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RE: Public Comments in Response to Request for Written Comments: Resolution of Internet Domain Name Disputes Involving the Personal Names of Individuals, 65 Fed. Reg. 10763 (February 29, 2000).

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COMMENTS:

Note: Original copy submitted electronically. Thank you.

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April 20, 2000

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Re: Public Comments in Response to Request for
Written Comments: Resolution of Internet Domain
Name Disputes Involving the Personal Names of
Individuals, 65 Fed. Reg. 10763 (February 29,
2000)

Dear Ms. McLaughlin:

The Motion Picture Association of America (MPAA) is pleased to respond to the Request for Written Comments: Resolution of Internet Domain Name Disputes Involving the Personal Names of Individuals for Written Submissions appearing on February 29, 2000 in the Federal Register.

MPAA believes that it would be premature at best to issue any additional guidelines or procedures for resolving disputes arising out of the use of personal names as second level domain names. Section 3002(b) of the Anticybersquatting Consumer Protection Act of 1999 ("the Act"), which addresses this problem, has just taken effect, and it is far too early to evaluate its effectiveness or to conclude that it is insufficient. Besides this new provision of federal law, myriad other federal and state causes of action are already available to deal with situations in which a person's name has been abusively registered and used as a domain name by another. In this sphere, the application of legal claims to particular facts must take place within the confines of well-established First Amendment principles of free speech and free expression. Because any additional guidelines or procedures must also respect these constitutional limits, the government should proceed with great caution in this area. The courts are well equipped to ensure that the existing menu of potential legal remedies, as enhanced by the Act, are adequate to address abuses without infringing on First Amendment rights.

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1. ABOUT THE MOTION PICTURE ASSOCIATION OF AMERICA

MPAA is a trade association representing major producers and distributors of theatrical motion pictures, home video material and television programs. MPAA members include: Walt Disney Company; Sony Pictures Entertainment, Inc.; Metro-Goldwyn-Mayer Inc.; Paramount Pictures Corporation; Twentieth Century Fox Film Corp.; Universal Studios, Inc.; and Warner Bros.

2. SCOPE OF THE STATUTE

Section 3002(b) of the Anticybersquatting Consumer Protection Act of 1999 (incorporated into Public Law 106-113) (hereinafter the "Act") makes liable, subject to an important exception, "[a]ny 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." The key elements invoking liability are 1) a registration by a person 2) with "specific intent to profit . . . by selling the domain name for financial gain."

The statute explicitly excepts "[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 . . . if such name is used in, affiliated with, or related to a work of authorship protected under 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 is helpful because, as is confirmed in the Senate Report, it "recognizes the First Amendment issues that may arise in such cases and defers to existing bodies of law that have developed under State and Federal law to address such uses of personal names in conjunction with works of expression."¹

3. SCOPE OF THIS REQUEST FOR WRITTEN COMMENTS

These public comments respond to the Request for Written Comments: Resolution of Internet Domain Name Disputes Involving the Personal Names of Individuals for Written Submissions appearing on February 29, 2000 in the Federal Register. The request for written comments (hereinafter "RFC") invites comments "from any interested member of the public on the resolution of Internet domain name disputes involving the personal names of individuals." Specifically, Section 3006 of the 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

¹ S. 1948: Section-by-Section Analysis - Joint Statement Conference Report.

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involving the registration or use of domain names that include personal names of others or names that are confusingly similar thereto." The Act identifies six areas to consider in this study, all of which are dealt with to varying degrees below. MPAA believes that: a) it is premature to consider any further guidelines or procedures for resolving disputes involving the registration or use of domain names that include personal names of others or names that are confusingly similar thereto; b) existing remedies under state and federal law (and through the Internet Corporation for Assigned Names and Numbers) are sufficient to address the considerations described in subparagraphs (1) through (4) of Section 3006; and c) the Act as enacted provides strong protection against abuses of the domain name registration process while trying to balance countervailing First Amendment principles of free speech and free expression. We take the opportunity here to briefly elaborate on these points.

a. **It Is Premature To Consider Guidelines And Procedures For Resolving Disputes Involving The Registration Or Use Of Domain Names That Include Personal Names Of Others Or Names That Are Confusingly Similar Thereto**

Recognizing that the Act requires the Commerce Department to report to Congress no later than 180 days after enactment of the Act, the fact is that interested parties have not had nearly enough time since the Act went into force to fully evaluate its effectiveness in resolving disputes involving the registration of domain names that include personal names of others. For example, to our knowledge, not one case in any court has yet been decided on the basis of Section 3002(b). The statutory provision is straightforward, and so far there is no evidence that specific guidelines or procedures are needed to implement it.

