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106TH CONGRESS  
1ST SESSION

# S. 1948

To amend the provisions of title 17, United States Code, and the Communications Act of 1934, relating to copyright licensing and carriage of broadcast signals by satellite.

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## IN THE SENATE OF THE UNITED STATES

NOVEMBER 17, 1999

Mr. LOTT introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend the provisions of title 17, United States Code, and the Communications Act of 1934, relating to copyright licensing and carriage of broadcast signals by satellite.

1 *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE; TABLE OF CONTENTS.**

4 (a) **SHORT TITLE.**—This Act may be cited as the  
5 “Intellectual Property and Communications Omnibus Re-  
6 form Act of 1999”.

7 (b) **TABLE OF CONTENTS.**—The table of contents of  
8 this Act is as follows:

1           (1) an analysis of the extent to which local sig-  
2 nals are being provided by direct-to-home satellite  
3 television providers and by other multichannel video  
4 program distributors;

5           (2) an enumeration of the technical, economic,  
6 and other impediments each type of multichannel  
7 video programming distributor has encountered; and

8           (3) recommendations for specific measures to  
9 facilitate the provision of local signals to subscribers  
10 in unserved and underserved markets by direct-to-  
11 home satellite television providers and by other dis-  
12 tributors of multichannel video programming service.

### 13           **TITLE III—TRADEMARK** 14           **CYBERPIRACY PREVENTION**

#### 15           **SEC. 3001. SHORT TITLE; REFERENCES.**

16           (a) **SHORT TITLE.**—This title may be cited as the  
17 “Anticybersquatting Consumer Protection Act”.

18           (b) **REFERENCES TO THE TRADEMARK ACT OF**  
19 **1946.**—Any reference in this title to the Trademark Act  
20 of 1946 shall be a reference to the Act entitled “An Act  
21 to provide for the registration and protection of trade-  
22 marks used in commerce, to carry out the provisions of  
23 certain international conventions, and for other purposes”,  
24 approved July 5, 1946 (15 U.S.C. 1051 et seq.).

1 **SEC. 3002. CYBERPIRACY PREVENTION.**

2 (a) IN GENERAL.—Section 43 of the Trademark Act  
3 of 1946 (15 U.S.C. 1125) is amended by inserting at the  
4 end the following:

5 “(d)(1)(A) A person shall be liable in a civil action  
6 by the owner of a mark, including a personal name which  
7 is protected as a mark under this section, if, without re-  
8 gard to the goods or services of the parties, that person—

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

12 “(ii) registers, traffics in, or uses a domain  
13 name that—

14 “(I) in the case of a mark that is distinc-  
15 tive at the time of registration of the domain  
16 name, is identical or confusingly similar to that  
17 mark;

18 “(II) in the case of a famous mark that is  
19 famous at the time of registration of the do-  
20 main name, is identical or confusingly similar  
21 to or dilutive of that mark; or

22 “(III) is a trademark, word, or name pro-  
23 tected by reason of section 706 of title 18,  
24 United States Code, or section 220506 of title  
25 36, United States Code.

1       “(B)(i) In determining whether a person has a bad  
2 faith intent described under subparagraph (A), a court  
3 may consider factors such as, but not limited to—

4           “(I) the trademark or other intellectual prop-  
5 erty rights of the person, if any, in the domain  
6 name;

7           “(II) the extent to which the domain name con-  
8 sists of the legal name of the person or a name that  
9 is otherwise commonly used to identify that person;

10          “(III) the person’s prior use, if any, of the do-  
11 main name in connection with the bona fide offering  
12 of any goods or services;

13          “(IV) the person’s bona fide noncommercial or  
14 fair use of the mark in a site accessible under the  
15 domain name;

16          “(V) the person’s intent to divert consumers  
17 from the mark owner’s online location to a site ac-  
18 cessible under the domain name that could harm the  
19 goodwill represented by the mark, either for com-  
20 mercial gain or with the intent to tarnish or dispar-  
21 age the mark, by creating a likelihood of confusion  
22 as to the source, sponsorship, affiliation, or endorse-  
23 ment of the site;

24          “(VI) the person’s offer to transfer, sell, or oth-  
25 erwise assign the domain name to the mark owner

