

MANIFEST DESTINY? THE FOURTH CIRCUIT'S INEVITABLE EXPANSION OF "REGISTERS" UNDER THE ACPA

Abstract: In 2023, in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*, the United States Court of Appeals for the Fourth Circuit interpreted “registers” broadly under the Anti-Cybersquatting Protection Act to include re-registrations—that is, when a party registers a domain name again after an initial registration. Siding with the Third and Eleventh Circuits, the Fourth Circuit emphasized the growing circuit split over whether subsequent registrations fall within the scope of liability under the Act. This Comment argues that courts should join the Third, Fourth, and Eleventh Circuits in construing “registers” broadly because the plain meaning of the terms encompasses re-registrations. Moreover, this Comment critiques the Ninth Circuit’s reliance on property law in excluding re-registrations from liability under the Act, advocating instead for analysis grounded in contract law.

INTRODUCTION

As consumers transition from browsing supermarket shelves to webpages, acquiring a distinctive and fitting internet domain name has become vital to a company’s success in the digital market.¹ A domain name is the portion of a uniform resource locator (URL) that identifies a specific website.² Internet searchers rely on keywords and domain names to access relevant websites.³

¹ See *From Compromise to Premium: 100+ Businesses That Upgraded to Their Perfect Domain Name*, SMARTBRANDING, <https://smartbranding.com/from-compromise-to-premium-100-businesses-that-upgraded-to-their-perfect-domain-name/> [<https://perma.cc/X3YS-TH6N>] [hereinafter *From Compromise to Premium*] (heralding domain names as playing a critical role in the growth of a brand, especially as the number of websites climbs into the billions); Kristy Snyder, *35 E-Commerce Statistics of 2024*, FORBES (Mar. 28, 2024), <https://www.forbes.com/advisor/business/ecommerce-statistics/> [<https://perma.cc/4SLQ-65L3>] (projecting that 23% of all retail purchases will occur online by 2027).

² 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:A10 to 11 (5th ed. 2024); see *What Is a Domain Name?*, CLOUDFLARE, <https://www.cloudflare.com/learning/dns/glossary/what-is-a-domain-name/> [<https://perma.cc/5YFB-29Q5>] (explaining the difference between domain names and URLs). Domain names are split into different levels: the “top-level domain” refers to the section after the rightmost period, and the “second-level domain” refers to the portion of “human-friendly” text to the left of the rightmost period before the “protocol,” which is typically “https://.” *What Is a Domain Name?*, *supra*.

³ Christopher G. Clark, Note, *The Truth in Domain Name Act of 2003 and a Preventative Measure to Combat Typosquatting*, 89 CORNELL L. REV. 1476, 1478, 1485 (2004). For example, although YouTube and Facebook have domain names that match their company names exactly, the two most searched keywords in Google’s search engine in 2024 were “youtube” and “facebook,” with 1.2 billion and 867 million searches respectively. Anna Baluch, *60 SEO Statistics for 2024*, FORBES ADVI-

Thus, a business's domain name must closely match its trademarks and other recognizable branding elements to ensure a seamless integration between its online presence and user search behavior.⁴

Cybersquatting, the abusive registration of domain names to profit from others' trademarks, disturbs this business-consumer connection.⁵ Cybersquatters pose as reputable businesses to deceive consumers into purchasing counterfeit goods, misdirect consumers to unrelated or malicious sites, or profit from pay-per-click ads.⁶ As internet usage has exploded over the past decade, so has cybersquatting: between 2013 and 2023, reported cases increased by approximately 140%.⁷

SOR (Nov. 28, 2023), <https://www.forbes.com/advisor/business/software/seo-statistics/> [https://perma.cc/HHF6-T52Q].

⁴ See Clark, *supra* note 3, at 1485 (arguing that corporations must have domain names that accurately reflect their purpose to ensure efficient, trustworthy access to information on the Internet); see also *From Compromise to Premium*, *supra* note 1 (emphasizing that a business's success depends, at least in part, on its selected domain name). In a commercial setting, a trademark is any "word, name, symbol, or device, or any combination thereof" that is registered by the United States Patent and Trademark Office (USPTO) so that consumers may easily recognize and differentiate between the source of commercial goods sold by trademark owner and others. 15 U.S.C. § 1127. Many companies have sought to enhance their commercial appeal and limit consumer confusion by registering succinct, lesser descriptive domain names. See *From Compromise to Premium*, *supra* note 1 (listing over one hundred companies that have registered shorter domain names, which often consist of acronyms or offshoots of their registered marks). For instance, after having originally purchased the domain name "Thefacebook.com," Mark Zuckerberg, the CEO of Facebook, purchased "Facebook.com" for \$200,000 in 2005. Tatiana Bonneau, *From TheFacebook.com to Facebook.com to FB.com*, SMART-BRANDING, <https://smartbranding.com/thefacebook-com-facebook-com-fb-com/> [https://perma.cc/THS6-LQAL]. After the transition to "facebook.com" in 2009, Zuckerberg quipped during an interview that if he could go back in time and change anything, he would "get the right domain name." *Id.* Ironically, Zuckerberg shelled out \$8.5 million for the "FB.com" domain only one year later. *Id.*

⁵ See S. REP. NO. 106-140, at 4-5 (1999) ("The practice of cybersquatting harms consumers, electronic commerce, and the goodwill equity of valuable U.S. brand names, upon which consumers increasingly rely to locate the true source of genuine goods and services on the Internet."). "Cybersquatting" is also used interchangeably with the term "cyber-piracy." *Id.* at 18; see The Anti-Cybersquatting Protection Act (the ACPA) 15 U.S.C. § 1125(d) (defining cybersquatting and titling the section concerning cybersquatting "cyberpiracy prevention").

⁶ See MCCARTHY, *supra* note 2, § 25A:49 (characterizing various types of cybersquatting, including both archetypal and atypical examples contemplated by the ACPA); S. REP. NO. 106-140, at 6 (1999) (observing that some cybersquatting cases have involved misleading Internet users into entering websites littered with revenue-generating pornography advertisements based on the number of "hits" the advertisements receive). The "classic" cybersquatting scenario is when an individual registers a domain name containing another's registered trademark as ransom to extort the mark owner. MCCARTHY, *supra* note 2.

