**ANNOTATIONS AND COMMENTS**

15 U.S.C. § 1125(A) & ; *see also* House Judiciary Committee Report on H.R. 3028, H.R. Rep. No. 106-412, at 15 (Oct. 15, 1999); Senate Section-by-Section Analysis, Cong. Rec., at S14715 (Nov. 17, 1999). A plaintiff’s *in rem* civil action under the ACPA is in addition to any other civil action otherwise applicable.

In *Tartell v. S. Fla. Sinus & Allergy Ctr.*, 790 F.3d 1253 (11th Cir. 2015), the Eleventh Circuit held the inquiry into whether a plaintiff’s mark is sufficiently distinctive to qualify for protection under the ACPA turns on the following factors:

(1) the length and nature of the name’s use, (2) the nature and extent of advertising and promotion of the name, (3) the efforts of the proprietor to promote a conscious connection between the name and the business, and (4) the degree of actual recognition by the public that the name designates the proprietor’s product or service.

*Id.* at 1257 (quoting *Tana v. Dantanna’s,* 611 F.3d 767, 776 (11th Cir. 2010)).

In contrast, the Eleventh Circuit has not ruled on what makes a trademark famous under the ACPA. For dilution purposes under the Lanham Act, however, a “famous” trademark is one that is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the trademark’s owner.” 15 U.S.C. § 1125; *see also* J. Thomas McCarthy, *Trademarks and Unfair Competition* § 24.91 (4th ed.) (defining “famous” trademarks as those that are “truly prominent and renowned”) (citing *Thane Int’l v. Trek Bicycle Corp.*, 305 F.3d 894, 910-11 (9th Cir. 2002) (concluding that the Federal Trademark Dilution Act only protected a trademark that is a “household name”)). The Eleventh Circuit also has not yet ruled on the meaning of the terms “identical” or “confusingly similar” under the ACPA.

A defendant’s bad faith is not enough; the plaintiff must prove a bad faith *intent to profit*. *S. Grouts & Mortars, Inc. v. 3M Co.*, 575 F.3d 1235, 1246 (11th Cir. 2009). This statutory requirement of an intent to profit correlates with the ACPA’s purpose – namely, “to ‘curtail one form of cybersquatting – the act of registering someone else’s name as a domain name for the purpose of demanding remuneration from the person in exchange for the domain name.’” *Id*. (quoting *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3d Cir. 2003)). For this reason, “[a defendant] cannot be liable for registering or using [a plaintiff’s] trademark with a bad faith intent to profit if it . . . ‘believed and had reasonable grounds to believe that the use of the domain name was . . . lawful.’” *Pensacola Motor Sales Inc. v. E. Shore Toyota, LLC*, 684 F.3d 1211, 1226 (11th Cir. 2012) (second alteration in original) (quoting 15 U.S.C. § 1125(d)(1)(B)(ii) (2012)).