

# PATTISHALL

*insights*

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## What if You Can't Register Your Own Company Name as a Domain Name?

By Phillip Barengolts

So, you try to register your company name as a dot com domain name, say, abccompany.com, but you cannot do so because somebody else has already registered abccompany.com. In the ecommerce economy, where domain names are vital for a business and .com names fetch seven figure purchase prices, being able to use the domain name that corresponds to your company name can be crucial. Assuming you cannot, or do not want to, do a simplistic workaround (e.g., theabccompany.com or abc-company.com), what is your legal recourse?



In the most innocent scenario, the blocking domain name was registered and is being used in good faith by another company that happens to have the same name. In this case, you are probably out of luck unless you can negotiate a solution with the registrant. In a more sinister scenario, the domain name was registered, and used, after your company was already operating to take unfair advantage of your reputation. That is considered “bad faith,” and an effective and relatively inexpensive “recovery” action is available under the Uniform Dispute Resolution Policy (“UDRP”).

There is yet a third, even more frustrating, scenario. The prior domain name was registered early on, perhaps to speculate on whether a company by that name **might** come along some day, making the domain name a valuable commodity to sell at a high price. It might be inactive, perhaps even transferred and renewed from time to time. If the name is not “in use,” a UDRP action will fail because it requires the challenged name to be both registered **and** used in bad faith. In this case, the Anticybersquatting Consumer Protection Act (“ACPA”) may provide a remedy through a federal court action. In contrast to UDRP actions, which require proof of bad faith in both registration **and** use, the ACPA only requires bad faith registration *or* use. It prohibits the registration, trafficking *or* use of a domain name that is identical or confusingly similar to a “mark that is distinctive at the time of registration of the domain name.” 15 U.S.C. § 1125(d)(1)(A)(ii)(I).

“ IF THE NAME IS NOT “IN USE,” A UDRP ACTION WILL FAIL BECAUSE IT REQUIRES THE CHALLENGED NAME TO BE BOTH REGISTERED AND USED IN BAD FAITH

”

However, the ACPA's application to the third scenario has not been uniform. Some federal courts, notably including the influential Ninth Circuit, have held that "registration" applies only to the initial registration of the domain name and not re-registration or renewal – whether by the same registrant or a third party. *See, e.g., GoPets Ltd. v. Hise*, 657 F.3d 1024 (9th Cir. 2011). One district court outside the Ninth Circuit recently joined this view. *See Mehdiyev v. Qatar Nat'l Tourism Council*, No. 1:19-cv-03353, 2021 WL 1291143 (D. Colo. Apr. 1, 2021).

But most courts that have considered this issue have held otherwise; that re-registration/renewal also qualifies as "registration" and, therefore, renewed names can still be challenged in an ACPA action. *See Schmidheiny v. Weber*, 319 F.3d 581 (3d Cir. 2003); *Jysk Bed'N Linen v. Dutta-Roy*, 810 F.3d 767 (11th Cir. 2015); *Xereas v. Heiss*, 933 F. Supp. 2d 1, 16–17 (D.D.C. 2013); *see also* 5 McCarthy on Trademarks and Unfair Competition § 25A:52 (5th ed.) (noting Circuit split).

The Third and Eleventh Circuits, in particular, relied on the plain language of the ACPA, with the Eleventh Circuit expressly rejecting the Ninth Circuit's interpretation of "registration," to come to the opposite conclusion. It stated that "the Act nowhere contains the qualifications of initial or creation when it refers to the act of registering. It refers simply to a registration, and a re-registration is, by definition, a registration." *Jysk* at 777-78.

Very recently, the Eastern District of Virginia went even further, explicitly concluding that *GoPets* was wrongly decided. *See Prudential Ins. Co. of Am. v. PRU.COM*, No. 1:20-CV-450, 2021 WL 2744526, at \*11 (E.D. Va. June

30, 2021) ("...the Ninth Circuit's decision in *GoPets* is contrary to the plain text and statutory purpose of the ACPA, as there is no basis to read additional words into the statute such as *initial* or *creation*."). By contrast, the *Mehdiyev* Court, the first outside the Ninth Circuit to follow *GoPets*, reasoned as follows:

[The Third and Eleventh Circuits' approach] only makes sense if you've already decided that there can be multiple registrations and re-registrations. If there is only one "time of registration," as the text states, then there is no reason to include a qualifier such as "initial" or "first." The fact that the statute does not discuss multiple registrations, to this court, supports rather than undermines the conclusion that, consistent with the plain reading of the text, Congress contemplated only a single time of registration.

Thus, *Mehdiyev* views the plain language reference in the Lanham Act to "registration" as referring to a unique time of registration, i.e., the initial registration.

