

TO: Sabrina McLaughlin
Office of General Counsel
FROM: Erik Carter
DATE: April 21, 2000
RE: Comments on Anti Cybersquatting Consumer Protection Act

Dear Ms. McLaughlin:

Accompanying please find a report detailing the comments of CMG Worldwide, Inc., on the recently enacted Anti Cybersquatting Consumer Protection Act.

Thank you for allowing us the opportunity to voice our opinions. If you have any questions or comments concerning this submission, please do not hesitate to contact me at (317) 570-5035.

Cordially,

Erik Carter
Corporate Counsel

Celebrities and the attorneys representing their various intellectual property interests, such as copyright, trademark, and right of publicity, appreciated the recent enactment of the Anticybersquatting Consumer Protection Act, (hereinafter "ACPA"), an amendment to Section 43 of the Lanham Act. With explosive impact the Internet has offered a wealth of possibilities in both e-commerce, and information services. Domain names provide the initial address typed in by Internet users as they search for collectible items, memorabilia, and information related to their favorite sports and entertainment personalities, whether living or deceased.

CMG Worldwide, Inc. (CMG) is in the business of representing living and deceased celebrities and the heirs, families, and estates of deceased celebrities for the purposes of licensing to third parties permission to commercially utilize the names, likenesses, voices, rights of publicity and endorsement and other visual and aural depictions of such celebrities, together with the trademarks and related rights associated with same. CMG advertises and promotes the availability of its client's properties both in the United States and foreign commerce. Likewise, CMG is charged with the responsibility of enforcing said rights and protecting same against unauthorized uses.

CMG recognizes the importance of clients gaining possession of domain names utilizing the names of respective celebrities; however, CMG's pursuit of such domain names has resembled a situation mimicking the "race to notice" scenarios prevalent in property law, where CMG's opponents often are not identified by a name identical to that of the celebrities; where such opponents do not have any legitimate commercial interest in registering a domain name other than to profit from their own fortuitous quickness in double-clicking the "OK" button on a domain name registrar's online website; where such opponents often warehouse dozens—if not hundreds—of domain names using the celebrities' names; where such opponents utilize the goodwill, reputation, and notoriety gained by a celebrity by registering a domain name identical to the celebrity's name, then leading Internet users to a website(s) which has little, if anything, to do with the celebrity

at all, including a website displaying pornography, deceptive information, or otherwise tasteless images or language.

Because Congress amended the Lanham Act by inserting the ACPA, CMG remains encouraged that the various protections offered by this federal law will extend to protection of celebrities' names utilized in a domain name. CMG respectfully offers a brief narrative addressing some of the issues and scenarios it has encountered in its pursuit of domain names, coupled with an analysis of the ACPA and the Lanham Act as it applies to this diverse array of circumstances.

I. Protecting personal names from registration by another person as a second level domain name for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain.

In the heyday of registering domain names, most were registered by speculators with the expectation that a party with a real interest in the name would pay a lot of money to get the domain name back. Others have registered domain names, particularly of celebrities, for the purpose of soliciting "donations" or "contributions" to a charity or organization, or for the purpose of obtaining publicity for their charity or organization. Where the domain name is identical to, or confusingly similar to a celebrity name or famous Trademark, such request is tantamount to extortion, and most current State or other law provides adequate remedies for such events. The ACPA should provide for immediate transfer of the domain name to the complaining party upon a finding by a court of competent jurisdiction that such action has taken place, by the expediency of submitting a Court Order to the appropriate Registrar.

The issues that need to be addressed in this section are the Registrant's identity and jurisdiction in which the action can be brought. Through CMG's experience with domain name transfers, it has frequently encountered situations in which a registrant provides address and contact information in one location, but actually conducts its business activities in another location; such registrants sometimes further compound the registration by directing correspondence concerning the domain name registration, such as billing and administration, to a third party—usually an Internet service provider. These multiple locations create service of process issues; they also implicate jurisdictional issues.

CMG appreciates and recognizes the additional ACPA provisions allowing for filing of *in rem* proceedings. However, in terms of resolving potential service of process discrepancies, as well as simplifying the logistical elements involved in registrations encompassing multiple business interests, CMG believes the registrant must adhere to registration policies as they apply to the registrant information given to register the domain name. Similar to procedures pertaining to a state bureau of motor vehicles, determinations involving jurisdiction, service of process, and domain name registration validity, should depend upon the information provided on the registration documents, whether filed in written form, or electronically (via online Internet connection). Put simply, the defendant in a domain name dispute brought under ACPA should be the domain name registrant, as shown on the domain name registry and/or the registry's database.