1 or any third party for financial gain without having  
2 used, or having an intent to use, the domain name  
3 in the bona fide offering of any goods or services, or  
4 the person's prior conduct indicating a pattern of  
5 such conduct;

6 “(VII) the person's provision of material and  
7 misleading false contact information when applying  
8 for the registration of the domain name, the per-  
9 son's intentional failure to maintain accurate contact  
10 information, or the person's prior conduct indicating  
11 a pattern of such conduct;

12 “(VIII) the person's registration or acquisition  
13 of multiple domain names which the person knows  
14 are identical or confusingly similar to marks of oth-  
15 ers that are distinctive at the time of registration of  
16 such domain names, or dilutive of famous marks of  
17 others that are famous at the time of registration of  
18 such domain names, without regard to the goods or  
19 services of the parties; and

20 “(IX) the extent to which the mark incor-  
21 porated in the person's domain name registration is  
22 or is not distinctive and famous within the meaning  
23 of subsection (c)(1) of section 43.

24 “(ii) Bad faith intent described under subparagraph  
25 (A) shall not be found in any case in which the court de-

1 termines that the person believed and had reasonable  
2 grounds to believe that the use of the domain name was  
3 a fair use or otherwise lawful.

4 “(C) In any civil action involving the registration,  
5 trafficking, or use of a domain name under this para-  
6 graph, a court may order the forfeiture or cancellation of  
7 the domain name or the transfer of the domain name to  
8 the owner of the mark.

9 “(D) A person shall be liable for using a domain  
10 name under subparagraph (A) only if that person is the  
11 domain name registrant or that registrant’s authorized li-  
12 censee.

13 “(E) As used in this paragraph, the term ‘traffics in’  
14 refers to transactions that include, but are not limited to,  
15 sales, purchases, loans, pledges, licenses, exchanges of cur-  
16 rency, and any other transfer for consideration or receipt  
17 in exchange for consideration.

18 “(2)(A) The owner of a mark may file an in rem civil  
19 action against a domain name in the judicial district in  
20 which the domain name registrar, domain name registry,  
21 or other domain name authority that registered or as-  
22 signed the domain name is located if—

23 “(i) the domain name violates any right of the  
24 owner of a mark registered in the Patent and Trade-

1 mark Office, or protected under subsection (a) or  
2 (c); and

3 “(ii) the court finds that the owner—

4 “(I) is not able to obtain in personam ju-  
5 risdiction over a person who would have been a  
6 defendant in a civil action under paragraph (1);  
7 or

8 “(II) through due diligence was not able to  
9 find a person who would have been a defendant  
10 in a civil action under paragraph (1) by—

11 “(aa) sending a notice of the alleged  
12 violation and intent to proceed under this  
13 paragraph to the registrant of the domain  
14 name at the postal and e-mail address pro-  
15 vided by the registrant to the registrar;  
16 and

17 “(bb) publishing notice of the action  
18 as the court may direct promptly after fil-  
19 ing the action.

20 “(B) The actions under subparagraph (A)(ii) shall  
21 constitute service of process.

22 “(C) In an in rem action under this paragraph, a do-  
23 main name shall be deemed to have its situs in the judicial  
24 district in which—



1           “(i) the domain name registrar, registry, or  
2           other domain name authority that registered or as-  
3           signed the domain name is located; or

4           “(ii) documents sufficient to establish control  
5           and authority regarding the disposition of the reg-  
6           istration and use of the domain name are deposited  
7           with the court.

8           “(D)(i) The remedies in an in rem action under this  
9           paragraph shall be limited to a court order for the for-  
10          feiture or cancellation of the domain name or the transfer  
11          of the domain name to the owner of the mark. Upon re-  
12          ceipt of written notification of a filed, stamped copy of  
13          a complaint filed by the owner of a mark in a United  
14          States district court under this paragraph, the domain  
15          name registrar, domain name registry, or other domain  
16          name authority shall—

17                 “(I) expeditiously deposit with the court docu-  
18                 ments sufficient to establish the court’s control and  
19                 authority regarding the disposition of the registra-  
20                 tion and use of the domain name to the court; and

21                 “(II) not transfer, suspend, or otherwise modify  
22                 the domain name during the pendency of the action,  
23                 except upon order of the court.