⁷ See Hanna Ritchie, *6 in 10 People in the World Regularly Use the Internet*, OUR WORLD IN DATA (July 10, 2024), <https://ourworldindata.org/data-insights/6-in-10-people-in-the-world-regularly-use-the-internet> [https://perma.cc/WR4D-NFF5] (exploring data indicating that internet usage has rapidly expanded throughout the twenty-first century). Compare *Total Number of Cases per Month for Year 2013*, WORLD INTEL. PROP. ORG., https://www.wipo.int/amc/en/domains/statistics/cases_yr.jsp?year=2013 [https://perma.cc/2SWF-AEJ8] (2,585 total cases in 2013), with *Total Number of Cases per Month for Year 2023*, WORLD INTEL. PROP. ORG., https://www.wipo.int/amc/en/domains/statistics/cases_yr.jsp?year=2023 [https://perma.cc/3DUS-RS66] (6,192 total cases in 2023). In 2024,

But not all domain registrations are the same.⁸ In 2020, Prudential Insurance Company of America (Prudential) tested the boundaries of the term “registers” under the Anti-Cybersquatting Protection Act (ACPA) when it attempted to purchase “PRU.com”—a domain name containing one of its registered marks—from Shenzhen Stone Network (SSN).⁹ Part I of this Comment discusses the enactment of the ACPA and the facts and procedural history leading to the United States Court of Appeals for the Fourth Circuit’s 2023 decision in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*¹⁰ Part II examines the competing interpretations of “registers” adopted by the Third, Eleventh, Ninth, and Fourth Circuits.¹¹ Part III argues courts should follow the Fourth Circuit in adopting a broad interpretation of “registers” and that domain names should be analyzed using contract law rather than real property law.¹²

I. NAVIGATING THE LEGAL FRONTIER OF CYBERSQUATTING IN THE DIGITAL WILD WEST

In 2023, in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*, the United States Court of Appeals for the Fourth Circuit joined the Third and Eleventh Circuits in holding that the re-registration of a domain name qualifies as a registration under the ACPA.¹³ Section A of this Part examines the policy concerns that prompted Congress to enact the ACPA, along with the Act’s operative language.¹⁴ Section B of this Part discusses the facts of *Prudential* and the procedural history leading to the Fourth Circuit’s decision.¹⁵

the World Intellectual Property Organization (WIPO) reported 6,168 cybersquatting cases. *Total Number of Cases per Month for Year 2024*, WORLD INTEL. PROP. ORG., https://www.wipo.int/amc/en/domains/statistics/cases_yr.jsp?year=2024 [<https://perma.cc/YM5F-BMNW>].

⁸ See *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030–31 (9th Cir. 2011) (observing numerous actions that alter a domain’s registration status, including changing billing or contact information, obtaining a new registrar, and transferring to private registration renewal); Brian Gutterman, *Do You Have a Domain Name? Here’s What You Need to Know*, ICANN, <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/G65L-MLPX>] (explaining that registrants must periodically renew domain names with the appropriate registrar prior to the domain name’s expiration, which may occur between one to ten years depending on the initial registration period).

⁹ See *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 790–91, 796 (4th Cir. 2023) (asserting that SSN’s re-registration of “PRU.com” violated the ACPA). The scope of “registers” in the ACPA was a matter of first impression in the Fourth Circuit. *Id.* at 794.

¹⁰ See *infra* notes 13–32 and accompanying text.

¹¹ See *infra* notes 33–65 and accompanying text.

¹² See *infra* notes 66–80 and accompanying text.

¹³ *Prudential*, 58 F.4th at 797.

¹⁴ See *infra* notes 16–21 and accompanying text.

¹⁵ See *infra* notes 22–32 and accompanying text.

A. A New Sheriff in Cyberspace: The ACPA

Before the ACPA, federal law did not expressly prohibit cybersquatting.¹⁶ Then, in 1999, Congress amended the Lanham Act—the principal federal statute that defines trademark infringement—to address cybersquatting directly.¹⁷ The ACPA allows a trademark owner to bring a civil action against anyone who registers or uses a domain name that mirrors or is confusingly similar to the owner's mark.¹⁸ The ACPA does not define "registers," nor does the Act's legislative history comment on its meaning.¹⁹

To balance the deterrence of abusive conduct with the protection of lawful, free speech uses of registered trademarks, Congress limited liability to those who seek to gain an economic advantage from the mark in bad faith.²⁰

¹⁶ S. REP. NO. 106-140, at 7 (1999). Before Congress created a cause of action for cybersquatting under the ACPA, trademark owners attempted to curb cybersquatting by bringing claims against offending domain name registrants under the Federal Trademark Dilution Act (FTDA). *See id.* (noting that the FTDA has been used previously to provide a legal remedy for entities affected by cybersquatting); *see, e.g.*, *Panavision Int'l L.P. v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998) (holding that a defendant diluted plaintiff's registered trademark under the FTDA by registering a domain name containing plaintiff's marks and offering to sell it to plaintiff); *see also* 141 CONG. REC. § 19312-01 (daily ed. Dec. 29, 1995) (statement of Sen. Leahy) ("It is my hope that [the FTDA] can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others."). As cybersquatting cases became more frequent, cybersquatters became increasingly adept at circumventing liability under varying judicial applications of the FTDA. S. REP. NO. 106-140, at 7; *see, e.g.*, *Acad. of Motion Picture Arts & Scis. v. Network Sols., Inc.*, 989 F. Supp 1276, 1279 (C.D. Cal. 1997) (refusing to find defendant liable for registering domain name containing plaintiff's "famous mark" because defendant's use of the domain name was not for commercial purposes under the FTDA); *see also* 2 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 7A.07 (2024) (clarifying the differences between the ACPA and the FTDA in that under the FTDA, there is no requirement for the defendant to have registered the domain with a bad-faith intention to profit).

¹⁷ 15 U.S.C. §§ 1225(a), 8131. There are two federal statutes governing the "properization" of internet domain names: The ACPA, or section 1225(d) of the Lanham Act, and Title 15 Section 8131 of the United States Code. *Id.* §§ 1225(d), 8131. Section 8131 of Title 15 concerns cyberpiracy protections for internet domains names that are identical or "substantially and confusingly similar" to the legal name of a living persons. *Id.* § 8131.

¹⁸ *Id.* § 1225(d). The ACPA is split into two provisions, the first setting forth the elements of a cybersquatting claim and the second outlining the jurisdictional requirements. *Id.* Subject to the restrictions set forth in subparagraph (2)(A), a registered trademark owner may file a claim under the ACPA in rem or in personam, meaning that the claim may be filed against either the registrant or the domain name itself respectively. *Id.* § 1225(2)(A).

¹⁹ *See id.* § 1225(d) (including definition of "traffics in" but failing to define "registers"); S. REP. NO. 106-140, at 17 (discussing limitations on liability and definitions but neglecting to clarify the meaning of "registers").