Furthermore, upon a showing that the registration information is false or misleading, a presumption should exist that false information was provided for the

purpose of hiding the true identity or location of the Registrant, and that such registration was made with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name. This, coupled with a solicitation to sell the name for any consideration, should establish a rebuttable presumption that such registration was for the purpose of obtaining financial gain.

II. 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.

As was stated above, identification of a "bad faith" domain name Registrant is frequently a problem. Because legitimate Registrants of domain names have no reason to falsify identifying or location information, a showing that the registration information is false or misleading should create a presumption that such false information was provided for the purpose of hiding the true identity or location of the Registrant, and that such registration was made with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name.

The ACPA addresses *domain name* disputes. CMG explains that a domain name, as an address by which an Internet user accesses further information, is not the same concept or object as an Internet website, the method of displaying data, information, or related website links on the World Wide Web; the two concepts are entirely separate, and should be treated as such.

Domain names serve many functions, including mnemonic devices for the IP address of the host computer, identifying in whole or in part the website to which it

points, or identifying in whole or in part the Registrant. They can also serve to memorialize a Registrant's expressive feelings, views, or opinions. The ACPA should provide that, where a Complainant alleges that a domain name as registered indicates false, slanderous, misleading, scandalous, or otherwise damaging allegations concerning a person, the Registrant should be required to declare whether such domain name is the name of a legitimate business, or is the Registrant's own expressive speech. State and other law provide appropriate remedies for either selection, and the ACPA should expedite this by allowing the Registrant to state its intentions in registering that particular domain name. If the Registrant cannot be located, or if the location information provided by the Registrant turns out to be false or misleading, a presumption should exist that such allegation by Complainant is prima facie true.

III. 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 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

The ACPA provides protection against a person who, without consent or in connection with the lawful exploitation of a work of authorship, registers a domain name that consists of, or is substantially or confusingly similar to, the name of another living person with the specific intent to profit by selling that domain name. Many celebrities garner significant goodwill, reputation, and commercial success after they've died; CMG

represents the intellectual property interests of more than 200 entertainment and sports personalities, many of whom are deceased. But because the ACPA's language suggests that the disputed domain name be that of a living person, CMG expresses concern that the ACPA does not explicitly define or clarify whether deceased persons, still possessing significant rights in their names, including trademark and right of publicity, can bring a domain name infringement action against a defendant domain name registrant.

The ACPA does not directly address the issue of "famous names." However, trademark registration of a surname generally requires a showing of secondary meaning, which contributes to a showing that the surname, as a mark, is distinctive. CMG also asserts that many, if not all, celebrities can show that their names have acquired secondary meaning. Section 2 of the Lanham Act provides for registration of a mark which has become distinctive of the applicant's goods in commerce.¹ Section 2(f) provides that:

[t]he Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which *the claim of distinctiveness* is made.²

Subsection (c)(1) addresses dilution of a famous or distinctive mark, and provides a list of factors which a court may consider in determining whether such mark is distinctive, including:

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;

¹15 U.S.C. §1052.

²Id. (emphasis added).

- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.³

Notwithstanding the required showing of distinctiveness when applying for trademark registration of a surname, CMG notes that the ACPA—specifically subsection (d)(1)(B)(xi)—explicitly provides that when a court is considering whether a domain name registrant has registered a domain name with bad faith intent, it may consider “the extent to which the mark incorporated in the person's domain name registration is distinctive and famous within the meaning of subsection (c)(1) of section 43 of the Trademark Act of 1946 (15 U.S.C. 1125).” These provisions addressing distinctiveness and secondary meaning should apply to the ACPA as it governs domain name registration disputes involving celebrity names, and that satisfying one or more of these provisions should establish secondary meaning in a dispute concerning a bad faith domain name registration of a famous name.

In the same vein, satisfying the requirements of Section 2(f) in many, if not most, cases can establish that a celebrity name has become distinctive in a dispute concerning a bad faith domain name registration of a famous name.

