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November 29, 1999

Title III - Trademark Cyberpiracy Prevention

Section 3006 - "Study on Abusive Domain Name Registrations Involving Personal Names"





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Notices

DEPARTMENT OF COMMERCE (DOC)

Office of the General Counsel; Abusive Domain Name Registrations Involving Personal Names; Request for Public Comments on Dispute Resolution Issues Relating to Section 3002(b) of the Anticybersquatting Consumer Protection Act

65 FR 10763

DATE: Tuesday, February 29, 2000

ACTION: Notice and request for public comments.

SUMMARY: The Department of Commerce requests written comments from any interested member of the public on the resolution of Internet domain name disputes involving the personal names of individuals. On November 29, 1999, President Clinton signed into law (as incorporated into Public Law 106-113) the "Anticybersquatting Consumer Protection Act" (or "Act"). Generally, the Act is intended to protect the public from acts of Internet "cybersquatting," a term used to describe the bad-faith, abusive registration of domain names, and section 3002(b) in particular contains a prohibition on certain acts of cybersquatting that involve the personal names of living persons.

Section 3006 of the Anticybersquatting Consumer Protection Act directs the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, to conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving personal names, the subject of section 3002(b). The required report is due to Congress no later than 180 days after enactment of the Act. This Federal Register notice is intended to solicit comments from interested parties for consideration by the Department of Commerce as it prepares the required report. The specific questions posed by section 3006 of the Act are reprinted in the portion of this notice called "Supplemental Information."

DATES: Written comments must be received by March 30, 2000.

ADDRESSES: Please address written comments to: Department of Commerce, Room 5876; 14th & Constitution Avenues, NW; Washington, DC 20230, marked as "Public Comments" to the attention of Sabrina McLaughlin, Office of General Counsel. If possible, paper submissions should be accompanied by disks formatted in WordPerfect, Microsoft Word, or ASCII. As an alternate means of submission, comments may be transmitted by facsimile to Sabrina McLaughlin at (202) 482-0512. Electronic submissions may be directed to DomainName@doc.gov. Any accompanying diskettes should be labeled with the name of the party submitting comment and the version of the word processing program used to create the document.

FOR FURTHER INFORMATION CONTACT: Sabrina McLaughlin by telephone at (202) 482-4265, by mail to her attention addressed to Department of Commerce, Room 5876; 14th & Constitution Avenues, NW; Washington, DC 20230, or by electronic mail at DomainName@doc.gov.

SUPPLEMENTARY INFORMATION: Section 3002(b) of the Anticybersquatting Consumer Protection Act (Public Law 106-113) creates the following protection for the domain names n1 of individuals:

n1 Domain names are a crucial component of the online world, and yet many online users may not know by what technical device even new computer users tend to easily navigate the Internet. A domain name functions much like a cyberspace address book.

Domain names are the familiar and easy-to-remember names for Internet computers that map to Internet Protocol (IP) numbers, which, in turn, serve as routing addresses on the Internet. The domain name system translates Internet names into the IP numbers needed for transmission of information across the network. See June 5, 1998 Statement of Policy on the Management of Internet Names and Addresses, also known as the "White Paper" at <http://www.ntia.doc.gov/ntiahome/domainname/6-T35-T398dns.htm>.

(b) Cyberpiracy Protections for Individuals -

(1) In general -

(A) Civil liability -Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific

intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

(B) Exception -A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name is used in, affiliated with, or [*10764] related to a work of authorship protected under title 17, United States Code, including a work made for hire as defined in section 101 of title 17, United States Code, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946 (15 U.S.C. 1051 et seq. or other provision of Federal or State law.

(2) Remedies -In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

The Internet has grown exponentially from its humble origins as a tool for researchers and scientists. As more and more people are using the Internet for business or recreational purposes, domain names have taken on increased significance as valuable Internet locators. Online users have become accustomed to being able to guess the domain name of a company or entity, with a good degree of success. For example, in the shorthand of domain names, "the Department of Commerce" (or DoC) translates into the domain name "doc.gov". Businesses and other entities rely on this "seeking tendency" of online users to establish domain names that are valuable to businesses because the names are predictable to users. However, the sheer number of domain names in use on the Internet today means that an organization may find that their desired domain name has already been registered by another party.

The Anticybersquatting Consumer Protection Act provides a minimalist, predictable legal framework to address domain name disputes that can result when different parties compete for the right to register an identical name. It is not meant to override, but instead facilitate other domain name dispute resolution mechanisms such as those recognized by the Internet Corporation for Assigned Names and Numbers (ICANN), the not-for-profit organization responsible for domain name management. On October 24,



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FEDERAL REGISTER

Vol. 65, No. 67

Notices

DEPARTMENT OF COMMERCE (DOC)

**Office of the General Counsel; Request for Public Comments on
Dispute Resolution Issues Relating to Section 3002(b) of the
Anticybersquatting Consumer Protection Act**

65 FR 18032

DATE: Thursday, April 6, 2000

ACTION: Notice; 15-day re-opening of comment period.

