**10.7 Trademarks – Violation of 15 U.S.C. § 1125 –**

**The Anti-Cybersquatting Consumer Protection Act**

[Name of plaintiff] claims that [name of defendant] violated the federal law known as the Anti-Cybersquatting Consumer Protection Act, which will be referred to as the “ACPA.” To prove a violation of the ACPA, [name of plaintiff] must prove the following facts by a preponderance of the evidence:

[Name of defendant] has registered, trafficked in, or used the subject domain name;

[Name of plaintiff]’s trademark was distinctive at the time of [name of defendant]’s registration of [his/her/its] domain name and that domain name is identical or confusingly similar to [name of plaintiff]’s trademark; or [name of plaintiff]’s trademark was famous at the time of [name of defendant]’s registration of [his/her/its] domain name and that domain name is identical to, confusingly similar to, or likely to dilute [name of plaintiff]’s trademark; and

[Name of defendant] has committed such acts with a bad-faith intent to profit from [name of plaintiff]’s trademark.

[“Dilution” is the decrease in the power of a famous trademark to identify its goods. Dilution does not require (1) competition between the owner of the famous trademark and other parties, or a likelihood of confusion.]

[Plaintiff’s trademark is “famous” if it is widely recognized by the general public as identifying its goods.]

The purpose of the ACPA is to protect trademarks against certain confusing uses of those trademarks in internet domain names. A “domain name” is a designation that forms at least part of an address on the internet, such as www.cnn.com (“cnn” for the CNN television network), and has been registered with or assigned by domain-name authority.

The term “traffics in” means to engage in a transaction including, but not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration. For example, selling a domain name constitutes “trafficking in” that domain name.

[Name of defendant] is not liable for use of [domain name] unless you find that [name of defendant] is the registrant or the registrant’s authorized licensee.

In determining whether [name of defendant] had a bad-faith intent to profit from [name of plaintiff]’s trademark, you may consider the following nine factors. No single factor controls, and [name of plaintiff] is not required to prove that all, or even most, of the factors are present in any particular case. You may also use factors other than these nine to determine [name of defendant]’s intent:

Whether [name of defendant] has trademark or other intellectual property rights in [his/her/its] domain name;

The extent to which [name of defendant]’s domain name consists of [name of defendant]’s legal name or a name that is otherwise commonly used to identify [name of defendant];

The extent of [name of defendant]’s prior use, if any, of [his/her/its] domain name in connection with the bona fide offering of any goods;

The extent to which [name of defendant] used [name of plaintiff]’s trademark noncommercially or as a “fair use” in a site accessible under the domain name – “Fair use” is the good-faith descriptive use by [name of defendant] or term only to describe its goods or services, and not a trademark;

Whether [name of defendant] intended to divert consumers from [name of plaintiff]’s online location to a site that is accessible under [name of defendant]’s domain name and could harm the goodwill represented by [name of plaintiff]’s trademark. A site could harm the goodwill represented by [name of plaintiff]’s trademark if it is for commercial gain, intends to tarnish or disparage [name of plaintiff]’s trademark, or creates a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

Whether [name of defendant] offered to transfer, sell, or otherwise assign [his/her/its] domain name to [name of plaintiff] or any other third party for financial gain without using, or having an intent to use, [name of defendant]’s domain name in the bona fide offering of any goods, or whether [name of defendant]’s prior conduct indicates a pattern of such conduct;

Whether [name of defendant] provided material and misleading false contact information when applying for registration of [his/her/its] domain name, whether [name of defendant] intentionally failed to maintain accurate contact information, or whether [name of defendant]’s prior conduct indicates a pattern of such conduct;

Whether [name of defendant] registered or acquired multiple domain names which [he/she/it] knows are identical or confusingly similar to trademarks of others that are distinctive at the time of registration of such domain names, or dilutive of famous trademarks of others that are famous at the time of registration of such domain names, without regard to the goods of the parties; and

The extent to which [name of plaintiff]’s trademark is distinctive and famous.

Defenses

[Name of defendant] is not liable for violation of the ACPA with respect to [domain name] if you find that [name of defendant] has proven by a preponderance of the evidence that at the time [name of defendant] registered or otherwise obtained [his/her/its] domain name:

[Name of defendant] had reasonable grounds to believe that the use of [his/her/its] domain name was a fair use or otherwise lawful; and

[Name of defendant] actually believed that the use of [his/her/its] domain name was fair use or otherwise lawful.

Remedies

If you find that [name of defendant] violated the ACPA with respect to [domain name], you should consider what damages to award to [name of plaintiff]. [Name of plaintiff]’s remedies available under the ACPA are in addition to any other remedy otherwise applicable, even if they are duplicative of those made in another of [name of plaintiff]’s claims against [name of defendant].