Trademark or trade dress infringement actions frequently focus on the actual, or potential, likelihood of consumer confusion created by a defendant's use of mark which is identical or substantially similar to the mark used by the plaintiff. Trademark registration weighs strongly in favor of the Claimant in a dispute brought under the

ACPA. The ACPA allows protection for unregistered marks, as well. The registration of a domain name which is identical to a celebrity name by a Registrant who has no actual interest or rights in that celebrity name should create a presumption of actual or potential consumer confusion, which would support actions for unfair competition and dilution of famous marks, whether registered or unregistered on the Patent & Trademark Office's Principal Register. Such a showing should create a presumption that defendant's domain name registration was done in bad faith; was done without authorization, without any legitimate commercial intent other than to profit upon the goodwill, reputation, and notoriety of the celebrity plaintiff.

When determining whether a likelihood of confusion exists, courts often consider "the degree of care with which the public will choose the products in the marketplace."⁴ Such analysis helps the trier of fact determine whether a consumer's choice of buying one product over another was based predominantly, and/or initially, on the source of the product: the manufacturer, distributor, or licensed seller of the product. But whereas in an atmosphere in which a consumer can consider several factors, which may include shape, color, quality, taste, smell, weight, or price (among many factors), the Internet does not allow such choices: the Internet user, in order to access particular information, must type in the domain name, or at least double-click on such domain name when offered in a list. The user's first choice, i.e., its first factor, is the domain name. And the domain name is always the user's first choice. Further, CMG suggests that, once the user hits the "Enter" key or double-clicks, the user really doesn't have choices related to the other factors: the website, the "product" upon which the domain name is affixed, appears

³ 15 U.S.C. §1125(c)(1).

⁴ *Beer Nuts, Inc. v. Clover Club Foods Co.*, 711 F.2d 934 (10th Cir. 1983)

before the user's eyes (and ears, in many cases). And if the domain name registrant did not have authorization to use this domain name—this source-identifying mark—CMG suggests that confusion exists as soon as the user opens the website, via the user's choice of domain name. So while Congress, and the courts, should consider content of a website when considering whether a defendant had the requisite bad faith intent, such content should be used solely for determinations of intent. The actual or potential confusion does not begin with the website's content, but with the unauthorized use of a plaintiff celebrity's name as a domain name.

IV. Protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential 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.

CMG has no experience in this matter, and does not address this issue.

V. Existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the concerns described above.

Remedies are meaningless unless they can be enforced, and one big problem with enforcing remedies in a domain name case is identifying against whom such remedies should be sought, and the jurisdiction in which such remedies should be ordered. For celebrities who are harmed by the unauthorized use of their name in a domain name, the various Right of Publicity statutes, Unfair Competition, and Lanham Act provisions

provide sufficient remedies in terms of injunctive relief, monetary damages, or other relief. However, where the domain name registrant gives an address (that may be fictitious) in one state, hosts that domain name on computers in another state or even another country, licenses the web page to another party in another state, and receives income from that website in still another state, the jurisdictional questions become a nightmare. Identifying the parties is often impossible.

The ACPA should provide for preferred venue, starting with the jurisdiction of the Registrant, and proceeding progressively to the jurisdiction of the Registrar, and the jurisdiction of the Complainant if the Registrant cannot be located.

Infringing registrants can often evade preventive measures by simply transferring the hosting of the webpage to another host. The ACPA should provide "blanket" injunctive relief against the hosting of a webpage pointed to by a domain name registered without authority.

VI. The guidelines, procedures, and policies of the Internet Corporation for the Assignment of Names and Numbers and the extent to which they address the considerations described elsewhere.

The Internet Corporation for Assigned Names and Numbers ("ICANN"), the worldwide administrative body overseeing domain name registrars, registries, and registration policies, has adopted a Uniform Domain Name Dispute Resolution Policy ("UDRP"), which provides another avenue, arbitration, to resolve domain name disputes. Requiring a showing of bad faith intent, similar to the ACPA, ICANN's UDRP provides for injunctive relief in the form of either ordering a domain name transfer from the

infringing respondent to the injured complainant, or canceling the domain name registration. The UDRP's result does not eliminate a party's right to bring a domain name registration infringement action under the ACPA or other federal and state law. The ACPA should allow that a court could find a UDRP arbitrator's findings persuasive in its own determinations of whether a defendant's domain name registration violated provisions in the ACPA. The ACPA should permit a court to not only consider the findings of an ICANN UDRP arbitration provider, but also consider such findings as prima facie evidence of bad faith intent by defendant in registering a domain name which is identical to a celebrity's name. Further, such ICANN UDRP arbitration findings should create a rebuttable presumption that the defendant domain name registrant has registered the domain name in bad faith, in order to profit from use of a domain name which is identical to plaintiff celebrity's name; and a rebuttable presumption that a plaintiff celebrity is entitled to a transfer of the domain name to him/her.

