

THE ANTICYBERSQUATTING CONSUMER PROTECTION ACT AND THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

THE FIRST DECADE: LOOKING BACK AND ADAPTING FORWARD

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“The only constant is change, continuing change, inevitable change, which is the dominant factor in society today. No sensible decision can be made any longer without taking into account not only the world as it is, but the world as it will be.”

—Isaac Asimov¹

I. INTRODUCTION

The telephone book has gone the way of the Betamax² and the Walkman.³ Technology forces an almost continuous evolution of products and services—the latest and greatest quickly becomes a relic. Today, instead of the telephone book, there is yellowpages.com; instead of the Betamax, we have Blu-ray;⁴ instead of the Walkman, we have the iPod.⁵ Technology, and more specifically, the Internet, has forever changed the way consumers live their lives. Indeed, consumers increasingly use technology to make their lives easier—using the convenience of the Internet to purchase items previously bought at brick-and-mortar stores. Undeniably, the Internet plays a huge role in our eve-

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¹ Peter Micheuz, *Harmonization of Informatics Education—Science Fiction or Prospective Reality*, in *INFORMATICS EDUCATION—SUPPORTING COMPUTATIONAL THINKING* 317, 317 (Roland T. Mittermeir & Maciej M. Syslo eds., 2008).

² See *Betamax*, TOTAL REWIND, <http://www.totalrewind.org/betamax.htm> (last visited Apr. 2, 2011).

³ See *Sony Walkman Personal Stereo Turns 20 Years Old*, MAC.COM (Apr. 5, 1999), <http://homepage.mac.com/oldtownman/recording/walkman2.html>.

⁴ See *History of Blu-ray Disc*, BLU-RAY DISC, <http://www.blu-raydisc.com/en/about/Whatis-Blu-rayDisc/HistoryofBlu-rayDisc.html> (last visited Apr. 2, 2011).

⁵ Steven Levy, *iPod Nation: In Just Three Years, Apple’s Adorable Mini Music Player Has Gone from Gizmo to Life-Changing Cultural Icon*, NEWSWEEK, July 26, 2004, at 42, available at <http://www.newsweek.com/2004/07/25/ipod-nation.htm>.

ryday lives: today, there are more than 1.5 billion web users⁶ and more than 192 million domain names registered.⁷

Most businesses rely on the Internet, too, to sell their products or services or as a method of advertising and providing information to consumers.⁸ Businesses tend to use their corporate, product, or service trademarks in domain names to create a strong presence on the Internet and to help consumers find them more easily.⁹ They have been successful: in 2009, online retail sales accounted for approximately \$155 billion and are projected to grow to \$250 billion dollars by 2014.¹⁰ Perhaps even more staggering: it is estimated that Internet research influenced \$917 billion of overall retail sales.¹¹ Globally, this revenue stream is so important that in 2010, businesses paid an estimated \$29.8 billion for paid search advertising.¹²

This influx of consumer and business use of the Internet has led to some interesting legal issues, including copyright infringement, phishing, spam, cybersquatting, and much more. As the Internet and related technology constantly evolve and rapidly change, the law governing this area is slow to adapt.¹³ In 1999, Congress took steps to protect online consumers from deceptive practices of cybersquatters by enacting the Anticybersquatting Consumer Protection Act (ACPA). Also in 1999, the Internet Corporation for Assigned Names and Numbers (ICANN) promulgated a regulatory structure for alternative dispute resolution for cybersquatting, known as the Uniform Domain Name Dispute Resolution Policy (UDRP).

Ten years after the enactment of the ACPA and UDRP, these important statutory and regulatory frameworks no longer adequately protect consumers and trademark owners dealing with new issues such as social-squatting, private domain name registration services, registrar liability, international registrars, and reverse domain name hijacking and are ill-equipped to address future issues.

Part II of this Note provides an overview and background information about domain names and cybersquatting. Part III discusses pre-ACPA and pre-UDRP cases and the reasons for enacting these new legal frameworks. Part IV

⁶ INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, 2009 ANNUAL REPORT ADDRESSING THE GLOBAL INTERNET 16 (2009), available at <http://www.icann.org/en/annualreport/annual-report-2009-en.pdf>.

⁷ *Internet Tops 192 Million Domain Name Registrations*, VERISIGN (Feb. 22, 2010), https://press.verisign.com/easyir/customrel.do?easyirid=AFC0FF0DB5C560D3&version=live&prid=589249&releasejsp=custom_97.

⁸ Dara B. Gilwit, Note, *The Latest Cybersquatting Trend: Typosquatters, Their Changing Tactics, and How to Prevent Public Deception and Trademark Infringement*, 11 WASH. U. J.L. & POL'Y 267, 267 (2003).

⁹ *Id.* at 273.

¹⁰ Erick Schonfeld, *Forrester Forecast: Online Retail Sales Will Grow to \$250 Billion by 2014*, TECHCRUNCH (Mar. 8, 2010), <http://techcrunch.com/2010/03/08/forrester-forecast-online-retail-sales-will-grow-to-250-billion-by-2014/>.

¹¹ *Id.*

¹² Oliver T. Hellriegel, *Global Online Advertising Lead by Paid Search*, DIGI:MARKETING (June 17, 2010), <http://www.hellriegel.net/2010/06/17/global-online-advertising-lead-by-paid-search/>. Paid search accounts for nearly half of global online advertising. *Id.*

¹³ IAN C. BALLON, E-COMMERCE & INTERNET LAW § 1.07 (2d ed. 2011); Jacqueline D. Lipton, *Clickfarming: The New Cybersquatting?*, J. INTERNET L., July 2008, at 1, 21 (2008).

discusses the enactment of ACPA and UDRP, the first cases decided under the new legal frameworks, and compares the ACPA and UDRP. Part V discusses new Internet-related issues and shows how the ACPA and UDRP are not equipped to handle these needs. Finally, Part VI offers suggestions for the future of cyberlaw.

II. LOOKING BACK: THE BASICS OF DOMAIN NAMES AND CYBERSQUATTING

A. Domain Name Basics

The Internet Corporation for Assigned Names and Numbers (ICANN)¹⁴ is a non-profit organization responsible for coordinating domain names and their associated identifiers.¹⁵ It also coordinates related technological policy development, among other things.¹⁶ Domain names are unique, similar to street addresses or telephone numbers,¹⁷ and are available on a “first-come, first-served basis.”¹⁸ Domain names primarily identify the owner of the website,¹⁹ and they primarily consist of two parts: the second-level domain and the top-level domain.²⁰ The second-level domain is a term or series of terms²¹—for example, “google,”—and the generic top-level domain (also known as gTLD²² or TLD) is the enterprise identifier—for example, “.com” for commercial or “.gov” for government.²³

Each TLD has a registry associated with it that is responsible for maintaining the TLD’s database.²⁴ In turn, each registry has numerous registrars that register domain names.²⁵ A person seeking to register a domain name (known as the registrant) visits the website of the domain name registrar, completes the domain-name registration information, pays a registration fee, and is the proud new owner of a domain name.²⁶ The information provided by the registrant to

¹⁴ For a detailed discussion of the history of ICANN, see *History*, CASLON ANALYTICS, <http://www.caslon.com.au/icannprofile1.htm> (last visited Apr. 2, 2011).

¹⁵ *What Does ICANN Do?*, ICANN, <http://www.icann.org/en/participate/what-icann-do.html> (last visited Apr. 2, 2011).

¹⁶ 1-1 McGRADY ON DOMAIN NAMES § 1.14 (2010).

¹⁷ *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1318 (9th Cir. 1998).

¹⁸ H.R. REP. NO. 106-412, at 5 (1999); Zohar Efroni, *The Anticybersquatting Consumer Protection Act and the Uniform Dispute Resolution Policy: New Opportunities for International Forum Shopping?*, 26 COLUM. J.L. & ARTS 335, 337 (2003).

¹⁹ *Panavision*, 141 F.3d at 1327.

²⁰ *Interactive Prods. Corp. v. A2Z Mobile Office Solutions, Inc.*, 326 F.3d 687, 691 (6th Cir. 2003).

²¹ *Id.*

²² Currently, there are twenty gTLDs: .com, .edu, .gov, .int, .mil, .net, .org, .biz, .info, .name, .pro, .aero, .coop, .museum, .asia, .cat, .jobs, .mobi, .tel, and .travel. See *Top-Level Domains (gTLDs)*, ICANN, <http://www.icann.org/en/tlds/> (last visited Apr. 2, 2011).

²³ *Interactive Prods. Corp.*, 326 F.3d at 691.

²⁴ BALLON, *supra* note 13, § 7.02[1]. For example, the .com registry is VeriSign, Inc. For a listing of all TLD registries, see *Registry Listing*, ICANN, <http://www.icann.org/en/registries/listing.html> (last visited Apr. 2, 2011).

²⁵ BALLON, *supra* note 13, § 7.02[1]. For example, GoDaddy.com is a registrar of domain names. See GoDADDY.COM, www.godaddy.com (last visited Apr. 2, 2011).

²⁶ *Balsam v. Tucows, Inc.*, No. CV 09-03585 CRB, 2009 WL 3463923, at *1 (N.D. Cal. Oct. 23, 2009).

the registrar is collected into a publically accessible database, known as the “WhoIs” record.²⁷

ICANN requires each registrar to maintain eight pieces of information in the WhoIs record, including the registrant’s name, postal address, e-mail addresses, telephone number, the creation date of registration, and the expiration date of registration, among other information.²⁸ The WhoIs record allows the public to determine the contact information for the registrant in order to communicate about legal, business, or technical issues.²⁹ Some domain name registrars, such as GoDaddy.com and eNom, also provide private registration services through affiliate companies, which shield the registrant’s information from public display.³⁰

B. Cybersquatter Basics

Cybersquatters are individuals or companies that register domain names containing the trademarks of others for the purpose of profiting from the goodwill associated with the trademark, or by selling the domain name to the trademark owner or its competitors.³¹ Aside from this standard definition of cybersquatting, the practice has evolved to include at least three other categories: the “cyberpirate,” the “typosquatter,” and the “pseudo-cybersquatter.”³² The cyberpirate, rather than intending to resell a domain name to the trademark owner or highest bidder, uses the notoriety and goodwill of the trademark to drive traffic to the website.³³ The cyberpirate earns revenue by either selling advertising space on the website or generates fees for diverting traffic to third-party websites.³⁴

The typosquatter registers common misspellings of trademarks to route the web user who misspells their intended domain name to another website.³⁵ For example, typosquatters looking to prey on web users seeking information on Hewlett-Packard, Harry Potter, Looney Tunes, and Scooby Doo have registered <hewlittpackard.com>,³⁶ <harypotter.com>, <looneytoon.es.com>, and <scobydoo.com>.³⁷ Typosquatters will typically link these domain names to websites containing Google ads or other third-party sponsored ads, which web

²⁷ *Dell Inc. v. BelgiumDomains, L.L.C.*, No. 07-22674-CIV, 2007 WL 6862342, at *3 (S.D. Fla. Nov. 21, 2007).

²⁸ See *Registrar Accreditation Agreement*, ICANN (May 21, 2009), <http://www.icann.org/en/registrars/ra-agreement-21may09-en.htm>.

²⁹ *Transamerica Corp. v. Moniker Online Servs., L.L.C.*, 672 F. Supp. 2d 1353, 1357 (S.D. Fla. 2009).

³⁰ See *infra* Part V.B.

³¹ *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996).

³² Efroni, *supra* note 18, at 337.

³³ *Id.*

³⁴ BALLON, *supra* note 13, § 7.29[1].

³⁵ Efroni, *supra* note 18, at 337.

³⁶ *Hewlett-Packard Co. v. Cupcake City*, No. FA0002000093562 (Nat’l Arb. Forum Mar. 31, 2000), <http://domains.adrforum.com/domains/decisions/93562.htm>.

