

To: Domain Name@Leg@OGC
From: "Sumita Ghosh" <sumita_ghosh@hotmail.com>
Cc:
Subject: Comment
Attachment: commentscg.wpd,Headers.822
Date: 3/31/00 12:53 AM

Public Comments
Attn: Sabrina McLaughlin
Office of General Counsel

Document in WordPerfect 8.0 format- submitted by e-mail to
DomainName@doc.gov

Comment to Notice and request for public comments on Abusive Domain Name
Registrations Involving Personal Names; Request for Public Comments on
Dispute Resolution Issues Relating to Section 3002(b) of the
Anticybersquatting Consumer Protection Act

Get Your Private, Free Email at <http://www.hotmail.com>

Department of Commerce
Room 5876
14th & Constitution Avenues, NW
Washington, DC 20230

Public Comments

Attn: Sabrina McLaughlin
Office of General Counsel

Document in WordPerfect 8.0 format- submitted by e-mail to DomainName@doc.gov

Comment to Notice and request for public comments on Abusive Domain Name Registrations Involving Personal Names; Request for Public Comments on Dispute Resolution Issues Relating to Section 3002(b) of the Anticybersquatting Consumer Protection Act

As indicated in the **Supplementary Information** of your Request for Comments in the February 29, 2000 Federal Register (Volume 63, Number 40), section 3002(b) of the newly signed Public Law 106-113, the Anticybersquatting Consumer Protection Act (or "Act") contains a prohibition on certain acts of cybersquatting that involve the personal names of living persons.

Cybersquatting is a term used to describe the bad faith, abusive registration of domain names. Domain names are the familiar and easy-to-remember names for Internet computers that map to Internet Protocol (IP) numbers, which, in turn, serve as routing addresses on the Internet. A domain name functions much like a cyberspace address book. Specifically, section 3002(b) of the Act creates the following protection for the domain names of individuals:

(b) Cyberpiracy Protections for Individuals--

(1) In general--

(A) Civil liability--Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

(B) Exception--A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name is used in, affiliated with, or related to a work of authorship protected under title 17, United States Code, including a work made for hire as defined in section 101 of title 17, United States Code, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946 (15 U.S.C. 1051 et seq. or other provision of Federal or State law.

(2) Remedies--In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain

name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

As to the above section, the wording of Section B is somewhat confusing. Some of the words used are "terms of art" which trademark attorney may be familiar with but the general public may not understand the allusions to. For example, in determining the boundaries of "confusingly and substantially similar" will the so-called "Polaroid" factors be used. Since the use of these factors varies from state to state, perhaps a definitions section defining certain terms is warranted.

Furthermore, section 3006 of this Act directs the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, to conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving personal names. Specifically section 3006 of the Act asks the Department of Commerce to consider and to recommend guidelines and procedures for:

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

(2) protecting individuals from bad faith uses of their personal names as second level domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name;

(3) protecting consumers from the registration and use of domain names that include personal names in the second level domain in matters which are intended or are likely to confuse or deceive the public as to the affiliation, connection, or association of the domain name registrant, or a site accessible under the domain name, with such other person, or as to the origin, sponsorship, or approval of the goods, services, or commercial activities of the domain name registrant;

(4) protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential official candidates for Federal, State, or local political office in the United States, and the use of such domain names in a manner that disrupts the electoral process or the public's ability to access accurate and reliable information regarding such individuals;

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

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

Many of the terms used in section 3006 are vague and ill-defined. Section (2) especially seems to be unnecessary. What is "bad faith use"? How will the PTO deal with bad faith "intent to use" registrations by which a cybersquatter reserves names. The term "malicious intent" implies criminal liability and is a subjective standard which would be quite difficult to prove. How do you determine loss of reputation and the value of goodwill. I have serious First Amendment concerns about section (4). What standard will be used to determine what "disrupts the electoral process the public's ability to access accurate and reliable information regarding such

individuals"?