TO: Sabrina McLaughlin
Office of General Counsel
FROM: Erik Carter
DATE: April 21, 2000
RE: Comments on Anti Cybersquatting Consumer Protection Act

Dear Ms. McLaughlin:

Accompanying please find a report detailing the comments of CMG Worldwide, Inc., on the recently enacted Anti Cybersquatting Consumer Protection Act.

Thank you for allowing us the opportunity to voice our opinions. If you have any questions or comments concerning this submission, please do not hesitate to contact me at (317) 570-5035.

Cordially,

Erik Carter
Corporate Counsel

Celebrities and the attorneys representing their various intellectual property interests, such as copyright, trademark, and right of publicity, appreciated the recent enactment of the Anticybersquatting Consumer Protection Act, (hereinafter "ACPA"), an amendment to Section 43 of the Lanham Act. With explosive impact the Internet has offered a wealth of possibilities in both e-commerce, and information services. Domain names provide the initial address typed in by Internet users as they search for collectible items, memorabilia, and information related to their favorite sports and entertainment personalities, whether living or deceased.

CMG Worldwide, Inc. (CMG) is in the business of representing living and deceased celebrities and the heirs, families, and estates of deceased celebrities for the purposes of licensing to third parties permission to commercially utilize the names, likenesses, voices, rights of publicity and endorsement and other visual and aural depictions of such celebrities, together with the trademarks and related rights associated with same. CMG advertises and promotes the availability of its client's properties both in the United States and foreign commerce. Likewise, CMG is charged with the responsibility of enforcing said rights and protecting same against unauthorized uses.

CMG recognizes the importance of clients gaining possession of domain names utilizing the names of respective celebrities; however, CMG's pursuit of such domain names has resembled a situation mimicking the "race to notice" scenarios prevalent in property law, where CMG's opponents often are not identified by a name identical to that of the celebrities; where such opponents do not have any legitimate commercial interest in registering a domain name other than to profit from their own fortuitous quickness in double-clicking the "OK" button on a domain name registrar's online website; where such opponents often warehouse dozens—if not hundreds—of domain names using the celebrities' names; where such opponents utilize the goodwill, reputation, and notoriety gained by a celebrity by registering a domain name identical to the celebrity's name, then leading Internet users to a website(s) which has little, if anything, to do with the celebrity

at all, including a website displaying pornography, deceptive information, or otherwise tasteless images or language.

Because Congress amended the Lanham Act by inserting the ACPA, CMG remains encouraged that the various protections offered by this federal law will extend to protection of celebrities' names utilized in a domain name. CMG respectfully offers a brief narrative addressing some of the issues and scenarios it has encountered in its pursuit of domain names, coupled with an analysis of the ACPA and the Lanham Act as it applies to this diverse array of circumstances.

I. Protecting personal names from registration by another person as a second level domain name for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain.

In the heyday of registering domain names, most were registered by speculators with the expectation that a party with a real interest in the name would pay a lot of money to get the domain name back. Others have registered domain names, particularly of celebrities, for the purpose of soliciting "donations" or "contributions" to a charity or organization, or for the purpose of obtaining publicity for their charity or organization. Where the domain name is identical to, or confusingly similar to a celebrity name or famous Trademark, such request is tantamount to extortion, and most current State or other law provides adequate remedies for such events. The ACPA should provide for immediate transfer of the domain name to the complaining party upon a finding by a court of competent jurisdiction that such action has taken place, by the expediency of submitting a Court Order to the appropriate Registrar.

The issues that need to be addressed in this section are the Registrant's identity and jurisdiction in which the action can be brought. Through CMG's experience with domain name transfers, it has frequently encountered situations in which a registrant provides address and contact information in one location, but actually conducts its business activities in another location; such registrants sometimes further compound the registration by directing correspondence concerning the domain name registration, such as billing and administration, to a third party—usually an Internet service provider. These multiple locations create service of process issues; they also implicate jurisdictional issues.

CMG appreciates and recognizes the additional ACPA provisions allowing for filing of *in rem* proceedings. However, in terms of resolving potential service of process discrepancies, as well as simplifying the logistical elements involved in registrations encompassing multiple business interests, CMG believes the registrant must adhere to registration policies as they apply to the registrant information given to register the domain name. Similar to procedures pertaining to a state bureau of motor vehicles, determinations involving jurisdiction, service of process, and domain name registration validity, should depend upon the information provided on the registration documents, whether filed in written form, or electronically (via online Internet connection). Put simply, the defendant in a domain name dispute brought under ACPA should be the domain name registrant, as shown on the domain name registry and/or the registry's database.