We strongly advocate the allowance of further time so that a body of case law under Section 3002(b) may develop, and so that interested parties have the opportunity to examine how the statute has played out in practice. If, at that point, it appears that the purpose of the statute is not being realized, the problems could be addressed on the basis of a more complete record.

b. **Existing Remedies Under State And Federal Law (And Through The Internet Corporation For Assigned Names And Numbers) Are Sufficient To Address The Considerations Described In Section 3006**

There exists a literal plethora of federal and state remedies for "resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto." The following bullet lists provide examples of causes of action that now may be available (including under the Act), which we believe taken together may provide sufficient remedies for all the wrongs referred to in Section 3006 of the Act, although of course not every cause of action is available in any specific case. The lists are broken down into two categories: first, those causes of action that protect personal names regardless of whether they are used in a commercial setting or to indicate the source of goods or services; and second, those additional causes of action that are applicable to protection of personal names that are used to indicate the source of a good or service.

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Causes of action that protect personal names regardless of whether they act as a mark

- Section 3002(b) of the Anticybersquatting Consumer Protection Act of 1999: One of the precise issues to be addressed by this study – “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” – is the specific goal of Section 3002(b) of the Act. As discussed above, we see no reason to provide any guidelines or procedures regarding this issue at this time, and we strongly assert that it is premature to do so.
- Common Law Right of Publicity: This cause of action, available in almost all states, provides relief if a plaintiff can show that: 1) the plaintiff owns an enforceable right (which would be the case if the plaintiff is suing on his/her own behalf) in the identity of a human being (referred to as “validity”); and 2) there is infringement, meaning that the defendant has, without permission, used some aspect of identity or persona in such a way that the plaintiff is identifiable from defendant’s use, and defendant’s use is likely to cause damage to the commercial value of that persona. See McCarthy on Trademarks and Unfair Competition, § 28:7 (1999). Unauthorized use of a personal name in a domain name could depending on the given facts give rise to a claim of violation of this common law right.
- State Statutory Rights of Publicity: State statutes like California Civil Code Section 3344 provide remedies against the knowing use of another’s name or likeness in a commercial manner without the other’s authorization. Again, depending on the facts, the unauthorized registration and use by a person of a domain name that includes the personal name of another person could give rise to such a claim.
- Defamation (Libel or Slander): Generally, these causes of action, which are available in every state, provide a remedy against false publication by written or printed words, causing injury to a person’s reputation, or exposing him to public hatred, contempt, ridicule, shame, or disgrace, or affecting him adversely in his trade or business. While certainly not available in every case involving the registration or use of a personal name in a second level domain, depending on the content provided on such a website using or employing a personal name in the second-level domain, these causes of action may be available.
- False Light Invasion of Privacy: This cause of action is available when a plaintiff can show a material falsehood and (in most instances) the necessity that the falsehood in question be published or disseminated with constitutional “actual malice” consisting of a knowledge of that falsity or a reckless disregard whether the statement or impression is true or false; it need not be defamatory in a technical sense in order to be actionable, so long as it is “highly offensive” to a reasonable person. As with defamation, depending on

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the content provided on such a website using or employing a personal name in the second-level domain, these causes of action may be brought.

- Intentional Infliction of Emotional Distress: This cause of action is available by proving (1) outrageous conduct by the defendant and (2) the defendant's intentional causing, or reckless disregard of the probability of causing, emotional distress. While the mere registration or use of a personal name may not rise to the level of outrageousness needed for liability under this tort, depending on the context and content of the website involved, a plaintiff whose personal name is registered or used as a second level domain may be able to avail him or herself of this cause of action.

