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What Does "Registers" Mean? The Wrong Interpretation Could Allow Cybersquatters to Escape Liability

Kiley Carey

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WHAT DOES “REGISTERS” MEAN? THE WRONG INTERPRETATION COULD ALLOW CYBERSQUATTERS TO ESCAPE LIABILITY

*Kiley Carey**

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I. INTRODUCTION

Imagine that an up-and-coming business intends to register the business's trademark, but another person catches wind of this rising business and registers a website domain name that "is identical or confusingly similar to" the business's trademark.¹ Shortly thereafter, the business becomes very well-known. Their trademark, including their business name as well as trademarks they use on products or services sold to consumers, becomes very distinctive and indeed famous to the general consuming public. The person who registered the domain name—and who thus now owns it—approaches the trademark owner and offers to sell them the domain name for a high price.

This is known as "cybersquatting."² In the situation just described the person who obtained the domain name—even though they have technically cybersquatted—might escape liability. They might hold this domain name at "ransom" until the trademark owner agrees to pay them for it. The reason is that some courts have adopted an overly narrow interpretation of a law called the Anticybersquatting Consumer Protection Act ("ACPA").³ If this narrow interpretation succeeds and is widely adopted, then some cybersquatters will extort trademark owners by relying on a loophole in the current law: As long as the domain name was

1. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II).

2. Clarke D. Cotton, *Keep Your Laws Off My Domain Name: How a Misinterpretation Of "Registration" In The Anticybersquatting Consumer Protection Act Violates The Property Rights Of Individuals*, 86 U. CIN. L. REV. 265, 267–68 (2018) (citing H.R. 106-412, 106th Cong. § 1 (1999)) ("Essentially, cybersquatters register numerous domain names and then hold those domain names at ransom in an effort to extort money from a person or a company more commonly associated with that domain name."); Elizabeth D. Lauzon, J.D., M.L.S., *Validity, Construction, and Application of Anticybersquatting Consumer Protection Act*, 15 U.S.C.A. § 1125(d), 177 A.L.R. Fed 1, § 2[a], 15 (originally published in 2002) (citing *Virtual Works, Inc. v. Volkswagen of America, Inc.*, 238 F.3d 264 (4th Cir. 2001)) ("Cybersquatting (or cyberpiracy) refers to the deliberate, bad-faith, and abusive registration of Internet domain names utilizing distinct or famous trademarks in violation of the trademark owner's rights, often forcing the owners to pay for the right to engage in electronic commerce under their own brand names."); *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015) ("Cybersquatting is essentially extortion."). See J. Thomas McCarthy, *FIFTY YEARS OF MCCARTHY ON TRADEMARKS*, 113 TRADEMARK REP. 702, 709 (2023) (quoting *Interstellar Starships Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 946 (9th Cir. 2002); *Jysk Bed'N Linen*, 810 F.3d at 775) ("Cybersquatters register well-known brand names as internet domain names in order to force the rightful owners of the marks to pay for the right to engage in electronic commerce under their own name."); Westlaw Glossary, *Cyberpiracy*, (last visited Dec. 13, 2023), <https://next.westlaw.com/Document/> [https://perma.cc/NM86-XMW4] (providing a definition for cyberpiracy, specifically stating it is "[a]lso known as cybersquatting.").

3. The ACPA is part of the Lanham Act. See *infra* Part II(B); BARTON BEEBE, *TRADEMARK LAW: AN OPEN-ACCESS CASEBOOK*, (VERSION 10) (2023), 11 (2023) (citing Consolidated Appropriations Act, 2000, Pub. L. No. 106–113, 113 Stat. 1501, (1999/2000)).

initially registered *prior to time the mark became famous or distinctive*, they will not be liable.⁴

Cybersquatting occurs when an individual “register[s] numerous domain names” solely to leverage it over “a person or a company more commonly associated with that domain name” in exchange for a high sum.⁵ Essentially, a domain name is the text that one types into a search bar.⁶ The Lanham Act governs the process of registering and enforcing trademarks throughout the United States.⁷ “To combat the cybersquatting of domain names confusingly similar to or dilutive of trademarks,” the Lanham Act was amended to include the ACPA.⁸ Generally, the ACPA has the effect of protecting individuals from being subjected to cybersquatting.⁹ Specifically, Section 1125(d)(1)(A)(i) and (ii) establishes civil liability in two distinct contexts¹⁰ for anyone who “has a bad faith intent to profit from that mark” and “registers, traffics in, or uses

4. 15 U.S.C.A. § 1125(d)(1)(A)(i)(ii)(I)–(III); *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011) (holding that since the domain name was initially registered prior to the registration of the trademark, there could not be a violation within Section 1125(d)(1) of the ACPA); *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *3 (D. Ariz. 2023) (“Under this interpretation, if a mark is not distinctive at the time of a domain name’s ‘initial registration,’ liability under [Section] 1125 is not possible.”); *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021) (holding that since the registrant “registered [the domain name] prior to the [time the] mark bec[a]m[e] distinctive,” there is no violation or liability under Section 1125(d)); *AIRFX.com v. AirFX LLC*, 2012 WL 3638721, at *4 (D. Ariz. 2012) (quoting *GoPets Ltd.*, 657 F.3d at 1032 (holding that since the domain name was “registered [] ‘long before [defendant] registered its service mark,’ plaintiffs’ registration and ownership...’ does not violate [Section] 1125(d)(1)’”)); *contra Schmidheiny v. Weber*, 319 F.3d 581, 583 (3d Cir. 2003) (“To conclude otherwise would permit the domain names of living persons to be sold and purchased without the living persons’ consent, ad infinitum, so long as the name was first registered before the effective date of the Act.”).

5. Cotton, *supra* note 2, at 267–68 (citing H.R. 106–412).

6. *The Domain Name System*, ICANN, <https://www.icann.org/resources/pages/dns-2022-09-13-en> [<https://perma.cc/N8W3-BP6Y>] (last visited Dec. 12, 2023); James E. Clevenger, J.D., *Proof of Cyberpiracy Under the Anti-Cybersquatting Consumer Protection Act*, 97 AM. JURIS. PROOF OF FACTS 3D 1, § 3 (originally published in 2007, updated Dec. 2023) (“Domain names are the words or phrases typed into an internet browser or search engine to locate a Website.”).

7. Patrick H.J. Hughes, *Q&A: Fish & Richardson’s Cindy J. Walden on the Lanham Act’s 75th Anniversary*, THOMSON REUTERS (June 4, 2021), <https://www.fr.com/uploads/1010-westlaw-interview-w-c-walden-june-4-2021.pdf> [<https://perma.cc/LU67-3TZW>] (“The Lanham Act was the first comprehensive nationwide legislation that outlined a framework for the registration and enforcement of trademarks.”).

8. See BEEBE, *supra* note 3, at 11. (citing Consolidated Appropriations Act, 2000, Pub. L. No. 106–113, 113 Stat. 1501, (1999/2000)).

9. 15 U.S.C.A. § 1125(d)(1)(A); see *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015) (citing *Southern Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009)) (“The ACPA was enacted to prevent cybersquatting.”).

10. Section 1125(d)(1)(A)(ii) permits liability in three distinct contexts but this note will only discuss the two contexts listed. The third context establishes liability when the domain name at issue reflects “a trademark, word, or name protected by reason of section 706 of Title 18 or section 220506 of Title 36.” 15 U.S.C.A. § 1125(d)(1)(A)(ii)(III).

a domain name."¹¹ The two contexts are: when the trademark "is distinctive at the time of registration of the domain" and when the trademark "is famous at the time of registration of the domain name...."¹² The upshot of these provisions is that, to trigger ACPA liability for domain name cybersquatting, the trademark must be either "distinctive" or "'famous' at the time" it was "registered."¹³

The primary debate over Section 1125(d) of the ACPA centers on the definition of one word: *registers*.¹⁴ This results from the fact that "the statute does not define the term 'registers.'"¹⁵ Currently, there is a circuit split regarding the definition of registers and what Congress intended to be included within that term for liability to occur, specifically, whether its interpretation has a narrow or broad reading.¹⁶ The narrow interpretation focuses solely on the initial registration of a domain name, also known as the "creation registration" because it was obtained at the domain name's creation date.¹⁷ In contrast, a broad interpretation focuses on "the initial registration and any subsequent re-registrations" that follow the initial registration.¹⁸ The timing of the registration of a domain name is critically important because Section 1125(d) is written in such a way, without a definition, that hooks the liability-imposing portions of the Act, such as "registers, traffics in, or uses" to the time the registration occurred, leaving liability open in various situations.¹⁹ As of now, the Third, Eleventh, and the Fourth Circuits have held in favor of a broad interpretation.²⁰ In

11. 15 U.S.C.A. § 1125(d)(1)(A)(i) and (ii)(I)–(III).

12. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I)–(III).

13. *Id.*

14. 15 U.S.C.A. § 1125(d)(1)(A)(ii).

15. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 794 (4th Cir. 2023) (citing 15 U.S.C. § 1125(d)(1)(A)).

16. *See Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 774 (11th Cir. 2015) ("[R]e-registration[s] constituted a registration under the ACPA."); *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3rd Cir. 2003) ("[T]he plain meaning of the word 'registration' is not limited to 'creation registration.'"); *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011) (holding that a "re-registration of [a domain name] was not a registration within the meaning of [Section] 1125(d)(1)."); *Prudential Ins. Co. of Am.*, 58 F.4th at 797 ("[T]he term 'registers' and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations.").

17. *See supra* note 4 and accompanying text.

18. *Prudential Ins. Co. of Am.*, 58 F.4th at 797 ("[T]he term 'registers' and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations."). *See Jysk Bed'N Linen*, 810 F.3d at 774 ("[R]e-registration[s] constituted a registration under the ACPA."); *Schmidheiny*, 319 F.3d at 582 ("[T]he plain meaning of the word 'registration' is not limited to 'creation registration.'"); *We the Protesters, Inc. v. Sinyangwe*, 2024 U.S. Dist. LEXIS 49532 at *36–37 (S.D.N.Y. 2024) (holding that a "re-registration suffices as a bases for" a cybersquatting claim).

19. *See supra* note 4 and accompanying text.

20. *See Jysk Bed'N Linen*, 810 F.3d at 774; *Schmidheiny*, 319 F.3d at 582; *Prudential Ins. Co. of Am.*, 58 F.4th at 797.

contrast, the Ninth Circuit, and a Colorado District Court have interpreted the term registration²¹ narrowly, only focusing on the initial registration.²²

If the narrow interpretation were to control, this would open up loopholes that would permit some forms of cybersquatting and allow the perpetrators to escape liability under the Act.²³ For example, if a domain name was initially registered before the trademark became “distinctive,”²⁴ then a person could escape civil liability, because the mark would not have triggered the ACPA at the time the domain name was registered.²⁵ Another instance where one can escape liability is if a domain name was registered prior to the time a trademark became famous.²⁶

21. When analyzing this issue, some courts interpret the term “registration” whereas the Fourth Circuit analyzed the term “registers,” but both words refer to the same issue. As such, throughout this note when referring to the terms within the ACPA any non-quoted language will refer to the term “registers.” See *GoPets Ltd.*, 657 F.3d at 1026 (“The primary question before us is whether the term ‘registration’ applies only to the initial registration of the domain name, or whether it also applies to a re-registration of a currently registered domain name by a new registrant.”); *Schmidheiny*, 319 F.3d at 583 (“We hold that the word ‘registration’ includes a new contract at a different registrar and to a different registrant.”); *Jysk Bed’N Linen*, 810 F.3d at 774 (“We hold that the re-registration constituted a registration under the ACPA.”); *Prudential Ins. Co. of Am.*, 58 F.4th at 797 (“Accordingly, we join the Third and Eleventh Circuits in holding that the term ‘registers’ and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations.”).

22. *GoPets Ltd. v. Hise* 657 F.3d 1024, 1032 (holding that a “re-registration of [a domain name] was not a registration within the meaning of [Section] 1125(d)(1).”); *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1070–73 (D. Colo. 2021) (holding that the term registration has a singular interpretation).

23. See *supra* note 4 and accompanying text.

24. The term distinctive means the trademark serves “to identify and distinguish...goods...and...indicate the source of the goods.” See BEEBE, *supra* note 3, 24, (VERSION 10) (quoting 15 U.S.C.A. § 1127). A trademark can be inherently distinctive, or it can develop distinctiveness over time, which is known as acquired distinctiveness. See BEEBE, *supra* note 3, at 24–25.

25. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I). See *GoPets Ltd.*, 657 F.3d at 1032; *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *3 (D. Ariz. 2023); *Mehdiyev*, 532 F. Supp. 3d at 1073; *AIRFX.com v. AirFX LLC*, 2012 WL 3638721, at *4 (D. Ariz. 2012) (quoting *GoPets Ltd.*, 657 F.3d at 1032); Anticybersquatting Consumer Protection Act (ACPA) Claims, Practical Law Intellectual Property & Technology, Timing of Distinctiveness or Fame, (last visited Dec. 23, 2023), <https://1.next.westlaw.com> (log into Westlaw; search the title in the search bar; click “Content types” on the left-hand side; then click “Practical Law;” and click on the work.) [<https://perma.cc/QJ55-TSMP>] (citing *GoPets Ltd.*, 657 F.3d at 1032; *ZP No. 314, LLC v. ILM Cap., LLC*, 335 F. Supp. 3d 1242, 1259–60 (S.D. Ala. 2018)) (“In cases where the asserted mark became distinctive or famous after registration of the challenged domain name, this may be grounds for rejecting an ACPA cybersquatting claim.”).

26. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(II). See Anticybersquatting Consumer Protection Act (ACPA) Claims, Practical Law Intellectual Property & Technology, Timing of Distinctiveness or Fame, (last visited Dec. 23, 2023), <https://1.next.westlaw.com> (log into Westlaw; search the title in the search bar; click “Content types” on the left-hand side; then click “Practical Law;” and click on the work.) [<https://perma.cc/5YGE-BGJF>] (citing *GoPets Ltd.*, 657 F.3d at 1032; *ZP No. 314, LLC*, 335 F. Supp. 3d at 1259–60) (“In cases where the asserted mark became distinctive or famous after registration of the challenged domain name, this may be grounds for rejecting an ACPA cybersquatting claim.”). A mark is considered famous when “it is widely recognized by the general

By having Congress amend Section 1125(d) to include a definition for the word registers to encompass subsequent re-registrations, such as renewals and domain name management, including alterations to domain name information that are related to transfers, those loopholes would dissipate. For example, including re-registrations will allow individuals who initially registered a domain name before the trademark became distinctive to be held civilly liable if such a domain name was subsequently re-registered in bad faith.²⁷ The same reasoning applies when a domain name owner re-registers a domain name after a trademark is famous.²⁸

A change in the ACPA is imperative due to the vast amount of domain names in the United States, approximately 126.9 million, that will need to be re-registered.²⁹ Since domain names must be renewed and maintained to continue ownership, ultimately, each of these registrations will need to be re-registered, in addition to any newly created domain

consuming public," 15 U.S.C. § 1125(C)(2)(A), and upon infringement, is judged based on a dilution standard. 15 U.S.C. § 1125(C)(1) ("[T]he owner of a famous mark...shall be entitled to an injunction against another person who...commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark."); *see also* BEEBE, *supra* note 3, at 439 (stating that a mark needs to be famous for an infringement claim under dilution theory).