24           “(ii) The domain name registrar or registry or other  
25          domain name authority shall not be liable for injunctive

1 or monetary relief under this paragraph except in the case  
2 of bad faith or reckless disregard, which includes a willful  
3 failure to comply with any such court order.

4 “(3) The civil action established under paragraph (1)  
5 and the in rem action established under paragraph (2),  
6 and any remedy available under either such action, shall  
7 be in addition to any other civil action or remedy otherwise  
8 applicable.

9 “(4) The in rem jurisdiction established under para-  
10 graph (2) shall be in addition to any other jurisdiction  
11 that otherwise exists, whether in rem or in personam.”.

12 (b) CYBERPIRACY PROTECTIONS FOR INDIVID-  
13 UALS.—

14 (1) IN GENERAL.—

15 (A) CIVIL LIABILITY.—Any person who  
16 registers a domain name that consists of the  
17 name of another living person, or a name sub-  
18 stantially and confusingly similar thereto, with-  
19 out that person’s consent, with the specific in-  
20 tent to profit from such name by selling the do-  
21 main name for financial gain to that person or  
22 any third party, shall be liable in a civil action  
23 by such person.

24 (B) EXCEPTION.—A person who in good  
25 faith registers a domain name consisting of the

1 name of another living person, or a name sub-  
2 stantially and confusingly similar thereto, shall  
3 not be liable under this paragraph if such name  
4 is used in, affiliated with, or related to a work  
5 of authorship protected under title 17, United  
6 States Code, including a work made for hire as  
7 defined in section 101 of title 17, United States  
8 Code, and if the person registering the domain  
9 name is the copyright owner or licensee of the  
10 work, the person intends to sell the domain  
11 name in conjunction with the lawful exploitation  
12 of the work, and such registration is not prohib-  
13 ited by a contract between the registrant and  
14 the named person. The exception under this  
15 subparagraph shall apply only to a civil action  
16 brought under paragraph (1) and shall in no  
17 manner limit the protections afforded under the  
18 Trademark Act of 1946 (15 U.S.C. 1051 et  
19 seq.) or other provision of Federal or State law.

20 (2) REMEDIES.—In any civil action brought  
21 under paragraph (1), a court may award injunctive  
22 relief, including the forfeiture or cancellation of the  
23 domain name or the transfer of the domain name to  
24 the plaintiff. The court may also, in its discretion,

1 award costs and attorneys fees to the prevailing  
2 party.

3 (3) DEFINITION.—In this subsection, the term  
4 “domain name” has the meaning given that term in  
5 section 45 of the Trademark Act of 1946 (15 U.S.C.  
6 1127).

7 (4) EFFECTIVE DATE.—This subsection shall  
8 apply to domain names registered on or after the  
9 date of the enactment of this Act.

10 **SEC. 3003. DAMAGES AND REMEDIES.**

11 (a) REMEDIES IN CASES OF DOMAIN NAME PI-  
12 RACY.—

13 (1) INJUNCTIONS.—Section 34(a) of the Trade-  
14 mark Act of 1946 (15 U.S.C. 1116(a)) is amended  
15 in the first sentence by striking “(a) or (c)” and in-  
16 serting “(a), (c), or (d)”.

17 (2) DAMAGES.—Section 35(a) of the Trade-  
18 mark Act of 1946 (15 U.S.C. 1117(a)) is amended  
19 in the first sentence by inserting “, (c), or (d)” after  
20 “section 43(a)”.

21 (b) STATUTORY DAMAGES.—Section 35 of the Trade-  
22 mark Act of 1946 (15 U.S.C. 1117) is amended by adding  
23 at the end the following:

24 “(d) In a case involving a violation of section  
25 43(d)(1), the plaintiff may elect, at any time before final

1 judgment is rendered by the trial court, to recover, instead  
2 of actual damages and profits, an award of statutory dam-  
3 ages in the amount of not less than \$1,000 and not more  
4 than \$100,000 per domain name, as the court considers  
5 just.