²⁰ 15 U.S.C. § 1225(d). Subparagraph (1)(A) indicates punctually that a bad faith intent to profit is necessary for a successful cybersquatting claim. *Id.* § 1225(d)(1)(A); *see* *Newport News Holdings Corp. v. Virtual City Vinson, Inc.*, 650 F.3d 423, 434 (4th Cir. 2011) (citing bad faith intent to profit as inherent within a cybersquatting claim). Subparagraph (B) of the ACPA provides a non-exhaustive list of factors that a court may, but need not, consider when assessing whether an individual has a bad faith intent to profit. *Id.* § 1225(d)(B)(i); *see* *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 269 (4th Cir. 2001) (noting that the ACPA permits a totality of the circumstances assessment that is guided by, not rigidly informed, by the factors listed in § 1225(d)(B)(i)). Not all uses of another's

By providing a specific cause of action against bad-faith domain name registrants, Congress sought to shield consumers from cybersquatters posing as reputable corporations, preserve the goodwill tied to businesses' distinctive trademarks, and promote the internet as a viable platform for commerce.²¹

B. Marking the "PRU" Territory

Prudential is a United States company that provides insurance, retirement planning, asset management, and other financial services globally.²² In November 2002, Prudential registered trademarks for "PRU" and other "PRU" formative marks with the United States Patent and Trademark Office (USPTO).²³ In October 2017, SSN, a Chinese company that creates content about the foreign exchange market for Chinese audiences, bought the "PRU.com" domain name

domain name are necessarily in bad faith: For instance, domain names could potentially be used for genuine, free-speech purposes, such as for political speech or parody. *See* Jacqueline D. Lipton, *Who Owns "Hillary.com"? Political Speech and the First Amendment in Cyberspace*, 49 B.C. L. REV. 55, 95 (2008) (alluding to free-speech implications of restricting the registration of political domain names); Munir Kotadla, *Software Giant Threatens MikeRoweSoft*, ZDNET, <https://web.archive.org/web/20241130070020/https://www.zdnet.com/article/software-giant-threatens-mikerowesoft/> [<https://perma.cc/56B7-ZLWK>] (Jan. 19, 2004) (detailing how Microsoft threatened to file a cybersquatting claim against then-teenager software writer Mike Rowe for registering the domain name "MikeRoweSoft.com"). Microsoft later admitted it took the "MikeRoweSoft.com" domain name "a little too seriously" and settled the matter with Rowe out of court, funding the expenses he incurred while battling Microsoft, a trip to Microsoft's headquarters, and an Xbox. Munir Kotadla, *Microsoft: We Took Mike RoweSoft Too Seriously*, ZDNET, <https://web.archive.org/web/20241130063409/https://www.zdnet.com/article/microsoft-we-took-mikerowesoft-too-seriously/> [<https://perma.cc/S9PQ-S3PZ>] (Jan. 20, 2004); Munir Kotadla, *MikeRoweSoft Settles for an Xbox*, CNET, <https://www.cnet.com/tech/tech-industry/mikerowesoft-settles-for-an-xbox/> [<https://perma.cc/7CLQ-KYEB>] (Jan. 26, 2004).

²¹ *See* S. REP. NO. 106-140, at 7 (1999) (noting that the ACPA was enacted to protect both American businesses and citizens while encouraging the growth of internet-based consumerism).

²² *See* Q1 PRUDENTIAL FIN. FACT SHEET (Apr. 2024), https://s203.q4cdn.com/639437276/files/fact_sheets/earnings-fact-sheet_1q24_final.pdf [<https://perma.cc/V8F3-XEPW>] (depicting Prudential's sales figures for numerous areas of U.S. businesses); *see also* Prudential Financial's Portfolio of Business, <https://www.prudential.com/links/about/business-portfolio> [<https://perma.cc/526Q-Y62C>] (providing details about Prudential's services).

²³ *Prudential Ins. Co of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 785, 789 (4th Cir. 2023). A formative mark is a mark belonging to a larger "family of marks" that consumers recognize as sharing a distinctive and common element. MCCARTHY, *supra* note 2, § 23:61; *see, e.g.*, *J&J Snack Food Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1461 (Fed. Cir. 1991) (evaluating the distinctiveness of McDonald's "Mc" formative marks, including "McMuffin," "McChicken," and "McRib"). "PRU" had been associated with Prudential prior to it trademarking the term. *See* Q1 PRUDENTIAL FIN. FACT SHEET, *supra* note 22 (stating that Prudential's stock symbol in the New York Stock Exchange is "PRU" and has been traded since 2001). Although Prudential has similarly trademarked "PRU" in other countries, it has not registered "PRU" or "PRU" formative trademarks in China. *Prudential*, 58 F.4th at 789. Furthermore, per an agreement with a separate life insurance company, Prudential PLC, Prudential has not conducted any business in mainland China using "PRU" or other "PRU" formative marks. *Id.* According to SSN, Prudential uses the marks "Pramerica" and "Pricoa" in regions where Prudential PLC operates. Brief of Defendants-Appellants at 6, *Prudential*, 58 F.4th 785 (No. 1:20-cv-450-TSE-MSN2781).

from an unknown company.²⁴ SSN then re-registered “PRU.com” and maintained control over the domain, but never uploaded viewable content on the site.²⁵

Nearly three years later, Prudential sought to obtain “PRU.com,” but when it did so, an intermediary domain name registrar alerted Prudential that an undisclosed company (SSN) had already re-registered the domain.²⁶ Prudential offered to purchase “PRU.com” through a domain broker, but SSN declined.²⁷ After initiating administrative proceedings with the World Intellectual Property Organization (WIPO), Prudential discovered that Zhaoyuan “Frank”

²⁴ *Prudential*, 58 F.4th at 789. It is unclear why Prudential did not buy the “PRU.com” domain name prior to its attempts in March 2020. *See id.* (observing only that Prudential sought to purchase the “PRU.com” in March 2020); *see also* Emmanuel Gillet, *Pru.com: A Lack of Prudence, a Bluff, and a Success*, LEXOLOGY (Apr. 4, 2023), <https://www.lexology.com/library/detail.aspx?g=dc71c811-d7c7-4bdb-826e-7a12a0e2d265> [<https://perma.cc/Q277-DBQC>] (presenting evidence suggesting that Prudential, despite using the mark “PRU” in 2002, did not attempt to purchase the “PRU.com” domain when the domain name was eligible for purchase in 2016). Indeed, when appraised against similarly concise and well-known phrasings, the value of “PRU.com” likely exceeded \$100,000—the amount paid by SSN in 2017 to acquire the domain name. *See* Gillet, *supra* (compiling a list of comparable domain names and their respective selling prices, ranging from \$200,002 to \$14,000,000).

²⁵ *Prudential*, 58 F.4th at 789–90. When SSN controlled the domain name, typing and entering “PRU.com” into an internet browser would direct the user to a placeholder webpage containing numerous advertisements expressing Prudential’s registered marks and those of its competitors. *Id.* at 790. Furthermore, the question “Would you like to buy this domain?” appeared on the “PRU.com” webpage. *Id.* When a domain name is registered but is inactive or does not yet have a webpage, accessing the site will redirect an internet user to a “parked page,” where the owner of the domain can monetize traffic by generating revenue from clicks on the advertisements. Adem Asha, *Parked Domain: What Is It & How to Use It?* GODADDY (Jan. 3, 2011), <https://www.godaddy.com/resources/ae/skills/parked-domain> [<https://perma.cc/PWQ9-A4WJ>]. Currently, typing “PRU.com” into the search bar in a Google Chrome or Safari browser and clicking the “enter” key will redirect the user to “Prudential.com,” Prudential’s primary website. PRUDENTIAL, <https://www.pru.com/> [<https://perma.cc/VD55-R497>].