SUMMARY: Pursuant to public request, the Department of Commerce re-opens for an additional 15 days the response period for our request for public comments and suggestions concerning the "Anticybersquatting Consumer Protection Act" (or "the Act") (Public Law 106-113) and the resolution of Internet domain name disputes involving the personal names of individuals. The original notice and request for comments was published on February 29, 2000, with written comments to be provided by March 30, 2000 (65 FR 10763). Detailed background information, as well as the scope of this request, may be found in the above-cited Federal Register notice.

DATES: Written comments must be received no later than April 21, 2000. Under no circumstances shall any written comments received after April 21, 2000 be considered by the Department of Commerce.

ADDRESSES: Please address written comments to: Department of Commerce, Room 5876; 14th & Constitution Avenues, NW; Washington, DC 20230, marked as "Public Comments" to the attention of Sabrina McLaughlin, Office of General Counsel. If possible, paper submissions should be accompanied by disks formatted in WordPerfect, Microsoft Word, or ASCII. As an alternate means of submission, comments may be transmitted by facsimile to Sabrina McLaughlin at (202) 482-0512. Electronic submissions may be directed to DomainName@doc.gov. Any

accompanying diskettes should be labeled with the name of the party submitting comment and the version of the word processing program used to create the document.

FOR FURTHER INFORMATION CONTACT: Sabrina McLaughlin by telephone at (202) 482-4265, by mail to her attention addressed to: Department of Commerce, Room 5876; 14th & Constitution Avenues, NW; Washington, DC 20230, or by electronic mail at DomainName@doc.gov.

SUPPLEMENTARY INFORMATION: The Department of Commerce has determined that it is appropriate to re-open the record for public comment in order: (1) To officially accommodate the significant number of comments being filed somewhat beyond the original comment deadline; and (2) to ensure that the Department receives the benefit of broad public perspectives as the Department, in consultation with the United States Patent and Trademark Office and the Federal Election Commission, proceeds to study and to recommend to Congress appropriate guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto. The Department's guidelines and recommendations will take the form of a Report to Congress, as required under section 3006 of the Act.

The Department will not be posting comments online. However, because all submissions received pursuant to a solicitation for public comment are treated as public information, respondents should not submit materials that they do not desire to be made public.

Dated: April 3, 2000.

Andrew J. Pincus,

General Counsel.

1999, ICANN approved rules for an inexpensive, online alternative to litigation in the form of its uniform dispute resolution policy (UDRP). Under this UDRP, disputes alleged to arise from abusive registrations of domain names may be addressed by expedited administrative proceedings. Additional details about the ICANN policy may be found at <http://www.icann.org/udrp/udrp.htm>.

Many domain name disputes are the subject of court actions brought under federal trademark law (more precisely, under the Lanham Act) because the commercially valuable asset that is in dispute is a brand or other mark traditionally protected by trademark law. See, e.g., *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1228-29 (N.D. Ill. 1996) (adopting the report and recommendation of the Magistrate and adding, "by applying the law of trademarks to the Internet, [the Magistrate Judge] strikes an appropriate balance between trademark law and the attendant policy concerns raised by defendant"), subsequent proceeding 1998 U.S. Dist. LEXIS 15431 (N.D. Ill. 1998). By definition, a trademark is either a word, phrase, symbol or design, or combination of words, phrases, symbols or designs, which identifies and distinguishes the source of the goods or services of one party from those of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. See 15 U.S.C. @ 1127.

The basic theories of trademark law that apply to non-personal name domain disputes provide some basis for addressing the problem of abusive domain name registration involving personal names. In traditional court cases of trademark infringement, the complaining party must show that the infringing use causes a "likelihood of confusion." 15 U.S.C. 1114. This concept suggests that the harm suffered by the litigating plaintiff is one of deception. Trademarks serve an identifying function. By leading the consumer to think that a product originates from a source that it does not, an infringer is able to divert sales into his own pockets. A court's determination of whether there has been a likelihood of confusion turns on such factors as: (1) the area of concurrent sale, (2) the extent to which the products or services are related, (3) the extent to which the mark and the alleged infringing name are similar, (4) the strength or novelty of the plaintiff's mark, (5) evidence of bad faith or intention on the part of the defendant in selecting and using the disputed name with a view to obtaining some advantage from the goodwill that the plaintiff has built, and (6) evidence of actual confusion. See *Chopra v. Kapur*, 185 U.S.P.Q. 195, (N.D. Cal. 1974).

"Dilution" is another available cause of action under the Lanham Act. The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services...". 15 U.S.C. 1127. The section of the Lanham Act that provides for remedies in cases involving the

dilution of famous marks may also be illuminating as a basis for personal name domain name protection. 15 U.S.C. 1125.

