

106TH CONGRESS
1ST SESSION

S. 1255

AMENDMENTS

In the House of Representatives, U. S.,

October 26, 1999.

Resolved, That the bill from the Senate (S. 1255) entitled “An Act to protect consumers and promote electronic commerce by amending certain trademark infringement, dilution, and counterfeiting laws, and for other purposes”, do pass with the following

AMENDMENTS:

Strike out all after the enacting clause and insert:

1 ***SECTION 1. SHORT TITLE; REFERENCES.***

2 (a) *SHORT TITLE.*—*This Act may be cited as the*
3 *“Trademark Cyberpiracy Prevention Act”.*

4 (b) *REFERENCES TO THE TRADEMARK ACT OF 1946.*—
5 *Any reference in this Act to the Trademark Act of 1946*
6 *shall be a reference to the Act entitled “An Act to provide*
7 *for the registration and protection of trade-marks used in*
8 *commerce, to carry out the provisions of certain inter-*
9 *national conventions, and for other purposes”, approved*
10 *July 5, 1946 (15 U.S.C. 1051 et seq.).*

1 **SEC. 2. 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 famous personal name
7 which is protected under this section, if, without regard to
8 the goods or services of the parties, that person—

9 “(i) has a bad faith intent to profit from that
10 mark, including a famous personal name which is
11 protected 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 distinctive
15 at the time of registration of the domain name,
16 is identical or confusingly similar to that mark;

17 “(II) in the case of a famous mark that is
18 famous at the time of registration of the domain
19 name, is dilutive of that mark; or

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

24 “(B) In determining whether there is a bad-faith in-
25 tent described under subparagraph (A), a court may con-
26 sider factors such as, but not limited to—

1 “(i) the trademark or other intellectual property
2 rights of the person, if any, in the domain name;

3 “(ii) the extent to which the domain name con-
4 sists of the legal name of the person or a name that
5 is otherwise commonly used to identify that person;

6 “(iii) the person’s prior lawful use, if any, of the
7 domain name in connection with the bona fide offer-
8 ing of any goods or services;

9 “(iv) the person’s lawful noncommercial or fair
10 use of the mark in a site accessible under the domain
11 name;

12 “(v) the person’s intent to divert consumers from
13 the mark owner’s online location to a site accessible
14 under the domain name that could harm the goodwill
15 represented by the mark, either for commercial gain
16 or with the intent to tarnish or disparage the mark,
17 by creating a likelihood of confusion as to the source,
18 sponsorship, affiliation, or endorsement of the site;

19 “(vi) the person’s offer to transfer, sell, or other-
20 wise assign the domain name to the mark owner or
21 any third party for financial gain without having
22 used, or having an intent to use, the domain name
23 in the bona fide offering of any goods or services;

24 “(vii) the person’s provision of material and
25 misleading false contact information when applying

1 *for the registration of the domain name or the per-*
2 *son’s intentional failure to maintain accurate contact*
3 *information;*

4 “(viii) *the person’s registration or acquisition of*
5 *multiple domain names which the person knows are*
6 *identical or confusingly similar to marks of others*
7 *that are distinctive at the time of registration of such*
8 *domain names, or dilutive of famous marks of others*
9 *that are famous at the time of registration of such do-*
10 *main names, without regard to the goods or services*
11 *of such persons;*

12 “(ix) *the person’s history of offering to transfer,*
13 *sell, or otherwise assign domain names incorporating*
14 *marks of others to the mark owners or any third*
15 *party for consideration without having used, or hav-*
16 *ing an intent to use, the domain names in the bona*
17 *fide offering of any goods and services;*

18 “(x) *the person’s history of providing material*
19 *and misleading false contact information when apply-*
20 *ing for the registration of other domain names which*
21 *incorporate marks, or the person’s history of using*
22 *aliases in the registration of domain names which in-*
23 *corporate marks of others; and*

24 “(xi) *the extent to which the mark incorporated*
25 *in the person’s domain name registration is distinc-*

1 *tive and famous within the meaning of subsection*
2 *(c)(1) of section 43 of the Trademark Act of 1946 (15*
3 *U.S.C. 1125).*

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

9 *“(D) A person shall be liable for using a domain name*
10 *under subparagraph (A)(ii) only if that person is the do-*
11 *main 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) In addition to any other jurisdiction that oth-*
19 *erwise exists, whether in rem or in personam, the owner*
20 *of a mark may file an in rem civil action against a domain*
21 *name in the judicial district in which the domain name*
22 *registrar, domain name registry, or other domain name au-*
23 *thority that registered or assigned the domain name is lo-*
24 *cated, if—*

1 “(i) the domain name violates any right of the
2 owner of the mark; and

3 “(ii) the owner—

4 “(I) has sent a copy of the summons and
5 complaint to the registrant of the domain name
6 at the postal and e-mail address provided by the
7 registrant to the registrar; and

8 “(II) has published notice of the action as
9 the court may direct promptly after filing the
10 action.