²⁶ *Prudential*, 58 F.4th at 789, 802. Domain name registrars are not necessarily obligated to disclose information about a domain name’s registrant, such as the registrant’s name or contact information. *See Q&A: Domain Name WHOIS Data and the UDRP*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/en/web/amc/domain-name-disputes/gdpr/index> [<https://perma.cc/3V5R-4NK8>] (noting that a Uniform Domain Name Dispute Resolution Policy (UDRP) complaint may still be filed where the identity of the registrant cannot be discovered). However, the Internet Corporation for Assigned Names and Numbers (ICANN), which implements policies concerning domain names and oversees the global domain name system, requires that registrars supplant this information in UDRP proceedings. *See id.* (discussing the process by which a UDRP claim against an anonymous registrant may be amended to include the registrant’s information via ICANN’s requirements for UDRP providers).

²⁷ *Prudential*, 58 F.4th at 789. SSN claimed to the broker that another party previously offered “six figure[s]” for the “PRU.com” domain name; however, SSN did not provide evidence of such an offer. *Id.* at 789–90. Moreover, SSN refused to name a price for the domain to the broker until the broker disclosed identifying information about the buyer, such as its location and area of business. *Id.* at 789. According to SSN, it planned to use the domain name in its foreign exchange (“forex”) business dealings. Brief of Defendants-Appellants, *supra* note 23, at 12–13. SSN claimed that the Chinese name for one of its products would be “普魯社,” which in Simplified Chinese is a transliteration of “Prussia” from “Pu Lu Shè.” *Id.* at 12, 21; *see Prudential*, 58 F.4th at 801 (“If there is some reason why the term ‘PRU’ or ‘Prussia’ would lead Chinese consumers to believe that a product branded as such would have some relation to the forex market, SSN has not provided it.”).

Zhang, SSN's CEO, had re-registered the domain.²⁸ In April 2020, Prudential again offered to purchase the domain name, and—once again—SSN refused.²⁹

Prudential filed a cybersquatting claim under the ACPA in the Eastern District of Virginia and terminated its administrative action against SSN.³⁰ The District Court for the Eastern District of Virginia granted Prudential's motion for summary judgment and ordered SSN to transfer ownership of "PRU.com" to Prudential.³¹ SSN appealed to the Fourth Circuit, arguing that it did not "register" the domain name under the ACPA because it was not the original registrant of "PRU.com," thereby escaping liability.³²

II. THE "REGISTRATION" FORK IN THE ACPA ROAD

Although courts agree that the initial registration of a domain name triggers liability under the ACPA, they disagree on the scope of the term "registers" as it pertains to the processes following a primary registration.³³ Before the Fourth Circuit's 2023 decision in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*, the only circuits to have interpreted the meaning of "registers" within the ACPA were the United States Court of

²⁸ *Prudential*, 58 F.4th at 790. The WIPO operates under the United Nations and assists with protecting IP within cross-border disputes. WORLD INTEL. PROP. ORG., *About WIPO*, <https://www.wipo.int/about-wipo/en/> [<https://perma.cc/VY4G-EFMH>]. The UDRP provides trademark owners a form of dispute resolution concerning abusive registrations of internet domain names through administrative action. *Prudential*, 58 F.4th at 790.

²⁹ *Prudential*, 58 F.4th at 790.

³⁰ *Id.* at 790–91. Prudential initially filed its cybersquatting claim, as well as a trademark infringement claim under the Lanham Act, against both Zhang personally and the "PRU.com" domain itself. *Id.* at 790. Per the ACPA, however, only if the claimant owner cannot establish in personam jurisdiction over the registrant may the trademark owner file an in rem action. 15 U.S.C. § 1125(d)(2)(A)(ii). Thus, the Court for the Eastern District of Virginia dismissed Prudential's claim against Zhang for lack of in personam jurisdiction and permitted Prudential's claim against the "PRU.com" domain name to proceed in rem in accordance with the ACPA. *Prudential*, 58 F.4th at 790.

³¹ *Prudential*, 58 F.4th at 791. The remedies available to trademark owners in cybersquatting actions proceeding in rem are limited to the registrant's forfeiture of the domain name, thereby returning the domain name to the registry, or direct transfer of the domain name to the rightful trademark owner. 15 U.S.C. § 1125(d)(2)(D)(i). Remedies under the ACPA, for either in personam or in rem actions, do not limit remedies for other applicable civil actions. 15 U.S.C. § 1125(d)(4). In granting Prudential's motion for summary judgment, the District Court for the Eastern District of Virginia dismissed Prudential's claim under the Lanham act as moot, given that the court's ruling would give Prudential ownership over the domain name containing its registered mark. *Prudential*, 58 F.4th at 791.

³² *Prudential*, 58 F.4th at 791, 794; see Brief of Defendants-Appellants, *supra* note 23, at 18–19, (citing *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1027–32 (9th Cir. 2011)) (relying on the Ninth Circuit's narrow construal of "registers" under the ACPA).

³³ *Prudential*, 58 F.4th at 794; see *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030 (9th Cir. 2011) ("It is obvious that, under any reasonable definition, the initial contract with the registrar constitutes a 'registration' under ACPA. It is less obvious which later actions, if any, are also 'registrations.'").

Appeals for the Third, Ninth, and Eleventh Circuits.³⁴ Section A of this Part examines the Third and Eleventh Circuits' findings, both of which favor a broad interpretation of the term.³⁵ Section B discusses the minority, narrow construction of "registers" advanced by the Ninth Circuit.³⁶ Section C analyzes the Fourth Circuit's decision in *Prudential* to adopt a broad reading of "registers" and its rejection of the Ninth Circuit's exclusion of re-registrations from the ambit of the ACPA.³⁷

A. The Wide Trail

In 2003, in *Schmidheiny v. Weber*, the United States Court of Appeals for the Third Circuit decided its first case under the ACPA.³⁸ There, multimillionaire Stephan Schmidheiny sued Stephen Weber for cybersquatting after Weber re-registered the domain name "Schmidheiny.com" under his company, "Famology.com," and attempted to sell it back to Schmidheiny.³⁹ The Third Circuit first addressed the ACPA's language, observing the lack of a limitation from the plain language meaning of "registers" and any restrictive modifiers, such as "initial" or "creation."⁴⁰ Second, the court considered the Act's structure, noting that the absence of an exception for re-registrations supported a

³⁴ See *GoPets*, 657 F.3d at 1031 (noting that, at the time, the only other circuit court to have contemplated the inclusions of re-registrations under the ACPA was the Third Circuit); *Prudential*, 58 F.4th at 794 (exploring the reasoning of the Third, Ninth, and Eleventh Circuits in their interpretations of "registers" prior to reaching its own decision); *Jysk Bed'N Linen v. Dutta-Roy*, 801 F.3d 767, 777 (11th Cir. 2015) (observing that the Third and Ninth Circuit Courts of Appeals landed on opposing interpretations of "registrations" within the ACPA). The Ninth Circuit Court of Appeals is the only circuit court to have narrowly interpreted "registration" under the ACPA. See *Prudential*, 58 F.4th at 795–96 (analyzing the Ninth Circuit's opinion exclusively when contemplating a narrow definition of "registers" under the ACPA).