³⁷ *Time Warner Entm’t Co. v. Zuccarini*, No. D2001-0184 (World Intellectual Property Organization (WIPO) Arb. & Med. Ctr. Apr. 11, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0184.html>.

users will inadvertently click on and generate revenue for the typosquatter.³⁸ Finally, the pseudo-cybersquatter merely registers the domain name without a website and does not offer the domain name for sale.³⁹

III. TECHNOLOGY AND TRADEMARK LAW CONVERGE: PRE-ACPA TOOLS TO COMBAT CYBERSQUATTERS

Prior to the enactment of the ACPA, courts and litigants relied on the Trademark Act of 1946 (the Lanham Act) and the Federal Trademark Dilution Act (FTDA) to deal with cybersquatters.⁴⁰ Although both the Lanham Act and FTDA were useful tools in fighting cybersquatters, neither statute adequately addressed domain names.

A. Trademark Infringement under The Lanham Act

The Lanham Act provides a remedy for trademark infringement when a person uses, without permission, a registered trademark to advertise or sell goods and services in a way that is likely to cause consumer confusion.⁴¹ To succeed on a trademark infringement claim under the Lanham Act, the trademark owner must prove that there is a likelihood of confusion between the trademark and the allegedly infringing trademark. To determine whether a likelihood of confusion exists, courts examine (1) the strength or distinctiveness of the mark, (2) the similarity of the marks, (3) the similarity of the goods

³⁸ Gilwit, *supra* note 8, at 268-69; David Hechler, *Profiting from Your Mistakes: The Current Form of Cybersquatting Exploits the Human Tendency for Error*, CORP. COUNS., Aug. 1, 2008, at 20, 20, available at <http://www.law.com/jsp/cc/PubArticleCC.jsp?id=1202423278409>.

³⁹ Efroni, *supra* note 18, at 337.

⁴⁰ Gilwit, *supra* note 8, at 278; see also Lanham Act, 15 U.S.C. §§ 1051-1141 (2006); Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c).

⁴¹ 15 U.S.C. § 1114(1) provides:

[a]ny person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .

Under 15 U.S.C § 1125, claims of trademark infringement apply to:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities

and services the marks identify, (4) the similarity of the facilities the parties use in their businesses, (5) the similarity of advertising used by the parties, (6) the defendant's intent, and (7) whether there is actual confusion.⁴²

*Cardservice International v. McGee*⁴³ is an early example of the application of trademark infringement principles to domain name registration. There, plaintiff Cardservice International, a provider of credit-processing services, owned federal trademark registrations for "Cardservice International."⁴⁴ McGee also provided credit-processing services through his sole proprietorship.⁴⁵ McGee registered the <cardservice.com> domain name, which he used to advertise merchant credit-card-processing services.⁴⁶ Cardservice filed suit against McGee, alleging trademark infringement, unfair competition, common law unfair competition, misappropriation, and unjust enrichment.⁴⁷ McGee made the preliminary argument that he was entitled to keep the domain name because domains are issued on a first come, first served basis.⁴⁸ The court rejected his argument, stating that the registrar's policy is "subject to . . . liability . . . provided for by federal law."⁴⁹

The court analyzed the likelihood-of-confusion factors and found that McGee's <cardservice.com> domain name was likely to confuse the consuming public.⁵⁰ The court reasoned that confusion was likely because the domain name contains Cardservice's exact mark, both parties use the Internet to provide services, and Cardservice's customers are likely to assume that the <cardservice.com> domain name belongs to Cardservice, especially upon seeing similar services at McGee's website.⁵¹

Courts have also found a likelihood of confusion in domains names such as <victoriasecrets.net> (confusingly similar to VICTORIA'S SECRET),⁵² <playmatelive.com> (confusingly similar to PLAYMATE),⁵³ and <audisport.com> (confusingly similar to AUDI).⁵⁴

B. Trademark Dilution under the FTDA

Another tool in the trademark owner's pre-ACPA and pre-UDRP arsenal was a claim for dilution under the FTDA. Congress had domain names in mind when it enacted the FTDA.⁵⁵ Trademark dilution begins with the idea that

⁴² *Cardservice Int'l, Inc. v. McGee*, 950 F. Supp. 737, 740 (E.D. Va. 1997) (citations omitted).

⁴³ *Id.* at 737.

⁴⁴ *Id.* at 738.

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ *Id.* at 739.

⁴⁸ *Id.* at 740.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.* at 741.

⁵² *Victoria's Secret Stores v. Artco Equip. Co.*, 194 F. Supp. 2d 704, 738 (S.D. Ohio 2002).

⁵³ *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1218, 1219 (N.D. Cal. 1997).

⁵⁴ *Audi AG v. D'Amato*, 469 F.3d 534, 545 (6th Cir. 2006).

⁵⁵ *Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316, 1326 (9th Cir. 1998) (citations omitted).

trademarks, in addition to identifying the source of goods, also provide consumers with information about the quality of those goods.⁵⁶ For example, consumers purchasing products bearing the VICTORIA'S SECRET trademark understand the quality they will receive based upon their existing knowledge of the products and the extensive advertising by Victoria's Secret.

To succeed on a dilution claim under the FTDA, the trademark owner must prove: (1) the trademark at issue is famous, (2) the defendant is making commercial use of the trademark, (3) the defendant's use of the trademark began after the trademark became famous, and (4) the defendant's use dilutes the quality of the mark.⁵⁷ Dilution "lessen[s] the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."⁵⁸ Examples of trademarks that are famous for the purpose of trademark dilution under the FTDA include BUDWEISER,⁵⁹ TOYS "R" US,⁶⁰ and PORSCHE.⁶¹

Prior to the enactment of the Anticybersquatting Consumer Protection Act, the FTDA was a favored vehicle for relief in domain name cases because it does not require the showing of likelihood of confusion that is required under the Lanham Act.⁶² However, remedies under the Lanham Act and the FTDA were uncertain and often very expensive to prosecute.⁶³ Although Congress had domain names in mind when it enacted the FTDA,⁶⁴ cybersquatters became more sophisticated and tailored their behavior to find refuge in loopholes of the FTDA.⁶⁵

Dennis Toeppen is one notorious cybersquatter who attempted to exploit a potential loophole in the FTDA. Toeppen registered more than one hundred domain names, which contained trademarks such as Delta, Neiman Marcus, Eddie Bauer, and Panavision.⁶⁶ Toeppen then attempted to sell the domain names to the trademark owners at exorbitant prices.⁶⁷ One such case was *Panavision International, L.P. v. Toeppen*.⁶⁸ There, Toeppen registered <panavision.com> and linked the domain name to a website containing photos of the City of Pana, Illinois.⁶⁹ When Panavision notified Toeppen that he was

⁵⁶ Andrew Baum & Mark Epstein, *New Dilution Act Used to Evict 'Cybersquatters,'* NAT'L L.J., Jan. 27, 1997, at C3.

⁵⁷ *Panavision*, 141 F.3d at 1324.

⁵⁸ Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1127 (2000) (repealed 2006).

⁵⁹ *Anheuser-Busch, Inc. v. VIP Prods., L.L.C.*, 666 F. Supp. 2d 974, 987-88 (E.D. Mo. 2008) (allegedly infringing product was not dilutive of famous BUDWEISER trademark).

⁶⁰ *Toys "R" Us, Inc. v. Akkaoui*, No. C96-3381 CW, 1996 WL 772709, at *2-3 (N.D. Cal. Oct. 29, 1996) (ADULTS R US is dilutive of the famous "R Us" family of trademarks).

⁶¹ *Porsche Cars N. Am., Inc. v. Manny's Porshop, Inc.*, 972 F.2d 1128, 1129, 1132 (N.D. Ill. 1997) (MANNY'S PORSHOP likely to dilute famous PORSCHE trademark).

⁶² Gilwit, *supra* note 8, at 278.

⁶³ H.R. REP. NO. 106-412, at 6 (1999); S. REP. NO. 106-140, at 7 (1999).

⁶⁴ *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1326 (9th Cir. 1998) (citations omitted).

⁶⁵ S. REP. NO. 106-140, at 7.

⁶⁶ *Panavision*, 141 F.3d at 1319.

⁶⁷ *Id.*

⁶⁸ *Id.* at 1316.

⁶⁹ *Id.* at 1319.

violating Panavision's trademark rights, Toeppen offered to sell the domain name for \$13,000 with an agreement that he would refrain from registering other domain names containing Panavision's trademarks.⁷⁰ When Panavision declined Toeppen's offer, Toeppen registered another domain name containing one of Panavision's trademarks.⁷¹ Panavision filed suit against Toeppen alleging dilution under the FTDA and related state law claims.⁷² Toeppen argued that the mere registration of a domain name did not constitute "commercial use," as required under the FTDA.⁷³ The court found that Toeppen's registration of a domain name, combined with offering the domain name for sale to the trademark owner, constituted "commercial use" under the FTDA.⁷⁴ Some commentators argue that this holding stretched the idea of what constituted "commercial use" too far, rendering the FTDA as the catch-all statute for misuse of trademarks.⁷⁵

Panavision highlighted a major flaw with the FTDA. Absent "commercial use" of a domain name, a cybersquatter merely registers a domain name and sits on this "cyber realty," precluding the trademark owner from using domain names containing its trademarks.⁷⁶ Stated another way, a cybersquatter could avoid liability under the FTDA by registering a domain name containing a famous trademark and waiting for the trademark owner to come calling with a purchase price.⁷⁷ This square peg, round-hole application of the FTDA against cyberpirates eventually gave way to the enactment of the ACPA.

IV. EVOLUTION OF TECHNOLOGY AND CYBERSQUATTING

Congress recognized the flaws in the Federal Trademark Dilution Act highlighted in *Panavision*. Specifically, Congress noted that the FTDA no longer adequately addressed cybersquatting: "While the [FTDA] has been useful in pursuing cybersquatters, cybersquatters have become increasingly sophisticated as the case law has developed and now take the necessary precautions to insulate themselves from liability."⁷⁸ Congress also noted that cyberpiracy, which was becoming very common, could negatively affect businesses in a number of ways.⁷⁹ For example, a cybersquatter could register a domain name containing a trademark and link that domain name to a website offering illegal

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.* at 1324.

⁷⁴ *Id.* at 1325.

⁷⁵ Anne E. Kennedy, Note, *From Delusion to Dilution: Proposals to Improve Problematic Aspects of the Federal Trademark Dilution Act*, 9 N.Y.U. J. LEGIS. & PUB. POL'Y 399, 432-33 (2006).

⁷⁶ Christopher G. Clark, Note, *The Truth in Domain Names Act of 2003 and a Preventative Measure to Combat Typosquatting*, 89 CORNELL L. REV. 1476, 1496 (2004).

⁷⁷ See, e.g., *HQM, Ltd. v. Hatfield*, 71 F. Supp. 2d 500, 506 (D. Md. 1999); *Acad. of Motion Picture Arts & Scis. v. Network Solutions, Inc.*, 989 F. Supp. 1276, 1278-79 (C.D. Cal. 1997).

⁷⁸ S. REP. NO. 106-140, at 7 (1999).

⁷⁹ H.R. REP. NO. 106-412, at 6 (1999).

or offensive material, which would tend to tarnish the trademark.⁸⁰ Further, a cybersquatter causes “lost business opportunities”⁸¹ for the trademark owner from the registration of the domain name because the trademark holder is unable to use its trademarks that it has spent substantial resources advertising. Moreover, some cybersquatters registered domain names merely for the purpose of making a profit by selling the domain names to the trademark owners.⁸² The culmination of these new issues gave way to Congress’ enactment of the ACPA and ICANN’s implementation of the UDRP as an alternative dispute resolution to address cybersquatting.