27. Compare 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I), with *GoPets Ltd.*, 657 F.3d at 1032 (holding, in the view of a singular interpretation, that because a domain name was registered prior to the mark being registered, there was no violation of Section 1125(d)(1)); *Blair*, 2023 WL 4548352, at *3 ("Under this interpretation, if a mark is not distinctive at the time of a domain name's 'initial registration,' liability under [Section] 1125 is not possible."); *Mehdiyev*, 532 F. Supp. 3d at 1073 (holding that since the registrant "registered [the domain name] prior to the [time] the [] mark becam[e] distinctive," there is no violation or liability under Section 1125(d)); *AIRFX.com*, 2012 WL 3638721, at *4 (quoting *GoPets Ltd.*, 657 F.3d at 1032) (holding that since the domain name was "registered [] 'long before [defendant] registered its service mark,' plaintiffs' registration and ownership... 'does not violate [Section] 1125(d)"); Anticybersquatting Consumer Protection Act (ACPA) Claims, Practical Law Intellectual Property & Technology, Timing of Distinctiveness or Fame, (last visited Dec. 23, 2023), <https://1.next.westlaw.com> (log into Westlaw; search the title in the search bar; click "Content types" on the left-hand side; then click "Practical Law;" and click on the work.) [<https://perma.cc/QJ55-TSMP>] (citing *GoPets Ltd.*, 657 F.3d at 1032); *ZP No. 314, LLC.*, 335 F. Supp. 3d at 1259–60 ("In cases where the asserted mark became distinctive or famous after registration of the challenged domain name, this may be grounds for rejecting an ACPA cybersquatting claim.").

28. See 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II); *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 794, 797 (4th Cir. 2023) (rejecting the registrants singular interpretation argument that liability cannot be found since the domain name was initially registered prior to the time the mark was trademarked).

29. Damjan Milenkovic, *35+ Must-Know Domain Name Statistics (2023)*, (Sept. 28, 2023), <https://domainwheel.com/domain-name-statistics/#gref> [<https://perma.cc/D3AK-ZCEX>] ("There are about 126.9 million domains registered in the US..."); *FAQs for Registrants: Domain Name Renewals and Expiration*, ICANN, <https://www.icann.org/resources/pages/domain-name-renewal-expiration-faqs-2018-12-07-en> [<https://perma.cc/6UV8-CND8>] (last visited Jan. 10, 2024).

names.³⁰ Thus, there would be an abundance of opportunities for individuals to escape civil liability under the ACPA if a narrow interpretation were to control. The statute should be read broadly to include initial and subsequent re-registrations, including renewals and domain name management, so each circuit applies a uniform analysis to ensure those who partake in cybersquatting behavior are held civilly responsible for the type of actions that Section 1125(d) intended to protect.³¹

Section one will discuss the relevant authority of domain names and trademark law, along with introductory information regarding the current circuit split, including each circuit's analysis and conclusive interpretation of the term registers.³² Section two will discuss the imperative need for a definition clarifying the meaning of the term registers, which is supported by the statute's text and construction, the congressional purpose of the enactment of the ACPA, the public policy impacts of a narrow interpretation, international law, and the moral foundations in which this interpretation relies on.

II. BACKGROUND

A. *What is a Domain Name?*

"A domain name identifies a specific address on the Internet that belongs to an entity such as a company, organization, institution, or individual."³³ In other words, a domain name is what an individual will type into a search bar on platforms to arrive on a desired website.³⁴

30. ICANN, *supra* note 29 ("When you register a domain name, you're able to use it for the period of time you registered it for, which is typically between one to ten years. If you want to keep using the domain name...you need to renew the domain name registration prior to its expiration.")

31. 15 U.S.C.A. § 1125(d)(1)(A)(i) and (ii); *see Prudential Ins. Co. of Am.*, 58 F.4th at 796-97 (citing S. Rep. No. 106-140, at 4-6 (1999) & H.R. Rep. No. 106-412, at 6-7 (1999)); S. Rep. No. 106-140, at 4 (1999) ("[T]o protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive regulation of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks."); H.R. Rep. No. 106-412, at 6 (1999) ("[A]ctions undermine consumer confidence, discourage consumer use of the Internet, and destroy the value of brand-names and trademarks of American businesses."); *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 778 (11th Cir. 2015) ("It would be nonsensical to exempt the bad-faith re-registration of a domain name simply because the bad-faith behavior occurred during a noninitial registration, thereby allowing the exact behavior that Congress sought to prevent.")

32. *See Jysk Bed'N Linen*, 810 F.3d at 774; *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3rd Cir. 2003); *GoPets Ltd.*, 657 F.3d at 1032; *Prudential Ins. Co. of Am.*, 58 F.4th at 797.

33. ICANN, *supra* note 6.

34. *Id.* ("A domain name consists of two or more textual segments separated by dots, such as icann.org. A domain name identifies a specific address on the Internet that belongs to an entity such as a company, organization, institution, or individual.")

Generally, creation of a domain name occurs when a registrant purchases a domain name from a registrar and subsequently registers it.³⁵ In terms of domain names, a registrant is the person or organization that purchases, registers, and owns a domain name.³⁶ A registrant has certain responsibilities, such as "provid[ing] accurate information for publication in directories such as WHOIS [and the RDAP], and promptly updat[ing] this to reflect any changes."³⁷ Other responsibilities of a registrant include renewing and managing a domain name.³⁸ Renewal of a domain name occurs before ownership expires and is required if the registrant intends to continue ownership and use after that timeframe.³⁹ Renewals are required since a registrant cannot permanently own the domain name that was purchased; instead, a registration is "just acquiring the rights to register it to themselves and continue to manage and re-register it in the future."⁴⁰ Domain name management includes continual responsibilities of a registrant to maintain their domain name, such as ensuring domain stability.⁴¹

Registrars are a type of organization that provides services to registrants to purchase, register, and maintain domain names.⁴² The

35. *Mehdiyev v. Qatar Nat'l Tourism Council*, 532 F. Supp. 3d 1065, 1070 (D. Colo. 2021) (citing *Office Depot Inc., v. Zuccarini*, 596 F.3d 696, 698–99 (9th Cir. 2010)) ("A domain name is created when it is registered with a registry operator that maintains the registry that associates domain names with the proper IP numbers for the respective domain name servers.").

36. See *Information for Domain Name Registrants*, ICANN, <https://www.icann.org/registrants> [<https://perma.cc/YA5S-85U2>] (last visited Dec. 12, 2023) ("A domain name registrant is an individual or entity who registers a domain name."); *General Questions*, ICANN, <https://www.icann.org/resources/pages/faqs-84-2012-02-25-en#4> [<https://perma.cc/C653-UFZN>] (last visited Dec. 20, 2023); Derek Miller, *What is a domain name? The best beginner's guide (2023)*, GODADDY (Mar. 6, 2023), <https://www.godaddy.com/resources/skills/what-is-a-domain-name> [<https://perma.cc/KBA5-EALQ>] ("A domain registrant is a person or entity registering a specific domain name from the domain registrar.").

37. *Registrants' Benefits and Responsibilities*, ICANN, <https://www.icann.org/resources/pages/benefits-2013-09-16-en> [<https://perma.cc/6S54-967M>] (last visited Dec. 13, 2023).

38. See Katie Collins, *A complete guide to domain management*, FASTHOSTS, (last visited Dec. 13, 2023), <https://www.fasthosts.co.uk/blog/guides/domain-management-guide/> [<https://perma.cc/R7CG-RWVD>] (listing registrant responsibilities regarding the management of domain names); ICANN, *Renewing Domain Names*, (last visited Dec. 13, 2023), <https://www.icann.org/resources/pages/renew-domain-name-2018-12-07-en> [<https://perma.cc/VN6M-L5LE>] (stating that to continue to use a domain name, a registrant must renew the domain name prior to its expiration).

39. ICANN, *supra* note 29 ("If you want to keep using the domain name and any of the services associated with it...you need to renew the domain name registration prior to its expiration.").

40. ICANN, *supra* note 36.

41. Kristin Crabb, *Everything you need to know about domain management*, DOMAIN.COM (July 29, 2024), <https://www.domain.com/blog/domain-management-101/> [<https://perma.cc/F5WS-Z6RC>] ("Domain management...refers to the ongoing tasks of keeping a personal or corporate domain (or domains) stable, secure, and able to support related websites.").

42. See *About Registrars*, ICANN, <https://www.icann.org/resources/pages/what-2013-05-03-en> [<https://perma.cc/9WR7-6JZT>] (last visited Dec. 12, 2023) ("A registrar is an entity that offers

Internet Corporation for Assigned Names and Numbers (“ICANN”) is the entity that manages the registration system for domain names and not the ACPA.⁴³ ICANN is not encompassed within the term registrar; instead, “ICANN... is an international group that offers non-binding arbitration for adjudicating disputes over domain names.”⁴⁴ ICANN requires a person or an organization who intends to provide services to registrants for registering a domain name as a registrar, to enter into an agreement with and be accredited by ICANN.⁴⁵

The process of selecting, purchasing, and registering a domain name includes selecting an accredited registrar, choosing a domain name via a search through the registrar, and then purchasing the domain name on the registrar.⁴⁶ Upon the registration, the registrant will pay the registrar’s

domain name registration services to registrants...”); *Domain Name Industry*, ICANN, <https://www.icann.org/resources/pages/domain-name-industry-2017-06-20-en> [<https://perma.cc/K3UP-7UTY>] (last visited Dec. 29, 2023) (“Registrars are companies that you can contact to register a domain name.”); *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1070 (D. Colo. 2021) (citing *Office Depot Inc. v. Zuccarini*, 596 F.3d 696, 698–699 (9th Cir. 2010) (“Registrars, which are distinct from registries, facilitate the purchase of available and expired domain names to registrants and work with registries to ensure that domain names are properly registered.”); *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3rd Cir. 2003) (citing Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187, 216–17 (2000)) (“Domain name registrars are organizations that keep track of Internet domain names and ensure that only one party controls a specific domain name during any given period.”).

43. *Mehdiyev*, 532 F. Supp. 3d at 1070 (citing *Office Depot Inc.*, 596 F.3d at 698–699 (“The entire process of registering domain names is overseen by the non-profit Internet Corporation for Assigned Names and Numbers.”); see Cotton, *supra* note 2, (citing *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015) (stating that “the ACPA does not manage the registration of domain names” because “[t]hat responsibility is left to the Internet Corporation for Assigned Names and Numbers (ICANN), which is responsible for overseeing multiple third-party registries”).

44. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1027 (9th Cir. 2011); Personal communication with Emily Michiko Morris, David L. Brennan Endowed Professor, University of Akron School of Law, Akron, Ohio (Jan. 8, 2024).

45. *Information for Registrars*, ICANN, <https://www.icann.org/resources/pages/registrars-0d-2012-02-25-en> [<https://perma.cc/3AFB-D88K>] (last visited Jan. 10, 2024) (stating that “[a]ny entity that wants to offer domain name registration services...is required to obtain an accreditation from ICANN” and such a relationship between ICANN and a registrar will be “governed by the individual Registrar Accreditation Agreements (RAA), which set out the obligations of both parties”); see *Registering Domain Names*, ICANN, <https://www.icann.org/resources/pages/register-domain-name-2017-06-20-en> [<https://perma.cc/T7WZ-Y3HC>] (last visited Dec. 13, 2023) (“Registrars are accredited by ICANN organization and certified by the registries to sell domain names.”).

46. Brenda Barron, *How to buy a domain name in 3 steps*, GODADDY, (Apr. 29, 2019), <https://www.godaddy.com/resources/skills/how-to-buy-a-domain-name> [<https://perma.cc/YZQ4-AZAJ>]; see Miller, *supra* note 36, at <https://www.godaddy.com/resources/skills/what-is-a-domain-name> [<https://perma.cc/28ZM-WNFE>] (listing the ways of locating a domain name and subsequently purchasing it). See also ICANN, *supra* note 36 (“The registrar you choose will ask you to provide various contact and technical information that makes up the registration.”).

fee.⁴⁷ The registrar subsequently has the duty of maintaining documentation of a domain name.⁴⁸ This includes maintenance requirements under the RDDS Accuracy Program Specification or "Whois," which is a program that contains an annual procedural requirement of reviewing and updating information related to domain name ownership.⁴⁹ Specifically, within the RDAP, it is the responsibility of the registrant, following the initial registration, to "provide accurate information for publication in directories... and promptly update this to reflect any changes."⁵⁰

Generally, after successfully registering a domain name, the owner keeps ownership for a duration of time that was agreed upon between the registrant and the registrar, "which is typically between one and [ten] years."⁵¹ A registrant does not permanently own a domain name after its initial registration, meaning after the period of time a domain name was registered for, action must be taken to retain ownership.⁵² To continue the use of a domain name after said duration, the registrant must renew the domain name prior to its expiration date.⁵³ The timeline of which renewal

47. *GoPets Ltd.*, 657 F.3d at 1030 ("When an individual registrant registers a domain name, [they] pay[] the registrar a fee and gives the registrar a registrant name, along with contact, billing, and technical information."); see *Mehdiyev*, 532 F. Supp. 3d at 1070 (citing *GoPets Ltd.*, 657 F.3d at 1030) ("At the time of initial registration, the registrant pays the registrar a fee for the domain name and provides contact, billing, and technical information.").

48. ICANN, *supra* note 36 ("The registrar will then keep records of the contact information and submit the technical information to a central directory known as the 'registry.'").

49. *2013 Registrar Accreditation Agreement*, ICANN (Apr. 30, 2023), <https://www.icann.org/en/system/files/files/registrar-accreditation-agreement-redline-30apr23-en.pdf> [<https://perma.cc/354E-2TD6>] (stating that a "[r]egistrar shall comply with the obligations specified in the RDDS Accuracy Program Specification"); *FAQs: Domain Name Registrant Contact Information and ICANN's WHOIS Data Reminder Policy (WDRP)*, ICANN, <https://www.icann.org/resources/pages/faqs-f0-2012-02-25-en> [<https://perma.cc/89L4-UTBN>] (last visited Dec. 18, 2023) ("The policy requires your registrar to formally remind you once a year to review and update your contact information.").

50. ICANN, *supra* note 49.

51. ICANN, *supra* note 38; ICANN, *supra* note 29 ("Options and fees for renewing domain names, including expired ones, vary by registrar..."); see Brian Gutterman, *Do You Have a Domain Name? Here's What You Need to Know*, ICANN (Dec. 7, 2018), <https://www.icann.org/en/blogs/details/do-you-have-a-domain-name-heres-what-you-need-to-know-7-12-2018-en> [<https://perma.cc/HYF4-GS3F>] ("Options and fees for renewing domain names, including expired ones, vary by registrar...").

52. Michael Gargiulo, *How To Register Your Domain Name For As Long As Possible*, Forbes, (Mar. 18, 2021, 8:40 AM), <https://www.forbes.com/sites/forbestechcouncil/2021/03/18/how-to-register-your-domain-name-for-as-long-as-possible/?sh=6f2c9ab13113> [<https://perma.cc/3RXW-A8WG>] ("While it's not possible to permanently buy a domain, there are leases for indefinite lengths."); ICANN, *supra* note 29.