³⁵ See *infra* notes 39–47 and accompanying text.

³⁶ See *infra* notes 48–57 and accompanying text.

³⁷ See *infra* notes 59–65 and accompanying text.

³⁸ 319 F.3d 581, 582–83 (3d. Cir. 2003).

³⁹ *Id.* at 581–82. The ACPA treats personal names as protected marks. 15 U.S.C. § 1125(d)(1)(A). Currently, typing and entering the "Famology.com" domain into a Safari or Chrome browser takes the internet user to a parked page. *Famology.com*, <http://ww1.famology.com/?usid=15&utid=30684107704> [<https://perma.cc/E28C-TXRQ>]. It is unclear whether Schmidheiny sought to obtain the "Schmidheiny.com" domain name through the cybersquatting suit, but regardless of his goals, the domain name is not currently registered to anyone. See *Schmidheiny.com*, <http://schmidheiny.com/> [<https://perma.cc/2FBT-7XWN>] (type and enter "Schmidheiny.com" into Google Chrome's search engine and observe the "DNS_PROBE_FINISHED_NXDOMAIN" error signal that results); Rob Pugh, *How to Fix the DNS_PROBE_FINISHED_NXDOMAIN Error*, JETPACK (updated July 12, 2024), <https://jetpack.com/resources/dns-probe-finished-nxdomain/> [<https://perma.cc/CZN6-2BMN>] (explaining that "NXDOMAIN" means "Non-Existent Domain" and indicates that the user's IP address could not find a record of the domain name because it does not exist).

⁴⁰ See *Schmidheiny*, 319 F.3d at 582–83 (rejecting inversely the district court's reasoning that if Congress had intended to construe "register" to incorporate re-registrations, it would have done so by including adjectives and other appropriate language indicating such an intention).

broad reading of “registers.”⁴¹ The court determined that, under the plain meaning of the term, “registers” encompassed re-registrations, which therefore may trigger liability under the ACPA.⁴²

In 2015, in *Jysk Bed’N Linen v. Dutta-Roy*, the United States Court of Appeals for the Eleventh Circuit decided a similar case.⁴³ There, Jysk Bed’N Linen, a furniture store, hired Monosij Dutta-Roy and others to design a website and register a domain name for the business.⁴⁴ When their relationship soured, Dutta-Roy re-registered the domain in his own name and refused to transfer it, prompting Jysk Bed’N Linen to file a claim under the ACPA.⁴⁵ Relying on the *Oxford English Dictionary*’s definition of “re-register,” the Eleventh Circuit held that a re-registration is unambiguously a “registration.”⁴⁶

⁴¹ See *id.* (referencing the lack of exceptions due to the presence of a safe-harbor clause in ACPA). The safe-harbor clause provides that “[b]ad faith intent described under subparagraph (A) shall 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.” 15 U.S.C. § 1125(d)(1)(B)(ii). Given this large exception to cybersquatting, the Third Circuit inferred that Congress had already contemplated exceptions for re-registrations and therefore made a conscious choice not to carve out an explicit exception for re-registrations. See *Schmidheiny*, 319 F.3d at 582–83 (quoting *United States v. Johnson*, 529 U.S. 53, 58 (2000)) (“[W]hen Congress provides exceptions in a statute, a court should infer that Congress considered the issue of exceptions and limited the exceptions to the ones set forth.”).

⁴² See *Schmidheiny*, 319 F.3d at 582–83 (citing *Sweger v. Chesney*, 294 F.3d 506, 516 (3d Cir. 2002)) (asserting that a court does not need to speculate as to Congress’s intent when interpreting a statute if the statute’s language is plain). At issue was also whether the ACPA would apply to domain names registered prior to the statute’s enactment in 1999. See *id.* at 582 (referring to the district court’s ruling that Weber’s re-registration was not within the scope of the ACPA because Weber registered “Schmidheiny.com” before Congress enacted the statute). The Third Circuit disagreed with the district court that the ACPA did not apply retroactively but circumvented the issue by finding that the defendant’s re-registration was bound by the ACPA. *Id.* Courts are now in agreement that the ACPA applies to domain names registered prior to the statute’s enactment. *Accord Sporty’s Farm v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 496–97 (2d Cir. 2000) (finding that the ACPA applies to domain names registered before the statute’s enactment).

⁴³ 801 F.3d at 777.

⁴⁴ *Id.* at 771.

⁴⁵ *Id.* at 771–72. Unlike the defendant in *Schmidheiny v. Weber*, the defendant in *Jysk Bed’N Linen* had originally registered the domain name in good faith on behalf of the plaintiff. Compare *Jysk Bed’N Linen*, 801 F.3d at 771–72 (authorizing defendant to register the “bydesignfurniture.com” domain name), with *Schmidheiny*, 319 F.3d at 581 (creating the domain name of a well-known celebrity for no reason other than to profit from the sale of the domain name). Thus, the question of whether the defendant was cybersquatting by re-registering the domain name, required the court to interpret “registers,” unlike the Third Circuit. See *Jysk Bed’N Linen*, 801 F.3d at 777 (reviewing the district court’s finding that re-registrations are “registrations” under the ACPA because the initial registration was in good faith); *Schmidheiny*, 319 F.3d at 581 (reaching the “re-registration” interpretation issue because the date of the initial registration of the domain name at issue predated the passage of the ACPA).

⁴⁶ See *Jysk Bed’N Linen*, 801 F.3d at 777 (“To ‘re-register’ is ‘[t]o register again.’”); *Re-register*, OXFORD ENGLISH DICTIONARY, https://www.oed.com/dictionary/re-register_v?tl=true [<https://perma.cc/RN59-VMPA>]. The court did not apply or consider any alternative definitions. See *Jysk Bed’N Linen*, 801 F.3d at 777. (quoting *Cox Enters., Inc v. Pension Benefit Guar. Corp.*, 666 F.3d 697, 704 (11th Cir. 2012)) (“When the language of a statute is plain and unambiguous, [the court] must apply that meaning.”).