A. *The ACPA*

On November 29, 1999, President Clinton signed the ACPA into law, which provides liability for cybersquatting when a person who, with a bad faith intent to profit, registers, traffics in, or uses a famous or distinctive trademark as a domain name.⁸³

Four elements must be met to prove cybersquatting under the ACPA: (1) the registrant has a bad faith intent to profit, (2) the registrant registers, traffics in, or uses a domain name, (3) the domain name is famous or distinctive, and (4) the domain name is identical or confusingly similar, or in the case of a famous mark, dilutive.⁸⁴

1. *Understanding the Elements*

Under the first element of the ACPA, the domain name registrant must have a bad faith intent to profit to be liable for cybersquatting. To help the courts determine what constitutes bad faith under the ACPA, Congress provided a non-exhaustive list of factors: (1) the registrant has no apparent trademark rights in the domain name, (2) the domain name does not contain any of the registrant’s legal names, (3) the registrant has not made any (a) bona fide non-commercial or (b) fair use of the domain name, (4) the registrant has used

⁸⁰ See S. REP. NO. 106-140, at 6 (discussing testimony from a parent whose child mistakenly typed “dosney.com” when trying to access the Disney website and was directed to a website containing pornographic images).

⁸¹ H.R. REP. NO. 106-412, at 6; see also *The Real Cost of Cybersquatting*, CADNA, <http://www.cadna.org/en/issues/cadna-analysis/real-cost-of-cybersquatting> (last visited Apr. 2, 2011).

⁸² See *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 778 (8th Cir. 2004).

⁸³ 15 U.S.C. § 1125(d)(1)(A) (2006) provides:

(d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person –

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that –

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of Title 18, United States Code, or section 220506 of Title 36, United States Code.

⁸⁴ *Id.* § 1125(d)(1)(A).

the domain name in a commercial manner, (5) the trademark was distinctive or famous at the time the registrant registered the domain name, (6) the registrant has registered other domain names containing the trademarks of others, and (7) the registrant has offered the domain name for sale.⁸⁵

Although the rights of trademark owners were a significant concern in enacting the ACPA, Congress intended there to be a balance between the property interests of trademark owners and the rights of web users to lawfully use trademarks for “comparative advertising, comment, criticism, parody, news reporting, [and] fair use,” among other things.⁸⁶ Therefore, Congress provided a safe harbor exception for domain name registrants that “believe[] and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.”⁸⁷ Courts have found that “otherwise lawful” uses of domain names include so-called “gripe sites”⁸⁸ and parody.⁸⁹ However, because most domain name registrants could conjure up lawful reasons for their use of domain names, the registrant’s reasonable belief requires more than just plausibility.⁹⁰ As one court noted, “All but the most blatant cybersquatters will be able to put forth at least some lawful motives for their behavior. To hold that all such individuals may qualify for the safe harbor would frustrate Congress’ purpose by artificially limiting the statute’s reach.”⁹¹

Under the second ACPA element, a registrant must register, traffic in, or use a domain name. Although undefined by the ACPA, the *registering* of a domain name appears self-explanatory on its face. Similarly, *use* is undefined within the ACPA. However, *traffics in* has challenged courts interpreting this provision of the ACPA.⁹² The ACPA provides an illustrative definition of what this entails: “[T]raffics in’ refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.”⁹³ One court has interpreted this language to mean “a direct transfer or receipt of ownership interest in a domain name.”⁹⁴

Under the third ACPA element, the trademark contained within the domain name must be famous or distinctive. A trademark is famous “if it is

⁸⁵ See *id.* § 1125(d)(1)(B); H.R. REP. NO. 106-412, at 10-14.

⁸⁶ H.R. REP. NO. 106-412, at 10.

⁸⁷ 15 U.S.C. § 1125(d)(1)(B)(ii).

⁸⁸ See, e.g., *Career Agents Network, Inc. v. Careeragentsnetwork.biz*, No. 09-CV-12269-DT, 2010 WL 743053, at *6, *10 (E.D. Mich. Feb. 26, 2010).

⁸⁹ See, e.g., *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1055 (10th Cir. 2008).

⁹⁰ BALLON, *supra* note 13, § 7.06[2].

⁹¹ *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 270 (4th Cir. 2001).

⁹² See, e.g., *Ford Motor Co. v. Catalanotte*, 342 F.3d 543, 549 (6th Cir. 2003) (registering a famous mark in a domain name and offering it for sale, despite no “transaction” commencing, constitutes trafficking under the ACPA). *But see* *Vulcan Golf, L.L.C. v. Google, Inc.*, 552 F. Supp. 2d 752, 764 (N.D. Ill. 2008) (denying motion to dismiss on grounds that auctioning domain names and providing domain name monetization services could plausibly fall under the ACPA definition of “traffics in”).

⁹³ 15 U.S.C. § 1125(d)(1)(E) (2006).

⁹⁴ *Ford Motor Co. v. Greatdomains.com, Inc.*, 177 F. Supp. 2d 635, 645 (E.D. Mich. 2001) (finding that an auction website does not “traffic in” the domain names it sells by merely providing a conduit for sale between parties).

widely recognized by the general consuming public . . . as a designation of source of the goods or services of the mark's owner."⁹⁵ Among the factors that courts can consider to determine whether a trademark is famous are (1) the duration, extent, and geographic reach of advertising; (2) the amount, volume, and geographic extent of sales; and (3) the extent of actual recognition of the trademark.⁹⁶ A trademark is distinctive if it is either inherently distinctive or has acquired secondary meaning, that is to say that the consuming public "associate[s] the mark with a particular source."⁹⁷

Under the fourth, and final, ACPA element, the domain name must contain a mark that is identical or confusingly similar to the trademark owner's mark or, in the case of a famous mark, dilutes the trademark owner's mark. This is a narrower test than the likelihood-of-confusion test for trademark infringement under the Lanham Act.⁹⁸ To determine whether a domain name is confusingly similar, all that is required is a simple comparison to the trademark at issue.⁹⁹ Courts will find a domain name is confusingly similar to a trademark if "consumers might think that [the domain name] is used, approved, or permitted by the mark holder."¹⁰⁰

It is irrelevant that a consumer can resolve any confusion by visiting the website.¹⁰¹ Minor differences, such as the inclusion or exclusion of a hyphen, the addition of minor or generic words, or typographical errors between the domain name and the trademark are also irrelevant.¹⁰² Indeed, "unless words or letters added to the plaintiff's mark within the domain name clearly distinguish it from the plaintiff's usage, allegations that a domain name incorporates a protected mark generally will suffice to satisfy the 'identical or confusingly similar to' requirement."¹⁰³ Examples of domain names that have been found to be confusingly similar to trademarks include <4fordparts.com> (confusingly similar to FORD), <jaguarcenter.com> (confusingly similar to JAGUAR), and <volvoguy.com> (confusingly similar to VOLVO).¹⁰⁴

2. First Cases under the ACPA

*Sporty's Farm, LLC v. Sportsman's Market, Inc.*¹⁰⁵ was the first appellate court decision interpreting the newly enacted ACPA and analyzing the illustrative statutory bad faith factors.¹⁰⁶ Sportsman's is a well-known mail-order cat-

⁹⁵ 15 U.S.C. § 1125(c)(2)(a).

⁹⁶ *Id.* § 1125(c)(2)(A)(i)-(iii).

⁹⁷ *Solid Host, NL v. Namecheap, Inc.*, 652 F. Supp. 2d 1092, 1106 (C.D. Cal. 2009); *see also id.* at 1106 n.43 (discussing the spectrum of distinctiveness and noting that "[t]erms that are suggestive, or arbitrary and fanciful . . . are inherently distinctive").

⁹⁸ *See Coca-Cola Co. v. Purdy*, 382 F.3d 774, 783 (8th Cir. 2004); *infra* Part III.A.

⁹⁹ *N. Light Tech., Inc. v. N. Lights Club*, 97 F. Supp. 2d 96, 117 (D. Mass. 2000).

¹⁰⁰ *Ford Motor Co. v. Greatdomains.com, Inc.*, 177 F. Supp. 2d 635, 641 (E.D. Mich. 2001) (alteration in original) (citations omitted).

¹⁰¹ *Coca-Cola*, 382 F.3d at 783 (citations omitted).

¹⁰² *Ford Motor Co.*, 177 F. Supp. 2d at 641.

¹⁰³ *Id.* at 642 (citations omitted).

¹⁰⁴ *See id.* at 641.

¹⁰⁵ *Sporty's Farm, L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489 (2d Cir. 2000).

¹⁰⁶ *Id.* at 496.

alog company that caters to aviation enthusiasts and pilots.¹⁰⁷ Sportsman's began using the logo "sporty" in the 1960s and registered the trademark with the United States Patent and Trademark Office.¹⁰⁸ In 1995, Arthur Hollander, a pilot who received Sportsman's catalogs, registered the <sportys.com> domain name.¹⁰⁹ In 1996, Hollander formed a Christmas tree company that he named Sporty's Farm and began advertising this business on the <sportys.com> website.¹¹⁰ In March 1996, Sporty's Farm filed a declaratory relief action and Sportsman's countersued for trademark infringement, dilution, and unfair competition.¹¹¹ Congress enacted the ACPA while the case was pending.¹¹²

The Second Circuit noted that the "unique circumstances of th[e] case . . . do not fit neatly into the [ACPA] factors"¹¹³ but that Congress allowed courts to consider other factors to determine bad faith.¹¹⁴ The Second Circuit reasoned that Sporty's Farm had a bad-faith intent to profit because Hollander was fully aware of the "sporty" mark because he received the Sportsman's catalog bearing that name and created another unrelated company to use the <sportys.com> domain name after the lawsuit was initiated to attempt to shield himself from liability.¹¹⁵ Additionally, the court discredited Sporty Farms' assertion that the domain name (and thus the corporate name) was selected to pay tribute to a childhood dog, Spotty.¹¹⁶ The court found that there was "overwhelming evidence" that Sporty's Farm had acted with a bad faith intent to profit from registration of the <sportys.com> domain name.¹¹⁷

*Shields v. Zuccarini*¹¹⁸ was the first case that held typosquatting is a violation of the ACPA. There, Shields was a cartoon artist who drew "Joe Cartoon," which he licensed and marketed for use on mugs, t-shirts, and other items sold at gift stores nationwide for fifteen years.¹¹⁹ Shields also owned the <joe-cartoon.com> domain name that received approximately seven hundred thousand visitors per month.¹²⁰ Zuccarini, a wholesaler of domain names,¹²¹ registered <joescartoon.com>, <joecarton.com>, <joescartons.com>, <joescartoons.com>, and <cartoonjoe.com>.¹²² Zuccarini linked these domain names to websites advertising other websites and "mousetrapped"¹²³ web users into clicking a succession of advertisements.¹²⁴ Mousetrapping occurs when a

¹⁰⁷ *Id.* at 493.

¹⁰⁸ *Id.* at 494.

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.* at 495.

¹¹³ *Id.* at 499.

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.* at 494, 499.

¹¹⁷ *Id.* at 499.

¹¹⁸ *Shields v. Zuccarini*, 89 F. Supp. 2d 634 (E.D. Penn. 2000).

¹¹⁹ *Id.* at 635.

¹²⁰ *Id.*

¹²¹ *Id.* at 635 n.1 (" 'Wholesaling' refers to the practice of acquiring multiple domain names with the intent to profit from them. ").

¹²² *Id.* at 635.

¹²³ *Id.*; see also Efroni, *supra* note 18, at 337 (describing "mousetrapping").

