

**70-3a-309 Cybersquatting.**

- (1)
- (a) A person is liable in a civil action by the owner of a mark, including a personal name, which is a mark for purposes of this section, if, without regard to the goods or services of the person or the mark's owner, the person:
    - (i) has a bad faith intent to profit from the mark, including a personal name; and
    - (ii) for any length of time registers, acquires, traffics in, or uses a domain name in, or belonging to any person in, this state that:
      - (A) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to the mark;
      - (B) 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 the mark; or
      - (C) is a trademark, word, or name protected by reason of 18 U.S.C. Sec. 706 or 36 U.S.C. Sec. 220506.
  - (b)
    - (i) In determining whether a person has a bad faith intent described in Subsection (1)(a), a court may consider all relevant factors, including:
      - (A) the trademark or other intellectual property rights of the person, if any, in the domain name;
      - (B) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
      - (C) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
      - (D) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
      - (E) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;
      - (F) the person's offer to transfer, sell, or otherwise assign, or solicitation of the purchase, transfer, or assignment of the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;
      - (G) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;
      - (H) the person's registration or acquisition of multiple domain names that the person knows are identical or confusingly similar to another's mark that is distinctive at the time of registration of the domain names, or is dilutive of another's famous mark that is famous at the time of registration of the domain names, without regard to the goods or services of the person or the mark owner; and
      - (I) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous.

- (ii) Bad faith intent described in Subsection (1)(a) may not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.
  - (c) In a civil action involving the registration, trafficking, or use of a domain name under this section, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.
  - (d)
    - (i) A person is liable for using a domain name under Subsection (1)(a) only if that person is the domain name registrant or that registrant's authorized licensee, affiliate, domain name registrar, domain name registry, or other domain name registration authority that knowingly assists a violation of this chapter by the registrant.
    - (ii) A person may not be held liable under this section absent a showing of bad faith intent to profit from the registration or maintenance of the domain name.
    - (iii) For purposes of this section, a "showing of bad faith intent to profit" shall be interpreted in the same manner as under 15 U.S.C. Sec. 1114(2)(D)(iii).
  - (e) As used in this section, the term "traffics in" refers to transactions that include sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.
- (2)
- (a) The owner of a mark registered with the U.S. Patent and Trademark Office or under this chapter may file an in rem civil action against a domain name in the district court if the owner is located in the state and if:
    - (i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office or registered under this chapter; and
    - (ii) the court finds that the owner:
      - (A) is not able to obtain personal jurisdiction over a person who would be a defendant in a civil action under Subsection (1); or
      - (B) through due diligence was not able to find a person who would be a defendant in a civil action under Subsection (1) by:
        - (I) sending a notice of the alleged violation and intent to proceed under this Subsection (2)
          - (a) to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and
        - (II) publishing notice of the action as the court may direct promptly after filing the action.
  - (b) Completion of the actions required by Subsection (2)(a)(ii) constitutes service of process.
  - (c) In an in rem action under this Subsection (2), a domain name is considered to be located in the judicial district in which:
    - (i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or
    - (ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.
  - (d)
    - (i) The remedies in an in rem action under this Subsection (2) are limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.
    - (ii) Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in the district court under this Subsection (2), the domain name registrar, domain name registry, or other domain name authority shall:

- (A) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and
- (B) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.
- (iii) The domain name registrar or registry or other domain name authority is not liable for injunctive or monetary relief under this section, except in the case of bad faith or reckless disregard, which includes a willful failure to comply with a court order.
- (3) The civil actions and remedies established by Subsection (1) and the in rem action established in Subsection (2) do not preclude any other applicable civil action or remedy.
- (4) The in rem jurisdiction established under Subsection (2) does not preclude any other jurisdiction, whether in rem or personal.

Enacted by Chapter 200, 2010 General Session