53. ICANN, *supra* note 38 ("If [the owner] want[s] to keep using it, including all of the services associated with it (like a website or email service), [they] have to renew it with [their] registrar before it expires.").

occurs is determined by the owner's agreement with the specific registrar chosen.⁵⁴

If there is any dispute regarding a domain name, then a registrant must follow the procedures and requirements provided under the Uniform Domain Name Dispute Resolution Policy ("UDRP").⁵⁵ UDRP, adopted by ICANN and administered by the WIPO,⁵⁶ provides protections to trademark owners in cybersquatting cases by administrative proceedings that can result in the "cancellation of the domain name or the transfer of the domain name registration to the trademark owner."⁵⁷ However, owners can subsequently challenge such rulings in court.⁵⁸

B. *Anti-Cybersquatting Consumer Protection Act*

The Lanham Act safeguards the owners of trademarks from two forms of infringement, the likelihood of confusion or dilution of the mark, and enforces trademark owner's rights to their mark in commerce.⁵⁹ In 1999, the ACPA amended the Lanham Act to protect trademark owner's from cybersquatters on the same basis of infringement.⁶⁰ Domain name registration occurs on a first-come, first-serve basis, which manufactured cybersquatting due to the exclusive ownership of the domain name and

54. ICANN, *supra* note 29.

55. *Uniform Domain Name Dispute Resolution Policy*, ICANN (Oct. 24, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [<https://perma.cc/27SV-M7W2>] (stating that ICANN has endorsed the UDRP, which "is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you.").

56. Luke A. Walker, *ICANN'S UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY*, 15 BERKELEY TECH. L.J. 289, 298–299 (2000) ("ICANN has adopted [] its Uniform Name Dispute Resolution Policy" which was a "proposed [] policy adapted from the World Intellectual Property Organization ("WIPO") proposal to resolve certain domain disputes."); *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1027 (9th Cir. 2011) ("[T]he World Intellectual Property Organization (WIPO) [] administers ICANN's Uniform Dispute Resolution Policy.").

57. Lauzon, *supra* note 2, 17. See *Uniform Domain-Name Dispute-Resolution Policy*, ICANN <https://www.icann.org/resources/pages/help/dndr/udrp-en> [<https://perma.cc/F7Y7-E9NW>] (last visited Oct. 1, 2023) ("Disputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.").

58. Walker, *supra* note 56, at 300.

59. See Hughes, *supra* note 7, at <https://www.fr.com/uploads/1010-westlaw-interview-w-c-walden-june-4-2021.pdf> [<https://perma.cc/LU67-3TZW>] ("[T]he Lanham Act...has been enacted in the U.S. to help trademark owners protect and enforce their marks, and to protect the public from likelihood of confusion."); BEEBE, *supra* note 3, at 334, 341, 434. See 15 U.S.C.A. § 1125(a)(1)(A) and (e)(1).

60. BEEBE, *supra* note 3, at 11 (citing Consolidated Appropriations Act, 2000, Pub. L. No. 106-113, 113 Stat. 1501 (1999/2000)) ("[T]o combat the cybersquatting of domain names confusingly similar to or dilutive of trademarks.").

the ability of the registrant to obtain an expensive payment for transfer of such domain name.⁶¹ As such, cybersquatting, also known as cyberpiracy, occurs when an individual registers one or more domain names intending to confront the trademark owner for selling said domain name at an overly expensive price.⁶² Thus, "Cybersquatting is essentially extortion."⁶³

In the eyes of Congress, the ACPA's enactment is based on protecting the public and the economy, explicitly to deter "registrations that harm commerce, business, and consumers."⁶⁴ The language of the ACPA creates civil liability for anyone who:

- (i) [H]as a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and
- (ii) [R]egisters, traffics in, or uses a domain name that—
 - a. [I]n 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;

61. Lauzon, *supra* note 2, at § 2[a] (originally published in 2002) ("Cybersquatting has resulted from the first-come, first-served manner in which domain name registrars grant domain names, ... [with] generally no inquiry into whether a domain name request matches a trademark held by someone other than the requestor.").

62. Cotton, *supra* note 2 (citing H.R. 106-412, 106th Cong. § 1 (1999)) ("Essentially, cybersquatters register numerous domain names and then hold those domain names at ransom in an effort to extort money from a person or a company more commonly associated with that domain name."); Lauzon, *supra* note 2 (originally published in 2002) (citing *Virtual Works, Inc. v. Volkswagen of America, Inc.*, 238 F.3d 264 (4th Cir. 2001)) ("Cybersquatting (or cyberpiracy) refers to the deliberate, bad-faith, and abusive registration of Internet domain names utilizing distinct or famous trademarks in violation of the trademark owner's rights, often forcing the owners to pay for the right to engage in electronic commerce under their own brand names."). See McCarthy, *supra* note 2, at 709 (quoting *Interstellar Starships Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 946 (9th Cir. 2002) ("Cybersquatters register well-known brand names as Internet domain names in order to force the rightful owners of the marks to pay for the right to engage in electronic commerce under their own name."); *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015)); Westlaw Glossary, *Cyberpiracy*, (last visited Dec. 13, 2023), [https://next.westlaw.com/Document/\[https://perma.cc/NM86-XMW4\]](https://next.westlaw.com/Document/[https://perma.cc/NM86-XMW4]) (providing a definition for cyberpiracy, specifically stating it is "[a]lso known as cybersquatting.").

63. *Jysk Bed'N Linen*, 810 F.3d at 775.

64. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 796 (4th Cir. 2023) (citing S. Rep. No. 106-140, at 4-6 (1999) & H.R. Rep. No. 106-412, at 6-7 (1999)); see also S. Rep. No. 106-140, at 4 (1999) ("[T]o protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive regulation of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks."); H.R. Rep. No. 106-412, at 6 (1999) ("[A]ctions undermine consumer confidence, discourage consumer use of the Internet, and destroy the value of brand-names and trademarks of American businesses."); *Jysk Bed'N Linen*, 810 F.3d at 775 (citing *Southern Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009)) ("The ACPA was enacted to prevent cybersquatting.").

- b. [I]n 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; or
- c.⁶⁵

Courts establish such civil liability when they find those actions to be in bad faith, based on a nine factor list within the ACPA.⁶⁶ Accordingly, for civil liability to occur, a trademark owner must prove that there was “bad faith intent to profit from that mark,” as analyzed by the factors above, and the domain name was “register[ed], traffic[ked] in, or use[d]” when “the...mark [] is distinctive” or “famous at the time of the registration of the domain name.”⁶⁷ This note focuses on the proper broad interpretation of the term registers within the ACPA due to the tension between the Circuit Courts that was created because “the statute does not define the term ‘registers.’”⁶⁸

C. Different Jurisdictional Approaches

The uncertainty of when liability can be imposed on individuals has created a circuit split.⁶⁹ Most circuits favor a broad interpretation of the ACPA that includes subsequent re-registrations. In contrast, the minority view focuses solely on the initial registration of the domain name under the narrow interpretation—that is, they hold that the creation regulation must qualify for ACPA liability.⁷⁰ The trademark at issue must be distinctive or famous, or otherwise qualify, at the time of the initial registration that created the domain name.⁷¹ Such uncertainty raises

65. 15 U.S.C. § 1125(d)(1)(A)(i) and (ii)(I)(II) and (ii)(III).

66. 15 U.S.C. § 1125(d)(1)(B)(i)(I)–(IX).

67. 15 U.S.C.A. § 1125(d)(1)(A)(i)(ii)(I)–(III) and (d)(1)(B)(i)(I)–(IX); see *Jysk Bed’N Linen*, 810 F.3d at 770–71 (quoting 15 U.S.C. § 1125(d)(1)(A)) (“A person shall be liable...by the owner of a mark...if...that person...has a bad faith intent to profit from that mark...; and...registers, traffics in, or uses a domain name that...is identical or confusingly similar to that mark.”); *Prudential Ins. Co. of Am.*, 58 F.4th at 794 (quoting 15 U.S.C. § 1125(d)(1)(A)) (“[A] cybersquatter who ‘registers’ a domain identical or confusingly similar to a distinctive trademark or famous mark with a ‘bad faith intent to profit’ from the domain is liable to the trademark owner.”); *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030 (9th Cir. 2011) (quoting 15 U.S.C. § 1125(d)(1)) (“To prevail on its ACPA claim, [the plaintiff] must show (1) registration of a domain name, (2) that was ‘identical or confusingly similar to’ a mark that was distinctive at the time of registration, and (3) ‘bad faith intent’ at the time of registration.”) (emphasis original).

68. *Prudential Ins. Co. of Am.*, 58 F.4th at 794, 797.

69. See cases cited *supra* note 16 and accompanying text.

70. *GoPets Ltd.*, 657 F.3d at 1032; *Mehdiyev v. Qatar Nat’l Tourism Counsel*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021).

71. *GoPets Ltd.*, 657 F.3d at 1032; *Mehdiyev*, 532 F. Supp. 3d at 1073.

significant policy issues, which is why Congress must provide clarification.

1. The Third Circuit

The Third Circuit, in *Schmidheiny v. Weber*, adopted a broad interpretation of the ACPA.⁷² The initial registration occurred in 1999, prior to the enactment of the ACPA, and it was subsequently re-registered in 2000. The registrant's name was altered in the domain name, and it was transferred to another registrar.⁷³

The Third Circuit held the ACPA could apply to this second registration event.⁷⁴ In adopting this view, the court stated the statute's text supported a broad reading since it did not include any language that would limit the scope of its application, such as "[t]he words 'initial' and 'creation' appear nowhere...and Congress did not add an exception for 'non-creation registrations.'"⁷⁵ Additionally, a narrow interpretation would allow individuals who initially registered a domain name prior to the ACPA's effective date to escape liability, so the Court ultimately held that when an alteration of the registrar and registrant names occur, such as the subsequent alteration in 2000, those actions are encompassed within the term registration.⁷⁶

2. The Ninth Circuit

The Ninth Circuit, in contrast, has adopted a narrow interpretation of the word registration.⁷⁷ The registrant initially "registered the domain name *gopets.com* in his own name in March 1999."⁷⁸ Simultaneously, the registrant also owned a corporation, named *Digital Overture*.⁷⁹ A company named *GoPets Ltd.* was created in 2004, and the trademark owner subsequently registered it as its trademark.⁸⁰ The trademark owner

72. *Schmidheiny v. Weber*, 319 F.3d 581, 581 (3d Cir. 2003). Although the Third Circuit's decision was centered around Section 1129, which is now known as Section 8131, of the ACPA, it is relevant because the Third Circuit analyzed the same term when deciding if a re-registration was included when the domain name registrant and registrar names were altered. *Schmidheiny*, 319 F.3d at 582, 583. See 15 U.S.C. § 1129 (transferred to § 8131(1)(A)) ("Any person who registers a domain name...with the specific intent to profit...by selling the domain name for financial gain to that person or any third party."); *Schmidheiny*, 319 F.3d at 582 (quoting 15 U.S.C. § 1129).

73. *Schmidheiny v. Weber*, 2002 WL 562642, at *1,3 (E.D. Pa. 2002).

74. *Schmidheiny*, 319 F.3d at 581.

75. *Id.* at 582 (citing *United States v. Johnson*, 529 U.S. 53, 58 (2000)).

76. *Id.* at 583.

77. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1028, 1032 (9th Cir. 2011).

78. *Id.* at 1026.

79. *Id.* at 1027.

80. *Id.*

solicited the domain name from the registrant.⁸¹ Because of many failed inquiries, the trademark owner's company attempted to obtain the domain name through WIPO proceedings, but subsequently failed, selling the domain name for five-million dollars.⁸² Shortly after, the registrant "transferred the registration of gopets.com from himself to the [registrant's] corporation, Digital Overture."⁸³ The trademark owner's corporation, GoPets Ltd., sued the registrant pursuant to the ACPA and argued "that the re-registration of the domain by Digital Overture" following the transfer was encompassed within the term registration and thus, was a violation of the ACPA.⁸⁴

Ultimately, the Ninth Circuit found the term registration did not apply to the transfer of the domain name from the registrant to his corporation because a broad interpretation "would make rights to many domain names effectively inalienable,"⁸⁵ and it is in direct contradiction with the general rule of property: "a property owner may sell all of the rights he holds in property."⁸⁶ The Ninth Circuit endorsed a narrow interpretation when it held the re-registration of the domain name with Digital Overture was not a violation of the ACPA since the registrant initially registered the domain name prior to the establishment of the mark.⁸⁷

81. *Id.*

82. *Id.* at 1027–28.

83. *Id.*

84. *Id.* at 1030.

85. *Id.* at 1031–32.

86. *Id.* at 1031. The Ninth Circuit rejected the Third Circuit's interpretation because its analysis was based on an incorrect assumption that the ACPA would not apply retroactively. *Id.* The Ninth Circuit refuted that argument on the basis of a public law and a Second Circuit opinion that stated, "that [Section] 1125(d)(1) ...appl[ies] to registrations made before the passage of [the] ACPA." *Id.* (citing *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 496–97 (2d Cir. 2000)) (emphasis original); see *Sporty's Farm L.L.C.*, 202 F.3d at 496, 500 (quoting Pub. L. No. 106–113, § 3010) (stating that liability for a domain name can occur "if the domain name was 'registered before, on, or after the date of the enactment of this Act'"). The Second Circuit applied the ACPA to a domain name that was initially registered prior to the enforcement of the ACPA because a Public Law stated that Section 1125 permits court intervention for "domain name[s] [that] w[ere] 'registered before, on, or after the date of the enactment of this Act.'" *Sporty's Farm L.L.C.*, 202 F.3d at 496 (2d Cir. 2000) (quoting Pub. L. No. 106–113, § 3010); see Pub. L. No. 106–113, § 3010. Thus, the Third Circuit erroneously assumed the ACPA did not apply retroactively and only accepted such a broad interpretation to ensure liability could still be found when, in fact, the ACPA does apply retroactively. *GoPets Ltd.*, 657 F.3d at 1031.

87. *GoPets Ltd.*, 657 F.3d at 1032.

3. The Eleventh Circuit

The Eleventh Circuit in *Jysk Bed’N Linen v. Dutta-Roy*, adopted a broad interpretation of the ACPA.⁸⁸ The trademark owner made an agreement for the creation of a business, which required the creation of a domain name by the registrant.⁸⁹ Contrary to instructions, upon creation of the domain name, the registrant listed their name and not the trademark owner when specifying ownership.⁹⁰ The trademark owner discovered this ownership problem and requested upon re-registration, the registrant to modify the information to reflect the trademark owner as the owner.⁹¹ In response, the registrant re-registered that domain name and initially registered similar domain names in their name and requested compensation under an agreement that the trademark owner refused existed, in return for the domain names.⁹² Following this disagreement, the trademark owner sued.⁹³ The registrant argued for a narrow interpretation of the ACPA stating that no violation could have occurred since subsequent re-registrations were not encompassed within the term registration.⁹⁴ The District Court disagreed and accepted a broad interpretation of the ACPA, and ultimately, the Eleventh Circuit agreed.⁹⁵

In its analysis, the Eleventh Circuit determined that “[t]he plain meaning of *register* includes a re-registration,”⁹⁶ and followed the Third Circuit’s reasoning of the statute’s text, specifically stating that there are no “qualifications of *initial* or *creation* when it refers to the act of registering.”⁹⁷ Furthermore, it would be illogical “to exempt the bad-faith re-registration of a domain name simply because the bad-faith behavior occurred during a noninitial registration,” especially when this analysis would allow those to escape liability from “the exact behavior that Congress sought to prevent.”⁹⁸ Thus, the Eleventh Circuit adopted a broad interpretation.⁹⁹

88. *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 778 (11th Cir. 2015) (emphasis original).