¹²⁴ *Shields*, 89 F. Supp. 2d at 635.

web user reaches an unintended website and is inundated with a plethora of “pop up”¹²⁵ or “pop under”¹²⁶ ads. These “pop up” and “pop under” ads make it difficult for web users to browse away from the websites they were trying to access to stop the advertisements from appearing.¹²⁷

Zuccarini generated revenue from each click on an advertiser’s ad,¹²⁸ resulting in average yearly revenue of almost \$1 million.¹²⁹ Shortly after Shields filed suit, Zuccarini changed the websites to reflect a political commentary criticizing the violent nature of Shields’s cartoon.¹³⁰ Zuccarini claimed his post-service conduct fell under the safe harbor provision of the ACPA¹³¹ because he reasonably believed his political commentary was lawful.¹³² The court rejected his safe harbor defense as “incredible” because Zuccarini changed the websites to reflect political commentary *after* being served with notice of the complaint.¹³³ Zuccarini’s argument was especially “incredible” in light of his owning thousands of domain names, including typographically misspelled domain names containing the names of celebrities such as Gwyneth Paltrow, Ricky Martin, and Britney Spears.¹³⁴ The court enjoined Zuccarini from using the domain names pending litigation.¹³⁵ Shields ultimately prevailed on a motion for summary judgment,¹³⁶ which the court of appeals affirmed.¹³⁷

Trademark holders are very concerned about typosquatters and engage in defensive domain name registration—registering domain names for the simple purpose of blocking typosquatters—to combat the problem.¹³⁸ Overall, defensive domain name registrations cost businesses an estimated \$1.6 billion.¹³⁹

¹²⁵ 1-800 Contacts, Inc. v. WhenU.com, 309 F. Supp. 2d 467, 476 n.18 (S.D.N.Y. 2003) (“‘Pop-up’ windows are windows containing notifications or advertisements that appear on the screen, usually without any triggering action by the computer user.”).

¹²⁶ 2-7A GILSON ON TRADEMARKS § 7A.14 (2010).

¹²⁷ *Shields*, 89 F. Supp. 2d at 635; Gilwit, *supra* note 8, at 275.

¹²⁸ *Shields*, 89 F. Supp. 2d at 635.

¹²⁹ *Id.* at 640 n.7.

¹³⁰ *Id.* at 635.

¹³¹ See 15 U.S.C. § 1125(d)(1)(B)(ii) (2006).

¹³² *Shields*, 89 F. Supp. 2d at 640.

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.* at 642-43.

¹³⁶ *Shields v. Zuccarini*, No. 00-494, 2000 WL 1056400, at *5 (E.D. Pa. June 5, 2000).

¹³⁷ *Shields v. Zuccarini*, 254 F.3d 476, 488 (3d Cir. 2001).

¹³⁸ *Concerns Rising over Domain Name Dispute Procedures*, WASH. INTERNET DAILY (Warren Comm’ns News, Inc., Washington, D.C.), Oct. 16, 2009, available at 2009 WL 20749884 (noting that MarkMonitor, a brand protection company, reports that 90-99.99 percent of its clients’ domain name registrations are defensive). Many trademark holders never utilize domain names registered for defensive purposes.

¹³⁹ Taylor Buley, *Um.whatever*, FORBES, Nov. 17, 2008, at 38, available at 2008 WL 21009929; see also *Concerns Rising Over Domain Name Dispute Procedures*, *supra* note 138 (noting that defensive registration is an “extremely expensive” way to protect these domain names from cyberquatters). As new gTLDs are added, the costs of defensive domain name registrations continue to grow. See ICANN’s Predictions—The Hard Costs of New Generic TLDs, CADNA, <http://www.cadna.org/en/issues/cadna-analysis/icanns-predictions-hard-costs-new-generic-tlds> (last visited Apr. 2, 2011).

B. *The UDRP*

While Congress prepared to enact the ACPA, the U.S. government investigated the possibility of creating an alternative dispute resolution policy, the Uniform Domain Name Dispute Resolution Policy, to address cybersquatters. In 1999, the National Telecommunications and Information Administration (NTIA) requested that World Intellectual Property Organization (WIPO) conduct a study on domain name and trademark issues.¹⁴⁰ WIPO completed the study, which included a suggestion of a uniform dispute resolution procedure for handling domain name issues.¹⁴¹ The result was the Uniform Domain Name Dispute Resolution Policy (UDRP), which ICANN adopted on August 26, 1999, and implemented on October 24, 1999.¹⁴² The UDRP is an alternative dispute resolution process and was created as an “effective, predictable alternative to court litigation for rights holders.”¹⁴³

One court explained that the UDRP “creates a contract-based scheme for addressing disputes between domain name registrants and third parties challenging the regulation and use of their domain names.”¹⁴⁴ Another court has described the UDRP as “an administrative alternative dispute resolution policy which creates a procedure specifically designed to provide a fast and cheap means for resolving domain name disputes.”¹⁴⁵ Indeed, the UDRP has become “the most important alternative dispute resolution procedure for domain names.”¹⁴⁶

ICANN, as the accreditation organization for domain name registrars,¹⁴⁷ mandates that registrars, as a condition of accreditation, must require domain name registrants to adhere to the UDRP.¹⁴⁸ Upon the registration or renewal of a domain name, the domain name registrant represents and warrants that

(a) the statements that [the registrant] made in [the] Registration Agreement are complete and accurate; (b) to [the registrant’s] knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) [the registrant is] not registering the domain name for an unlawful purpose; and (d) [the registrant] will not knowingly use the domain name in violation of any applicable

¹⁴⁰ *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*, ICANN, <http://www.icann.org/en/udrp/udrp-schedule.htm> (last visited Apr. 2, 2011).

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ Memorandum from Erik Wibers, Dir., WIPO Arbitration & Mediation Ctr, to Rod Beckstrom, CEO & President, WIPO and Peter Dengate-Thrush, Chairman Bd. Dirs., WIPO (Mar. 26, 2010), available at <http://www.wipo.int/export/sites/www/amc/en/docs/icann260310rap.pdf>.

¹⁴⁴ *Parisi v. Netlearning, Inc.*, 139 F. Supp. 2d 745, 751 (E.D. Va. 2001).

¹⁴⁵ *Am. Girl, L.L.C. v. Nameview, Inc.*, 381 F. Supp. 2d 876, 883 (E.D. Wis. 2005).

¹⁴⁶ TORSTEN BETTINGER, *DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* § IIIA.08 (2005).

¹⁴⁷ *What Does ICANN Do?*, *supra* note 15.

¹⁴⁸ BETTINGER *supra* note 146, § IIIA.23; see also Jacqueline D. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 WAKE FOREST L. REV. 1361, 1372 (2005) (noting that domain name registrants are required to submit to mandatory arbitration if a complaint is made under the UDRP).

laws or regulations. It is [the registrant's] responsibility to determine whether [the registrant's] domain name registration infringes or violates someone else's rights.¹⁴⁹

1. *Understanding the Elements*

Under the UDRP, the complainant must prove three elements in order to warrant the transfer or cancellation of the domain name:¹⁵⁰ (1) the domain name must be identical or confusingly similar to the complainant's trademark, (2) the domain name registrant has no legitimate interest in the domain name, and (3) the domain name has been registered and is being used in bad faith.¹⁵¹ The UDRP provides an illustrative list of evidence of bad faith, including registration of a domain name for the purpose of selling it to the trademark owner or its competitor, having a pattern of registering domain names to prevent the trademark owner from doing so, registering domain names to disrupt the trademark owner's business, and intentionally attempting to cause consumer confusion.¹⁵²

2. *First Case under the UDRP*

The first case decided under the newly enacted UDRP was *World Wrestling Federation Entertainment, Inc. v. Bosman*.¹⁵³ There, Bosman registered the <worldwrestlingfederation.com> domain name, which incorporated World Wrestling Federation Entertainment's WORLD WRESTLING FEDERATION trademark. Three days after registering the domain name, Bosman e-mailed the World Wrestling Federation Entertainment (WWF) and offered to sell the domain name for \$1,000 dollars. In his e-mail, Bosman asserted that the payment was a fee for his time and money and that it would also serve as "consideration . . . 'for the right of current ownership of the domain name.'"¹⁵⁴ The WIPO panel did not hesitate to find that the domain name was identical or confusingly similar to WWF's trademark and that Bosman had no legitimate interest in the domain name.¹⁵⁵ The panel instead focused its analysis on whether the domain name had been registered and used in bad faith.¹⁵⁶

Although Bosman had registered the domain name and offered it for sale to WWF, Bosman did not develop a website for the domain name, and thus the panel questioned whether this would be enough to constitute bad faith *use*. The panel consulted the illustrative list of evidence of bad faith provided by WIPO,¹⁵⁷ and determined that offering the domain name for sale constituted bad faith use. The panel concluded by stating that the WWF had no desire to engage in litigation with its fans and had "engag[ed] in this proceeding . . . to

¹⁴⁹ *Uniform Domain Name Dispute Resolution Policy*, ICANN (Oct. 24, 1999), <http://www.icann.org/en/dndr/udrp/policy.htm> [hereinafter *Policy*].

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *World Wrestling Fed'n Entm't, Inc. v. Bosman*, No. D99-0001 (WIPO Arb. & Med. Ctr. Jan. 14, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html>.

¹⁵⁴ *Id.* (internal quotation marks omitted).

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ *See supra* Part IV.B.1.

protect [WWF's] intellectual property interests while preserving the relationship between complainant and its fans at a minimal cost to all concerned."¹⁵⁸ This alternative dispute resolution procedure is an important tool for trademark owners who wish to recover intellectual property rights while minimizing alienation of consumers and fans.¹⁵⁹

C. Comparing the ACPA and the UDRP

Although not mutually exclusive,¹⁶⁰ the ACPA and UDRP differ considerably in jurisdictional requirements, evidentiary requirements, availability and technical knowledge of the adjudicator, the cost and timing of proceedings, and the remedies available.

1. Jurisdiction¹⁶¹

Although generally quick and inexpensive, proceeding under the UDRP has a few drawbacks. First, a trademark owner must consent to jurisdiction in subsequent litigation where either the registrant or registrar of the domain name is located.¹⁶² If the registrant files suit, jurisdiction may play a vital role in the proceedings where circuits are split on certain aspects of the law.¹⁶³ This is especially problematic if the registrant or registry is located overseas, forcing the trademark owner to litigate in a foreign, and probably unfamiliar, court.¹⁶⁴ Conversely, if the trademark owner files suit under the ACPA, as long as the registrant is subject to the court's jurisdiction, the trademark owner has its preference of jurisdiction.¹⁶⁵

2. Evidentiary Requirements

As a practical matter, the type of cybersquatter and domain name infringement at issue is relevant to determine whether to proceed under the ACPA or the UDRP. Under the ACPA, a plaintiff must prove the registrant has a bad faith intent *to profit* from registering, using, or trafficking in a domain name.¹⁶⁶ Under the UDRP, the claimant must prove bad faith *registration and use* of a domain name. Thus, if a plaintiff has difficulty proving bad faith intent to profit, but can easily prove bad faith, a UDRP action is preferable.¹⁶⁷ The UDRP requires the registration *and* use of a domain name, whereas the ACPA requires use, registration *or* trafficking in a domain name.¹⁶⁸ Both the UDRP

¹⁵⁸ *World Wrestling Fed'n Entm't, Inc.*, No. D1999-0001.

¹⁵⁹ *See id.*

¹⁶⁰ 1-2 McGRADY ON DOMAIN NAMES § 2.13 (2010); *see also id.* § 2.12 (discussing the fact that there is no claim preclusion when first filing a UDRP action because the ACPA "is not dependent upon the UDRP process in any way").

¹⁶¹ A detailed discussion of jurisdictional issues related to cybersquatting is beyond the scope of this Note, but jurisdiction is discussed in other authorities. *See, e.g., Efroni, supra* note 18, at 338.

¹⁶² BALLON, *supra* note 13, § 7.04[2].

