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LICENSED TO PRACTICE IN NEW YORK, NEW JERSEY, AND BEFORE THE U.S. PATENT OFFICE

April 18, 2013

VIA: E-MAIL ONLY

Mr. Jeffrey Tognetti
Media Revo Corp.
115 River Rd
Suite 425
Edgewater, NJ07020

Subject: **Opinion Letter**
Re: Referential Use of Trademarks in Domains
Your File: Unknown
My File: AJV005

Dear Mr. Tognetti,

You have requested my opinion with regards to use of trademarks in domain names, when properly referring to the trademarked goods. In simpler English, an example would be, "sell-used-honda.com" where "Honda" refers to a well known trademark, and you are, in fact, selling used Honda cars on this website.

In order for there to be trademark infringement, there must be a likelihood of confusion (see *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). Referential use of a trademark, however, does not lead to

infringement. I refer you to *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. July 8, 2010), stating:

> "the Sleek-craft analysis [for determining likelihood of confusion and therefore, trademark infringement] doesn't apply where a defendant uses the mark to refer to the trademarked good itself. See Playboy Enters., Inc. v. Welles, 279 F.3d 796, 801 (9th Cir. 2002); New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992)."

While the cases are fact sensitive and may not appear to each and every one of your domains and usages thereof, if you are merely referring to a trademark holder's mark, and not acting or leading the public to believe in any way that you are the trademark holder, then such usage is permissible referential usage.

Specifically, with regards to domain names, the *Toyota Motor Sales* case referenced above was referring to the domain name,"buy-a-lexus.com" where an owner was lawfully reselling Lexus cars.

Having said the above, it is also worth mentioning the "cyber-squatting" statute. The Uniform Domain Name Resolution Policy, of which you agree to

when you register a domain and all registrars must hold by, states that a domain is cyber-squatting if:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

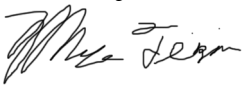
(ii) the present owner has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

While the first prong will be met in the cases we are referring to, as long as you are using the domains legitimately (e.g. “sell-used-honda.com” for selling Hondas and not Oldsmobiles or any other brand), at least the second prong should not be met.

Having stated the above, I further reiterate that this is a general opinion which may not apply to specific cases and specific domain names and usages thereof by yourself. Still further, there are other (to my knowledge, older) court cases which tend to disagree, but such cases are, in my opinion, outdated and not as persuasive, and come from lower courts than the 9th Circuit *Toyota* case referenced above. Suffice to say, if a large car manufacturer goes after you, they will be citing such other cases. Still further, the case law is probably not entirely settled and it very well might be that another circuit may still rule differently in the future.

Sincerely,



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Attorney at Law

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