Otherwise, the court reasoned, the ACPA would illogically permit cybersquatting—the very activity that the ACPA aims to eliminate—simply because the re-registration was for renewal rather than creation.⁴⁷

B. The Narrow Trail

In 2011, in *GoPets Ltd. v. Hise*, Edward Hise registered the domain name “gopets.com” for a college class.⁴⁸ Five years later, Erik Bethke, the creator of a company and videogame titled *GoPets*, trademarked the name and attempted to purchase the domain from Hise.⁴⁹ Hise relentlessly refused to sell the domain and ultimately re-registered it.⁵⁰ Bethke then filed a cybersquatting claim against Hise and moved for summary judgment, arguing that Hise’s re-registration of “gopets.com” was in bad faith.⁵¹ The district court granted

⁴⁷ See *Jysk Bed’N Linen*, 801 F.3d at 777–78 (pointing out that the purpose of the ACPA is to curtail cybersquatting, and that it would be “nonsensical” to read the statute in a way that permits cybersquatting).

⁴⁸ 657 F.3d 1024, 1026–27 (9th Cir. 2011). At the time of the Ninth Circuit’s decision, Hise—through his corporation Digital Overture—had registered over 1,300 domain names, including domain names such as “ehinges.com,” “ebenches.com,” “erivets.com,” “escones.com,” etc. *Id.* at 1027. Allegedly, Hise had registered the domain name with the intent to develop the website with his cousin, a veterinarian. *Id.* For around five and half years, however, there was no viewable content on the “gopets.com” webpage. See *id.* at 1028 (noting that records produced by a non-profit organization known as the “Internet Archive” indicated that there was no information appearing on the “gopets.com” site until after Bethke’s original inquiry into purchasing the domain name).

⁴⁹ *Id.* at 1027. When Bethke first sought to purchase the “gopets.com” domain name from Hise, Hise claimed that he was open to selling it to a “serious buyer” in an auction. *Id.* Bethke did not participate in the auction and, upon seeing that Hise was still listed as the registrant of the domain name, retorted to Hise that he “presumably . . . did not have any other serious offers” and offered \$750 for the domain name. *Id.* Months later, Hise refused the offer, to which Bethke responded by offering \$100 and informing Hise that he would be filing a UDRP claim with the WIPO. *Id.* Although the WIPO sided with Bethke, the WIPO could not force Hise to transfer “gopets.com” to Bethke. *Id.* at 1027–28. Following the WIPO claim, Bethke attempted to purchase the domain name from Hise again, offering \$5,000 and subsequently raising his offer to \$40,000. *Id.*

⁵⁰ *Id.* at 1027–28. Hise demanded \$5 million for the domain name and threatened to send a letter to GoPets’ investors detailing the shortcomings of GoPets’ then-existing domain name “gopetslive.com.” *Id.* Hise also threatened to add “metatags” to the “gopets.com” code, which would redirect internet users trying to reach the “gopetslive.com” site to Hise’s site. *Id.* Hise then registered multiple domain names similar to “gopets.com,” including gopetssite.com, goingpets.com, gopet.biz, gopet.org, egopets.com, gopets.bz, gopets.ws, gopet.tv, gopet.ws, gopet.bz, gopet.de, gopet.eu, and gopet.name, mygopets.com, and igopets.com. *Id.* at 1028–29. Currently, typing and entering “gopets.com” into a Safari or Google Chrome browser will take the searcher to a website “dedicated to all pets, whether furry, feathery, or scaly,” with pictures of animals and a storefront for various pet products. *Gopets.com*, <https://gopets.com/?v=ps> [<https://perma.cc/NH34-KQVR>]. On the contrary, typing and entering “gopetslive.com” into a Safari or Google Chrome browser will take the searcher to what appears to be Vietnamese gambling site “Sunwin . . . the number [one] reputable redemption card game portal in Asia.” *Sunwin - game bài đổi thưởng số 1 châu á*, <https://gopetslive.com> [<https://perma.cc/3XMF-6G9J>].

⁵¹ *GoPets Ltd.*, 657 F.3d at 1029–30. GoPets conceded that Hise’s initial registration of the “gopets.com” domain name in 1999 was not a bad-faith registration under the ACPA, thus requiring the Ninth Circuit to interpret whether “registers” entails re-registrations such as Hise’s. *Id.* GoPets also

Bethke's motion, and Hise appealed to the United States Court of Appeals for the Ninth Circuit.⁵²

On appeal, the Ninth Circuit first addressed the meaning of "registers," noting that registrants may engage in a range of actions that qualify as a "re-registrations"—from renewal to merely updating billing information.⁵³ Accordingly, the court found that "registers" was ambiguous and interpreted it against the backdrop of Congress's intent behind the ACPA.⁵⁴ The Ninth Circuit then resorted to real property law to guide its analysis.⁵⁵ It reasoned that including re-registrations under the ACPA would render certain domain names inalienable, contravening a major tenet of traditional property law: that property owners may freely sell or transfer their property rights.⁵⁶ Thus, because Congress could not have intended for domain names to be uniquely inalienable, the Ninth Circuit reversed the district court's summary judgment grant and held that "registers" applies exclusively to initial registrations.⁵⁷

moved for summary judgement with respect to its cybersquatting claims for Hise's gopets.com formative domain name registrations. *See id.* at 1030 (arguing that Hise's various "gopets" registrations using different top-level domains violated the ACPA).

⁵² *Id.* at 1029. The district court similarly granted GoPets' motion for summary judgement regarding Hise's registration of "gopets.com formative" domain names under the ACPA. *Id.* at 1031–33.

⁵³ *See id.* at 1030–31 (listing the various actions that could be taken by a registrant that could conceivably be cabined under "registrations," including but not limited to updating registrant's contact or billing information, switching to a "private" registration wherein another's name replaces the name of the registrant in public databases, registering the domain name with a different registrar, renewing the domain name prior to its expiration, etc.).

⁵⁴ *See id.* at 1031 (discussing Congress's motivations after noting that the language within the ACPA does not clarify explicitly whether re-registrations are bound by the ACPA).

⁵⁵ *See id.* at 1031–32 (finding only that the Third Circuit "erred in assuming" that the ACPA did not apply to defendant Weber's initial domain name registration) After determining that the meaning of "registers" was vague, the Ninth Circuit dismissed the Third Circuit's concerns that the ACPA did not apply retroactively but did not address its statutory interpretation of "registers." *See id.* at 1031 (failing to respond to the Third Circuit's interpretation of registers); *Schmidheiny v. Weber*, 319 F.3d 581, 582–83 (3d. Cir. 2003) (reasoning that the lack of limiting language surrounding the word "registers" and the insertion of a safe-harbor exception in the statute signal that Congress contemplated an exception for re-registrations and opted not to include one). Moreover, the Ninth Circuit omits from its decision the Third Circuit's contrary finding that the meaning of "registers" is unambiguous. *See GoPets Ltd.*, 657 F.3d at 1030 (noting only that "the text . . . considered in isolation does not answer the question of whether "registration" includes re-registration"); *Schmidheiny*, 319 F.3d at 582 (finding that registration has a "plain meaning" that is not limited to original registrations of domain names).