¹⁶³ *Id.*

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* § 7.04[3].

and ACPA require a showing that the domain name is identical or confusingly similar. However, the ACPA has the added option of showing likelihood of dilution.¹⁶⁹ Finally, the ACPA applies to famous or distinctive trademarks, whereas the UDRP applies to any trademark.¹⁷⁰

3. *Adjudicator*

Currently, there are four ICANN-accredited arbitration organizations: the Asian Domain Name Dispute Resolution Centre, the National Arbitration Forum (NAF), WIPO, and the Czech Arbitration Court.¹⁷¹ NAF and WIPO are the two main arbitration organizations for domain name disputes in the United States. Arbitrators, who are private attorneys that are typically experts in trademark law, oversee UDRP proceedings.¹⁷² UDRP arbitrators generally have been favorable to trademark owners.¹⁷³ In 2009, 1,759 domain name dispute cases were filed with NAF,¹⁷⁴ while 2,107 were filed with WIPO.¹⁷⁵ In 2009, 310 panelists from 46 countries handled the 2,107 domain name dispute cases filed with WIPO.¹⁷⁶ Of those cases, 1,331 resulted in a transfer of the domain name to the complainant.¹⁷⁷ A recent study reports that NAF has approximately 141 panelists and approximately 83 percent of cases conclude with the transfer of the domain name to the complainant.¹⁷⁸

In contrast, ACPA suits are typically filed in federal court with a judge that might not have much, if any, knowledge of the specialized area of trademark law.¹⁷⁹ Statistics on the success of ACPA lawsuits are difficult to locate but are likely have as little consistency and success as any other type of litigation.

4. *Cost and Timing*

There is a considerable disparity in the cost and timing of UDRP proceedings compared to an ACPA suit. UDRP proceedings, which include only a complaint and answer with no additional discovery or motion practice, typically resolve within six to twelve weeks of filing and typically are much less

¹⁶⁹ *Id.*

¹⁷⁰ David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 35, 50 (2001).

¹⁷¹ *List of Approved Providers for Uniform Domain-Name Dispute-Resolution Policy*, ICANN, <http://www.icann.org/en/dndr/udrp/approved-providers.htm> (last visited Apr. 2, 2011).

¹⁷² BALLON, *supra* note 13, § 7.04[3].

¹⁷³ *Id.* § 7.04[2].

¹⁷⁴ *National Arbitration Forum Domain Name Dispute Filings Hold Steady in 2009*, NAT'L ARB. F. (Apr. 5, 2010), <http://domains.adrforum.com/newsroom.aspx?itemID=1595>.

¹⁷⁵ *Total Number of Cases Per Year*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/cases.jsp> (last visited Apr. 2, 2011).

¹⁷⁶ *Brands Tackle Cybersquatters in 2009, UDRP Becomes Eco-Friendly*, WIPO (Mar. 23, 2010), http://www.wipo.int/madrid/en/statistics/articles/2010/article_0007.html.

¹⁷⁷ *Case Outcome by Year(s) (Breakdown)*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/outcome.jsp> (last visited Apr. 2, 2011).

¹⁷⁸ Natalie Ledra, *National Arbitration Forum ("N.A.F.") Domain Name Dispute Study* (Mar. 2010), <http://www.dnattorney.com/study.shtml>.

¹⁷⁹ BALLON, *supra* note 13, § 7.04[2]-[3].

expensive than filing a federal lawsuit.¹⁸⁰ The amount of time that a federal suit will take depends on whether the registrant appears and contests the complaint. As with other federal lawsuits, if the defendant does not respond at all, the plaintiff can seek entry of default judgment, which expedites the case and lessens the cost.¹⁸¹ Default judgments are also common in UDRP proceedings, as one-third to one-half of domain name registrants simply do not respond to the complaint.¹⁸²

5. Remedies

The ACPA and UDRP are not mutually exclusive.¹⁸³ For example, the UDRP is non-binding, which means the parties involved can commence litigation under the ACPA either before or after the proceeding.¹⁸⁴ As one court noted, “UDRP proceedings are structured specifically to permit the domain-name registrant two bites at the apple.”¹⁸⁵ The only remedy available under the UDRP is the cancellation or transfer of the domain name.¹⁸⁶ By contrast, the remedies under the ACPA include injunctive relief;¹⁸⁷ election of actual *or* statutory damages;¹⁸⁸ the possibility of attorneys’ fees;¹⁸⁹ and forfeiture, cancellation, or transfer of the domain name.¹⁹⁰ The ACPA also provides for *in rem* proceedings.¹⁹¹

At first blush, the ACPA remedies seem very tantalizing, given the range of remedies and possibility of statutory damages and attorneys’ fees, especially in comparison with the extremely limited remedy available under the UDRP. However, there are important caveats to most of the categories of remedies under the ACPA. First, most plaintiffs elect to receive statutory damages rather than actual damages. Statutory damages under the ACPA deter wrongful conduct and provide an adequate remedy for trademark owners.¹⁹² The statutory damages provision of the ACPA provides:

In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the court considers just.¹⁹³

¹⁸⁰ See BALLON, *supra* note 13, § 7.04[2]; *The Uniform Domain Name Dispute Resolution Procedure*, WIPO, <http://www.wipo.int/export/sites/www/amc/en/docs/UDRPflowchart.doc> (last visited Apr. 2, 2011).

¹⁸¹ BALLON, *supra* note 13, § 7.04[2].

¹⁸² Sorkin, *supra* note 170, at 42.

¹⁸³ 1-2 McGRADY ON DOMAIN NAMES, *supra* note 160, § 2.12.

¹⁸⁴ Efroni, *supra* note 18, at 353.

¹⁸⁵ Storey v. Cello Holdings, L.L.C., 347 F.3d 370, 381 (2d Cir. 2003).

¹⁸⁶ *Policy*, *supra* note 149, at 4(i).

¹⁸⁷ 15 U.S.C. § 1116(a) (2006).

¹⁸⁸ *Id.* § 1117(d).

¹⁸⁹ *Id.* § 1117(a).

¹⁹⁰ *Id.* § 1125(d)(1)(C).

¹⁹¹ *Id.* § 1125(d)(2)(A).

¹⁹² *Pinehurst, Inc. v. Wick*, 256 F. Supp. 2d 424, 432 (M.D.N.C. 2003) (quoting S. REP. NO. 106-140, at 8 (1999)) (citations omitted).

¹⁹³ 15 U.S.C. § 1117(d) (2006).

In determining the amount of statutory damages, the court has wide discretion in the award amount and is restricted only by the statutory maximum and minimum.¹⁹⁴ In assessing statutory damages, courts take into account the egregiousness of the cybersquatter, including whether the cybersquatter provided false or misleading registration information,¹⁹⁵ whether the cybersquatter is a “serial cybersquatter” who has displayed a pattern of registering domain names containing the trademarks of others,¹⁹⁶ and whether the cybersquatter’s behavior demonstrates contempt for the court or judicial proceedings.¹⁹⁷ A court of appeals will overturn a lower court’s award of statutory damages only for an abuse of discretion.¹⁹⁸ Moreover, because liability under the ACPA requires a finding of bad faith, damages are non-dischargeable in bankruptcy proceedings.¹⁹⁹

Although permitted by statute, the court will award attorneys’ fees only in exceptional cases.²⁰⁰ However, a finding of “bad faith” does not necessarily mean that the defendant acted with the “malicious, fraudulent, willful or deliberate behavior necessary for an award of attorney fees” under the ACPA.²⁰¹

V. NEW ISSUES . . . OR, THE TIMES ARE STILL A CHANGIN’

Some commentators argue that the ACPA has become a relic since the popularity of search engines such as Google gained widespread popularity.²⁰² It is true that new issues have developed that the ACPA has been unable to answer. Among these new concerns are “social squatting,” private domain name registration services, registrar liability for services that arguably fall outside of the registrar’s duties, issues with international registrars, and reverse domain name hijacking.

A. Social Squatting

Trademark owners should be concerned about over the growing popularity of social networking websites and the increased opportunity for trademark misuse. In 2010, the average U.S.-based Internet user visited a social networking

¹⁹⁴ *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984) (citing *L.A. Westermann Co. v. Dispatch Printing Co.*, 249 U.S. 100 (1919)).

¹⁹⁵ See *Biocryst Pharm., Inc. v. Namecheap.com*, No. CV 05-7615 JFW (RZx), 2006 U.S. Dist. LEXIS 98340, at *5 (C.D. Cal. Nov. 21, 2006).

¹⁹⁶ See, e.g., *Verizon Cal. Inc. v. OnlineNic, Inc.*, No. C 08-2832 JF (RS), 2009 WL 2706393, at *3 (N.D. Cal. Aug. 25, 2009); *Elecs. Boutique Holdings Corp. v. Zuccarini*, No. 00-4055, 2000 WL 1622760, at *7-8 (E.D. Pa. Oct. 30, 2000).

¹⁹⁷ *Verizon Cal. Inc.*, 2009 WL 2706393, at *3.

¹⁹⁸ See *Harris*, 734 F.2d at 1335.

¹⁹⁹ *Choice Hotels Int’l, Inc. v. Wright (In re Wright)*, 355 B.R. 192, 212-23 (Bankr. C.D. Cal. 2006). But see *PETA v. Doughney*, 263 F.3d 359, 370 (4th Cir. 2001).

²⁰⁰ *Pinehurst, Inc. v. Wick*, 256 F. Supp. 2d 424, 433 (M.D.N.C. 2003) (citations omitted).

²⁰¹ *Doughney*, 263 F.3d at 370.

²⁰² Karen Jacobs Loudon, et al., *Legitimate Businesses Get Caught in the Web: Does the Anticybersquatting Protection Act Go Too Far?*, 10 DEL. L. REV. 1, 3-4 (2008); Lipton, *supra* note 13, at 21.

website, spending in excess of four hours per month on these websites.²⁰³ February 2009 marked the first time social networking exceeded the use of web-based e-mail.²⁰⁴ This rapid influx of social networking is generating heightened concern over “social squatting,” sometimes known as “identity squatting” and username hijacking—essentially forms of online impersonation.²⁰⁵ Social-squatters pose a variety of concerns for trademark owners. Once the squatter is comfortably in control of a Twitter or Facebook space using a trademark, he can then use the space to provide false or misleading brand or product information or offer counterfeit goods and services, among other things.²⁰⁶ As one commentator notes, “‘usernames’ will become the new ‘domain names.’”²⁰⁷

In June 2009, Facebook allowed its users to register vanity web addresses to allow for a more convenient method to locate users.²⁰⁸ Facebook announced the availability of vanity web addresses a few short days before launching the program, forcing trademark owners to act very quickly to secure their products and brand names.²⁰⁹ More than five million usernames were registered in twenty-four hours.²¹⁰ Among the vanity web addresses registered were <facebook.com/dellcomputers>, <facebook.com/iphones>, and <facebook.com/Nasa>.²¹¹ Facebook, recognizing the likelihood of username-squatting, implemented a strict no-transfer policy as to usernames, which will prevent username-squatters from holding names for ransom.²¹² Trademark owners are concerned about Facebook’s trademark policies. For example, Facebook’s trademark policy requires the trademark owner to provide trade-

²⁰³ Press Release, comScore Releases “The 2010 U.S. Digital Year in Review” (Feb. 8, 2011), http://www.comscore.com/Press_Events/Press_Releases/2011/2/comScore_Releases_The_2010_U.S._Digital_Year_in_Review.

²⁰⁴ Press Release, Online Engagement Deepens as Social Media and Video Sites Reshape the Internet, Nielsen Reports (Apr. 22, 2009), http://blog.nielsen.com/nielsenwire/wp-content/uploads/2009/04/nielsen-online-global_.pr.pdf.

²⁰⁵ *Concerns Rising over Domain Name Dispute Procedures*, *supra* note 138.

²⁰⁶ *See*, Brian J. Winterfeldt, *Protecting Marks in the Wild West of Web 2.0*, NAT’L L.J., Nov. 30, 2009, at S3, available at <http://www.law.com/jsp/cc/PubArticleCC.jsp?id=1202435924630>.

²⁰⁷ Nicholas F. Ducoff & Michele Schwartz, *A New Kind of Cybersquatting Facebook, Twitter and Online Social Media Sites* (June 26, 2009), http://www.martindale.com/advertising-marketing/article_Andrews-Kurth-LLP_725518.htm.

