



MasterCard Prevails In Domain Name Dispute

December 14, 2009

Judge Stephan P. Mickle of the United States District Court for the Northern District of Florida issued an order in the case of *MasterCard International Incorporated v. Michael J. Yanda, d/b/a Indy Web Productions and Finance Globe Portal*, Case No. 4:08-cv-00565 (N.D. Fla. Nov. 5, 2009). Judge Mickle's order confirms that the registration of multiple Internet domain names containing trademarks owned by another party, or domain name "warehousing", is a violation of the Anti-cybersquatting Consumer Protection Act ("ACPA") and constitutes trademark infringement, unfair competition and dilution.

In this case, the defendant registered approximately 40 domain names consisting of variants of MasterCard's MASTERCARD and PAYPASS trademarks. The domain names resolved to the defendant's website where the finance-related goods and services of MasterCard and its competitors were advertised. The defendant profited whenever an Internet user viewed his web page and clicked through to a competitor's site.

The Court order instructs that MasterCard's MASTERCARD, PAYPASS and Interlocking Circles Device trademarks are famous (the "Marks"), the domain names at issue are confusingly similar to MasterCard's Marks, and the defendant's registration and use of the domain names were in bad faith. As a result, the defendant's actions constitute cybersquatting in violation of the ACPA, trademark infringement under the Lanham Act, unfair competition under the Lanham Act and Florida State law, and trademark dilution under the Lanham Act and Florida State law.

Judge Mickle's order is significant for two reasons. First, it is one of the first cases in the Eleventh Circuit to address the practice of domain name warehousing and find it in violation of the ACPA. Second, it confirms that the correct test in the Eleventh Circuit under the ACPA is the confusing similarity test, not the likelihood of confusion test. Previous case law in the Eleventh Circuit interpreting the ACPA had muddied the issue.

In conclusion, the Court enjoined the defendant from (a) using the Marks or the domain names in any manner, (b) registering or maintaining any registration in the domain names or any other domain names consisting of the Marks, (c) using the Marks or confusingly similar terms on the



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defendant's web sites, (d) using the Marks or any confusingly similar terms in any code, metatags, keywords or search terms that are intended to cause the defendant's web sites to be listed by any Internet search engines, (e) otherwise infringing the Marks, (f) making any representation that MasterCard's goods or services, domain names or web sites are affiliated with or otherwise connected with the defendant, and (g) engaging in conduct likely to cause confusion with MasterCard. The court ordered the defendant to transfer the domain names at issue to MasterCard.

The plaintiff, MasterCard International Incorporated, was represented by [Mark V.B. Partridge](#), [Alexis E. Payne](#) and [David Beeman](#) of [Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP](#) in Chicago, Illinois and David P. Healy of Law Offices of David P. Healy, PLC in Tallahassee, Florida. The defendant, Michael J. Yanda, an individual, d/b/a Indy Web Productions and Finance Globe Portals, was represented by Dennis A. Creed of Robbins Equitas Lawyers and Counselors in St. Petersburg, Florida.

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