89. *Id.* at 771–72.

90. *Id.* at 772.

91. *Id.*

92. *Id.*

93. *Id.*

94. *Id.* at 774.

95. *Id.* at 778 (“The District Court correctly held that a re-registration falls within the purview of the ACPA.”).

96. *Id.* at 778 (emphasis original).

97. *Id.* at 777 (emphasis original).

98. *Id.* at 778.

99. *Id.* at 774 (“We hold that the re-registration constituted a registration under the ACPA.”).

4. The Fourth Circuit

The Fourth Circuit in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*, adopted a broad interpretation.¹⁰⁰ In 2002, the trademark owner had “PRU” trademarked.¹⁰¹ Later in 2017, the registrant bought a domain name (“PRU.COM”) from a platform and subsequently registered the domain name; however, this was not the initial registration since an unknown third party formerly owned it.¹⁰² Upon realization of the existence of the domain name, the trademark owner tried to purchase it from the registrant, but was unsuccessful.¹⁰³ Thereafter, the trademark owner filed suit against the registrant claiming ACPA violations.¹⁰⁴

The Fourth Circuit determined the reading of the statutory text, in conjunction with a term definition, includes re-registrations, especially due to the absence of any limiting qualifiers within the statute, such as initial.¹⁰⁵ The Fourth Circuit rejected the Ninth Circuit’s holding since it is in direct conflict with Congress’s purpose of enactment, specifically the prevention of cybersquatting,¹⁰⁶ and although the Fourth Circuit acknowledged the Ninth Circuit’s concern, ““that innocent persons would be subject to ACPA liability for minor, periodic re-registrations of domain names,”” it can be combatted by Section 1125(d)’s ““bad faith intent to profit inquiry.””¹⁰⁷ Reliance on the bad faith requirement aids in eradicating the property concerns in re-registrations, and thus the Ninth Circuit’s inalienability concerns¹⁰⁸ since any subsequent re-registration will not enable any loss of domain name rights unless there was a registration done in bad faith.¹⁰⁹ Therefore, the Fourth Circuit held the

100. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023).

101. *Id.* at 789.

102. *Id.*

103. *Id.*

104. *Id.* at 790–91.

105. *Id.* at 796 (stating that “the ordinary meaning of the word ‘registers’ necessarily includes both the first registration and any subsequent re-registrations,” there is no specified limitation “to only the initial or creation registration,” and “conclude that the re-registration of a domain name is a registration for purposes of the ACPA.”).

106. *Id.* at 796 (“[T]he Ninth Circuit’s *GoPets* decision is contrary to the statutory purpose of the ACPA, which is to curtail cyberpirates and cybersquatting.” (citing H.R. Rep. No. 106–464, at 108 (1999))).

107. *Id.* at 797 (quoting *Prudential Ins. Co. of Am. v. PRU.COM*, 546 F. Supp. 3d 476, 492 (E.D. Va. 2021)). See 15 U.S.C.A. § 1125(d)(1)(A)(i).

108. *Prudential Ins. Co. of Am.*, 58 F.4th at 797.

109. *Id.* (“[A] registrant will only lose their rights to a domain name at one of the aforementioned junctures if they act in bad faith.”).

proper statutory interpretation encompasses any successive re-registrations.¹¹⁰

5. The District of Colorado

One district court within the Tenth Circuit held in favor of a narrow interpretation in *Mehdiyev v. Qatar Nat'l Tourism Council* in the context of when a registration was transferred.¹¹¹ The court considered whether the domain name was registered within the meaning of the ACPA when the trademark owner later acquired it in 2016 after the trademark owner initiated the use of its mark in 2015, or if the analysis should focus on the initial registration by a non-party in 2004.¹¹² To resolve this, the registrant sued arguing that his actions do not amount to cybersquatting.¹¹³ The trademark owner argued a broad interpretation includes subsequent interactive alterations to domain name information, such as the registrant's acquisition in 2016, and is thus a violation of the ACPA.¹¹⁴ Whereas the registrant argued the only registration relevant is the initial registration in 2004, and since the domain name was initially registered prior to the time the trademark owner started to develop their mark, "the [] mark was not distinctive at the time of registration" thus, no violation has occurred.¹¹⁵

In adopting a narrow interpretation, the court determined the statute's text conveyed "a singular point in time" based on the language "'the time of registration'" within Section 1125(d), which is evident due to the lack of language supporting subsequent re-registrations.¹¹⁶ As a result, the Third and Eleventh Circuit's inference made on the absence of words such as "'initial' or 'first' registration" was rejected, because the text already reads in a singular manner, there is no need for additional qualifiers to

110. *Id.* at 797. See Attison L. Barnes, III, Ari Meltzer, David E. Weslow, and Adrienne J. Kosak, *Fourth Circuit Finds "Re-registration" of a Domain Can be Cybersquatting—A Prudential Clarification to the ACPA* (Jan. 25, 2023), <https://www.wiley.law/alert-Fourth-Circuit-Finds-Re-registration-of-a-Domain-Can-be-Cybersquatting-A-Prudential-Clarification-to-the-ACPA> [<https://perma.cc/4STC-J4CZ>] ("[T]he Fourth Circuit's opinion is not limited to re-registration...but, instead, appears to include any successive re-registration of a domain name including acts such as domain renewals.").

111. See *Mehdiyev v. Qatar Nat'l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021) (holding that since the registrant "registered [the domain name] prior to the [time] the [] mark becam[e] distinctive," there is no violation or liability under Section 1125(d)).

112. *Id.* at 1070–71.

113. *Id.* at 1069.

114. *Id.* at 1070–71.

115. *Id.* at 1070. See 15 U.S.C. § 1125(d)(1)(A)(ii)(I).

116. *Mehdiyev*, 532 F. Supp. 3d at 1071–72.

solidify a narrow interpretation.¹¹⁷ This is further supported by ICANN because it “lists a single registration date for a registered domain name,” and any endorsement of a broad interpretation would obscure the current registration process.¹¹⁸ Moreover, the inclusion of subsequent re-registrations “after each acquisition of a domain name would render the specific references to acquisition in [Section] 1125(d)(B)(VIII) meaningless.”¹¹⁹ The District of Colorado further refuted the designation of “aftermarket sales of domain names as ‘re-registrations’” because the transfer process is different than initial registrations and the “develop[ment] [of] the extra-textual term ‘re-registrations’ suggests that a re-registration is not, in fact, a registration.”¹²⁰

Furthermore, any congressional purpose argument is not likely to defeat textual arguments, because Congress already limited the statute’s liability to registrations following the time “a similar mark became distinctive,” so if further limitations were warranted Congress could have explicitly stated so.¹²¹ Lastly, the District of Colorado implies negative incentives of permitting a broad interpretation of registrations, such as the incentives to choose a trademark that is analogous to current domain names and use the legal process to obtain it; instead of using the registration process to deter individuals from registering marks that are like domain names.¹²² Thus, since the initial registration occurred before the trademark in question was distinctive, there is no violation under Section 1125(d).¹²³

III. WHY IT IS IMPERATIVE TO AMEND THE ACPA TO DEFINE THE TERM REGISTERS AND NOT LEAVE ITS INTERPRETATION UP TO THE CIRCUIT COURTS

The ACPA enactment provides civil liability when an individual registers one or more domain names that dilute a famous mark or is likely to confuse a distinctive mark with the bad faith intent to extort money

117. *Id.* at 1072 (citing *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 777 (11th Cir. 2015); *Schmidheiny v. Weber*, 319 F.3d 581, 582–83 (3d Cir. 2003)).

118. *Id.* at 1073.

119. *Id.* at 1071 (citing *Obduskey v. McCarthy & Holthus LLP*, 139 S. Ct. 1029, 1037 (2019)).

120. *Id.* at 1073.

121. *Id.* at 1072–73. *See* 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I); *Mehdiyev*, 532 F. Supp. 3d at 1073 (“But if Congress had wanted to prohibit any such bad-faith use of a registration, it could have saved everyone a lot of trouble by not limiting [Section] 1125(d) to domains that were registered after a similar mark became distinctive.”).

122. *Mehdiyev*, 532 F. Supp. 3d at 1073.

123. *Id.*

from a trademark owner.¹²⁴ Although this may seem straightforward, “the statute does not define the term ‘registers.’”¹²⁵ This omitted definition from Section 1125 has created a circuit split regarding when a registration will trigger liability.¹²⁶ The uncertainty lies in determining whether re-registrations are encompassed within the term registers under Section 1125(d) of the ACPA, and whether it will affect the ability to hold those responsible for violating the ACPA.¹²⁷ The acceptance of a narrow interpretation would open various loopholes for those who violate the Act, like not being subject to civil liability.¹²⁸

For example, if a domain name was initially registered before the trademark became distinctive or famous, then civil liability would not be found within the ACPA.¹²⁹ Congress should amend Section 1125(d) to include a definition of the word registers to encompass subsequent re-registrations, such as renewals and domain name management, including the alterations to domain name information that are related to transfers. This congressional alteration would close those loopholes.¹³⁰ The inclusivity of a broad interpretation will allow individuals who initially registered prior to the time distinctiveness is recognized with the trademark to be held civilly liable if such a domain name were subsequently registered in bad faith.¹³¹ The same reasoning applies to

124. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 794 (4th Cir. 2023) (“[A] cybersquatter who ‘registers’ a domain identical or confusingly similar to a distinctive trademark or famous mark with a ‘bad faith intent to profit’ from the domain is liable to the trademark owner.” (quoting 15 U.S.C. § 1125(d)(1)(A))).

125. *Id.* at 794. *See* 15 U.S.C.A. § 1125.

126. *See* case cited *supra* note 16 and accompanying text.

127. *See* case cited *supra* note 16 and accompanying text.

128. *See* cases cited *supra* note 4 and accompanying text.

129. *See* cases cited *supra* note 4 and accompanying text; 15 U.S.C.A. § 1125(d)(1)(A)(ii)(II).

130. *See* 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II); *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 794, 797 (4th Cir. 2023) (rejecting the registrants singular interpretation argument that liability under the ACPA cannot be found since the domain name was initially registered prior to the time the mark was trademarked); *Schmidheiny v. Weber*, 319 F.3d 581, 581–83 (3d Cir. 2003) (holding that when one initially registered a domain name prior to the ACPA’s enactment, they could still be subject to civil liability under the ACPA due to a subsequent registration that was made after the ACPA’s enactment).

131. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I). *Contra* *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011) (holding, in the view of a singular interpretation, that because a domain name was registered prior to the mark being registered, there was no violation of Section 1125(d)(1)); *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *3 (D. Ariz. 2023) (“Under this interpretation, if a mark is not distinctive at the time of a domain name’s ‘initial registration,’ liability under [Section] 1125 is not possible.”); *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021) (holding that since the registrant “registered [the domain name] prior to the [time] the [] mark becam[e] distinctive,” there is no violation or liability under Section 1125(d)); *AIRFX.com v. AirFX LLC*, 2012 WL 3638721, at *4 (D. Ariz. 2012) (holding that since the domain name was “registered [] ‘long before [defendant] registered its service mark,’ plaintiffs’ registration and ownership...’ does not violate [Section] 1125(d)” (quoting *GoPets Ltd.*, 657 F.3d at 1032)).

situations when a domain name owner subsequently registers a domain name at the time a trademark is famous so long as bad faith is found.¹³²

As of now, the majority of the cases heard by the circuit courts favor a broad interpretation, and thus, support an alteration to the ACPA. If Congress were to add a definition in favor of a broad interpretation, there would be a uniform application of Section 1125(d), which would close the loopholes found within a narrow interpretation.¹³³ Thus, the only solution to create uniformity and clear rights for trademark owners and registrants is for Congress to amend the ACPA and include a definition of the term registers that favors a broad interpretation.

IV. ANALYSIS

Congress should amend Section 1125(d) of the ACPA to include a definition for registers, specifically a definition including subsequent re-registrations of a domain name. It may be argued that Congress need not amend the ACPA to provide an explicit definition when the majority of the circuit courts already appear to be applying the broad interpretation that this note argues for; however, if no action is taken, then the circuit courts will continue their application of the ACPA, including the narrow interpretation, with the additional interpretations that are likely to come forth from the other circuit courts, which will create confusion for the courts, trademark owners, and registrants.

Furthermore, the determination of the correct interpretation is critically important since reliance on the other liability-imposing portions of the Act, such as “registers, traffics in, or uses” also attaches liability to the timing of the registration, so an acceptance of a narrow interpretation can leave liability open.¹³⁴ The only clear solution is for congressional alteration to the ACPA or a Supreme Court decision, but there is no timeline for when or if the Supreme Court will hear a case regarding this issue. But the decision to wait for the Supreme Court to issue an opinion on this issue will allow for many injustices to occur.¹³⁵ A congressional alteration would clarify the confusion between the circuit courts by providing a uniform rule and a solution to the loopholes of liability for a narrow interpretation.¹³⁶

132. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II); see *Prudential Ins. Co. of Am.*, 58 F.4th at 794, 797 (rejecting the registrants singular interpretation argument that liability under the ACPA cannot be found since the domain name was initially registered prior to the time the mark was trademarked).

133. See cases cited *supra* note 4 and accompanying text.

134. See cases cited *supra id.*

135. See cases cited *supra id.*

136. See cases cited *supra id.*

A. *Statutory Interpretation Favors a Broad Interpretation of the Term Registers*

Because this issue is directly derived from the text of the statute, specifically its statutory interpretation, it is imperative to first look to the language within Section 1125(d).¹³⁷ The statute's text and construction shows that the term registers include subsequent re-registrations because "a re-registration is, by definition, a registration."¹³⁸ The plain meaning of the word and its definition within a dictionary, as supported by the Eleventh Circuit, shows that "[t]o 're-register' is '[t]o register again.'"¹³⁹ As such, "the ordinary meaning of the word 'registers' necessarily includes both the first registration and any subsequent re-registrations."¹⁴⁰ Additionally, as in the Third Circuit, there are no qualifiers within the statute, such as "'initial' or 'creation,'" that indicates the term can only be applied to the initial registration.¹⁴¹ Nor is there "an exception for 'non-creation registrations.'"¹⁴² Since the term naturally reads broadly and there is no deliberate specification requiring the interpretation to focus solely on the initial registration, the interpretation should not be limited to such a reading that could have serious consequences of individuals escaping liability.¹⁴³

B. *The Legislative History of the ACPA Supports a Broad Reading*

Most courts correctly recognized that the congressional purpose of the ACPA demands a broad interpretation.¹⁴⁴ The Fourth Circuit

137. *Prudential Ins. Co. of Am.*, 58 F.4th at 796 ("In cases involving statutory interpretation, we 'begin our analysis with the text of the governing statute.'"(quoting *Snyder's-Lance, Inc. v. Frito-Lay N. Am., Inc.*, 991 F.3d 512, 516 (4th Cir. 2021))).

138. *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 777 (11th Cir. 2015).