²⁰⁸ Theodora Blanchfield, *Facebook Land Grab: Usernames Could Create Cybersquatting Issues*, L. TECH. NEWS, July, 2009, at 6, 6; Aura Lichtenberg & Melissa Solomon, *What Social Squatting Means for Trademark Holders: How to Protect Your Brand on Social Networking Sites*, 22 DUPAGE COUNTY B. ASS’N 36, 36 (2009).

²⁰⁹ Winterfeldt, *supra* note 206.

²¹⁰ Blanchfield, *supra* note 208, at 6.

²¹¹ Lichtenberg & Solomon, *supra* note 208, at 36.

²¹² *See* Help Center, *Usernames: General Information*, FACEBOOK, <http://www.facebook.com/help.php?page=897> (last visited Apr. 2, 2011); Blanchfield, *supra* note 208, at 45. Facebook provides a form for complaints of non-copyright infringement claims. *Notice of Intellectual Property Infringement (Non-Copyright Claim)*, FACEBOOK, http://www.facebook.com/legal/copyright.php?noncopyright_notice=1&type=23&uid=0&cid=100907566536&cid2=0&h=4cdbcf2641 (last visited Apr. 2, 2011).

mark registration information, which suggests that common law trademark rights are not enough for enforcement under Facebook's policy.²¹³

In May 2009, Major League Baseball manager Tony LaRussa sued Twitter when someone created a Twitter account (<twitter.com/TonyLaRussa>) impersonating him.²¹⁴ LaRussa alleged seven causes of action, including trademark dilution and cybersquatting.²¹⁵ LaRussa's was apparently the first suit against Twitter. The case settled with undisclosed terms shortly after filing.

The question the court would have undoubtedly asked had the case gone to trial is whether the mere inclusion of a username would cause confusion. Interestingly, Twitter's trademark policy allows for clear parody uses, but will take down any Twitter page "if there is a clear intent to mislead others through the unauthorized use of a trademark."²¹⁶ Facebook and Twitter have the potential to be bigger problems than domain name abuse because it costs the user nothing to register usernames with Facebook and Twitter.²¹⁷

Social squatting is unchartered legal territory.²¹⁸ Although no courts have addressed application of the UDRP or ACPA to social squatters, it does not

²¹³ Amy E. Bivens, *Trademarks/Domain Names: Facebook Gives Mark Owners Option to Block Squatters Before June 13 Vanity URLs Launch*, 78 BNA'S PAT., TRADEMARK & COPYRIGHT J. 223 (2009).

²¹⁴ See Notice of Removal of Civil Action at exhibit A, *La Russa v. Twitter, Inc.*, No. CGC-09-488101 (N.D. Cal. June 5, 2009), available at <http://docs.justia.com/cases/federal/district-courts/california/candce/3:2009cv02503/215692/1/>.

²¹⁵ *Id.*

²¹⁶ Twitter Support, *Trademark Policy*, TWITTER (Jan. 14, 2009), <http://support.twitter.com/entries/18367-trademark-policy>. In June 2009, Twitter launched its "Verified Accounts" program. Pete Cashmore, *Twitter Launches Verified Accounts*, MASHABLE (June 11, 2009), <http://mashable.com/2009/06/11/twitter-verified-accounts-2/>. The goal of the Verified Accounts program "is to limit user confusion by making it easier to identify authentic accounts on Twitter." Twitter Help Center, *About Verified Accounts*, TWITTER, <http://support.twitter.com/groups/31-twitter-basics/topics/111-features/articles/119135-about-verified-accounts> (last visited Apr. 2, 2011). In late 2010, Twitter suspended the program pending release of a more user-friendly system. Peter Kafka, *Twitter Trusts, No Longer Verifies*, MEDIAMEMO (Nov. 30, 2010, 10:19 AM), <http://mediamemo.allthingsd.com/20101130/twitter-trusts-no-longer-verifies/>.

²¹⁷ Lichtenberg & Solomon, *supra* note 208, at 39.

²¹⁸ Steven Seidenberg, *Names' Sake: Social Media Pose Trademark Threats for Companies*, INSIDE COUNS., Sept. 1, 2009, at 24, 24, available at <http://www.insidecounsel.com/Issues/2009/September-2009/Pages/Names-Sake.aspx?k=names'+sake>. On January 1, 2011, California SB 1411 went in to effect, prohibiting "E-personation." One legislator noted that prior California law was insufficient to deal with current technology. See *Fact Sheet: Senate Bill 1411 (Simitian) Criminal "E-personation,"* http://www.senatorsimitian.com/images/uploads/SB_1411_Fact_Sheet.pdf (last visited Apr. 2, 2011). Specifically, SB 1411 criminalizes anyone who "credibly impersonates another actual person through or on an Internet Web site or by other electronic means for purposes of harming, intimidating, threatening, or defrauding another person . . ." CAL. PENAL CODE § 528.5(a) (West Supp. 2011). The law defines "electronic means" to include creating an e-mail or social networking account utilizing another person's name. *Id.* § 528.5(c). Such conduct is punishable by a fine not to exceed \$1,000 or imprisonment not to exceed one year, or both a fine and imprisonment. *Id.* § 528.5(d). The new law also explicitly permits victims to pursue other civil remedies. *Id.* § 528.5(e). In 2009, Texas enacted a similar law. See TEX. PENAL CODE ANN. § 33.07 (West Supp. 2010).

appear that either will apply.²¹⁹ Social networking sites such as Facebook and Twitter provide usernames and subdomains,²²⁰ which do not appear to fall within the UDRP or ACPA, which apply only to domain names.²²¹

B. Private Registration Services

Many domain name registrars now offer private registration services.²²² Some of the domain name registrars that offer privacy registration services do so under a subsidiary or affiliated company, undoubtedly for the purpose of distancing themselves from liability.²²³ For an additional fee, these services allow registrants to shield their identification from the WhoIs record.²²⁴ A domain name registered using a private registration service will list the privacy service as the registrant and provide an e-mail address, such as domainname@acmeprivacyservice.com, which will privately route to the correct e-mail address of the registrant.²²⁵ Although there are undoubtedly legitimate purposes for the use of a domain name privacy registration service,²²⁶ these services have become the calling card of cybersquatters.²²⁷ Indeed, private registration services “stifle accountability” of registrants that are operating infringing websites.²²⁸

In this situation, it is impossible to tell from the WhoIs record where the registrant is located to determine whether the trademark owner can bring an *in personam* or *in rem* suit. One possible solution to this issue is to contact the domain name registrar to let them know that the domain name is in dispute. This may be sufficient for the registrar to unmask the registrant’s informa-

²¹⁹ Seidenberg, *supra* note 218, at 27.

²²⁰ A subdomain is an unregistered portion of a domain name. For example, in the domain name “<www.store.apple.com>,” the “store” portion is the subdomain. *See also* 1-1 McGRADY ON DOMAIN NAMES, *supra* note 16, § 1.07[7][a][i].

²²¹ *Id.* § 1.07[7].

²²² Ian J. Block, Comment, *Hidden Whois and Infringing Domain Names: Making the Case for Registrar Liability*, 2008 U. CHI. LEGAL F. 431, 431.

²²³ One such example is GoDaddy.com, which provides private domain registration services through affiliate Domains By Proxy. *See About Us*, DOMAINS BY PROXY, <http://domainsbyproxy.com/Aboutus.aspx> (last visited Apr. 2, 2011); *see also* Michael S. Gunterdorfer, *Unmasking Private Domain Name Registrations*, L.A. LAW., Apr. 2006, at 19.

²²⁴ Block, *supra* note 222, at 431-32.

²²⁵ *See Public v. Private*, DOMAINS BY PROXY, <http://www.domainsbyproxy.com/popup/whoisexample.aspx?app%5Fhdr=0&ci=5165> (last visited Apr. 2, 2010) (providing an example of the difference between a public domain name registration and a private domain name registration).

²²⁶ *See Career Agents Network, Inc. v. Careeragentsnetwork.biz*, No. 09-CV-12269-DT, 2010 WL 743053, at *2 (E.D. Mich. Feb. 26, 2010) (identifying legitimate privacy registration uses, such as “limit[ing] the amount of spam, junk mail, and unsolicited contact”).

²²⁷ *DNS Developments Feed Growing Cybersquatting Concerns*, WIPO (Mar. 27, 2008), http://www.wipo.int/pressroom/en/articles/2008/article_0015.html; *see also* Solid Host, NL v. Namecheap, Inc., 652 F. Supp. 2d 1092, 1096 (C.D. Cal. 2009) (“[T]hese services . . . appeal to registrants who wish to conceal their identities for illegitimate purposes.”); Gunterdorfer, *supra* note 223, at 19. *But see Career Agents Network, Inc.*, 2010 WL 743053, at *5 (noting that the mere use of a privacy service “is not the same thing as providing false or misleading contact information”).

²²⁸ Block, *supra* note 222, at 441.

tion.²²⁹ If the registrar does not unmask the registrant's information, the trademark owner can file an *in rem* suit or file suit against the registrar.²³⁰ Once the complaint is filed, the registrar will unmask the registrant's information and the trademark owner can file an amended complaint dismissing the registrar and adding the registrant as the proper defendant.²³¹

C. Registrar Liability

The ACPA provides a safe harbor to domain name registrars for registering domain names containing the trademarks of others.²³² One commentator suggests that, by virtue of agency principles, a registrar's privacy service that is listed as the registrant in the WhoIs database would fall outside of the ACPA's safe harbor provision because the registrar is acting as the registrant.²³³ At least one court has rejected this rationale.²³⁴ However, registrars arguably exceed the boundaries of their typical role when they collect an additional fee for substituting registrant information for their own.²³⁵ To date, the federal courts have not held that a registrar is liable for offering private registration services,²³⁶ although at least one UDRP panel has indicated that the use of a privacy registration service, in addition to other evidence, may constitute bad faith.²³⁷

Registrar liability becomes an even bigger question when a domain name registrar offers "parking" services for the domain names it registers. When a registrant registers a domain name, some registrars will offer to provide a "parking" page for a fee while the registrant is developing the website.²³⁸ One court has explained that parking services "aggregate[] numerous domain names from individual domain registrants and contracts with an advertising service . . . to license and monetize [the] domain names."²³⁹ Domain name mone-

²²⁹ Guntersdorfer, *supra* note 223, at 20.

²³⁰ 15 U.S.C. § 1125(d)(2)(A) (2006).

²³¹ Personal experience of author while working at Lewis and Roca LLP.

²³² 15 U.S.C. § 1114(2)(D)(i)(I); *see also Solid Host, NL*, 625 F. Supp. 2d at 1104-05 (narrowly construing the safe harbor provision to apply only when the registrar "did nothing more than act as a registrar" (citing *Lockheed Martin Corp. v. Network Solutions, Inc.*, 141 F. Supp. 2d 648 (N.D. Tex. 2001)).

²³³ Block, *supra* note 222, at 443.

²³⁴ *Solid Host, NL*, 625 F. Supp. 2d at 1111 n.53 (noting that in a principal-agent relationship, liability flows from principal to agent, not from agent to principal).

²³⁵ Block, *supra* note 222, at 443-44.

²³⁶ *Id.* at 443.

²³⁷ *HSBC Fin. Corp. v. Clear Blue Sky Inc.*, No. D2007-0062 (WIPO Arb. & Med. Ctr. June 4, 2007), http://www.wipo.int/amc/en/domains/decisionsx/list.jsp?prefix=D&year=2007&seq_min=1&seq_max=199 ("The Panel does not consider the Respondent's use of a privacy service in and of itself to constitute bad faith under the Policy, but privacy services are subject to manipulation by a registrant seeking to evade enforcement of legitimate third-party rights or to obstruct proceedings commenced under the Policy or elsewhere.").

²³⁸ *See Cash Parking: Turn Your Parked Domain into Cash!*, GoDADDY.COM, <http://www.godaddy.com/gdshop/park/domain-name-parking.asp?ci=8997> (last visited Apr. 2, 2011).