The Internet is a complex piece of "real" estate. It began as a United States government enterprise supported by the Department of Defense (DoD). The controlling body of the Internet was initially IANA, a not-for profit corporation with a government contract for conducting its activities. However, as the globalization of the Internet continues, "a new not-for-profit organization with an international Board of Directors to oversee the operations of the necessary central coordinating functions of the Internet" was proposed.¹ From my understanding, regulation of domain names occurs via the Internet Corporation for Assigned Names and Numbers (ICANN), the non-profit corporation that was formed to take over responsibility for the IP address space allocation, protocol parameter assignment, domain name system management, and root server system management functions now performed under U.S. Government contract by IANA and other entities. "On November 25, 1998, the United States Department of Commerce ("DOC") officially recognized the Internet Corporation for Assigned Names and Numbers ("ICANN") as the global, non-profit consensus organization designed to carry on various administrative functions for the Internet name and address system that it had called upon the Internet community to create in its White Paper² issued in June, 1998."³ Regulation of the Internet also involves the Patent and Trademark Office (PTO), a branch of the Department of Commerce since many domain name disputes are the subject of court action brought under federal trademark law (the Lanham Act). Given the extremely rapid pace of development in regulation of the Internet, the administrative law aspects of the Department of Commerce actions will require much greater scrutiny and is beyond the scope of this comment. An excellent overview of the administrative law considerations involved in intellectual property disputes can be found at the following website: <http://www.fplc.edu/tfield/apro/ch1.htm>. These issues are further clouded by the involvement of the Federal Election Commission, an independent regulatory agency created by Congress in 1975 to administer and enforce the Federal Election Campaign Act (FECA) - the statute that governs the financing of federal elections⁴.

I will be commenting on two broad areas raised by this request.

I. General comments

a) comments and suggestions on the form that any new guidelines or procedures should take

In general, since the scope and authority of the various agencies and corporations involved is quite ill-defined, each of the governmental and non-governmental bodies should establish a better starting framework for such regulations. One of the chief complaints about domain name registrations is the apparent lack of oversight on whether a registering party is entitled to a

¹ <http://www.iana.org/faqs.html>

² <http://www.ntia.doc.gov/ntiahome/domainname/icann-memorandum.htm>

³ <http://www.icann.org/general/statusreport-15june99.htm>

⁴ <http://www.fec.gov/about.html>

certain name. ICANN administers the accreditation process for registrars of domain names. But, such registrars do not check whether other parties may have prior trademark rights to a domain name as is done during conventional trademark registration. The burden of detecting cybersquatters is placed upon trademark owners under the UDRP⁵. This is further complicated by the global nature of the Internet since there is no international harmonization of intellectual property regimes. Thus, while the Act may be a good initial attempt, its strength will be tested in the adequacy of its enforcement. For example, numerous cybersquatters conduct their activities beyond the boundaries of the U.S. The fundamental question of jurisdiction over such websites has yet to be settled. However, there appears to be strong international support for ICANN's activities and perhaps having such a United Nations-like body for controlling the Internet is just what the World (Wide Web) needs. The use of personal names has a long history of case precedence in U.S. trademark law. UDRP incorporates numerous concepts of trademark law such as likelihood of confusion and bad faith in Section 4 (Mandatory Administrative Proceedings). While it does not appear to explicitly address the concepts of dilution and right to publicity, the existing framework seems adequate for complaints involving these legal concepts. If the need arises, sections specifically directed to such claims could be added to the UDRP.

b) the degree to which additional protection may or may not be needed in this area

I personally do not believe additional protection is needed in this area especially since there are First Amendment rights to free speech concerns which may already have been tread upon by the new law. ICANN has implemented the UDRP which does seem to adequately cover disputes relating to personal names. The UDRP creates an administrative proceeding which provides for arbitration. As such, arbitrators are not bound by U.S. case precedence. Most of the arbitrators appear to be attorneys, who one would hope would have some familiarity with general trademark concepts. Also, a cursory review of the cases resolved since implementing UDRP indicates that the Section 4 standards established by UDRP for arbitrators to resolve these disputes appears to be providing adequate guidance in these cases. The public reporting of these decisions is especially enlightening and should provide its own form of "precedence" for domain name disputes.⁶ One concern I do have is that many non-Western countries do not view alternative dispute resolution mechanisms favorably. Considering how difficult global harmonization of IP regimes has been, how can the US control cybersquatters in other nations and force them to comply with US law and case precedence?

c) the extent to which individuals would avail themselves of protections offered in this area

Most people using the Internet are assumed to be quite literate and computer savvy. It should not be an enormous burden for individuals to simply check whether others have registered their personal names as cybersquatters. This search feature is available on the registration pages of all ICANN accredited registrars.