Causes of action that protect personal names that act as marks

- Section 3002(a) of the Anticybersquatting Consumer Protection Act of 1999: Section 3002(a) of the Act provides civil liability and other remedies against a person who "without regard to the goods or services of the parties . . . has a bad faith intent to profit from that mark, including a personal name which is protected under [Section 3002(a)]; and . . . registers, traffics in, or uses a domain name that . . . 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 . . . [or] 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." While not the direct subject of the study, this section provides some protection for those with personal names that are used as marks, and that are distinctive or famous.
- Federal Unfair Competition under 15 U.S.C. § 1125(a): Section 3006 lists "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" as another issue for discussion in written comments. The language in Section 3006 closely mirrors that of Section 43(a)(1) of the Lanham Act (15 U.S.C. § 1125(a)(1)), providing federal protection against acts of unfair competition. Depending on the facts, this claim might be available in the domain name context, including a domain name corresponding to a personal name in the second level domain.
- Federal Trademark Dilution under 15 U.S.C. § 1125(c): This cause of action would be available in those cases in which a plaintiff can establish that (1) its mark is famous; (2) the defendant is making commercial use of the mark in commerce; (3) the defendant's use began after the plaintiff's mark became famous; and (4) the defendant's use presents a likelihood of dilution of the distinctive value of the mark. *See, e.g., Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316, 1324 (9th Cir. 1998). Personal names could enjoy dilution

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protection if they meet the tests of the statute. There are also state trademark dilution statutes that may be used to protect against dilution of a personal name's distinctiveness.

- Common Law Product Disparagement or Trade Libel: Similar to Defamation, this cause of action involves the publication of any false and malicious statement which tends to disparage the quality, condition, or value of the goods, services or property of another, and which causes other special injury or damage.
- State Deceptive Trade Practices Acts and Similar Legislation: (e.g., Minnesota Deceptive Trade Practices Act ("MDTPA"), Minn. Stat. § 325D.44). These statutes in several states prohibit in general deceptive commercial conduct as well as a series of specific acts such as misleading advertising, disparagement, and trade symbol infringement. Other like statutes include the 1970 California Consumers Legal Remedies Act, which prohibits a broad range of unfair and deceptive acts, including passing off, misrepresentation of source, affiliation and sponsorship, disparagement, etc. See McCarthy at § 27:16.
- ICANN Online Uniform Dispute Resolution: The Internet Corporation for Assigned Names and Numbers (ICANN), the non-profit corporation formed in part to take responsibility for domain name system management, approved a Uniform Domain Name Dispute Resolution Policy ("UDRP"), which all domain name registrars in the .com, .net, and .org top-level domains follow, on October 24, 1999. Under the policy, disputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) may be addressed by expedited administrative proceedings that a rightholder initiates by filing a complaint with an approved dispute-resolution service provider.

Under the administrative proceeding provided for in the UDRP, a registrar can be ordered to cancel a domain name registration upon a showing that 1) the registrant's domain name is identical or confusingly similar to a trademark or service mark in which a complainant has rights; 2) the registrant has no rights or legitimate interests in respect of the domain name; and 3) the domain name has been registered and is being used in bad faith. Included as evidence of bad faith is one or more of the following: 1) proof of circumstances indicating that the registrant registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; 2) proof that the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name; 3) proof that the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or 4) proof that by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to his/her web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

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candidate has fraudulently taken campaign contributions intended for that candidate.¹⁴ Accordingly, "electronic democracy" will not serve as a truly transformative force in our political culture until the problems associated with cybersquatting are adequately resolved.

During the debates surrounding the passage of the Anticybersquatting Consumer Protection Act,¹⁵ Congress recognized the difficulties brought on by cybersquatters who misappropriate the names of candidates. Several representatives related instances where they had been the victims of cyberpirates who had registered the representatives' names and then attached them to highly objectionable web sites. At least one representative mentioned how he had had to register multiple permutations of his name "to preempt the unauthorized use of his name in websites."¹⁶ However, even using such a forward-looking approach can prove futile for some candidates. In 1999, a presidential campaign attempted to curb this potential hazard by registering more than 160 derivations of their candidate's name. The campaign even registered several offensive and possibly vulgar derivative domain names in an effort to prevent third parties from registering such names.¹⁷ As discussed earlier, even such intuitive thinking can prove fallible due to the fact that it is improbable, if not nearly impossible, to conceive of every possible permutation and combination to preempt such cybersquatting activity.