²³⁹ *Vulcan Golf, L.L.C. v. Google Inc.*, 552 F. Supp. 2d 752, 759 n.2 (N.D. Ill. 2008) (quoting First Amended Complaint at para. 83(w), *Vulcan Golf*, 552 F. Supp. 752 (No. 07 C 3371)) (internal quotation marks omitted). For an example of a parking service, see *Domain Optimization*, PARKED, <http://www.parked.com/tour/domainoptimization.php> (last visited Apr. 2, 2011).

tization is “the practice of using a domain name for commercial gain by generating revenue from Internet advertising located on a webpage.”²⁴⁰

Parking pages that utilize monetization rely on Internet users to click on advertising links listed on the website. Once the Internet user clicks on the link, the advertiser is charged a fee for the click and the parking service receives a portion of the fee,²⁴¹ of which the parking service pays a percentage to the domain name registrant.²⁴² In some cases, parking services “key” the advertising links to words found in a domain name.²⁴³ For example, if a domain name contains the word “lasvegas,” the advertising links will be “keyed” to goods and services located in or near Las Vegas, Nevada, such as attractions and entertainment in Las Vegas. Taking the example one step further, if the domain name contained a trademark, for example MGM GRAND, the advertising links would not only include advertising for goods and services in Las Vegas, but would likely also contain links to other Las Vegas resorts, such as the Venetian or the Wynn. If an Internet user attempts to reach a domain name containing MGM GRAND, and sees advertisements for other, similar services, perhaps at a better price or offering different amenities, that user might be diverted from its intended target, the MGM Grand. When the Internet user intends to reach the MGM GRAND website and reaches a cybersquatter’s parking page instead, two critical events occur. First, the cybersquatter (and the parking service) generate income based on the improper use of the trademark. Second, the Internet user may elect another service provider found in the advertising links, thus depriving the trademark owner of the opportunity to provide services.

To date, no court has directly ruled on liability for registrars that provide parking services. However, one court stated in dicta that it was “troubl[ed], to say the least” by a registrar’s assertion that it is shielded from liability for cybersquatting under § 1114(2)(D)(iii), despite the registrar earning revenue from hits on the parking page.²⁴⁴ That court did not reach a determination on liability because the trademark at issue was neither famous nor distinctive.²⁴⁵

D. International Registrars

Sophisticated cybersquatters have found ways to exploit jurisdictional issues with cybersquatting.²⁴⁶ To circumvent the system, U.S. registrants register domain names through registrars located in foreign countries that are not

²⁴⁰ *Vulcan Golf*, 552 F. Supp. 2d at 759 n.2 (quoting First Amended Complaint, *supra* note 239, at para. 83(u)) (internal quotation marks omitted).

²⁴¹ This is also referred to as “pay per click” or “cost per click.” See *Pay Per Click*, WIKIPEDIA, http://en.wikipedia.org/wiki/Pay_per_click (last visited Apr. 2, 2011).

²⁴² *Cash Parking: Turn Your Parked Domain into Cash!*, *supra* note 238.

²⁴³ See, e.g., *Gen. Media Commc’ns, Inc. v. Crazy Troll, L.L.C.*, No. 06 Civ. 40581 LAKFM, 2007 WL 102988, at *3 (S.D.N.Y. Jan. 16, 2007) (noting that penthousebo-tique.com “directed web users to a variety of internet websites almost totally unrelated to . . . the Penthouse marks, or the Penthouse Boutique, including links to websites concerned with travel, entertainment, finance, business, and pornography”).

²⁴⁴ *Philbrick v. eNom, Inc.*, 593 F. Supp. 2d 352, 366 (D.N.H. 2009).

²⁴⁵ *Id.*

²⁴⁶ See *supra* note 161.

obligated to honor U.S. court orders.²⁴⁷ Trademark owners in this situation have several options. First, they can file a lawsuit in the location of the registry²⁴⁸ (in the case of “.com,” the Eastern District of Virginia, where VeriSign, the “.com” registry, is located) seeking preliminary and permanent injunctive relief. The preliminary and permanent injunctive orders should include language that the *registry or current registrar* shall transfer the domain name at issue to the trademark owner.²⁴⁹ In this case, the registry is a “thin registry,”²⁵⁰ meaning that VeriSign can only move the domain name to another registrar, which will then have to move the domain name into the trademark owner’s domain name account.²⁵¹ If a foreign registrar declines to follow the U.S. court order, the domain name will not be on registrar-hold, which would prohibit the moving of the domain and the registrant will have the ability to move or transfer the domain name to other registrars, requiring the trademark owner to chase the domain name from registrar to registrar.²⁵² The generic description of “current registrar” in the injunction orders is important to allow for the possibility of registrar changes during the pendency of litigation.²⁵³ Alternatively, the trademark owner can file a UDRP proceeding or file an *in rem* lawsuit to recover the domain name.

E. Reverse Domain Name Hijacking

In reverse domain name hijacking cases, unlike other issues within cybersquatting, the lawful trademark owner is the “bad guy.” Reverse domain name hijacking occurs when a trademark owner attempts to force a domain name registrant to transfer a lawfully obtained domain name.²⁵⁴ One commentator calls reverse domain name hijacking a form of trademark bullying where “a trademark owner uses his trademark rights to harass and intimidate another beyond what the law might be reasonably interpreted to allow.”²⁵⁵ Former circuit judge and current Supreme Court Justice Sonia Sotomayor authored the opinion in *Storey v. Cello Holdings, LLC*, in which she described reverse domain name hijacking as “the overreaching use of the mechanisms established to remedy cybersquatting against a registrant with a legitimate interest in his domain name.”²⁵⁶ Court cases involving reverse domain name hijacking are limited.²⁵⁷ However, a search of the National Arbitration Forum domain deci-

²⁴⁷ See *Protecting Your Domains—Going Offshore to Canada*, DOMAIN BITS (Nov. 4, 2008), <http://www.domainbits.com/protecting-domains-offshore/>.

²⁴⁸ 15 U.S.C. § 1125(d)(2)(C) (2006).

²⁴⁹ Personal experience of author while working at Lewis and Roca LLP.

²⁵⁰ 1-1 McGRADY ON DOMAIN NAMES, *supra* note 16, § 1.10[1][a] (2010).

²⁵¹ Personal experience of author while working at Lewis and Roca LLP.

²⁵² See *Guide to Domain Name Status Codes*, DOMAINTOOLS, <http://whois.domaintools.com/domain-help/status-codes.php> (last visited Apr. 2, 2011).

²⁵³ Personal experience of author while working at Lewis and Roca LLP.

²⁵⁴ Darren Heitner, *X6D Limited Found to Have Engaged in Reverse Domain Name Hijacking*, CHANGELEGAL.COM (Dec. 29, 2010), <http://changelegal.com/category/intellectual-property/trademarks/>.

²⁵⁵ *Id.*

²⁵⁶ *Storey v. Cello Holdings, L.L.C.*, 347 F.3d 370, 373 (2d Cir. 2003).

²⁵⁷ The ACPA provides limited recourse for reverse domain name hijacking:

sions reveals that reverse domain name hijacking is often alleged in those proceedings.²⁵⁸ Under Rule 15(e) of the Rules for the UDRP,

[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.²⁵⁹

In order to sustain a claim of reverse domain name hijacking under the UDRP, the respondent must show that the claimant knew of the respondent's legitimate interest and brought the proceeding in bad faith.²⁶⁰ Arbitrators presiding over UDRP proceedings rarely grant claims of reverse domain name hijacking.²⁶¹ To be sure, a search of WIPO decisions where reverse domain name hijacking was found reveals only thirty-two cases as of early March 2011.²⁶² However, this does not mean that reverse domain name hijacking is not an ongoing concern for domain name registrants. Rather, it is highly likely that instances of reverse domain name hijacking are merely unreported or underreported.²⁶³ The ACPA does not explicitly address reverse domain name hijacking.

VI. ADAPTING FORWARD: SUGGESTIONS FOR THE FUTURE

Although it has been a short ten years since Congress enacted the ACPA and ICANN implemented the UDRP, in *technology years*, it has been an eternity. Technology moves fast—much faster than the law. Indeed, each release of a new top-level domain opens the door to another wave of cybersquatting for trademark owners.²⁶⁴ Some commentators suggest that an online dispute resolution procedure, similar to the UDRP for domain names, is the wave of the

A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.

15 U.S.C. § 1114(2)(D)(v) (2006).

²⁵⁸ See *Doman Name Dispute Proceedings and Decisions*, NAT'L ARB. F., <http://domains.adrforum.com/decision.aspx> (last visited Apr. 2, 2011).

²⁵⁹ *Rules for Uniform Domain Name Dispute Resolution Policy*, ICANN, R. 15(e), <http://www.icann.org/en/dndr/udrp/uniform-rules.htm> (last visited Apr. 2, 2011).

²⁶⁰ *Ardyss Int'l Inc. v. Lauren Silva Grp., Inc.*, No. FA0912001296536, at *10 (Nat'l Arb. Forum Jan. 14, 2010), available at <http://domains.adrforum.com/domains/decisions/1296536.htm>.

²⁶¹ *Id.*

²⁶² See *Index of WIPO UDRP Panel Decisions*, WIPO, <http://www.wipo.int/amc/en/domains/search/legalindex.jsp> (last visited Apr. 2, 2011). Unfortunately, a similar detailed search method is not available for National Arbitration Forum proceedings.

²⁶³ See Posting of Shari Steel, sstele@eff.org, to comment-udrp@icann.org (Aug. 24, 1999), <http://www.icann.org/en/comments-mail/comment-udrp/current/msg00015.html>.

²⁶⁴ *Concerns Rising over Domain Name Dispute Procedures*, *supra* note 138 (noting that when the hotel gTLD is released there will be “an entirely new marketplace for cybersquatters”) (internal quotation marks omitted); Catherine Saez & William New, *WIPO Sees Decrease in Cybersquatting Complaints, Warns of Domain Name Expansion*, INTELL. PROP.

future.²⁶⁵ Although such a procedure may ultimately be the wave of the future, much can be done to address current issues by the enactment of state cybersquatting laws and amendments to the ACPA and UDRP.

A. *Deterrents under State Law*

States should enact some form of cybersquatting prevention statute that either mimics the ACPA or provides some minimum threshold of protection. A handful of jurisdictions have already enacted statutes to deal with cybersquatting,²⁶⁶ but protection under these state statutes is often limited in scope compared to the ACPA. States could remedy this by carving out protection for state-registered trademarks to provide smaller trademark owners, which may not have a famous or distinctive trademark, with some level of protection.

Utah's legislation, passed in 2009, is an example of state legislation that is aggressive, but stops short by limiting protections to small businesses. The Utah E-Commerce Integrity Act (the Utah Act)²⁶⁷ largely follows the language of the ACPA with a couple of notable exceptions. First, although the statute provides for the same statutory damages as provided under the ACPA (not less than \$1,000 and not more than \$100,000 per domain name) the legislation provides for presumed statutory damages in the amount of \$100,000 per domain name "if there is a pattern and practice of infringements committed willfully for commercial gain."²⁶⁸ This provision will undoubtedly serve as an enormous deterrent for cybersquatters.

Another significant addition to the Utah Act is that it provides for liability that reaches beyond the domain name registrant. Liability under the Utah Act casts a wide net over anyone acting as the registrant's agent or representative and the domain name registrar and the domain name registry, provided that assistance was knowingly provided to the registrant.²⁶⁹ Unsurprisingly, this legislation has the support of the Coalition Against Domain Name Abuse (CADNA),²⁷⁰ whose membership is comprised of companies such as Dell, Verizon Communications, and Nike.²⁷¹ CADNA anticipates that the Utah legislation will get the ball rolling for similar changes at the federal level.²⁷²

WATCH (Mar. 23, 2010, 12:01 AM), <http://www.ip-watch.org/weblog/2010/03/23/wipo-sees-decrease-in-cybersquatting-complaints-warns-of-internet-domain-expansion/>.