139. *Jysk Bed'N Linen*, 810 F.3d at 777 (quoting *Re-register*, OXFORD ENGLISH DICTIONARY (2015)) (original emphasis); see *Prudential Ins. Co. of Am.*, 58 F.4th at 796 ("To 're-register' simply means 'to register again.'" (quoting *Re-register*, MERRIAM-WEBSTER DICTIONARY (11th ed. 2022))).

140. *Prudential Ins. Co. of Am.*, 58 F.4th at 796.

141. *Schmidheiny v. Weber*, 319 F.3d 581, 582–83 (3d Cir. 2003); *Prudential Ins. Co. of Am.*, 58 F.4th at 796; *Jysk Bed'N Linen*, 810 F.3d at 777.

142. *Schmidheiny*, 319 F.3d at 582–83 (citing *United States v. Johnson*, 529 U.S. 53, 58 (2000)); see *Johnson*, 529 U.S. at 58 (2000) ("When Congress provides exceptions in a statute, it does not follow that courts have authority to create others.").

143. See *supra* note 4 and accompanying text.

144. See *Prudential Ins. Co. of Am.*, 58 F.4th at 797 ("This interpretation furthers the ACPA's purpose of eliminating cybersquatting and protecting American businesses, consumers, and online commerce."); *Jysk Bed'N Linen*, 810 F.3d at 777–78 ("Including re-registrations under the registration hook comports with the purpose of Congress in enacting the ACPA—to prevent cybersquatting." (citing *S. Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246–47 (11th Cir. 2009))). ; *Schmidheiny*, 319 F.3d at 582 ("The purpose of the Anti-cybersquatting Act is to 'curtail one form of "cybersquatting"—the act of registering someone else's name as a domain name for the

accurately identified that the Ninth Circuit not only failed to address the congressional purpose, but its holding is also in conflict with the ACPA's purpose "to curtail cyberpirates and cybersquatting."¹⁴⁵ The Fourth Circuit specifically noted that the construction of the ACPA was meant to avert registrants from choosing domain names that consists of trademarks and subsequently demanding a high price for those domain names from the trademark owners.¹⁴⁶ Furthermore, it has been explicitly noted by Congress the purpose "was to curtail abusive bad faith registrations that harm commerce, business, and consumers," which is supported by statements made by the Senate and House.¹⁴⁷ A Senate report stated that enactment of legislation was necessary "to clarify the rights of trademark owners with respect to bad faith, abusive domain name *registration practices* to provide clear deterrence to prevent bad faith and abusive conduct."¹⁴⁸ The Senate report directly refers to "registration practices" meaning that there is more than one registration practice that the ACPA should deter and not merely the initial registration.¹⁴⁹

Only analyzing an initial registration within the statute would permit subsequent owners of a domain name to act with "a bad faith intent to profit" from registering the domain name simply because someone initially registered in good faith before the transfer.¹⁵⁰ This narrow interpretation analysis would continue to "harm commerce, business, and consumers," including the very consumers the Act should protect when using the Internet.¹⁵¹ For example, as long as the initial registration was done in good faith, a subsequent registrant who re-registers the domain name in bad faith to profit from the trademarked business would be permitted to continue this activity to confuse consumers or dilute marks simply on the basis that the re-registration is not encompassed under Section 1125.¹⁵² This does not logically flow from Congress's purpose in enacting the ACPA when the intention was "to protect consumers and American businesses, to promote the growth of online commerce, and to

purpose of demanding remuneration from the person in exchange for the domain name."(quoting 145 CONG. REC. S. 14715 (daily ed. Nov. 17, 1999) (statement of Sen. Lott)).

145. *Prudential Ins. Co. of Am.*, 58 F.4th at 796 (citing H.R. REP. NO. 106-464, at 108 (1999)).

146. *Prudential Ins. Co. of Am.*, 58 F.4th at 791 (citing Tamara Kurtzman, *Cyber Center: The Continued Hijacking and Ransoming of the Domain Name System by Modern-Day Corporate Privateers*, BUS. L. TODAY (June 20,2016)), https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/ [<https://perma.cc/A42T-W4DQ>]].

147. *See supra* note 64 and accompanying text.

148. S. REP. NO. 106-140, at 7-8 (1999) (emphasis added).

149. *Id.*

150. 15 U.S.C.A. § 1125(d)(1)(A)(i)(i)(I)-(III). *See supra* note 4 and accompanying text.

151. *See supra* note 64 and accompanying text.

152. *See supra* note 4 and accompanying text.

provide clarity in the law for trademark owners...."¹⁵³ Such a narrow interpretation is not a logical option to achieve the goals of the ACPA since one can exhibit bad faith in every instance following the initial registration so long as there was a good faith initial registration, especially when this conduct was intended to be prohibited.¹⁵⁴

C. A Broad Interpretation Should Control as Congress Intended for Various Policy Reasons

1. Renewals and Domain Name Management Must be Included Within the Broad Interpretation due to the Vast Amount of Time Permitted for Bad Faith to Occur

Renewals and domain management actions should be encompassed within the broad interpretation of the ACPA, including the alterations made to a domain name through RDAP. The trademark system and domain names both have a similar mechanism of re-filing documents to ensure that one's registration for their mark or domain name is not invalidated.¹⁵⁵ In particular, a renewal of a domain name prior to its expiration is a requirement for a registrant if an individual wants to continue ownership.¹⁵⁶ There are additional ways for a domain name to be managed, such as the alteration of domain names, renewals, updating WHOIS records, and more.¹⁵⁷

The contention that renewals and domain management actions should be included within the broad interpretation is supported because when one searches for a domain name through the RDAP Lookup

153. S. REP. NO. 106-140, at 4 (1999).

154. *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 778 (11th Cir. 2015).

155. *Keeping your registration alive*, UNITED STATES PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/maintain/keeping-your-registration-alive> [<https://perma.cc/796V-FJDG>] (last visited Dec. 22, 2023) ("Once you own a trademark registration, you must do a few important things to maintain that registration and keep it alive."); *Renewing Domain Names*, ICANN, <https://www.icann.org/resources/pages/renew-domain-name-2018-12-07-en#:~:text=When%20you%20register%20a%20domain,your%20registrar%20before%20it%20expires> [<https://perma.cc/72QL-V9HV>] (last visited Dec. 22, 2023) ("If you want to keep using [a domain name], including all of the services associated with it..., you have to renew it with your registrar before it expires.").

156. *Renewing Domain Names*, ICANN, <https://www.icann.org/resources/pages/renew-domain-name-2018-12-07-en#:~:text=When%20you%20register%20a%20domain,your%20registrar%20before%20it%20expires> [<https://perma.cc/ZHC8-Z7TN>] (last visited Dec. 15, 2023).

157. Katie Collins, *A complete guide to domain management*, FASTHOSTS, <https://www.fasthosts.co.uk/blog/guides/domain-management-guide/> [<https://perma.cc/H5AR-4NYK>] (last visited Dec. 15, 2023); Kristin Crabb, *Everything you need to know about domain management*, <https://www.domain.com/blog/domain-management-101/> [<https://perma.cc/V3CT-X6F4>] (last visited Dec. 15, 2023).

function on ICANN, they will find many “dates..., includ[ing] the date when the domain name registration was created, expires, and updated...”¹⁵⁸ This highlights that there are some acts, such as updating domain name information that are significant enough in terms of the registration of domain names their dates are included within ICANN, such as updating domain name information on RDAP.¹⁵⁹ Furthermore, the evolution of cybersquatting has made “developments in the domain name registration system—including the use of WHOIS privacy services...that have increasingly led to registrations, often anonymous, being undertaken with little or no attention to third-party intellectual property rights.”¹⁶⁰ Such developments in terms of the WHOIS, and RDAP, with the fact that one factor used when determining bad faith analyzes an individual’s “intentional failure to maintain accurate contact information,” which is a primary function of Whois and RDAP, highlights the importance of including such actions within the broad interpretation of the ACPA.¹⁶¹ Thus, a broad interpretation should also encompass the alteration and submission of information through WHOIS, or RDAP, within the term.¹⁶²

These subsequent re-registrations are necessary because renewals of a domain name are sporadic because it depends on the agreement made between the registrant and the registrar, namely durations “between one to ten years.”¹⁶³ This provides those who renew a domain name for the

158. *Registration data lookup tool Frequently Asked Questions (FAQs)*, ICANN LOOKUP, <https://lookup.icann.org/en/faq> [<https://perma.cc/YZT7-FGD3>] (last visited Jan. 3, 2023).

159. *Id.* (“Multiple dates may be displayed in the ‘Dates’ section and can include the date when the domain name registration was created, expires, and updated, as applicable.”). See *Advisory: Clarifications to the Registry and Registrar Requirements for WHOIS (port43) and Web-Based Directory Services*, ICANN (May 25, 2018) <https://www.icann.org/resources/pages/registry-agreement-raa-rdds-2015-04-27-en> [<https://perma.cc/VE5Q-DB6L>]; *Understanding Whois lookup, NAME.COM* (Oct. 23, 2023) <https://www.name.com/support/articles/205922568-understanding-whois-lookup> [<https://perma.cc/FQ43-4UZ2>] (“The updated date is the last time a change was made to the domain’s Whois information.”).

160. World Intellectual Property Organization [WIPO], *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062 (June 4, 2007) (citing WIPO, *Cybersquatting Remains on the Rise with further Risk to Trademarks from New Registration Practices* (Press Release, Mar. 12, 2007)), https://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0062.html#P220_55123 [<https://perma.cc/5UWV-EEQX>].

161. 15 U.S.C.A. § 1125(d)(1)(B)(i)(VII); see *FAQs: Domain Name Registrant Contact Information and ICANN’s WHOIS Data Reminder Policy (WDRP)*, ICANN, <https://www.icann.org/resources/pages/faqs-f0-2012-02-25-en> [<https://perma.cc/6ZLK-T43H>] (last visited Jan. 13, 2024) (stating that programs such as WHOIS or the RDAP, “requires your registrar to formally remind you once a year to review and update your contact information). *But see* Personal Communication with Xuan-Thao Nguyen, Professor, University of Washington School of Law, Seattle, Wash. (Feb. 14, 2024).

162. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023).

163. *FAQs for Registrants: Domain Name Renewals and Expiration*, ICANN, <https://www.icann.org/resources/pages/domain-name-renewal-expiration-faqs-2018-12-07-en>

latter part of ten years, an extensive amount of time for an individual's bad faith to come into fruition and sell the domain name in bad faith before the next renewal. Moreover, it is crucial to incorporate subsequent re-registrations into a broad interpretation because the majority of "registrars offer [a] auto-renewal option for domain name registrations," which would make analysis under the ACPA arduous and costly for a court to determine if bad-faith was present at the time of the automatic renewal, thus undermining Section 1125(d)'s analysis.¹⁶⁴ That the exact moment of re-registration is known does not aid in determining whether there was bad faith at that exact moment. This, coupled with the fact that an individual may not need to renew a domain name for up to ten years, is exactly why the vast inclusion of re-registrations is needed.

2. Although an Acquisition Itself May Not be Encompassed Within the Term Registers, a Broad Interpretation Should Include the Alteration of Domain Name Information, Including Transfers That Alter Registrars and Registrants

While the sale or purchase of a domain name itself is likely covered within the term "acquisition" or "traffics in," there are transfers that occur that do not fall under those definitions that should be encompassed within the broad interpretation, which includes the alteration of a registrar within the domain name.¹⁶⁵ The District of Colorado rejected the argument that an acquisition itself could be inclusive within the broad interpretation, specifically the modification of the correct registrar or registry that occurs shortly following the acquisition.¹⁶⁶ This contention is evident because the

[<https://perma.cc/M4WR-XPR4>] (last visited Dec. 18, 2023); *Renewing Domain Names*, ICANN, <https://www.icann.org/resources/pages/renew-domain-name-2018-12-07-en> [<https://perma.cc/RA7H-47HX>] (last visited Dec. 18, 2023).

164. *Id.*

165. See 15 U.S.C.A. § 1125(d)(1)(E) ("As used in this paragraph, the term 'traffics in' refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration."); *Schmidheiny v. Weber*, 319 F.3d 581, 583 (3d Cir. 2003) (holding that when a domain name's registrant and registrar was altered, such conduct of "a new contract at a different registrar and to a different registrant" was encompassed within the broad interpretation of the term registration and the ACPA); *FAQs for Registrants: Transferring Your Domain Name*, ICANN, <https://www.icann.org/resources/pages/name-holder-faqs-2017-10-10-en> [<https://perma.cc/2M5Y-YDXB>] (last visited Jan. 3, 2023) ("[I]t is your right to transfer your domain name registrations between registrars."); Natalie Brownell, *Transferring Domain Name Ownership: Everything You Need to Know*, <https://www.domain.com/blog/transferring-domain-name-ownership-everything-you-need-to-know/#1-what-does-it-mean-to-transfer-a-domain-name-> [<https://perma.cc/S6AA-4J3V>] (last visited Jan. 3, 2023) ("Transferring a domain name means moving a domain from the registrar where it is currently managed to a different registrar.")

166. *Mehdiyev v. Qatar Nat'l Tourism Council*, 532 F. Supp. 3d 1065, 1070–71, 1073 (D. Colo. 2021).

term acquisition is used within the statute, meaning that the term registers could not possibly include an acquisition because it would make that term within the statute meaningless.¹⁶⁷ As such, any subsequent registration would not encompass “aftermarket sales or acquisitions.”¹⁶⁸

Although it is a valid argument that the term acquisition within the statute highlights the fact that an acquisition cannot be encompassed within the term registration, the court is wrong when it fails to acknowledge the necessary alterations to domain name information such as registrars, registrants, and more that occur following the acquisition that must be included within the broad interpretation as in the Third Circuit’s opinion.¹⁶⁹ ICANN refers to these changes to the domain name registrars as “transfers.”¹⁷⁰ These transfers must be included within the broad interpretation because when a transfer occurs with a new registrar, there is a one-year extension that will be added to the expiration date so long as it does not exceed the maximum ten years.¹⁷¹ This extension

167. *Mehdiyev*, 532 F. Supp. 3d at 1071 (citing *Obduskey v. McCarthy & Holthus LLP*, 139 S. Ct. 1029, 1037 (2019)) (“To hold that a trademark is re-registered after each acquisition of a domain name would render the specific references to acquisition in [Section] 1125(d)(B)(VIII) meaningless.”). See 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

168. *Mehdiyev*, 532 F. Supp. 3d at 1071 (citing *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1031–32 (9th Cir. 2011)).

169. *Mehdiyev*, 532 F. Supp. 3d at 1071–72; 15 U.S.C.A. § 1125(d)(1)(E) (emphasis added). See *Schmidheiny*, 319 F.3d at 583 (holding that when a domain name’s registrant and registrar was altered, such conduct of “a new contract at a different registrar and to a different registrant” was encompassed within the broad interpretation of the term registration and the ACPA).

170. *FAQs for Registrants: Transferring Your Domain Name*, ICANN, <https://www.icann.org/resources/pages/name-holder-faqs-2017-10-10-en> [<https://perma.cc/2M5Y-YDXB>] (last visited Jan. 3, 2023) (“[I]t is your right to transfer your domain name registrations between registrars.”). See Natalie Brownell, *Transferring Domain Name Ownership: Everything You Need to Know*, <https://www.domain.com/blog/transferring-domain-name-ownership-everything-you-need-to-know/#1-what-does-it-mean-to-transfer-a-domain-name-> [<https://perma.cc/S6AA-4J3V>] (last visited Jan. 3, 2023), (“Transferring a domain name means moving a domain from the registrar where it is currently managed to a different registrar.”).