Furthermore, upon a showing that the registration information is false or misleading, a presumption should exist that false information was provided for the

purpose of hiding the true identity or location of the Registrant, and that such registration was made with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name. This, coupled with a solicitation to sell the name for any consideration, should establish a rebuttable presumption that such registration was for the purpose of obtaining financial gain.

II. 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.

As was stated above, identification of a "bad faith" domain name Registrant is frequently a problem. Because legitimate Registrants of domain names have no reason to falsify identifying or location information, a showing that the registration information is false or misleading should create a presumption that such false information was provided for the purpose of hiding the true identity or location of the Registrant, and that such registration was made with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name.

The ACPA addresses *domain name* disputes. CMG explains that a domain name, as an address by which an Internet user accesses further information, is not the same concept or object as an Internet website, the method of displaying data, information, or related website links on the World Wide Web: the two concepts are entirely separate, and should be treated as such.

Domain names serve many functions, including mnemonic devices for the IP address of the host computer, identifying in whole or in part the website to which it

points, or identifying in whole or in part the Registrant. They can also serve to memorialize a Registrant's expressive feelings, views, or opinions. The ACPA should provide that, where a Complainant alleges that a domain name as registered indicates false, slanderous, misleading, scandalous, or otherwise damaging allegations concerning a person, the Registrant should be required to declare whether such domain name is the name of a legitimate business, or is the Registrant's own expressive speech. State and other law provide appropriate remedies for either selection, and the ACPA should expedite this by allowing the Registrant to state its intentions in registering that particular domain name. If the Registrant cannot be located, or if the location information provided by the Registrant turns out to be false or misleading, a presumption should exist that such allegation by Complainant is prima facie true.

III. 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 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

The ACPA provides protection against a person who, without consent or in connection with the lawful exploitation of a work of authorship, registers a domain name that consists of, or is substantially or confusingly similar to, the name of another living person with the specific intent to profit by selling that domain name. Many celebrities garner significant goodwill, reputation, and commercial success after they've died; CMG

represents the intellectual property interests of more than 200 entertainment and sports personalities, many of whom are deceased. But because the ACPA's language suggests that the disputed domain name be that of a living person, CMG expresses concern that the ACPA does not explicitly define or clarify whether deceased persons, still possessing significant rights in their names, including trademark and right of publicity, can bring a domain name infringement action against a defendant domain name registrant.

The ACPA does not directly address the issue of "famous names." However, trademark registration of a surname generally requires a showing of secondary meaning, which contributes to a showing that the surname, as a mark, is distinctive. CMG also asserts that many, if not all, celebrities can show that their names have acquired secondary meaning. Section 2 of the Lanham Act provides for registration of a mark which has become distinctive of the applicant's goods in commerce.¹ Section 2(f) provides that:

[t]he Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which *the claim of distinctiveness* is made.²

Subsection (c)(1) addresses dilution of a famous or distinctive mark, and provides a list of factors which a court may consider in determining whether such mark is distinctive, including:

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;

¹15 U.S.C. §1052.

²Id. (emphasis added).

- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.³

Notwithstanding the required showing of distinctiveness when applying for trademark registration of a surname, CMG notes that the ACPA—specifically subsection (d)(1)(B)(xi)—explicitly provides that when a court is considering whether a domain name registrant has registered a domain name with bad faith intent, it may consider “the extent to which the mark incorporated in the person's domain name registration is distinctive and famous within the meaning of subsection (c)(1) of section 43 of the Trademark Act of 1946 (15 U.S.C. 1125).” These provisions addressing distinctiveness and secondary meaning should apply to the ACPA as it governs domain name registration disputes involving celebrity names, and that satisfying one or more of these provisions should establish secondary meaning in a dispute concerning a bad faith domain name registration of a famous name.

In the same vein, satisfying the requirements of Section 2(f) in many, if not most, cases can establish that a celebrity name has become distinctive in a dispute concerning a bad faith domain name registration of a famous name.

