S. 1255

AN ACT

To protect consumers and promote electronic commerce by amending certain trademark infringement, dilution, and counterfeiting laws, and for other purposes.

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

SECTION 1. SHORT TITLE; REFERENCES.

(a) Short Title.—This Act may be cited as the
“Anticybersquatting Consumer Protection Act.”.
(b) References to the Trademark Act of 1946.—Any reference in this Act to the Trademark Act of 1946 shall be a reference to the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes”, approved July 5, 1946 (15 U.S.C. 1051 et seq.).

SEC. 2. FINDINGS.

Congress finds the following:

(1) The registration, trafficking in, or use of a domain name that is identical or confusingly similar to a trademark or service mark of another that is distinctive at the time of the registration of the domain name, or dilutive of a famous trademark or service mark of another that is famous at the time of the registration of the domain name, without regard to the goods or services of the parties, with the bad-faith intent to profit from the goodwill of another’s mark (commonly referred to as “cyberpiracy” and “cybersquatting”)—

(A) results in consumer fraud and public confusion as to the true source or sponsorship of goods and services;
(B) impairs electronic commerce, which is important to interstate commerce and the United States economy;

(C) deprives legitimate trademark owners of substantial revenues and consumer goodwill; and

(D) places unreasonable, intolerable, and overwhelming burdens on trademark owners in protecting their valuable trademarks.

(2) Amendments to the Trademark Act of 1946 would clarify the rights of a trademark owner to provide for adequate remedies and to deter cyberpiracy and cybersquatting.

SEC. 3. CYBERPIRACY PREVENTION.

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

``(d)(1)(A) A person shall be liable in a civil action by the owner of a trademark or service mark if, without regard to the goods or services of the parties, that person—

``(i) has a bad faith intent to profit from that trademark or service mark; and

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

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

“(II) in the case of a famous trademark or service mark that is famous at the time of registration of the domain name, is dilutive of such mark.

“(B) In determining whether there is a bad-faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

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

“(ii) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

“(iii) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

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

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

“(vi) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for substantial consideration without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services;

“(vii) the person’s intentional provision of material and misleading false contact information when applying for the registration of the domain name; and

“(viii) the person’s registration or acquisition of multiple domain names which are identical or confusingly similar to trademarks or service marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous trademarks or service marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of such persons.

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

“(D) A use of a domain name described under sub-
paragraph (A) shall be limited to a use of the domain
name by the domain name registrant or the domain name
registrant’s authorized licensee.

“(2)(A) The owner of a mark may file an in rem civil
action against a domain name if—

“(i) the domain name violates any right of the
registrant of a mark registered in the Patent and
Trademark Office, or section 43 (a) or (e); and

“(ii) the court finds that the owner has dem-
onstrated due diligence and was not able to find a
person who would have been a defendant in a civil
action under paragraph (1).

“(B) The remedies of an in rem action under this
paragraph shall be limited to a court order for the for-
feiture or cancellation of the domain name or the transfer
of the domain name to the owner of the mark.”.

(b) ADDITIONAL CIVIL ACTION AND REMEDY.—The
civil action established under section 43(d)(1) of the
Trademark Act of 1946 (as added by this section) and
any remedy available under such action shall be in addi-
tion to any other civil action or remedy otherwise applicable.

SEC. 4. DAMAGES AND REMEDIES.

(a) Remedies In Cases of Domain Name Piracy.—

(1) Injunctions.—Section 34(a) of the Trademark Act of 1946 (15 U.S.C. 1116(a)) is amended in the first sentence by striking “section 43(a)” and inserting “section 43(a), (c), or (d)”.

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

(b) Statutory Damages.—Section 35 of the Trademark Act of 1946 (15 U.S.C. 1117) is amended by adding at the end the following:

“(d) In a case involving a violation of section 43(d)(1), 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. The court shall remit statutory damages in any case in which an infringer believed and had reasonable grounds
to believe that use of the domain name by the infringer
was a fair or otherwise lawful use.”.

SEC. 5. LIMITATION ON LIABILITY.

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

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

(2) by redesignating subparagraph (D) as subparagraph (E) and inserting after subparagraph (C)

the following:

“(D)(i) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

“(ii) An action referred to under clause (i) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name—
“(I) in compliance with a court order under section 43(d); or

“(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another’s mark registered on the Principal Register of the United States Patent and Trademark Office.

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

“(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any person that a domain name is identical to, confusingly similar to, or dilutive of a mark registered on the Principal Register of the United States Patent and
Trademark Office, such person shall be liable for any damages, including costs and attorney’s fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

“(v) 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 Act. 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.”.

SEC. 6. DEFINITIONS.

Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127) is amended by inserting after the undesignated paragraph defining the term “counterfeit” the following:
"The term ‘Internet’ has the meaning given that term in section 230(f)(1) of the Communications Act of 1934 (47 U.S.C. 230(f)(1)).

“The term ‘domain name’ means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.”.

SEC. 7. SAVINGS CLAUSE.

Nothing in this Act shall affect any defense available to a defendant under the Trademark Act of 1946 (including any defense under section 43(c)(4) of such Act or relating to fair use) or a person’s right of free speech or expression under the first amendment of the United States Constitution.

SEC. 8. SEVERABILITY.

If any provision of this Act, an amendment made by this Act, or the application of such provision or amendment to any person or circumstances is held to be unconstitutional, the remainder of this Act, the amendments made by this Act, and the application of the provisions of such to any person or circumstance shall not be affected thereby.
SEC. 9. EFFECTIVE DATE.

This Act shall apply to all domain names registered before, on, or after the date of enactment of this Act, except that statutory damages under section 35(d) of the Trademark Act of 1946 (15 U.S.C. 1117), as added by section 4 of this Act, shall not be available with respect to the registration, trafficking, or use of a domain name that occurs before the date of enactment of this Act.

Passed the Senate August 5, 1999.

Attest:

Secretary.
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106TH CONGRESS