171. *Transfer Policy*, ICANN, <https://www.icann.org/resources/pages/transfer-policy-2016-06-01-en> [<https://perma.cc/6AEP-DHRR>] (last visited Jan. 3, 2023) (“The completion by Registry Operator of a holder-authorized transfer under Section I.A. shall result in a one-year extension of the existing registration, provided that in no event shall the total unexpired term of a registration exceed ten (10) years.”); ICANN, *Policy on Transfer of Registrations between Registrars, Takes effect 31 January 2015*, (Jan. 31, 2015), [https://www.icann.org/resources/pages/policy-transfers-2014-07-02-en#:~:text=The%20completion%20by%20Registry%20Operator,exceed%20ten%20\(10\)%20years.](https://www.icann.org/resources/pages/policy-transfers-2014-07-02-en#:~:text=The%20completion%20by%20Registry%20Operator,exceed%20ten%20(10)%20years.) [<https://perma.cc/EQ2N-5V3W>] (“The completion by Registry Operator of a holder-authorized transfer under this Part A shall result in a one-year extension of the existing registration, provided that in no event shall the total unexpired term of a registration exceed ten (10) years.”). See *Domain Transfer: How To Transfer Your Domain To Another Company*, DOMAIN.COM, <https://www.domain.com/help/article/domain-transfer-how-to-transfer-your-domain-to-another-company#:~:text=Domain%20Transfers%20are%20FREE.,transferred%20to%20a%20new%20host> . [<https://perma.cc/AX4T-HC66>] (last visited Jan. 3, 2023) (“ICANN requires a one-year extension to a domain when transferred to a new host.”); Jeffrey L. Wilson, *How to Transfer a Domain Name*,

provides ample opportunities for a registrant to gain bad faith while waiting for the next renewal that could occur in ten years, which is the exact reason these alterations, also known as transfers, should be included within the broad interpretation of the ACPA. These inclusions are further supported by *The Christensen Firm v. Chameleon Data Corp.*, the Washington Western District Court decision, which held that the alteration of an account holder name for domain names was a registration within the ACPA.¹⁷² Thus, since a registrant will take actions after the initial registration and acquisitions to maintain valid ownership, a broad interpretation that includes transfers should be encompassed within the analysis of the ACPA.¹⁷³

3. Any Inalienability Concerns is Correctly Addressed Through the Additional Elements Required by the ACPA

The Ninth Circuit cautioned against a broad interpretation of the ACPA due to concerns regarding the intrusion into the domain name market that would effectively make any rights inalienable.¹⁷⁴ When one purchases property from another, the purchaser likely expects to obtain all benefits of the property, and in essence, by purchasing a domain name, one is also purchasing its initial registration that was done in good faith.¹⁷⁵

(June 14, 2019), <https://www.pcmag.com/how-to/how-to-transfer-a-domain-name#https://perma.cc/356B-XYJ2> (“[Y]ou will likely need to renew your domain name with the new domain host.”).

172. *The Christensen Firm v. Chameleon Data Corp.*, 2006 WL 3158246, *1, *5 (W.D. Wash. 2006). See Practical Law Intellectual Property & Technology, *Anticybersquatting Consumer Protection Act (ACPA) Claims, Changing Ownership Information*, <https://1.next.westlaw.com> (log into Westlaw; search the title in the search bar; click “Content types” on the left-hand side; then click “Practical Law;” and click on the work.) [<https://perma.cc/G9C6-KHWM>] (last visited Dec. 23, 2023) (citing *The Christensen Firm.*, 2006 WL 3158246, at *4–5 (stating that an alteration to an account holder name was “qualified as domain name registration under the ACPA as a matter of law”).

173. 15 U.S.C. § 1125(d)(1)(A)(ii). See *Renewing Domain Names*, ICANN, <https://www.icann.org/resources/pages/renew-domain-name-2018-12-07-en> [<https://perma.cc/7SGT-3ANN>] (last visited Oct. 22, 2023) (“If [the owner] want[s] to keep using it..., [they] have to renew it with [their] registrar before it expires.”); Katie Collins, *A complete guide to domain management*, FASTHOSTS, <https://www.fasthosts.co.uk/blog/guides/domain-management-guide/> [<https://perma.cc/SD3T-3NX8>] (last visited Dec. 13, 2023) (listing registrant responsibilities regarding the management of domain names); *FAQs: Domain Name Registrant Contact Information and ICANN’s WHOIS Data Reminder Policy (WDRP)*, ICANN, <https://www.icann.org/resources/pages/faqs-f0-2012-02-25-en> [<https://perma.cc/6ZLK-T43H>] (last visited Jan. 13, 2024) (stating that programs such as WHOIS or the RDAP, “requires your registrar to formally remind you once a year to review and update your contact information).

174. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1031–32 (9th Cir. 2011).

175. *GoPets Ltd.*, 657 F.3d at 1031 (“[S]ee no basis in ACPA to conclude that a right that belongs to an initial registrant of a currently registered domain name is lost when that name is transferred to another owner. The general rule is that a property owner may sell all of the rights he holds in

The vast inclusions within a broad interpretation could violate a foundational principle of property by restricting one's ability to sell their domain name.¹⁷⁶ This free market argument is further supported by the Colorado District Court that stated the acceptance of a broad interpretation would “undo an otherwise valid, preexisting registration” by offering negative incentives that would ultimately go against the congressional purpose of enactment “and are not necessary to prevent true cybersquatting.”¹⁷⁷

Although there are inalienability and “public policy concern[s] that innocent persons would be subject to ACPA liability for minor, periodic re-registrations of domain names,” these are curtailed by another requirement within the ACPA: “the bad faith intent to profit.”¹⁷⁸ For an individual to be liable under Section 1125(d), it would require analysis into an individual's intent with the domain name during the time of the subsequent re-registration.¹⁷⁹ As such, the “the bad faith intent to profit” diminishes the inalienability concern for domain names requirement for liability under Section 1125(d).¹⁸⁰ The process of a registrant periodically re-registering their domain name is generally not done with any bad faith and rights to a domain name are not revoked unless such actions have the requisite bad faith.¹⁸¹ Thus, the inclusions of renewals and domain management within the broad interpretation of the ACPA will not encroach or restrict the property rights the Ninth Circuit and the Colorado District Court are concerned about.¹⁸²

4. A Broad Interpretation Should Prevail Internationally to Ensure Uniformity and Efficiency

The statutory interpretation of the ACPA should mirror the international interpretation of domain name registration violations

property.”). Personal communication with Xuan-Thao Nguyen, Professor, University of Washington School of Law, Seattle, Washington (Feb. 14, 2024).

176. *GoPets Ltd.*, 657 F.3d at 1031.

177. *Mehdiyev v. Qatar Nat'l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021).

178. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023) (quoting *Prudential Ins. Co. of Am. v. PRU.COM*, 546 F. Supp. 3d 476, 492 (E.D. Va. 2021)); see 15 U.S.C. § 1125(d)(1)(A)(i).

179. 15 U.S.C.A. § 1125(d)(1)(A)(i) and (ii).

180. *Prudential Ins. Co. of Am.*, 58 F.4th at 797 (quoting *PRU.COM*, 546 F. Supp. 3d at 492); see 15 U.S.C. § 1125(d)(1)(A)(i).

181. *Prudential Ins. Co. of Am.*, 58 F.4th at 797.

182. See *Prudential Ins. Co. of Am.*, 58 F.4th at 797 (quoting *PRU.COM*, 546 F. Supp. 3d at 492) (“Additionally, we agree with the district court that “[t]he underlying rationale for the Ninth Circuit’s decision—a public policy concern that innocent persons would be subject to ACPA liability for minor, periodic re-registrations of domain names—is best addressed through the bad faith intent to profit inquiry.”); 15 U.S.C. § 1125(d)(1)(A)(i).

because it will provide for uniformity under international law pursuant to Section 1125.¹⁸³ This interpretation is supported by statements made in an Congressional Record: "this legislation should not in any way frustrate the global efforts...."¹⁸⁴ International law supports a broad interpretation of the ACPA, which can be seen within more than one WIPO panel.¹⁸⁵ In *Twitter Inc. v. Geigo Inc.*, a panel expressed that analysis does not solely focus on the initial registration but any subsequent registration and acquisition.¹⁸⁶ Furthermore, *Eastman Sporto Group LLC v. Jim and Kenny*, found a domain name renewal was encompassed within the term registration.¹⁸⁷ Another WIPO's statement, in *HSBC Finance Co. v. Clear Blue Sky Inc. and Domain Manager*, equated an acquisition with a registration.¹⁸⁸ An acquisition of a domain name is considered a

183. 15 U.S.C.A. § 1125(d)(2)(A).

184. 145 CONG. REC. S14986-03 (1999).

185. World Intellectual Property Organization [WIPO], *Eastman Sporto Group LLC v. Jim and Kenny*, Case No. D2009-1688, (Mar. 1, 2010), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1688.html> [<https://perma.cc/RWY5-AUNX>] (holding that a "renewal of the disputed domain name to be the date on which to measure whether the disputed domain name was registered"); World Intellectual Property Organization [WIPO], *Twitter, Inc. v. Geigo, Inc.*, Case No. D2011-1210, (Nov. 2, 2011), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2011-1210> [<https://perma.cc/CL2J-6FP3>] (citing WIPO Overview 2.0, paragraph 3.7; World Intellectual Property Organization [WIPO], *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062, (June 4, 2007)) ("Policy precedent is clear that the question of Respondent registration in bad faith (or otherwise) is determined on the date of Respondent's registration (or if not the original creator, acquisition) of the disputed domain name, not the date the domain name was first created."); World Intellectual Property Organization [WIPO], *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062, (June 4, 2007) (citing WIPO, *Cybersquatting Remains on the Rise with further Risk to Trademarks from New Registration Practices* (Press Release, Mar. 12, 2007)), https://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0062.html#P220_55123 [<https://perma.cc/5UWV-EEQX>] (stating that the evolution of cybersquatting has included recent developments, such as "the use of Whois privacy services...that have increasingly led to registrations, often anonymous, being undertaken with little or no attention to third-party intellectual property rights").

186. World Intellectual Property Organization [WIPO], *Twitter Inc. v. Geigo Inc.*, No. D2011-1210 (Nov. 2, 2011) (citing WIPO Overview 2.0, paragraph 3.7) ("Policy precedent is clear that the question of Respondent registration...is determined on the date of Respondent's registration (or if not the original creator, acquisition) of the disputed domain name, not the date the domain name was first created."); see Baraa Kahf & Savannah Torborg, *A Future in Flux: Why the Anti-Cybersquatting Consumer Protection Act Created More Questions Than Answers*, 35 INTELL. PROP. & TECH. L.J. 1, 4 (2023) <https://www.knobbe.com/sites/default/files/2023-05/Kahf-Torborg.pdf> [<https://perma.cc/KP7X-7BTB>].

187. World Intellectual Property Organization [WIPO], *Eastman Sporto Group LLC v. Jim and Kenny*, Case No. D2009-1688, (Mar. 1, 2010), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1688.html> [<https://perma.cc/2GST-KQZ3>].

188. World Intellectual Property Organization [WIPO], *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062, (June 4, 2007) (citing *Ideenhaus Kommunikationsagentur GmbH v. Ideenhaus GmbH*, WIPO Case No. D2004-0016), <https://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0062.html>

registration in the eyes of the WIPO, and uniformity, internationally, will provide for a more efficient application of the analysis of the ACPA and its international counterparts.¹⁸⁹ Furthermore, this broad interpretation comports with the mission of the WIPO of providing “a balanced and effective international IP system.”¹⁹⁰ Thus, not only does a broad interpretation align with the congressional purpose of the enactment of the ACPA, but it is also the most efficient way to approach the analysis of the ACPA to hold those liable that violate the ACPA.¹⁹¹

5. The Ninth Circuit’s Holding is not a Deviation from a Broad Interpretation but is Premised Upon Fairness

The Ninth Circuit held that if the term registration had a broad interpretation, then any rights would be effectively inalienable.¹⁹² The Court stated there was no indication “that a right that belongs to an initial registrant of a currently registered domain name is lost when that name is transferred to another owner.”¹⁹³ “The general rule is that a property owner may sell all of the rights he holds in property,” and a broad interpretation “would make rights to many domain names effectively inalienable.”¹⁹⁴

Although the Ninth Circuit based its opinion on the creation of inalienable property rights, the court appears to imply the same foundational principles as the other circuits: fairness and morality.¹⁹⁵ The facts of *GoPets Ltd.* are unique because the domain name owner did not want to sell but was subjected to the trademark owner’s persistent offers, so the registrant transferred the domain name ownership to a corporation that he owned.¹⁹⁶ The court further stated if the registrant did not transfer the domain name, all rights could have been preserved indefinitely, which seems to highlight the court felt sympathetic to the plights of the registrant.¹⁹⁷ The registrant received constant offers from the trademark

[<https://perma.cc/CK2U-ZD3Z>] (stating “that the domain name was ‘registered’ within the meaning of the Policy by virtue of being acquired”).

189. *Id.*

190. *What is WIPO?* WIPO: ABOUT WIPO, <https://www.wipo.int/about-wipo/en/> (last visited Dec. 12, 2023).

191. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023) (holding that a subsequent registration “interpretation furthers the ACPA’s purpose of eliminating cybersquatting and protecting American businesses, consumers, and online commerce”).

192. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011).

193. *Id.* at 1031.

194. *Id.* at 1031–32.

195. *See id.* at 1031.

196. *Id.* at 1027–29.

197. *Id.* at 1031.

owner, was subjected to WIPO proceedings, and likely felt the need to protect their property.¹⁹⁸ While there may be property concerns when transferring property to another, the Ninth Circuit's decision uses these principles to obtain a fair result.¹⁹⁹

It would go against basic principles of morality and fairness to hold that the defendant should not retain ownership based on this re-registration considering the ownership was transferred to his corporation.²⁰⁰ This interpretation aligns with the WIPO's interpretation of their rules regarding interpretation, specifically that alterations to domain name information that include "an unbroken chain of possession" are not generally recognized as a registration.²⁰¹ These unique facts of the registrant being subjected to constant offers with no change in control of ownership of the domain name illustrate the need for the Ninth Circuit to make a fact-based decision.²⁰² As such, the Ninth Circuit's opinion is not really a departure from the majority view but a fact-based decision that was necessary to achieve fair results.²⁰³ What should have happened is the registrant should have sued under Section 1114 because the trademark owner was attempting to pressure the registrant into selling its domain name.²⁰⁴ Nevertheless, a broad interpretation of Section 1125(d) should be the accepted uniform rule, because it will aid in holding individuals who act in direct contradiction to the ACPA civilly liable²⁰⁵ and any

198. *Id.* at 1027–29.

199. *Id.* at 1031–32.

200. *Id.* at 1028.

201. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition* ("WIPO Jurisprudential Overview 3.0"), WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/#item38> [<https://perma.cc/N2XH-VBHV>] (last visited Dec. 16, 2023).

202. See *GoPets Ltd.*, 657 F.3d at 1027.

203. *Id.* at 1031–32.