Finally, the claim of "unfair competition" may be invoked in domain name disputes in which the trademark at issue has not been federally registered. Unfair competition is a commercial tort that evades precise definition. 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* @ 1.03 (3d ed. 1995). Courts have variously described the tort as one that exists "[w]hen competition is engaged in beyond the boundaries of fair play" or as a test that occurs if "defendants have damaged plaintiff's legitimate business interest through acts which equity would consider unfair." *Johnson & Johnson v. Quality Pure Manufacturing, Inc.*, 484 F. Supp. 975 (D.C.N.J. 1979); and *Reinforced Earth Co. v. Neumann*, 201 U.S.P.Q. 205 (D.C. Md. 1978), respectively. Some states treat the unauthorized commercial use of another's identity as a form of unfair competition under a version of the theory of a "right of publicity." Importantly, the right of publicity only exists as a concept under the common law or statutory laws of certain states; there is no parallel on the federal level.

The Anticybersquatting Consumer Protection Act provides for federal protection against the unauthorized use of personal names as domain names by individuals with a "specific intent" to profit from such name by selling the domain name for financial gain to that person or any third party. In passing this Act, Congress concluded that some form of federal protection was necessary to prevent acts of abusive domain name registration involving personal names. As a part of the legislation, Congress also directed the Department of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, to study and to recommend to Congress appropriate "guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto." In the required report that the Department of Commerce must prepare, the Department is being asked whether the protections afforded by the Anticybersquatting Consumer Protection Act are sufficient to address the problem. More specifically, section [*10765] 3006 of the Act asks the Department to consider and to recommend guidelines and procedures for:

(1) protecting personal names from registration by another person as a second level domain name n2 for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain;

n2 A second level domain name is that part of the Internet address before

the.com,.net,.org, or other generic top-level domain open for registration. For example, if the domain name is JaneDoe.com, the term "JaneDoe" is the second-level domain and the term ".com" is the top-level domain. (Footnote not in the original)

(2) protecting individuals from bad faith uses of their personal names as second level domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name;

(3) protecting consumers from the registration and use of domain names that include personal names in the second level domain in matters which are intended or are likely to confuse or deceive the public as to the affiliation, connection, or association of the domain name registrant, or a site accessible under the domain name, with such other person, or as to the origin, sponsorship, or approval of the goods, services, or commercial activities of the domain name registrant;

(4) protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential official candidates for Federal, State, or local political office in the United States, and the use of such domain names in a manner that disrupts the electoral process or the public's ability to access accurate and reliable information regarding such individuals;

(5) existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the considerations described in paragraphs (1) through (4); and

(6) the guidelines, procedures, and policies of the Internet Corporation for Assigned Names and Numbers and the extent to which they address the considerations described in paragraphs (1) through (4)."

So that the Department of Commerce can examine the full range of laws, policies, and regulations that may apply and may lend themselves to use in resolving personal name disputes, we are asking for public comments and input.

We note that on November 5, 1999, the Federal Election Commission printed in the Federal Register a Request for Comments on the Use of the Internet for Campaign Activity. Specifically, the Federal Election Commission asked for public comments "in order to assess the applicability of the Federal Election Campaign Act and the Commission's current regulations to Internet activity." Notice of Inquiry and Request for Comments, 64 FR 60,360 (1999). Both the Federal Election Commission

Request, and the responding comments, may be read at the Commission's Web site at <http://www.fec.gov/internet.html>. In the interests of focusing this Request for Comments, we would welcome public submissions on the use of the Internet for campaign activity only as such submissions relate to the more limited, fourth prong of the Act's study requirements.

Scope of this Request

Section 3006 of the "Anticybersquatting Consumer Protection Act" asks the Department of Commerce to study and recommend appropriate guidelines and procedures for dispute resolution in cases involving cyberpiracy of personal names. Information collected from responses to this Federal Register Notice will be considered when the Department of Commerce prepares the required report to Congress.

Therefore, we welcome comments that address the non-exhaustive list of laws presented in the supplemental information section, comments that assess the suitability of these laws for use in the context of abusive domain name registration of personal names, and suggestions of other frameworks that may be useful in considering approaches to resolution of personal name domain disputes. Respondents are also asked to provide comments on the degree to which the ICANN UDRP satisfactorily handles domain name disputes involving personal names. Comment is also invited concerning any legal or Constitutional issues raised by any new guidelines or procedures as they relate to personal name disputes, separate and apart from the legislative foundation established by the Anticybersquatting Consumer Protection Act.

More generally, we would be interested in comments and suggestions on the form that any new guidelines or procedures should take, and the degree to which additional protection may or may not be needed in this area. We encourage respondents to consider the extent to which individuals would avail themselves of protections offered in this area and to consider whether the appeal of such protections would be limited to only high-profile or famous individuals. Respondents should also consider the logistical problems that may attend implementation of new guidelines in this area, particularly as these problems relate to the current system of domain name registration. We would also like to hear comments from respondents with personal experience in unauthorized commercial appropriation involving a personal name.

Please be aware that all comments received pursuant to a solicitation for public comment are treated as public information. Respondents should not submit materials that they do not desire to be made public.

Dated: February 24, 2000.

Andrew J. Pincus,

General Counsel, Department of Commerce.