⁵ <http://www.icann.org/udrp/udrp.htm>

⁶ See <http://www.arbforum.com/domains/>

d) whether the appeal of such protections would be limited to only high-profile or famous individuals

Under 15 U.S.C. § 1052, marks which are primarily merely a surname cannot be registered without evidence of long and exclusive use which changes its significance to the public from that of a surname of an individual to that of a mark for a particular good or service. Specifically for .com registrations, this standard seems to adequately address concerns about cybersquatters who merely register a name without the requisite commercial use. Thus, I believe that such protection should not be limited to only high-profile or famous individuals. It should protect all individuals with a personal domain name commercial website.

e) the logistical problems that may attend implementation of new guidelines in this area, particularly as these problems relate to the current system of domain name registration

I do not believe that any logistical problems are insurmountable. The UDRP addresses some of the jurisdiction concerns and ICANN seems to be quite carefully scrutinizing the process. The implementation of these guidelines seems to have been greatly streamlined by the approved providers for UDRP as they are already web-based.⁷ I would prefer the "hands-off" approach for now and see how the current system is working. The proposed administrative resolution involves arbitration by a three or five member panel with fees beginning at \$750. This does not appear to be a prohibitive amount when legitimate commercial interests are concerned.

f) comments from respondents with personal experience in unauthorized commercial appropriation involving a personal name.

I first became aware of this issue when I attempted to register a website as a birthday present for my father by using the name "surname.com". This was done in expectation of his retirement after which he hoped to set up a web-based consulting service. His surname is certainly not a famous mark, although it is a common surname in the Indian subcontinent. To my surprise, I found that this name, and even his firstname.surname.com, along with 12,000 other surnames was already taken by a business at mailbank.com. Apparently, my father can no longer register his own name without first paying a monthly fee to this company. This just seems fundamentally unfair to me since this company is not using such websites in the conventional trademark sense. Under trademark law, there are two ways to file for registration of a mark: a) actual use in commerce 15 U.S.C. §1227 or b) intent to use in commerce 15 U.S.C. §1051. As established in Proctor & Gamble Co. V. Johnson & Johnson, Inc. (485 F. Supp. 1185), such "token use" used to grab a monopoly on a name without having a requisite bona fide commercial purpose behind it is impermissible. The Internet has very limited real estate in the area of personal names and especially when relating to .com designations, such tactics should be discouraged. Especially for such service marks, people with legitimate commercial interests are denied an opportunity for efficient self-promotion using "intent to use"-type registrations for domain names. Thus, I see a need for better defining the scope of "commercial appropriation" which might encompass activities of such personal name "leasing" websites.

II. Specific comments

a) comments that address the non-exhaustive list of laws presented in the supplemental

⁷ <http://www.eresolution.ca/services/dnd/complaint.htm>

information section

b) the suitability of these laws for use in the context of abusive domain name registration of personal names

1) Trademark Infringement

As already acknowledged by several registrars of domain names, trademark law may not be the best vehicle for protecting personal names because it requires having existing trademark rights. However, nothing in domain name registration requirements for .com (the top-level domain name originally reserved for commercial endeavors) requires commercial use. This is a fallacy of the domain name registration process which it is probably too late to ameliorate. I agree with Michael Fromkin, a University of Miami law professor who served on the World Intellectual Property Organization's domain advisory panel who suggests that a distinction needs to be made between cybersquatting (buying up domain names that "belong" to someone else, such as Al Gore buying Bushyes.com) and "warehousing" (Gore reserving variations of his own name). Warehousing is an ethical way to protect one's own trademark but cybersquatting should be subject to trademark scrutiny as is done by the UDRP. Analogous case precedence is available in trademark law and should serve as adequate precedence for decision-making. Thus, while trademark law may not be ideal for resolving every single dispute, it would be much easier to use its fundamental principles rather than attempting to reinvent the wheel.