11 The actions under clause (ii) shall constitute service
12 of process.

13 “(B) In an in rem action under this paragraph, a do-
14 main name shall be deemed to have its situs in the judicial
15 district in which—

16 “(i) the domain name registrar, registry, or
17 other domain name authority that registered or as-
18 signed the domain name is located; or

19 “(ii) documents sufficient to establish control
20 and authority regarding the disposition of the reg-
21 istration and use of the domain name are deposited
22 with the court.

23 “(C) The remedies of an in rem action under this
24 paragraph shall be limited to a court order for the forfeiture
25 or cancellation of the domain name or the transfer of the

1 domain name to the owner of the mark. Upon receipt of
2 written notification of a filed, stamped copy of a complaint
3 filed by the owner of a mark in a United States district
4 court under this paragraph, the domain name registrar, do-
5 main name registry, or other domain name authority
6 shall—

7 “(i) expeditiously deposit with the court docu-
8 ments sufficient to establish the court’s control and
9 authority regarding the disposition of the registration
10 and use of the domain name to the court; and

11 “(ii) not transfer or otherwise modify the do-
12 main name during the pendency of the action, except
13 upon order of the court.

14 The domain name registrar or registry or other domain
15 name authority shall not be liable for injunctive or mone-
16 tary relief under this paragraph except in the case of bad
17 faith or reckless disregard, which includes a willful failure
18 to comply with any such court order.

19 “(3) The civil action established under paragraph (1)
20 and the in rem action established under paragraph (2), and
21 any remedy available under either such action, shall be in
22 addition to any other civil action or remedy otherwise ap-
23 plicable.”.

24 **SEC. 3. DAMAGES AND REMEDIES.**

25 (a) *REMEDIES IN CASES OF DOMAIN NAME PIRACY.*—

1 (1) *INJUNCTIONS.*—Section 34(a) of the Trade-
 2 *mark Act of 1946 (15 U.S.C. 1116(a)) is amended in*
 3 *the first sentence by striking “(a) or (c)” and insert-*
 4 *ing “(a), (c), or (d)”.*

5 (2) *DAMAGES.*—Section 35(a) of the Trademark
 6 *Act of 1946 (15 U.S.C. 1117(a)) is amended in the*
 7 *first sentence by inserting “, (c), or (d)” after “section*
 8 *43(a)”.*

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

12 “(d) *In a case involving a violation of section 43(d)(1),*
 13 *the plaintiff may elect, at any time before final judgment*
 14 *is rendered by the trial court, to recover, instead of actual*
 15 *damages and profits, an award of statutory damages in the*
 16 *amount of not less than \$1,000 and not more than \$100,000*
 17 *per domain name, as the court considers just. The court*
 18 *may remit statutory damages in any case in which the*
 19 *court finds that an infringer believed and had reasonable*
 20 *grounds to believe that use of the domain name by the in-*
 21 *fringer was a fair or otherwise lawful use.”.*

22 **SEC. 4. LIMITATION ON LIABILITY.**

23 Section 32(2) of the Trademark Act of 1946 (15 U.S.C.
 24 1114) is amended—

1 (1) *in the matter preceding subparagraph (A) by*
2 *striking “under section 43(a)” and inserting “under*
3 *section 43(a) or (d)”*; and

4 (2) *by redesignating subparagraph (D) as sub-*
5 *paragraph (E) and inserting after subparagraph (C)*
6 *the following:*

7 “(D)(i) *A domain name registrar, a domain*
8 *name registry, or other domain name registration au-*
9 *thority that takes any action described under clause*
10 *(ii) affecting a domain name shall not be liable for*
11 *monetary or injunctive relief to any person for such*
12 *action, regardless of whether the domain name is fi-*
13 *nally determined to infringe or dilute the mark.*

14 “(ii) *An action referred to under clause (i) is*
15 *any action of refusing to register, removing from reg-*
16 *istration, transferring, temporarily disabling, or per-*
17 *manently canceling a domain name—*

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

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

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

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

21 **SEC. 5. DEFINITIONS.**

22 Section 45 of the Trademark Act of 1946 (15 U.S.C.
23 1127) is amended by inserting after the undesignated para-
24 graph defining the term “counterfeit” the following:

1 *“The term ‘domain name’ means any alphanumeric*
2 *designation which is registered with or assigned by any do-*
3 *main name registrar, domain name registry, or other do-*
4 *main name registration authority as part of an electronic*
5 *address on the Internet.*

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

9 **SEC. 6. SAVINGS CLAUSE.**

10 *Nothing in this Act shall affect any defense available*
11 *to a defendant under the Trademark Act of 1946 (including*
12 *any defense under section 43(c)(4) of such Act or relating*
13 *to fair use) or a person’s right of free speech or expression*
14 *under the first amendment of the United States Constitu-*
15 *tion.*