6 **SEC. 3004. LIMITATION ON LIABILITY.**

7 Section 32(2) of the Trademark Act of 1946 (15  
8 U.S.C. 1114) is amended—

9 (1) in the matter preceding subparagraph (A)  
10 by striking “under section 43(a)” and inserting  
11 “under section 43(a) or (d)”; and

12 (2) by redesignating subparagraph (D) as sub-  
13 paragraph (E) and inserting after subparagraph (C)  
14 the following:

15 “(D)(i)(I) A domain name registrar, a domain  
16 name registry, or other domain name registration  
17 authority that takes any action described under  
18 clause (ii) affecting a domain name shall not be lia-  
19 ble for monetary relief or, except as provided in sub-  
20 clause (II), for injunctive relief, to any person for  
21 such action, regardless of whether the domain name  
22 is finally determined to infringe or dilute the mark.

23 “(II) A domain name registrar, domain name  
24 registry, or other domain name registration author-  
25 ity described in subclause (I) may be subject to in-

1       junctive relief only if such registrar, registry, or  
2       other registration authority has—

3               “(aa) not expeditiously deposited with a  
4               court, in which an action has been filed regard-  
5               ing the disposition of the domain name, docu-  
6               ments sufficient for the court to establish the  
7               court’s control and authority regarding the dis-  
8               position of the registration and use of the do-  
9               main name;

10              “(bb) transferred, suspended, or otherwise  
11              modified the domain name during the pendency  
12              of the action, except upon order of the court; or

13              “(cc) willfully failed to comply with any  
14              such court order.

15              “(ii) An action referred to under clause (i)(I) is  
16              any action of refusing to register, removing from  
17              registration, transferring, temporarily disabling, or  
18              permanently canceling a domain name—

19              “(I) in compliance with a court order  
20              under section 43(d); or

21              “(II) in the implementation of a reasonable  
22              policy by such registrar, registry, or authority  
23              prohibiting the registration of a domain name  
24              that is identical to, confusingly similar to, or di-  
25              lutive of another’s mark.

1           “(iii) A domain name registrar, a domain name  
2 registry, or other domain name registration author-  
3 ity shall not be liable for damages under this section  
4 for the registration or maintenance of a domain  
5 name for another absent a showing of bad faith in-  
6 tent to profit from such registration or maintenance  
7 of the domain name.

8           “(iv) If a registrar, registry, or other registra-  
9 tion authority takes an action described under clause  
10 (ii) based on a knowing and material misrepresenta-  
11 tion by any other person that a domain name is  
12 identical to, confusingly similar to, or dilutive of a  
13 mark, the person making the knowing and material  
14 misrepresentation shall be liable for any damages,  
15 including costs and attorney’s fees, incurred by the  
16 domain name registrant as a result of such action.  
17 The court may also grant injunctive relief to the do-  
18 main name registrant, including the reactivation of  
19 the domain name or the transfer of the domain  
20 name to the domain name registrant.

21           “(v) A domain name registrant whose domain  
22 name has been suspended, disabled, or transferred  
23 under a policy described under clause (ii)(II) may,  
24 upon notice to the mark owner, file a civil action to  
25 establish that the registration or use of the domain

1 name by such registrant is not unlawful under this  
2 Act. The court may grant injunctive relief to the do-  
3 main name registrant, including the reactivation of  
4 the domain name or transfer of the domain name to  
5 the domain name registrant.”.

6 **SEC. 3005. DEFINITIONS.**

7 Section 45 of the Trademark Act of 1946 (15 U.S.C.  
8 1127) is amended by inserting after the undesignated  
9 paragraph defining the term “counterfeit” the following:  
10 “The term ‘domain name’ means any alphanumeric  
11 designation which is registered with or assigned by any  
12 domain name registrar, domain name registry, or other  
13 domain name registration authority as part of an elec-  
14 tronic address on the Internet.

15 “The term ‘Internet’ has the meaning given that term  
16 in section 230(f)(1) of the Communications Act of 1934  
17 (47 U.S.C. 230(f)(1)).”.

18 **SEC. 3006. STUDY ON ABUSIVE DOMAIN NAME REGISTRA-**  
19 **TIONS INVOLVING PERSONAL NAMES.**

20 (a) IN GENERAL.—Not later than 180 days after the  
21 date of the enactment of this Act, the Secretary of Com-  
22 merce, in consultation with the Patent and Trademark Of-  
23 fice and the Federal Election Commission, shall conduct  
24 a study and report to Congress with recommendations on  
25 guidelines and procedures for resolving disputes involving



1 the registration or use by a person of a domain name that  
2 includes the personal name of another person, in whole  
3 or in part, or a name confusingly similar thereto, including  
4 consideration of and recommendations for—