⁵⁶ *See GoPets Ltd.*, 657 F.3d at 1032 (reasoning that under a broad construal of "registers," Hise could have owned the "gopets.com" domain name indefinitely because he initially registered it in good faith, but would not have been able to sell, transfer, or gift the domain name). The Ninth Circuit does not enlighten the reader as to its retreat to real property law principles. *See id.* (failing to liken domain name alienation to real property alienation).

⁵⁷ *See id.* at 1032, 1035 ("Nothing in the text or structure of the statute indicates that Congress intended that rights in domain names should be inalienable."). The Ninth Circuit does not point to any examples of language or structure that *would* indicate that Congress meant to limit alienability of domain names. *See id.* (failing to propose an alternative reading of the statute that comports with a broad definition of "registers"). The Ninth Circuit affirmed the district court's ruling with respect to

C. The Fourth Circuit's Path

By the time *Prudential* reached the Fourth Circuit, the growing split between the Third, Ninth, and Eleventh Circuits was well established.⁵⁸ In 2023, the Fourth Circuit held that SSN's re-registration of "PRU.com" constituted cybersquatting under the ACPA.⁵⁹ Like the Eleventh Circuit, the court cited the conventional definition of "registers," concluding that the term necessarily encompasses all registrations regardless of their nature.⁶⁰ The court also aligned itself with the Third Circuit in finding the absence of limiting language—such as "initial" or "original"—to be significant.⁶¹

In response to SSN's reliance on the Ninth Circuit's exclusion of re-registrations from the ACPA, the Fourth Circuit emphasized that a narrow interpretation of "registers" fails to address cybersquatting and contradicts the Act's purpose.⁶² The court posited that, under the Ninth Circuit's reasoning, an employer would be unable to bring a claim against a former employee-

the additional gopets.com-formative domain names because there was "ample evidence in the record on which to base a finding of bad faith." *Id.* at 1033.

⁵⁸ See *Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd.*, 58 F.4th 786, 797 (4th Cir. 2023) (highlighting each Circuit court's interpretation of "registers").

⁵⁹ See *id.* at 797, 806 (finding that SSN had acted with bad faith in re-registering the "PRU.com" domain, as nearly all the factors demonstrating a defendant's bad-faith intent to profit under the ACPA were undertaken by SSN).

⁶⁰ See *id.* at 796 (citing to the *Merriam-Webster Dictionary* definitions of "registration" and "re-registration" to ascertain their "ordinary" meanings); *Registration*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/registration> [<https://perma.cc/LU9W-Z9N4>]; *Re-register*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/re-register> [<https://perma.cc/3EM8-FN7X>].

⁶¹ See *Prudential*, 58 F.4th at 794–96 ("[T]he ACPA does not expressly limit the term registers to only the initial or creation registration."); see *Schmidheiny v. Weber*, 319 F.3d 581, 582–83 (3d Cir. 2003) (noting the statute lacks modifiers on the word "registers," such as "initial" or "creation" and that where exceptions are present in a statute, the court ought to infer that "Congress considered the issue of exceptions and limited the exceptions to the ones set forth") (citing *United States v. Johnson*, 529 U.S. 53, 58 (2000)).

⁶² See *Prudential*, 58 F.4th at 796–97 ("[I]t would be 'nonsensical' not to include re-registrations within the purview of the ACPA as it would allow for 'the exact behavior that Congress sought to prevent.'" (quoting *Jysk Bed'N Linen v. Dutta-Roy*, 801 F.3d 767, 778 (11th Cir. 2015))). The Fourth Circuit postulates that the Ninth Circuit was concerned about expanding liability under the ACPA to minor, good-faith registrations. See *id.* at 797 (agreeing with the district court's assessment of the Ninth Circuit's public policy concerns, albeit not expressed by the Ninth Circuit in its decision). The Fourth Circuit likely articulated this concern because the Ninth Circuit failed to cite in its decision Congress's purpose in enacting the ACPA: preventing cybersquatting. See *id.* at 796–97 (discussing the purpose of the ACPA and how the Ninth Circuit's decision directly opposes the ACPA's aims, but leaving out any counterargument from the Ninth Circuit that explains how a narrow reading of "registers" furthers the ACPA's goals of eliminating cybersquatting); *GoPets*, 657 F.3d at 1029–32 (failing to describe the way in which a narrow interpretation of "registers" helps curtail cybersquatting). Thus, implied within the Fourth Circuit's opinion is that the Ninth Circuit had a concern outside of eliminating cybersquatting. See *Prudential*, 58 F.4th at 796–97 (observing after its discussion of congressional intent underlying the ACPA that the Ninth Circuit's unspoken concerns about holding "innocent persons" accountable under the ACPA are effectively countered by the statute's bad faith requirement).

registrant who, in an attempt to extort his former employer, re-registers the employer's domain name.⁶³ This extortion is precisely what Congress envisioned when enacting the ACPA; a narrow reading of "registers" would permit the former employee—a bad-faith actor—to hold the employer's domain name hostage indefinitely.⁶⁴ Thus, although sympathetic to the Ninth Circuit's concerns about alienability, the Fourth Circuit reasoned that a broad interpretation preserves registrants' rights to sell and transfer domain names, so long as such actions are not rooted in bad faith.⁶⁵

III. REINING IN DOMAIN NAME OUTLAWS REQUIRES EXPANDING "REGISTERS" UNDER THE ACPA

The Supreme Court and several other circuit courts have yet to deliberate over the scope of the term "registers" under the ACPA.⁶⁶ With cybersquatting on the rise and the nascent consensus between the Third, Fourth, and Eleventh Circuits, courts lacking binding authority on the issue should follow the majority because (1) the plain meaning of "registers" includes re-registrations, and (2) the Ninth Circuit overly appealed to real property law to support its decision, ignoring other alternative legal frameworks—such as contract law—that support a broad construction of the term "registers."⁶⁷

⁶³ *Prudential*, 58 F.4th at 797. The Fourth Circuit based its "hypothetical" on *Xereas v. Heiss*, wherein an employee was removed from his managerial role and, unbeknownst to him, was removed as the registrant of a domain name he initially had registered. *See id.* (citing *Xereas v. Heiss*, 933 F. Supp. 2d 1, 5 (D.D.C. 2013)).

⁶⁴ *See Prudential*, 58 F.4th at 796–97 (reasoning that re-registrations must be contained within the ACPA as to avoid undesirable outcomes); *Xereas*, 933 F. Supp. 2d at 5 (noting defendant's argument that the ACPA did not apply to them because it was the plaintiff, not defendants, who had initially registered the domain name and that a lawful transfer of the domain name had taken place); S. REP. NO. 106-140, at 5 (1999) (observing that some individuals register domain names as ransom, "who find their trademarks 'locked up' and are forced to pay for the right to engage in electronic commerce under their own brand name").