16 **SEC. 7. EFFECTIVE DATE.**

17 *Sections 2 through 6 of this Act shall apply to all do-*
18 *main names registered before, on, or after the date of the*
19 *enactment of this Act, except that damages under subsection*
20 *(a) or (d) of section 35 of the Trademark Act of 1946 (15*
21 *U.S.C. 1117), as amended by section 3 of this Act, shall*
22 *not be available with respect to the registration, trafficking,*
23 *or use of a domain name that occurs before the date of the*
24 *enactment of this Act.*

1 **SEC. 8. ADJUSTMENT OF CERTAIN TRADEMARK AND PAT-**
2 **ENT FEES.**

3 (a) *TRADEMARK FEES.*—Notwithstanding the second
4 sentence of section 31(a) of the Trademark Act of 1946 (15
5 U.S.C. 1113(a)), the Commissioner of Patents and Trade-
6 marks is authorized in fiscal year 2000 to adjust trademark
7 fees without regard to fluctuations in the Consumer Price
8 Index during the preceding 12 months.

9 (b) *PATENT FEES.*—

10 (1) *ORIGINAL FILING FEE.*—Section 41(a)(1)(A)
11 of title 35, United States Code, relating to the fee for
12 filing an original patent application, is amended by
13 striking “\$760” and inserting “\$690”.

14 (2) *REISSUE FEE.*—Section 41(a)(4)(A) of title
15 35, United States Code, relating to the fee for filing
16 for a reissue of a patent, is amended by striking
17 “\$760” and inserting “\$690”.

18 (3) *NATIONAL FEE FOR CERTAIN INTERNATIONAL*
19 *APPLICATIONS.*—Section 41(a)(10) of title 35, United
20 States Code, relating to the national fee for certain
21 international applications, is amended by striking
22 “\$760” and inserting “\$690”.

23 (4) *MAINTENANCE FEES.*—Section 41(b)(1) of
24 title 35, United States Code, relating to certain main-
25 tenance fees, is amended by striking “\$940” and in-
26 serting “\$830”.

1 (c) *EFFECTIVE DATE.*—Subsection (a) shall take effect
2 on the date of the enactment of this Act. The amendments
3 made by subsection (b) shall take effect 30 days after the
4 date of the enactment of this Act.

5 **SEC. 9. DOMAIN NAME FOR PRESIDENT, MEMBERS OF CON-**
6 **GRESS, SNF POLITICAL OFFICE HOLDERS**
7 **AND CANDIDATES.**

8 (a) *IN GENERAL.*—The Secretary of Commerce shall
9 require the registry administrator for the .us top level do-
10 main to establish a 2nd level domain name for the purpose
11 of registering only domain names of the President, Members
12 of Congress, United States Senators, and other current hold-
13 ers of, and official candidates and potential official can-
14 didates for, Federal, State, or local political office in the
15 United States.

16 (b) *GUIDELINES.*—The Secretary of Commerce, in con-
17 sultation with the Federal Election Commission, shall es-
18 tablish guidelines and procedures under which individuals
19 may register a domain name in the 2nd level domain name
20 established pursuant to subsection (a).

21 (c) *ELIGIBLE REGISTRANTS.*—The Federal Election
22 Commission shall establish and maintain a list of individ-
23 uals eligible, under the guidelines established pursuant to
24 subsection (b), to register a domain name in the 2nd level
25 domain name established pursuant to subsection (a).

1 (d) *FEEES.*—*The registry administrator and registrars*
2 *for the .us top level domain may charge individuals reason-*
3 *able fees for registering domain names pursuant to sub-*
4 *section (a).*

5 (e) *DEFINITION.*—*As used in this section, the term*
6 *“Member of Congress” means a Representative in, or a dele-*
7 *gate or Resident Commissioner to, the Congress.*

8 (f) *EFFECTIVE DATE.*—*Registration of domain names*
9 *in accordance with this section shall begin no later than*
10 *December 31, 2000.*

11 ***SEC. 10. HISTORIC PRESERVATION.***

12 *Section 101(a)(1)(A) of the National Historic Preser-*
13 *vation Act (16 U.S.C. 470a(a)(1)(A)) is amended by adding*
14 *at the end the following: “Notwithstanding section 43(c) of*
15 *the Act commonly known as the ‘Trademark Act of 1946’*
16 *(15 U.S.C. 1125(c)), buildings and structures meeting the*
17 *criteria for the National Register of Historic Places under*
18 *paragraph (2) may retain the name by which they are list-*
19 *ed on the Register, if that name is the historical name asso-*
20 *ciated with the building or structure.”.*

Amend the title so as to read: “An Act to amend certain trademark laws to prevent the misappropriation of marks.”.

Attest:

Clerk.