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

10           (2) protecting individuals from bad faith uses of  
11           their personal names as second level domain names  
12           by others with malicious intent to harm the reputa-  
13           tion of the individual or the goodwill associated with  
14           that individual's name;

15           (3) protecting consumers from the registration  
16           and use of domain names that include personal  
17           names in the second level domain in manners which  
18           are intended or are likely to confuse or deceive the  
19           public as to the affiliation, connection, or association  
20           of the domain name registrant, or a site accessible  
21           under the domain name, with such other person, or  
22           as to the origin, sponsorship, or approval of the  
23           goods, services, or commercial activities of the do-  
24           main name registrant;

1           (4) protecting the public from registration of  
2 domain names that include the personal names of  
3 government officials, official candidates, and poten-  
4 tial official candidates for Federal, State, or local  
5 political office in the United States, and the use of  
6 such domain names in a manner that disrupts the  
7 electoral process or the public's ability to access ac-  
8 curate and reliable information regarding such indi-  
9 viduals;

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

14           (6) the guidelines, procedures, and policies of  
15 the Internet Corporation for Assigned Names and  
16 Numbers and the extent to which they address the  
17 considerations described in paragraphs (1) through  
18 (4).

19           (b) GUIDELINES AND PROCEDURES.—The Secretary  
20 of Commerce shall, under its Memorandum of Under-  
21 standing with the Internet Corporation for Assigned  
22 Names and Numbers, collaborate to develop guidelines  
23 and procedures for resolving disputes involving the reg-  
24 istration or use by a person of a domain name that in-

1 cludes the personal name of another person, in whole or  
2 in part, or a name confusingly similar thereto.

3 **SEC. 3007. HISTORIC PRESERVATION.**

4 Section 101(a)(1)(A) of the National Historic Preser-  
5 vation Act (16 U.S.C. 470a(a)(1)(A)) is amended by add-  
6 ing at the end the following: “Notwithstanding section  
7 43(c) of the Act entitled ‘An Act to provide for the reg-  
8 istration and protection of trademarks used in commerce,  
9 to carry out the provisions of certain international conven-  
10 tions, and for other purposes’, approved July 5, 1946  
11 (commonly known as the ‘Trademark Act of 1946’ (15  
12 U.S.C. 1125(c))), buildings and structures on or eligible  
13 for inclusion on the National Register of Historic Places  
14 (either individually or as part of a historic district), or  
15 designated as an individual landmark or as a contributing  
16 building in a historic district by a unit of State or local  
17 government, may retain the name historically associated  
18 with the building or structure.”.

19 **SEC. 3008. SAVINGS CLAUSE.**

20 Nothing in this title shall affect any defense available  
21 to a defendant under the Trademark Act of 1946 (includ-  
22 ing any defense under section 43(c)(4) of such Act or re-  
23 lating to fair use) or a person’s right of free speech or  
24 expression under the first amendment of the United States  
25 Constitution.

1 **SEC. 3009. TECHNICAL AND CONFORMING AMENDMENTS.**

2 Chapter 85 of title 28, United States Code, is amend-  
3 ed as follows:

4 (1) Section 1338 of title 28, United States  
5 Codes, is amended—

6 (A) in the section heading by striking  
7 “**trade-marks**” and inserting “**trade-**  
8 **marks**”;

9 (B) in subsection (a) by striking “trade-  
10 marks” and inserting “trademarks”; and

11 (C) in subsection (b) by striking “trade-  
12 mark” and inserting “trademark”.

13 (2) The item relating to section 1338 in the  
14 table of sections for chapter 85 of title 28, United  
15 States Code, is amended by striking “trade-marks”  
16 and inserting “trademarks”.

17 **SEC. 3010. EFFECTIVE DATE.**

18 Sections 3002(a), 3003, 3004, 3005, and 3008 of  
19 this title shall apply to all domain names registered before,  
20 on, or after the date of the enactment of this Act, except  
21 that damages under subsection (a) or (d) of section 35  
22 of the Trademark Act of 1946 (15 U.S.C. 1117), as  
23 amended by section 3003 of this title, shall not be avail-  
24 able with respect to the registration, trafficking, or use  
25 of a domain name that occurs before the date of the enact-

26 ment of this Act.



## **Document No. 14**