²⁶⁵ *Concerns Rising over Domain Name Dispute Procedures*, *supra* note 138 (noting that there is a "'screaming need' for more third-party dispute resolution").

²⁶⁶ *See, e.g.*, CAL. BUS. & PROF. CODE § 17525 (West 2008); HAW. REV. STAT. § 481B-22 (West 2008); N.Y. GEN. BUS. LAW § 148 (McKinney Supp. 2011); OKLA. STAT. ANN. tit. 15, § 776.10 (West Supp. 2011).

²⁶⁷ Utah E-Commerce Integrity Act, S. 58-26, Gen. Sess. (Utah 2010), *available at* <http://le.utah.gov/~2010/bills/sbillint/sb0026.htm>.

²⁶⁸ UTAH CODE ANN. § 70-3a-402(4) (West Supp. 2010).

²⁶⁹ *Id.* § 70-3a-309(1)(d)(i). Additionally, the Utah Act provides both civil and criminal penalties for other Internet-related conduct, including spyware, pharming, and phishing. Utah S. 58-26.

²⁷⁰ CADNA Releases Letter of Support for the Utah E-Commerce Integrity Act, CADNA (Dec. 16, 2009), <http://www.cadna.org/en/newsroom/press-releases/utah-legislation-release>.

²⁷¹ *See* CADNA Member Organizations, CADNA, <http://www.cadna.org/en/members> (last visited Apr. 2, 2011).

²⁷² CADNA Releases Letter of Support for the Utah E-Commerce Integrity Act, *supra* note 270.

B. Amendments to the ACPA

The ACPA can stretch to reach the contours of new technological issues since its enactment in 1999. Congress intended the ACPA to provide a remedy for “a narrow class of wrongdoing.”²⁷³ However, courts have customarily treated the ACPA as a flexible statute.²⁷⁴ Moreover, because of the availability of large statutory damages, trademark owners are incentivized to shape their claims to fit within the ACPA.²⁷⁵ It is clear that the ACPA cannot adequately serve the future needs of consumers and trademark owners. Congress should amend the ACPA to address new technological advances and provide trademark owners and the courts with flexibility.

1. Damages

Congress should follow the lead of the Utah Act and provide presumed statutory damages for cybersquatters with a pattern and practice of infringement. Some cybersquatters are in the business of registering mass amounts of domain names and selling them for a profit. Amending the ACPA to include presumed statutory damages for the most brazen cybersquatters would act as a significant deterrent that will benefit all trademark owners. Moreover, the ACPA amendment should codify the common law rule that ACPA judgments are not dischargeable in bankruptcy. This amendment, too, will act as a significant cybersquatter deterrent.

2. Registrar Liability

Congress should amend the ACPA to provide a remedy against domain name registrars who knowingly offer pay-per-click services via parking pages that are keyed to trade off of the goodwill of trademarks. Specifically, the second element of the ACPA should provide a supplemental cause of action to include a registrar that uses a domain name to generate revenue. The amendment should be drafted in such a way that the registrar would maintain its safe harbor for registering a domain name, but would be liable for providing pay-per-click services utilizing the famous or distinct trademarks of others.

To protect registrars from broad liability for offering parking services, the statute should provide a five-day “claw back” provision. This provision would function similar to the “notice and take down” procedure found in the Digital Millennium Copyright Act.²⁷⁶ A trademark owner would provide the registrar with notice that its trademarks are being used in the parking page, along with a copy of a federal trademark registration, or copy of a court order declaring the trademarks to be famous or distinctive in the absence of a registration. The registrar would then have five business days to remove the parking page. Failure to remove the parking page would expose the registrar to liability under the ACPA.

²⁷³ *Solid Host, NL v. Namecheap, Inc.*, 625 F. Supp. 2d 1092, 1102 (C.D. Cal. 2009).

²⁷⁴ Jian Xiao, *The First Wave of Cases Under the ACPA*, 17 BERKELEY TECH. L.J. 159, 171 (2002).

²⁷⁵ *See id.* at 170.

²⁷⁶ *See* 17 U.S.C. § 512(d)(1)(C) (2006).

Moreover, the ACPA should require a domain name registrar to disable the website upon receiving a verified notice of cybersquatting dispute. Although registrars do not wish to be the arbiters of trademark rights, requiring them to take the website down, subject to the current safe harbor provisions, would be in the best interest of consumers. If the cybersquatter claims a legitimate use and provides evidence of the same (such as a business license or state trademark registration) the registrar would be permitted to reinstate the website pending resolution of the dispute by the courts.

With regard to private registration services, Congress should amend the ACPA to require the immediate cancellation of the registration service upon a verified notice of a cybersquatting dispute. Although many privacy registration services reserve the right to cancel the service upon notice of a dispute, many require the filing of a complaint before they will do so. This requirement adds an extra layer of complication for trademark owners. As such, the ACPA should provide that a verified notice of cybersquatting dispute is sufficient to cancel the privacy service.

3. Subdomains, Usernames, and E-mail Addresses

Congress should amend the ACPA to include bad faith use of subdomains, usernames, and e-mail addresses. The amendment should empower Internet service providers to take down or disable websites containing subdomains, usernames or e-mail addresses containing the famous or distinctive trademarks of others upon a verified notice of infringement. Often usernames and e-mail addresses are used in conjunction with phishing or pharming scams, as well as the sale of counterfeit goods. Although this category of Internet-related conduct does not fall squarely within the dominion of “cybersquatting,” it is closely related and similarly stands to cause consumer confusion.

4. Reverse Domain Name Hijacking

To balance the protections afforded under the ACPA, Congress should amend the ACPA to include a prohibition on reverse domain name hijacking. Trademark owners with famous or distinctive trademarks are typically large companies with significant financial and legal resources. Indeed, these trademark owners are in a position to demand that a domain name be turned over to them, even in the case of a lawfully registered domain name (either registered before the trademark became famous or distinctive, or subject to a fair use defense) under the threat of litigation. Some trademark owners are no longer as concerned with consumer confusion and they merely feel entitled to own all domain names containing their trademarks. If taken to task, these reverse domain name hijacking trademark owners would likely lose a claim under the ACPA, with lawful domain name registrants incurring legal fees to defend themselves.

In order to discourage reverse domain name hijacking, Congress should amend the ACPA to include a statutory damage award, plus attorneys’ fees, against any trademark owner that engages in reverse domain name hijacking. The amendment should provide that reverse domain name hijacking is available as an affirmative defense or as an affirmative cause of action. Including an

award of attorneys' fees is appropriate for two reasons. First, reverse domain name hijacking is arguably bad faith conduct that fits into the overall purpose of the ACPA. Second, recovery of attorneys' fees would encourage attorneys to represent lawful domain name registrants on a contingency basis, thereby giving lawful domain name registrants a real chance to succeed on the merits.

5. *International Registrars*

The Internet and cybersquatters are worldwide in scope, yet laws and regulations have focused on and in the United States. Indeed, savvy U.S.-based cybersquatters will often choose foreign registrars specifically to evade liability under the ACPA. Although trademark owners can recover a domain name under the UDRP, they have to submit to the foreign registrar's jurisdiction for post-UDRP judicial review. Thus, it would be useful to have an international treaty, such as the Berne Convention that addresses copyrights, to deal with cybersquatters and to allow for the recovery of the domain name as well as damages. For example, it would be useful to have an international agreement regarding the transfer of domain names between foreign registrars and U.S. registrars and/or an agreement regarding honoring U.S. court orders regarding domain transfers. Full consideration of existing treaties and other international duties and obligations should be evaluated to see whether similar obligations exist in other contexts.

6. *Trademark Ombudsman*

Although the amendments identified above should provide considerable deterrent and protection to trademark owners, Congress could amend the ACPA to provide for a "trademark ombudsman" within the United States Patent and Trademark Office to assist trademark owners in their fights against cybersquatters.

During the trademark application process, a trademark owner could elect to have their trademark added to the ombudsman program for an additional fee. Once a trademark is registered, the trademark ombudsman would notify ICANN of the trademark registration, which would then be added to a database that is accessible to domain name registrars. Whenever a domain name is registered that contains the trademark or comes close to the trademark (for instance, typosquatting), an e-mail notification would be generated and sent to the trademark owner. By participating in the trademark ombudsman program, the trademark owner would agree to exhaust administrative remedies under the UDRP prior to filing suit, unless extenuating circumstances existed. If there is a particularly egregious domain registration and use, the trademark owner could request an exemption from going through the UDRP prior to proceeding to litigation. This program would help keep down the costs associated with litigation for all the parties involved.

C. *Amendments to the UDRP*

The UDRP seems to have fulfilled its chief purpose, yet there is room for improvement with amendment of the UDRP. First, to have consistent rulings in UDRP cases, each case should be given precedential value. One complaint

among commentators is that UDRP decisions have no value beyond the cases in which they are rendered, and decisions can be inconsistent.²⁷⁷ Amending the UDRP to give these decisions precedential value would alleviate this concern.

Second, ICANN should amend the UDRP's rules regarding the number of respondents allowed per complaint. Currently, the UDRP requires that the complaint name only one respondent.²⁷⁸ In order to make the UDRP more cost effective and efficient, ICANN should amend the UDRP to allow trademark owners to recover multiple domain names registered by multiple registrants in one proceeding. This amendment would provide trademark owners a more cost efficient and expeditious return of their domain names.

A recent UDRP panel has addressed the inverse situation: multiple complainants with one respondent.²⁷⁹ That panel determined that allowing multiple complainants to file against one respondent is

consistent with the aim of the UDRP to combat cybersquatting in as efficient and cost effective a manner as is fairly possible. However the test must be applied judiciously and depending upon the circumstances of particular cases may require the exercise of a panel's discretion in adapting it as appropriate.²⁸⁰

ICANN should amend the UDRP consistent with this panel's holding to allow for the multi-complainant situation.

VI. CONCLUSION

Cybersquatters are a serious threat to trademark owners and consumers. Cybersquatters exploit consumer confusion by using famous or distinctive trademarks of others in their domain names and damage the goodwill and reputation of those trademarks. The Anticybersquatting Consumer Protection Act and Uniform Domain Name Dispute Resolution Policy have provided a good framework for combating cybersquatters. In general, the ACPA is more favorable in remedy with statutory damages and the possibility of attorneys' fees, but is costly and time-consuming to prosecute. By contrast, the UDRP is generally inexpensive and quick, but with very limited remedies. Both the ACPA and UDRP have different burden of proof requirements, which means the type of cybersquatting may determine the best route to proceed.

As technology advances and cybersquatters become more sophisticated and identify loopholes in current law, the current statutory and regulatory framework becomes inadequate. Congress enacted the ACPA to apply to a narrow class of conduct, which the courts continue to stretch beyond those

²⁷⁷ MHB, *WIPO Takes 13 Year Old Domain Sporto.com: Saying "UDRP Does Not Operate on a Strict Doctrine of Precedent,"* DOMAINS (Mar. 5, 2010), <http://www.thedomains.com/2010/03/05/wipo-takes-13-year-old-domain-sporto-com-saying-udrp-does-not-operate-on-a-strict-doctrine-of-precedent/> (noting that the unpredictable decisions render UDRP proceedings a "crap shoot").

²⁷⁸ See *Rules for Uniform Domain Name Dispute Resolution Policy*, *supra* note 259, R. 3(c) (allowing multiple domain names to be adjudicated, but only against a single name owner).

²⁷⁹ *Fulham Football Club (1987) Ltd. v. Domains by Proxy, Inc.*, No. D2009-0331 (WIPO Arb. & Med. Ctr. May 12, 2009), <http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0331.html>.

²⁸⁰ *Id.*

narrow bounds. In light of new technological advances, Congress needs to revisit the ACPA to ensure strong consumer protection, protection of trademark owners, and the rights of lawful domain name registrants.