2) Dilution

This is a concept which is not specifically addressed by the UDRP but is a concept present in U.S. federal law.⁸ This section incorporates the "Polaroid factors"⁹ for determining likelihood of confusion between non identical goods and services. This quite lengthy list of factors is not discussed in the UDRP procedure and should perhaps be more clearly delineated to arbitrators of decisions.

3) Unfair Competition

As already indicated in the Supplementary Information, the law of unfair competition is quite unclear and probably will not provide much guidance for domain name disputes involving personal names.

4) Right of Publicity

As will be discussed, there is no "federal law" regarding the right of publicity thus it is also probably not suitable at this juncture to use such law for guidance. There is a common law right of publicity but until this concept is more uniformly accepted and more concrete case precedence exists, ICANN should probably not attempt to address such claims.

c) suggestions of other frameworks that may be useful in considering approaches to resolution of personal name domain disputes

One advantage of the UDRP procedure is that it provides a body (Panel) similar to the Trademark Trial and Appeal Board (TTAB) for the resolution of such disputes. Perhaps as with the PTO, ICANN could develop a manual similar to the TTAB Manual of Procedure with guidelines such as section 101.03 which establishes that Board action should be governed, to a

⁸ 15 U.S.C. 1125

⁹ Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492.

large extent, by published decisions in prior cases. Alternative frameworks for resolution such as mediation may not be quite as efficient as arbitration. But, for certain types of domain name disputes, such as those involving right of publicity claims, arbitrators may not have sufficient UDRP guidance and the only option may be state court legal actions. Thus, depending on the claims raised, multiple proceedings may be necessary before a final determination as to ownership can be made.

d) comments on the degree to which the ICANN UDRP satisfactorily handles domain name disputes involving personal names

There were many public comments about UDRP despite the limited two-week comment time period. The implemented UDRP seems to have addressed many of the concerns raised by domain name registrants but there are numerous issues which remain open for study by the ICANN Board of Directors.¹⁰ Again, I would wait to see how effective and efficient the process is before attempting to make any changes.

e) comments concerning any legal issues and

I would like to again raise my concern about disputes involving the right of publicity. There is some case precedence from state law e.g. Carson v. Here's Johnny Portable Toilets, Inc. 698 F.2d 831; and White v. Samsung Electronics America, Inc. 971 F.2d 1395 and 15 U.S.C. 1052 indicates that "No trademark by which the goods of the applicant may be distinguished from the goods of other shall be refused registration on the principal register on account of its nature unless it (c) consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent..." Because the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement, it is potentially more expansive than the Lanham Act. Thus, state courts have recognized a need to limit this right to accommodate First Amendment concerns.

f) comments concerning Constitutional issues raised by any new guidelines or procedures as they relate to personal name disputes, separate and apart from the legislative foundation established by the Anticybersquatting Consumer Protection Act.

In a case which considered the interaction between the First Amendment and the right of publicity in California, the 9th Circuit determined that the First Amendment provides freedom of speech and press when the purpose of the media's use of a person's identity is "informative or cultural". However, if such identity appropriation serves no such function but merely exploits the individual portrayed, no First Amendment protection should be afforded.¹¹ I believe the motivators behind some of the current legislation are political candidates concerned about websites which might denigrate them. However, after examining the contents of one such site, www.gwbush.com, I think that common sense should rule. It is quite clear that this website is meant as parody which is considered fair use of a trademark. The website's author has sold T-shirts from this site but shutting down his website based on the likelihood of confusion standard would be unjust especially since Mr. Bush has responded by "squatting" himself- buying up other potential domain names which might not favor his campaign. I would compare such

¹⁰ <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm>

¹¹ Midler v. Ford Motor Co. 849 F.2d 460

domain names to the titles of movies. As in Rogers v. Grimaldi, 875 F.2d 994, the right of publicity should not bar the use of a celebrity's name in a movie title (or website) unless the title was wholly unrelated to the movie (or website content) or was simply a disguised commercial advertisement for the sale of goods and services. One simple solution to the controversy would be to require the use of disclaimer on such websites indicating that no affiliation or sponsorship is implied by the name of the website.

Thank-you for your consideration of my comments.

Sincerely,

Sumita Chowdhury-Ghosh