In an earlier version of the cybersquatting bill, a section was added directing the Commerce Department to establish a top-level domain for registration of the names of "the President, Members of Congress, United States Senators, and other current holders of, and official candidates and potential candidates for, Federal, State, or local political office in the United States."¹⁸ Though this section was later omitted, Congress expressed

¹⁴ Brian Blomquist & Daniel Jeffreys, FBI Crashes Campaign Web-Scam Site, N.Y. POST, February 20, 2000, at 26.

¹⁵ Pub. L. No. 106-113, 113 Stat. 1501, 1501A—545-52.

¹⁶ House Panels Take Quick Action On Measure to Combat "Cyberpiracy," Reg., L. & Econ. (BNA) No. 198, at A-4, A-5 (Oct. 14, 1999).

¹⁷ Bush consultant ties up strategic Bush domain names, A.P. WIRE, April 28, 1999, available in WESTLAW, Westnews database.

¹⁸ House-Passed Cyberpiracy Bill Protects Famous Names, Names of Public
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its concern over the effects of cybersquatting on the names of candidates by including a provision in the final version of the bill that requires the Department of Commerce "to conduct a study and report to Congress with recommendations and guidelines . . . for 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."¹⁹

IV. First Amendment Issues

Any proposed regulation of the appropriation of candidates' names by cybersquatters must take into account legitimate First Amendment concerns. The Supreme Court has declared that "[d]iscussion of public issues and debate on the qualifications of candidates are integral to the operation of the system of government established by our Constitution."²⁰ Therefore, according to the Court, "[t]he First Amendment affords the broadest protection to such political expression in order to assure [the] unfettered interchange of ideas for the bringing about of political and social changes desired by the people."²¹

We oppose any regulation that would restrict anyone's First Amendment rights under the Constitution and would adamantly reject any proposal to quell such rights. The speech primarily at issue here is political parody and we support such expression as protected by the First Amendment. Courts have, however, determined that such protection is not absolute, and under certain circumstances, courts have been willing to restrict such rights. It is not our position to attempt to alter any of the First Amendment protections afforded by the courts with regard to these matters. The solutions offered herein regarding parody sites accomplish the dual goal of affording the constitutional

(...Continued)

Officials, Reg., L. & Econ. (BNA) No. 208, at A-18 (Oct. 28, 1999).

¹⁹ Pub. L. No. 106-113, 113 Stat. 1501, 1501A—550-51.

²⁰ Buckley v. Valeo, 424 U.S. 1, 14 (1976).

²¹ Id. (citation and internal quotations omitted).

protection of free and unfiltered speech to parodists while still allowing candidates to protect their individual names as well as their candidate committee names, thereby facilitating the transference of accurate political information via a candidate's authorized web site.

V. Potential Solutions

1. *Registry of Campaign Sites*

There are a number of different approaches that have been suggested in attempting to meliorate the cybersquatting problem as it applies to the names of candidates. One solution would be to allow the Federal Election Commission ("FEC" or "Commission") to develop a web site that includes a registry of hypertext links to each federal candidate's authorized web page. For purposes of these comments, we will call it the Registry of Campaign Sites ("ROCS"). In addition, the FEC could coordinate with state and local campaign finance agencies in collecting the web addresses of non-federal candidates as well. ROCS would thus function as a dependable, centrally located access center where interested citizens could link to the web sites of federal, state, and local candidates. From this secure site, citizens would be able to obtain reliable information on candidates and issues, and volunteer or make online contributions to the desired candidate, without the fear and confusion caused by cybersquatters and parodists.

This solution would not restrict parodists' free speech rights because they would still be able to register and create web sites as they now do. The only difference is that, with ROCS, citizens could go to a secure government site in order to find the candidate's authorized site. Moreover, creating this site may be achieved relatively quickly—particularly on the federal level—by taking the following steps. First, the FEC could amend its Form 2—the designation form for a candidate—to include a section where registrants could fill in the address to their authorized web sites. Under current law, a declared candidate must designate a principal campaign committee by submitting to the FEC his or her name and party affiliation and the office being sought.²² By adding a section for a candidate to voluntarily provide a web address, a modified FEC Form 2

²² 11 C.F.R. § 101.1. The name of a candidate committee must include the name of the candidate who authorized the committee: "no unauthorized committee shall include the name of any candidate in its name." *Id.* § 102.14(a).