info below, put it out and send along with your check or money order payable to: Graphic Artists Guild of NY, 90 John Street, Suite 403, NYC, NY 10039-3252. (Before September 8th) Seating is on a first-come, first-served basis. You pick your own spot. We will confirm your registration by mail only and will include a floor plan showing location of tables and other show information. Computer/Internet hook-up will be available for an additional fee. For more info visit: www.gag.org/new.york.

First Name	PI	Last Name	Guild Number	S	FI
Address		City	State/Zip		
Day Phone	Fax	E-mail	Account Enclosed		

Can we talk?

Psst! Listen up. Some of the best tips around start with **good conversation**. Not sure how to word a new contract? **Ask a peer**. Looking for opinions on the best software to build your website with? **Start a dialog** with other designers. **Just need to scream?** Use your keyboard instead. It's all at the Graphic Artists Guild website. Just go to www.gag.org and click the link for "Chat/WebBoards."

There you'll find **passionate souls** dedicated to the **creative mind**. Psst...pass it on!