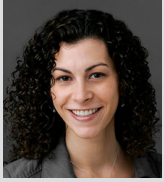
In conclusion, there may be recourse for recovering a domain name incorporating your own company name, which has been registered to

your detriment and damage. However, it will depend on the facts, including the renewal and transfer history of the domain name, as well as the way the ACPA is interpreted in different federal courts around the country. Ultimately, if you are faced with one of the scenarios noted above, you must carefully consider these factors in determining your options for action to preserve your online trade identity. ■

“ THE ACPA'S APPLICATION TO [RE-REGISTRATION/RENEWAL] HAS NOT BEEN UNIFORM. ”

## NEW PARTNER

### ■ Felicia Traub



We are pleased to welcome Felicia Traub as a Partner. Felicia focuses her practice on domestic and international trademarks and brand protection. She brings over 25 years of experience counseling clients

from a broad spectrum of industries with regard to trademark clearance, protection and maintenance, proper trademark usage, intellectual property aspects of mergers, acquisitions, divestitures and securitizations, global rebranding initiatives, and trademark and brand licensing. She has strategically structured and managed international trademark portfolios for large and small companies, including multi-national corporations with famous brand equities that are widely commercialized across the globe.

Felicia has practiced in both law firm and in-house corporate legal environments, including in-house with the French fashion house Chanel and in the global legal group of Colgate-Palmolive Company. In her roles as in-house and outside counsel, Felicia has ably guided her clients through the myriad of intellectual property issues that arise in all stages of a multi-national product launch and roll-out — from concept stage to the shelf and beyond.

Felicia received her J.D. from New York University School of Law, where she was selected to serve on the editorial staff of the *Journal of International Law and Politics* and was awarded the Jack J. Katz Memorial Prize in Entertainment Law. In addition to her prior undergraduate concentration in Ancient Latin literature, Felicia is proficient in French, has studied Ancient Greek, and can read Spanish, some Portuguese and some Italian.

## PRESENTATIONS

### ■ Jonathan Jennings

Jonathan will participate in a panel focused on current IP law developments at UIC Law's 65th Annual IP Conference (Virtual) on November 4th.

## APPOINTMENTS

### ■ Phillip Barendolts

Phil has been appointed to the INTA Emerging Issues Committee, having just completed two terms on the Legislation and Regulation Committee, U.S. Subcommittee.

### ■ Robert Sacoff



Bob will serve as a United States Delegate to the upcoming AIPPI World Congress, from October 15-22, 2021. The Congress will develop, debate, and vote upon proposed Resolutions concerning Registrability of Trademarks

Contrary to Morality or Public Order; Inventiveness and Sufficiency of Disclosure in AI Inventions; the Role of Prior Art in Industrial Designs; and Compensation for IP Infringements.

### ■ Belinda Scrimenti

Belinda, having completed two terms as Co-Chair of the DC Bar Intellectual Property Community Steering Committee, will serve a third year on the Community's Steering Committee for 2021-22. She will also serve as a Trademark Subcommittee Co-Chair.

Belinda has also been reappointed to the INTA Trademark Offices Practices Committee, U.S. subcommittee. She is currently working on the Committee Task Force on combating fraudulent trademark filings at the USPTO, including by Chinese trademark agencies and U.S. lawyers representing them.

## PUBLICATIONS

### ■ Jonathan Jennings



In September, 2021, PTMG's *Law, Lore & Practice* newsletter published **Jonathan's** U.S. Update article about a recent court decision over offensive comments on an Instagram account and posts disparaging a University and its brand about COVID-19 policies.

### IP Stars, Managing Intellectual Property Magazine

- **Pattishall McAuliffe** has again been ranked “Highly Recommended” in Trade Mark law in Illinois.
- **David Hilliard** and **Bradley Cohn** have been recognized as Copyright stars and Trade Mark stars nationally and in Illinois.
- **Brett August, Jonathan Jennings, Janet Marvel** and **Phil Barendolts** have been recognized as Trade Mark stars nationally and in Illinois.
- **Jessica Ekhoﬀ** has been recognized as a Notable Practitioner nationally and in Illinois.

### The Best Lawyers in America® 2022

**David Hilliard** has been recognized in the fields of Litigation – Intellectual Property Law, and Trademark Law. **Janet Marvel** has been recognized in the field of Trademark Law.

### Who’s Who Legal: Trademarks 2021

**David Hilliard, Janet Marvel, Robert W. Sacoff, Belinda J. Scrimenti** and **Joseph Welch II** have been recognized as being among the world’s leading trademark lawyers.

### World Trademark Review (WTR)

**David Hilliard, Jonathan Jennings** and **Janet Marvel** have been recognized as Global Leaders in Private Practice.



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