204. 15 U.S.C.A. § 1114(2)(D)(v). See e.g., *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *4 (D. Ariz. July 14, 2023) (quoting *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 625 (4th Cir. 2003) (citing 15 U.S.C. § 1114(2)(D)(v))) ("A provision of ACPA codified at 15 U.S.C. § 1114 allows 'a domain name registrant who is aggrieved by an overreaching trademark owner [to] commence an action to declare that the domain name registration or use by the registrant is not unlawful.'"); *Barcelona.com, Inc.*, 330 F.3d at 625 ("Under that reverse domain name hijacking provision, a domain name registrant who is aggrieved by an overreaching trademark owner may commence an action to declare that the domain name registration or use by the registrant is not unlawful under the Lanham Act."); *Dent v. Lotto Sport Italia SpA*, 2020 WL 1170840, at *4 (D. Ariz. Mar. 11, 2020) ("Under that reverse domain name hijacking provision, a domain name registrant who is aggrieved by an overreaching trademark owner may commence an action to declare that the domain name registration or use by the registration is not unlawful under the Lanham Act.").

205. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023) ("[T]he term 'registers' and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations."); Attison L. Barnes, III, Ari Meltzer, David E. Weslow, and Adrienne J. Kosak, *Fourth Circuit Finds "Re-registration" of a Domain Can be Cybersquatting—A Prudential Clarification to the ACPA*, (Jan. 25, 2023), <https://www.wiley.law/alert-Fourth-Circuit-Finds-Re-registration-of-a-Domain-Can-be>

inalienability concerns are curtailed by “the bad faith intent to profit” requirement for liability.²⁰⁶ Thus, an approval of successive re-registrations within a broad interpretation will not restrict the property concerns that the Ninth Circuit had.²⁰⁷

6. Reliance Upon “Uses” or “Traffics in” Within the ACPA is not Enough to Hold Those Liable for Cybersquatting

Perhaps individuals can still be subject to liability through the “uses” and “traffics in” components of the ACPA instead of registers; however, reliance on other liability-imposing parts of the ACPA is not enough, especially when “traffics in” and “uses” still rely on the determination of the term registration.²⁰⁸ This means that even at the time of bad faith “trafficking” or “using,” the mark must be “distinctive [or famous] at the time of registration of the domain name.”²⁰⁹ Reliance on these other liability-imposing parts of the ACPA does not solve the open issue on when a registration will trigger liability.

If a narrow interpretation were to control with reliance on the other liability-imposing components to subject an individual to ACPA liability, there would still be instances where individuals could escape liability by registering a domain name before a mark is deemed distinctive or famous so long as the bad faith of the “use” or “trafficked in” occurred later.²¹⁰ Thus, reliance on the other portions of the ACPA are not enough to hold those individuals liable.

7. A Law Journal Goes Too Far in Suggesting Nonuse as a Factor

A Future in Flux: Why the Anti-Cybersquatting Consumer Protection Act Created More Questions Than Answers provides a similar solution of a congressional amendment of the ACPA.²¹¹ However, this

Cybersquatting-A-Prudential-Clarification-to-the-ACPA [https://perma.cc/6QRB-DFRN] (“[T]he Fourth Circuit’s opinion is not limited to re-registration by the same owner or the transfer to a subsequent owner but, instead, appears to include any successive re-registration of a domain name including acts such as domain renewals.”); 15 U.S.C. § 1125(d).

206. *Prudential Ins. Co. of Am.*, 58 F.4th at 797 (quoting *Prudential Ins. Co. of Am. v. PRU.COM*, 546 F. Supp. 3d 476, 492 (E.D. Va. 2021)); 15 U.S.C. § 1125(d)(1)(A)(i).

207. *GoPets Ltd.*, 657 F.3d at 1031–32 (stating that the inclusion of subsequent re-registrations within the term “registration” “would make rights to many domain names effectively inalienable.”).

208. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I)–(II). Personal communication with Camilla Hrdy, Professor, University of Akron School of Law, in Akron, Ohio (Jan. 25, 2024).

209. *Id.*

210. See *supra* note 4 and accompanying text.

211. Baraa Kahf & Savannah Torborg, *A Future in Flux: Why the Anti-Cybersquatting Consumer Protection Act Created More Questions Than Answers*, 35 INTELL. PROP. & TECH. L.J. 1,

journal goes too far in stating that “nonuse as a factor in demonstrating liability and bad faith intent” in Section 1125 “could be its own bad faith factor.”²¹² Nonuse itself may be considered a relevant factor, but the article applied the reasoning “that a domain name purchase may start off with good intent, but nonuse could transform into bad intent.”²¹³ Even if true, and this were to be relevant in determining liability, it would be too hard and arbitrary for a court to draw a line to when one’s nonuse of a domain name morphed into bad faith. How would one go about proving when nonuse of a domain name conformed into bad faith?

Trying to prove that a registrant’s nonuse constitutes bad faith would be tenuous and reliance on such would not provide for a more efficient system for determining bad faith and thus liability within the broad interpretation; instead, it would be costly and time-consuming for an already complex analysis. Besides not proposing this type of analysis within the bad faith factors as *A Future in Flux*, my note goes further in suggesting and analyzing a broad interpretation, whereas the journal article merely suggests congressional amendment as an option.²¹⁴

D. *Counterarguments that Fall Short and Require a Broad Interpretation*

1. The Argument That the Text of the Statute Implies a Singular Point in Time

The construction of the statute, where registers is placed within the statute, may arguably only refer to its two subsections, (I) and (II) that contain the word registration.²¹⁵ For example, liability arises when one—

“[R]egisters, traffics in, or uses a domain name that— (I) 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; (II) 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.”²¹⁶

The location of where the term registers appear within the statute could arguably be plural not because it signals the inclusion of subsequent re-registrations but due to its reference to the two subsequent referrals of

7 (2023), <https://www.knobbe.com/sites/default/files/2023-05/Kahf-Torborg.pdf> [<https://perma.cc/KP7X-7BTB>].

212. *Id.*

213. *Id.*

214. *Id.*

215. 15 U.S.C. § 1125(d)(1)(A)(ii).

216. 15 U.S.C. § 1125(d)(1)(A)(i)(I) and (II) (emphasis added).

the term registration.²¹⁷ In this view, the construction of the statute would only contain a narrow identification of the term registration, which supports the Ninth Circuit’s holding²¹⁸ of a narrow interpretation under Section 1125(d) of the ACPA.²¹⁹ This construction is further supported by the District of Colorado’s analysis that Section 1125(d)’s text of “the time of registration” implies “a single event,”²²⁰ which is analogous to ICANN’s program that “lists a single registration date for a registered domain name.”²²¹ In this view, Congress did not include the terms “‘initial’ or ‘first’” as analyzed by the Third and Eleventh Circuit, because it was written in the view of an isolated event by using the text “time of

217. 15 U.S.C. § 1125(d)(1)(A)(ii)(I) and (II).

218. The Ninth Circuit also point to one issue pertaining to the construction of the ACPA, which is whether liability can be found if a domain name was initially registered prior to the ACPA’s enactment. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1031 (9th Cir. 2011) (quoting *Schmidheiny v. Weber*, 319 F.3d 581, 581–82 (3d Cir. 2003)); see 15 U.S.C. § 8131(1)(A). The Ninth Circuit refuted the Third Circuit’s analysis that a narrow interpretation would allow individuals who initially registered a domain name prior to the ACPA’s effective date to escape liability, because the Third Circuit erroneously assumed the ACPA did not apply retroactively and only accepted a broad interpretation to ensure liability could still be found when the ACPA, in fact, does apply retroactively. *GoPets Ltd.*, 657 F.3d at 1031; *Schmidheiny*, 319 F.3d at 583. The Ninth Circuit supported its contention by citing to a Second Circuit decision, and a public law, that stated the “ACPA applies to all domain names, whether registered before or after the enactment of the statute.” *GoPets Ltd.*, 657 F.3d at 1030 (citing *Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, 202 F.3d 489, 496–97 (2d Cir. 2000) (citing Pub.L. No. 106–113, § 3010, 113 Stat. 1536)). See *Sporty’s Farm L.L.C.*, 202 F.3d at 496, 500 (quoting Pub.L. No. 106–113, § 3010) (stating that the Act applies “if the domain name was ‘registered before, on, or after the date of the enactment of this Act.’”). However, the likely reason the Third Circuit analyzed retroactivity in this manner, is because that same public law did not refer to Section 1129, now Section 8131, when it stated, “this title shall apply to all domain names registered before, on, or after the date of the enactment of this Act.” CONSOLIDATED APPROPRIATIONS ACT, 2000, Pub. L. No. 106–113, § 3010 (2000). Even if the Ninth Circuit is correct in stating that Section 1125(d) of the ACPA applies retroactively, that determination is not enough for a narrow interpretation to prevail because there would still be an opening for individuals to escape liability; for example, if a domain name was initially registered prior to the time distinctiveness or famousness was found in the trademark. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I)–(III); see *GoPets Ltd.*, 657 F.3d at 1032; *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *3 (D. Ariz. 2023); *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021); *AIRFX.com v. AirFX LLC*, 2012 WL 3638721, at *4 (D. Ariz. 2012) (quoting *GoPets Ltd.*, 657 F.3d at 1032); Practical Law Intellectual Property & Technology, *Anticybersquatting Consumer Protection Act (ACPA) Claims, Timing of Distinctiveness or Fame*, <https://1.next.westlaw.com> (log into Westlaw; search the title in the search bar; click “Content types” on the left-hand side; then click “Practical Law;” and click on the work.) [<https://perma.cc/QJ55-TSMP>] (last visited Dec. 23, 2023) (citing *GoPets Ltd.*, 657 F.3d at 1032; ZP No. 314, LLC v. ILM Cap., LLC, 335 F. Supp. 3d 1242, 1259–60 (S.D. Ala. 2018)) (“In cases where the asserted mark became distinctive or famous after registration of the challenged domain name, this may be grounds for rejecting an ACPA cybersquatting claim.”).

219. *GoPets Ltd.*, 657 F.3d at 1032.

220. *Mehdiyev*, 532 F. Supp. 3d at 1072; 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II).

221. *Mehdiyev*, 532 F. Supp. 3d at 1073 (D. Colo. 2021). See *Mehdiyev*, 532 F. Supp. 3d at n.4 (“That entry lists two dates relevant to registration of the domain: the date ‘created’ [] and the current ‘registry expiration’ []”).

registration," which supports a narrow interpretation.²²² However, this narrow interpretation cannot overcome the tremendous consequences of individuals escaping liability that accompany a narrow interpretation.²²³ Furthermore, a claim that the language implies a singular event as supported by ICANN should not prevail because ICANN has a platform that opts for searches that contain numerous dates, such as "the date when the domain name registration was created, expires, and updated...."²²⁴

2. The Argument that Legislative History Should Not Overcome the Text of the Statute Does not Prevail Since the Congressional Purpose of Enactment Supports a Broad Interpretation

Perhaps such purpose-based evidence is not strong enough to prevail over the text of the statute, because Congress could have explicitly prohibited "such bad-faith use of a registration" if it intended to.²²⁵ This argument is premised upon a negative inference that since Congress did not specifically state that subsequent acts of re-registering would be encompassed within the ACPA, such purpose based arguments cannot alter the language of the statute.²²⁶ If Congress did in fact intend the inclusion of subsequent re-registrations, then, Congress should have explicitly stated so in the ACPA.²²⁷ This cannot be true because House and Senate documents reflect upon enactment that the main purpose Congress exhibited "was to curtail abusive, bad faith registrations that harm commerce, business, and consumers."²²⁸ One specific Senate report discussed the need for a uniform law to avoid "abusive domain name registration practices," meaning that such enactment was premised on various registration practices, including subsequent re-registration practices.²²⁹ Thus, the acceptance of a broad interpretation "further the ACPA's purpose of eliminating cybersquatting and protecting American businesses, consumers, and online commerce" in contrast to analyzing a narrow interpretation that directly violates the purpose of enactment.²³⁰

222. *Mehdiyev*, 532 F. Supp. 3d at 1072; 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II). *Contra* *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 777 (11th Cir. 2015); *Schmidheiny*, 319 F.3d at 582.

223. *See supra* note 4 and accompanying text.

224. *Registration data lookup tool Frequently Asked Questions (FAQs)*, ICANN LOOKUP, <https://lookup.icann.org/en/faq> [<https://perma.cc/YZT7-FGD3>] (last visited Jan. 3, 2023).

225. *Mehdiyev*, 532 F. Supp. 3d at 1073.

226. *Id.*

227. *Id.*

228. *See supra* note 64 and accompanying text.

229. S. Rep. No. 106-140, at 7-8 (1999) (emphasis added).

230. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023); *see also* S. Rep. No. 106-140, at 4 (1999) ("[T]o protect consumers and American

3. The Argument that Renewals, Including Auto-Renewals, Require a Narrow Interpretation Fails due to the Possibility of Individuals Escaping Liability

The Ninth Circuit questioned the possible vast inclusions of subsequent actions within a broad interpretation.²³¹ The Fourth Circuit, in response, stated besides the congressional purpose of enacting the ACPA, the bad faith requirement of Section 1125 reduces the concern of losing rights to a domain name during these subsequent re-registrations.²³² Although there are valid concerns regarding the inclusion of domain name management and the RDAP, within the broad interpretation due to the incursion into the domain name market, such concerns are vacated by the bad faith requirement in the ACPA.²³³ Thus, the loss of rights in a registrant's domain name will only occur during a subsequent re-registration if they exhibit the requisite bad faith.²³⁴

Alternatively, it could also be argued that the emergence of auto-renewal requires the need for a narrow interpretation due to how arbitrary and tenuous an analysis under the ACPA can become under a broad interpretation. Since it would be too hard to determine if such actions at the exact moment of an auto-renewal would constitute a bad faith re-registration, the court should solely analyze the initial registration. However, even if that were true, this argument does not prevail because if a court's analysis is solely focused on a narrow interpretation, there would still be ample opportunities for an individual to escape liability under Section 1125(d).²³⁵ Accepting a narrow interpretation would have significant repercussions, such as allowing cybersquatters to escape liability, which is why the only solution is an acceptance of a broad interpretation of the ACPA. There needs to be more inclusions into the broad interpretation, as in the Fourth Circuit, to ensure this kind of bad faith cybersquatting can be held accountable, including renewals and

businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive regulation of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks.”); H.R. Rep. No. 106-412, at 6 (1999) (“[A]ctions undermine consumer confidence, discourage consumer use of the Internet, and destroy the value of brand-names and trademarks of American businesses.”); *Jysk Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015) (citing *Southern Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009)) (“The ACPA was enacted to prevent cybersquatting.”).

231. *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030–31 (9th Cir. 2011).

232. *Prudential Ins. Co. of Am.*, 58 F.4th at 795–97.

233. *Id.*

234. *Id.* at 797.