[This instruction should be given if [name of plaintiff] seeks actual damages and [name of defendant]’s profits:

In this case, [name of plaintiff] seeks to recover the actual damages [he/she/it] sustained and [name of defendant]’s profits. [Name of plaintiff] may recover for all elements of injury to [name of plaintiff]’s business proximately resulting from [name of defendant]’s wrongful acts. You are not required to calculate actual damages with absolute exactness – you may make reasonable approximations. But any award of actual damages to [name of plaintiff] must be just and reasonable based on facts that are proved by a preponderance of the evidence.

In addition to [name of plaintiff]’s actual damages, you may also make an award based on an accounting of [name of defendant]’s profits if you find that:

[Name of defendant]’s conduct was willful and deliberate; or

[Name of defendant] was unjustly enriched; or

An award of [name of defendant]’s profits is necessary to deter [name of defendant]’s future conduct.

A defendant commits a “willful violation” of a trademark when that defendant knowingly and purposefully capitalized on and appropriated for itself the goodwill of a plaintiff.

“Unjust enrichment” occurs if [name of defendant] received a benefit to which [he/she/it] was not entitled.

In determining [name of defendant]’s profits, [name of plaintiff] is only required to prove [name of defendant]’s gross sales. [Name of defendant] may then prove the amount of sales made for reasons other than the violation of the ACPA. [Name of defendant] also may prove [his/her/its] costs or other deductions which [he/she/it] claims should be subtracted from the amount of [his/her/its] sales to determine [his/her/its] profits on such sales. Any costs or deductions that [name of defendant] proves by a preponderance of the evidence are subtracted from the sales attributable to the violation of the ACPA and the difference is the amount that may be awarded to [name of plaintiff].

[This instruction should be given if plaintiff has elected to receive statutory damages:

In this case, [name of plaintiff] seeks an award of “statutory damages.” Under the ACPA, statutory damages are punitive in nature meaning that they are designed to sanction or punish [name of defendant] for [name of defendant]’s bad-faith conduct and deter future violations of the ACPA. You may award statutory damages between $1,000 and $100,000 for each domain name that [name of plaintiff] proves [name of defendant] used.]

Violation of the Anti-Cybersquatting Consumer Protection Act

**Special Interrogatories to the Jury**

**Do you find by a preponderance of the evidence that:**

[Name of plaintiff] owns a trademark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to Question No. 2. If your answer is “No,” then your foreperson should sign and date the last page of this verdict form.

[Name of defendant] has registered, trafficked in, or used the domain name?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to Question No. 3. If your answer is “No,” then your foreperson should sign and date the last page of this verdict form.

[Name of plaintiff]’s trademark was distinctive at the time of [name of defendant]’s registration of [his/her/its] domain name and that domain name is identical or confusingly similar to [name of plaintiff]’s trademark, or that [name of plaintiff]’s trademark was famous at the time of [name of defendant]’s registration of [his/her/its] domain name and that domain name is identical to, confusingly similar to, or likely to dilute [name of plaintiff]’s trademark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to Question No. 4. If your answer is “No,” then your foreperson should sign and date the last page of this verdict form.

[Name of defendant] had a bad-faith intent to profit from [name of plaintiff]’s trademark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” go to Question No. 5. If your answer is “No,” then your foreperson should sign and date the last page of this verdict form.

**Defenses**

[Name of defendant] had reasonable grounds to believe that the use of [his/her/its] domain name was a fair use or otherwise lawful and [name of defendant] actually believed that the use of [his/her/its] domain name was fair use or otherwise lawful?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to Question No. 6.

**[These special interrogatories should be used if [name of plaintiff] seeks actual damages for violation of the Anti-Cybersquatting Consumer Protection Act:**

[Name of plaintiff] has suffered actual damages?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to Question No. 7. If your answer is “No,” then go to Question No. 8.

[Name of plaintiff] is awarded actual damages?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” in what amount?

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**[These special interrogatories should be used if [name of plaintiff] seeks [name of defendant]’s profits for violation of the Anti-Cybersquatting Consumer Protection Act:**

[Name of defendant]’s conduct was willful and deliberate, [name of defendant] was unjustly enriched, or such an award is necessary to deter future conduct?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer to this question is “Yes,” go to Question No. 9 below. If your answer is “No, then go to Question No. 10.

[Name of plaintiff] is awarded [name of defendant]’s profits?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” in what amount?

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**[This interrogatory should be given if [name of plaintiff] seeks statutory damages for violation of the Anti-Cybersquatting Consumer Protection Act:**

[Name of plaintiff] is awarded statutory damages?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” in what amount?

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So Say We All.

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Foreperson’s Signature

Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_