Trademark or trade dress infringement actions frequently focus on the actual, or potential, likelihood of consumer confusion created by a defendant's use of mark which is identical or substantially similar to the mark used by the plaintiff. Trademark registration weighs strongly in favor of the Claimant in a dispute brought under the

ACPA. The ACPA allows protection for unregistered marks, as well. The registration of a domain name which is identical to a celebrity name by a Registrant who has no actual interest or rights in that celebrity name should create a presumption of actual or potential consumer confusion, which would support actions for unfair competition and dilution of famous marks, whether registered or unregistered on the Patent & Trademark Office's Principal Register. Such a showing should create a presumption that defendant's domain name registration was done in bad faith; was done without authorization, without any legitimate commercial intent other than to profit upon the goodwill, reputation, and notoriety of the celebrity plaintiff.

When determining whether a likelihood of confusion exists, courts often consider "the degree of care with which the public will choose the products in the marketplace."⁴ Such analysis helps the trier of fact determine whether a consumer's choice of buying one product over another was based predominantly, and/or initially, on the source of the product: the manufacturer, distributor, or licensed seller of the product. But whereas in an atmosphere in which a consumer can consider several factors, which may include shape, color, quality, taste, smell, weight, or price (among many factors), the Internet does not allow such choices: the Internet user, in order to access particular information, must type in the domain name, or at least double-click on such domain name when offered in a list. The user's first choice, i.e., its first factor, is the domain name. And the domain name is always the user's first choice. Further, CMG suggests that, once the user hits the "Enter" key or double-clicks, the user really doesn't have choices related to the other factors: the website, the "product" upon which the domain name is affixed, appears

³ 15 U.S.C. §1125(c)(1).

⁴Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934 (10th Cir. 1983)

before the user's eyes (and ears, in many cases). And if the domain name registrant did not have authorization to use this domain name—this source-identifying mark—CMG suggests that confusion exists as soon as the user opens the website, via the user's choice of domain name. So while Congress, and the courts, should consider content of a website when considering whether a defendant had the requisite bad faith intent, such content should be used solely for determinations of intent. The actual or potential confusion does not begin with the website's content, but with the unauthorized use of a plaintiff celebrity's name as a domain name.

IV. Protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential 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.

CMG has no experience in this matter, and does not address this issue.

V. Existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the concerns described above.

Remedies are meaningless unless they can be enforced, and one big problem with enforcing remedies in a domain name case is identifying against whom such remedies should be sought, and the jurisdiction in which such remedies should be ordered. For celebrities who are harmed by the unauthorized use of their name in a domain name, the various Right of Publicity statutes, Unfair Competition, and Lanham Act provisions

provide sufficient remedies in terms of injunctive relief, monetary damages, or other relief. However, where the domain name registrant gives an address (that may be fictitious) in one state, hosts that domain name on computers in another state or even another country, licenses the web page to another party in another state, and receives income from that website in still another state, the jurisdictional questions become a nightmare. Identifying the parties is often impossible.

The ACPA should provide for preferred venue, starting with the jurisdiction of the Registrant, and proceeding progressively to the jurisdiction of the Registrar, and the jurisdiction of the Complainant if the Registrant cannot be located.

Infringing registrants can often evade preventive measures by simply transferring the hosting of the webpage to another host. The ACPA should provide "blanket" injunctive relief against the hosting of a webpage pointed to by a domain name registered without authority.

VI. The guidelines, procedures, and policies of the Internet Corporation for the Assignment of Names and Numbers and the extent to which they address the considerations described elsewhere.

The Internet Corporation for Assigned Names and Numbers ("ICANN"), the worldwide administrative body overseeing domain name registrars, registries, and registration policies, has adopted a Uniform Domain Name Dispute Resolution Policy ("UDRP"), which provides another avenue, arbitration, to resolve domain name disputes. Requiring a showing of bad faith intent, similar to the ACPA, ICANN's UDRP provides for injunctive relief in the form of either ordering a domain name transfer from the

infringing respondent to the injured complainant, or canceling the domain name registration. The UDRP's result does not eliminate a party's right to bring a domain name registration infringement action under the ACPA or other federal and state law. The ACPA should allow that a court could find a UDRP arbitrator's findings persuasive in its own determinations of whether a defendant's domain name registration violated provisions in the ACPA. The ACPA should permit a court to not only consider the findings of an ICANN UDRP arbitration provider, but also consider such findings as prima facie evidence of bad faith intent by defendant in registering a domain name which is identical to a celebrity's name. Further, such ICANN UDRP arbitration findings should create a rebuttable presumption that the defendant domain name registrant has registered the domain name in bad faith, in order to profit from use of a domain name which is identical to plaintiff celebrity's name; and a rebuttable presumption that a plaintiff celebrity is entitled to a transfer of the domain name to him/her.