235. See *supra* note 4 and accompanying text.

domain management.²³⁶ These inclusions will provide more opportunities to ensnare individuals who may register a domain name in bad faith in civil liability by lessening the instances in which cybersquatters can escape liability that is expressly prohibited within Section 1125(d).²³⁷

4. The Argument that a Broad Interpretation Creates Reverse Domain Name Hijacking is Solved by an Already-Existing ACPA Provision

Congress enacted the ACPA with incentives for individuals to not register a trademark that is analogous to domain names or to continue with the analogous trademark and buy the domain name,²³⁸ but the acceptance of a broad interpretation could have the reverse effect, and allow an individual to seek an existing domain name registration to create a trademark from it.²³⁹ In this instance, the trademark owner would be intentionally registering a trademark for the sole purpose of obtaining that domain name, either by purchase or by litigation.²⁴⁰ On the one hand, the trademark owner might opt to purchase the existing domain name, which would likely be expensive but nonetheless done in good faith.²⁴¹ On the other hand, a broad interpretation of registration under the ACPA could allow a situation in which a later trademark registrant could sue an earlier domain name registrant for cybersquatting, even if both the initial registration and subsequent re-registration were both done in good faith.²⁴² This concern is valid but already addressed by the ACPA,

236. See *Prudential Ins. Co. of Am.*, 58 F.4th at 797 (“[T]he term ‘registers’ and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations.”); Attison L. Barnes, III, Ari Meltzer, David E. Weslow, and Adrienne J. Kosak, *Fourth Circuit Finds “Re-registration” of a Domain Can be Cybersquatting—A Prudential Clarification to the ACPA*, WILEY (Jan. 25, 2023), <https://www.wiley.law/alert-Fourth-Circuit-Finds-Re-registration-of-a-Domain-Can-be-Cybersquatting-A-Prudential-Clarification-to-the-ACPA#:~:text=The%20Ninth%20circuit%27s%20decision%20focused,registration%20>would%20make%20domain%20names> [https://perma.cc/6QRB-DFRN] (“[T]he Fourth Circuit’s opinion is not limited to re-registration by the same owner or the transfer to a subsequent owner but, instead, appears to include any successive re-registration of a domain name including acts such as domain renewals.”); 15 U.S.C. § 1125(d).

237. See *supra* note 4 and accompanying text.

238. *Mehdiyev v. Qatar Nat’l Tourism Council*, 532 F. Supp. 3d 1065, 1073 (D. Colo. 2021).

239. Personal communication with Emily Michiko Morris, David L. Brennan Endowed Professor, University of Akron School of Law, in Akron, Ohio (Jan. 8, 2024).

240. *Id.*

241. *Id.*

242. *Id.*

however: “[Section] 1114(2)(D)(v) authorizes a domain name registrant to sue trademark owners for ‘reverse domain name hijacking.’”²⁴³

Any prior concern is solved since Section 1114(2)(D)(v) permits registrants to assert a cause of action to validate that their “registration or use of the domain name” was not in violation of any provision in its chapter, including Section 1125(d).²⁴⁴ It authorizes aggrieved registrants to file a suit against “an overreaching trademark owner . . . to declare that the domain name registration or use by the registrant is not unlawful.”²⁴⁵ There are two elements, out of four, that require clarification of the term registration: specifically proof of a “registration of a domain name” and “that [the plaintiff’s] registration or use of the domain name is not unlawful.”²⁴⁶ If a narrow interpretation of the term were accepted, it will have implications on Section 1114.²⁴⁷

Under Section 1114, if the term registers is limited solely to the initial registration, it will likely reduce findings of liability of subsequent re-registrations regardless of use or bath faith findings.²⁴⁸ The last element of Section 1114 “that [the plaintiff’s] registration or use of the domain name is not unlawful,” could be wrongly analyzed simply because the initial registration was lawful, even though a subsequent re-registration

243. *Dent v. Lotto Sport Italia SpA*, 2020 WL 1170840, at *4 (D. Ariz. 2020); see 15 U.S.C. § 1114(2)(D)(v). Personal communication with Emily Michiko Morris, David L. Brennan Endowed Professor, University of Akron School of Law, in Akron, Ohio (Jan. 8, 2024).

244. 15 U.S.C.A § 1114(2)(D)(v). See 2023 CONG US S 2934 (proposing legislation for Section 1114, “to provide for contributory liability for certain electronic commerce platforms for use of a counterfeit mark by a third party”).

245. *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *2 (D. Ariz. 2023) (quoting *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 625 (4th Cir. 2003) (citing 15 U.S.C. § 1114(2)(D)(v))). See *Barcelona.com, Inc.*, 330 F.3d at 625 (“Under that reverse domain name hijacking provision, a domain name registrant who is aggrieved by an overreaching trademark owner may commence an action to declare that the domain name registration or use by the registrant is not unlawful under the Lanham Act.”); *Dent*, 2020 WL 1170840, at *4 (“Under that reverse domain name hijacking provision, a domain name registrant who is aggrieved by an overreaching trademark owner may commence an action to declare that the domain name registration or use by the registration is not unlawful under the Lanham Act.”); 15 U.S.C.A. § 1114(2)(D)(v).

246. *Dent*, 2020 WL 1170840, at *5 (quoting *Ricks v. BMEzine.com, LLC*, 727 F. Supp. 2d 936, 959 (D. Nev. 2010) (citing *Barcelona.com, Inc.*, 330 F.3d at 625 & n.1) and 15 U.S.C. § 1114(2)(D)(v)); see 15 U.S.C. § 1114(2)(D)(v) (“A domain name registrant . . . may . . . file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter.”).

247. See *AIRFX.com v. AirFX LLC*, 2012 WL 3638721, at *2, 4, 6 (D. Ariz. 2012) (holding, under a narrow interpretation, that since the registration in question was not the initial registration, there was no violation under Section 1125 nor was there a violation under Section 1114 even though the registrant purchased the domain name after knowing about the pending trademark registration for that mark); 15 U.S.C. § 1114(2)(D)(v).

248. *Id.*

could have been unlawful.²⁴⁹ For example, in *AIRFX.com v. AirFX LLC*, when the registrant purchased a domain name after learning about a trademark application for the mark in question, the court held that because the initial registration occurred prior to the trademark, the subsequent registration was not unlawful.²⁵⁰ The acceptance of a narrow interpretation of Section 1125 in *AIRFX.com*, had a direct effect on the interpretation of Section 1114.²⁵¹ The court explicitly stated that since there was no violation under Section 1125, there was no violation of Section 1114.²⁵² Any narrow interpretation would grant a special standard that solely applies to the initial registration and not subsequent re-registrations, which will permit individuals to escape liability as long as the initial registration is done in good faith.²⁵³

5. Internationally, it may be Argued that the WIPO Operates Using a Narrow Interpretation, but This Argument Fails due to the Accepted Application of a Broad Interpretation by the WIPO

Based on statements or actions by the WIPO, the WIPO generally applies a narrow interpretation; for example, if a domain name is registered prior to the time a trademark right comes into fruition, liability will not be found.²⁵⁴ The WIPO Overview also states that formal

249. *Dent*, 2020 WL 1170840, at *5 (quoting *Ricks*, 727 F. Supp. 2d at 959 (citing *Barcelona.com, Inc.*, 330 F.3d at 625 & n.1 (4th Cir. 2003)) and 15 U.S.C. § 1114(2)(D)(v)); see 15 U.S.C. § 1114(2)(D)(v) ("A domain name registrant...may...file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter.")

250. *AIRFX.com*, 2012 WL 3638721, at *2, 4, 6.

251. *Id.* at *6 ("Because we have concluded that plaintiffs cannot be liable under the ACPA for cybersquatting as a matter of law...we conclude that there is no genuine issue of fact as to whether plaintiffs' use of the domain name is lawful" under Section 1114).

252. *Id.*

253. See *AIRFX.com*, 2012 WL 3638721, at *6. *Contra* *Blair v. Automobili Lamborghini SpA*, 2023 WL 4548352, at *4 (D. Ariz. 2023) (holding that if the Court would interpret a domain name registrant in a singular manner in Section 1114 as in registration within Section 1125 it "would mean an initial domain name registrant has special legal rights that, if the domain name were transferred, would be lost forever").

254. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition*, ("WIPO Jurisprudential Overview 3.0"), WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/#item38> [<https://perma.cc/MU3C-36PK>] (last visited Dec. 16, 2023) (stating that "where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent."); World Intellectual Property Organization [WIPO], Charter Communications, Inc., Charter Communications Holding Company, LLC and Charter Communications Operating LLC v. Perfect Privacy, LLC/ Sheri K Corwin, Case No. D2017-0040, (Apr. 19, 2017), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2017-0040> [<https://perma.cc/HQJ7-RJMP>] (quoting WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 3.1) ("Generally speaking...when a domain name is registered by the respondent before the complainant's relied-upon trademark right is

alterations, such as updating information, are generally not considered a re-registration.²⁵⁵ Renewals without a change in ownership are normally not enough to establish the requisite bad faith registration.²⁵⁶ In *Substance Abuse Management, Inc. v. Screen Actors Modest [sic] International, Inc. (SAMI)*, a panel analyzed that since the Policy did not explicitly state that registrations and renewals trigger liability, then the interpretation must not apply to renewals.²⁵⁷

Additionally, one might argue the WIPO merely encompasses acquisitions within the term registration because there is no equivalent term for “traffics in.”²⁵⁸ To file a UDRP proceeding with the WIPO, one must show that “the domain name has been registered and is being used in bad faith.”²⁵⁹ But it is important to note that in *HSBC Finance Co.*, the panel held that since there was no alteration to the WHOIS data following an acquisition, the registration was done in bad faith.²⁶⁰ So, domain name management and the alteration of such information, such as a registrar or registrant, is imperative in analyzing a registration and should be included when determining if bad faith was present during a registration regardless of the different language used in the UDRP.²⁶¹ As such, the alteration of the domain name’s registrars and registrants following the acquisition

shown to have been first established..., the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant’s then non-existent right.”).

255. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)*, WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/#item38> [<https://perma.cc/5744-GCFA>] (last visited Dec. 16, 2023) (“[P]anel’s typically would not treat merely ‘formal’ changes or updates to registrant contact information as a new registration.”).

256. *Id.* (“[T]he mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith.”).

257. World Intellectual Property Organization [WIPO], *Substance Abuse Management, Inc. v. Screen Actors Modest [sic] International, Inc. (SAMI)*, Case No. D2001-0782, (Aug. 14, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0782.html> [<https://perma.cc/8J8G-64BD>] (“[T]he Policy could have been drafted to address both bad faith registration and bad faith renewal.”).

258. *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WIPO, <https://www.wipo.int/amc/en/domains/guide/#a1> [<https://perma.cc/SLE7-3C2Z>]; *Uniform Domain Name Dispute Resolution Policy*, ICANN, <https://www.icann.org/resources/pages/policy-2012-02-25-en> [<https://perma.cc/FS87-V3FD>] (last visited Jan. 3, 2023).

259. *Id.*

260. World Intellectual Property Organization [WIPO], *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062, (June 4, 2007), https://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-0062.html#P56_7451 [<https://perma.cc/3BSR-3QVF>] (“This transfer of ownership was not reflected in the registrar’s Whois database.”).

261. *See supra* note 215.

should be encompassed within the broad interpretation of registers as in the Third Circuit's opinion.²⁶²

Furthermore, it appears the WIPO made an exception to remedy the loopholes that the narrow interpretation creates.²⁶³ WIPO made this exception for domain names that are "registered in anticipation of trademark rights."²⁶⁴ Specifically, if the facts show that a registration was done with the intent "to unfairly capitalize on the...trademark rights, panels" are more inclined to find a bad faith registration.²⁶⁵ This exception is an attempt to remedy loopholes that are created by not including subsequent re-registrations such as renewals and maintenance of a domain name, which can also be seen in the ACPA.²⁶⁶ If renewals and maintenance of a domain name were encompassed within the term registers, it would render these exceptions more effective as a uniform rule.

Despite the WIPO's contradicting statements, the WIPO applies a broad interpretation in practice to achieve just results that are lacking in a narrow interpretation,²⁶⁷ which illustrate that a broad interpretation should prevail, specifically subsequent re-registration of a domain name shall be incorporated within the term registers in the ACPA as it will aid in holding individuals who act in direct violation of the ACPA civilly liable.²⁶⁸

262. 15 U.S.C.A. § 1125(d)(1)(E) (emphasis added). See *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3d Cir. 2003) (holding that when a domain name's registrant and registrar was altered, such conduct of "a new contract at a different registrar and to a different registrant" was encompassed within the broad interpretation of the term registration and the ACPA).

263. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition* ("WIPO Jurisprudential Overview 3.0"), WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/#item38> [<https://perma.cc/4JKJ-MCWX>] (last visited Dec. 16, 2023).

264. *Id.*

265. *Id.*

266. See *supra* note 4 and accompanying text.

267. *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition* ("WIPO Jurisprudential Overview 3.0"), WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/#item38> [<https://perma.cc/4JKJ-MCWX>] (last visited Dec. 16, 2023). See *supra* note 187 and accompanying text.

268. *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 797 (4th Cir. 2023) ("[T]he term 'registers' and its derivatives extend to each registration of a domain name, including the initial registration and any subsequent re-registrations."); Attison L. Barnes, III, Ari Meltzer, David E. Weslow, and Adrienne J. Kosak, *Fourth Circuit Finds "Re-registration" of a Domain Can be Cybersquatting—A Prudential Clarification to the ACPA*, "Re-registration" is Covered by the ACPA, (Jan. 25, 2023), <https://www.wiley.law/alert-Fourth-Circuit-Finds-Re-registration-of-a-Domain-Can-be-Cybersquatting-A-Prudential-Clarification-to-the-ACPA> [<https://perma.cc/6QRB-DFRN>] ("[T]he Fourth Circuit's opinion is not limited to re-registration by the same owner or the transfer to a subsequent owner but, instead, appears to include any successive re-registration of a domain name including acts such as domain renewals."); 15 U.S.C. § 1125(d).

V. CONCLUSION

The current loopholes that a narrow interpretation permit can be solved by the congressional amendment of Section 1125 of the ACPA to include a definition stating that the term registers encompass initial and subsequent re-registrations, including renewals, domain management, and alterations to domain name information that are related to transfers. This broad interpretation would close the loopholes that would be present under the narrow interpretation by expanding the opportunities to hold those liable.²⁶⁹ Congressional action is necessary and without it, the circuit courts will apply their already existing interpretations, including the Ninth Circuit's narrow interpretation, which will allow individuals to escape liability on numerous occasions.²⁷⁰ That is why my solution is imperative by creating a uniform rule to diffuse the confusion between the circuit courts, trademark owners, and registrants while holding individuals responsible for conduct that is expressly prohibited by Section 1125(d).²⁷¹

269. See 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I) and (II); *Schmidheiny v. Weber*, 319 F.3d 581, 581–83 (3d Cir. 2003) (holding that when one initially registered a domain name prior to the ACPA's enactment, they could still be subject to civil liability under the ACPA due to a subsequent registration that was made after the ACPA's enactment); *Prudential Ins. Co. of Am.*, 58 F.4th at 794, 797 (rejecting the registrants' singular interpretation argument that liability under the ACPA cannot be found since the domain name was initially registered prior to the time the mark was trademarked); *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767, 774 (11th Cir. 2015) (“[R]e-registration[s] constituted a registration under the ACPA.”); *We the Protesters, Inc. v. Sinyangwe*, 2024 U.S. Dist. LEXIS 49532 at *36 (S.D.N.Y. 2024) (holding that a “re-registration suffices as a bases for” a cybersquatting claim).

270. See *supra* note 4 and accompanying text.

271. 15 U.S.C.A. § 1125(d)(1)(A)(ii)(I)–(III).