⁶⁵ *See Prudential*, 58 F.4th at 797 ("Cybersquatting is, by definition, a *bad faith* registration of another's trademark in a domain name."); *see also* 15 U.S.C. § 1125(d)(1)(B)(ii) (excluding from liability registrants who had reasonable grounds to believe that registration was fair or lawful).

⁶⁶ *See, e.g., Xereas*, 933 F. Supp. 2d at 5 (endorsing the broad interpretation of "registers" within the D.C. Circuit without guidance from the Supreme Court of the United States); *We the Protesters, Inc. v. Sinyangwe*, 2024 WL 1195417, *11 (S.D.N.Y. Mar. 20, 2024) (noting that the Second Circuit has not yet provided its interpretation of "registers" under the ACPA, but nevertheless endorses the broad construal of "registers"); *WorkForce Software, LLC v. Workforce.com, Inc.*, 2021 WL 4963608, *8–9 (N.D. Ill. Oct. 26, 2021) (adopting the Third and Eleventh Circuit's broad construal of "registers" despite lacking guidance from the Seventh Circuit); *Instructure, Inc. v. Canvas Techs., Inc.*, 2022 WL 43829, *16–17 (D. Utah Jan. 5, 2022) (interpreting the definition of "registers" within the meaning of the ACPA without Tenth Circuit precedent); *Villareal v. Saenz*, 2021 U.S. Dist. LEXIS 94183, *26–27 (W.D. Tex. 2021) (denying motion to dismiss ACPA claim where the Fifth Circuit has not interpreted the ACPA and at least one court has found that re-registrations are not encompassed by the statute).

⁶⁷ *See infra* notes 68–80 and accompanying text.

The definition of “registers” that most closely aligns with the meaning of initial registrations in the ACPA is to “make sure or secure official entry in a registration.”⁶⁸ Adding the prefix “re” in front of a word—especially with a hyphen—indicates that the actor is repeating the same action once more.⁶⁹ When a registrant takes any of several actions that alter the registration of an existing domain name, they effectively seek a new official entry regardless of whether a prior registration existed.⁷⁰ Thus, even without presuming that all re-registrations qualify as registrations solely by virtue of the prefix “re-,” the actions encompassed by “re-registers” fall comfortably within the plain meaning of “registers.”⁷¹

Furthermore, the Ninth Circuit’s statutory construction attributes undue weight to real property law.⁷² The court assumed—without justification—that conventional principles of real property apply to domain names.⁷³ Although this analogy may be convenient in limited contexts—such as illustrating digital scarcity or supporting *in rem* jurisdiction under the ACPA—it breaks down

⁶⁸ *Register*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/register> [<https://perma.cc/A3QB-TE8K>]; see S. REP. NO. 106-140, at 5–7 (1999) (discussing how cybersquatters register domains names to pose as reputable businesses and exploit rightsholders, implying that such a registration must be legitimately official or secure to threaten businesses and trademark owners). Ensuring that the meaning of “registers” and “re-registrations” is adequate in the context of initial registrations ensures that courts, at the outset, analyze “re-registrations” from the best understanding of Congress’s intent. See *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030 (9th Cir. 2011) (finding it “obvious” that “any reasonable” definition of “registers” would place initial registrations under the ACPA). Within some definitions of “registers,” it could be argued that even initial registrations are not “registrations,” because they have some defects in accuracy. See *Registers*, OXFORD ENGLISH DICTIONARY, https://www.oed.com/dictionary/register_v?tab=meaning_and_use [<https://perma.cc/T5QC-E5RG>] (“To record; to set down (facts, names, etc.) in writing, *esp. accurately or officially*.”) (emphasis added).

⁶⁹ Michael Quinton, *Re-*, AFFIXES (2008), <https://www.affixes.org/alpha/r/re-.html> [<https://perma.cc/ZLK8-KLHX>]. Circuit courts interpreting the term “registers” have never contested characterizing a subsequent registration as a re-registration. See *Schmidheiny v. Weber*, 319 F.3d 581, 583 (3d Cir. 2003) (interpreting whether “re-registrations” are “registrations”); *GoPets Ltd.*, 657 F.3d at 1031 (same); *Jysk Bed’N Linen v. Dutta-Roy*, 801 F.3d 767, 777 (11th Cir. 2015) (same).

⁷⁰ *Register*, *supra* note 68; see *GoPets Ltd.*, 657 F.3d at 1030–31 (listing the various actions that may be classified as “re-registrations”).

⁷¹ See *GoPets Ltd.*, 657 F.3d at 1030–31 (finding that “re-registrations” are not “registrations” under the ACPA). Specifically, the examples of “registrations” offered by the Ninth Circuit, such as altering existing billing or contact details, switching to “private” registration, transferring the registration to another, are actions that, again, “make sure or secure official entry in a registration,” or in other words, are “re-registering.” *Register*, *supra* note 68; see *GoPets Ltd.*, 657 F.3d at 1030–31 (enumerating various examples of actions that could conceivably be “registrations,” all of which involve verifying information with the registry to secure the domain name for continued use).

⁷² See *GoPets Ltd.*, 657 F.3d at 1031–32 (reviewing the statutory language of the ACPA in the context of real property law without rationalizing its decision to do so and sidestepping an analysis involving Congress’s intent underlying the statute itself).

⁷³ See *id.* (failing to justify its application of a general principle—that real property ought to be alienable—to domain name registration without first explaining how real property law applies).

upon closer scrutiny.⁷⁴ Unlike real property, domain names are limited in time, indestructible, and their value depends on their connection to intellectual property.⁷⁵ Thus, not all real property principles are applicable to domain names.⁷⁶

By fixating on alienability, the Ninth Circuit overlooked a more fitting legal framework: contract law.⁷⁷ For example, domain registries, managed by registrars, contract with domain registrants to provide the service of domain name use, typically subject to renewal.⁷⁸ Indeed, the implied covenant of good faith and fair dealing complements the ACPA's purpose in eliminating cyber-squatting a registrant acts in bad faith when registering a domain name, the

⁷⁴ See Anastasiia Chuvaieva, *Non-Fungible Tokens and Failed Promises of Simple Virtual Ownership*, 12 N.Y.U. J. INTELL. PROP. & ENT. L. 304, 326 (2023) (explaining that use of digital property, like real property, is exclusive and scarce in the context of domain names, given that only one person can register and host a website using one domain name where only a finite number of domain names available); Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd., 58 F.4th 786, 796 (4th Cir. 2023) ("By including the opportunity to pursue an in rem cause of action within the ACPA, Congress considered domain name holders to have a property-like interest in their domain names."). Creating a cause of action *in rem* gives the courts the ability to "adjudicate the rights to a given piece of property, including the Power to seize and hold it." *Jurisdiction*, BLACK'S LAW DICTIONARY (12th ed. 2024).

⁷⁵ Compare *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/7WXS-FEHA>] (explaining how domain names cannot be cancelled and that unless a domain name is renewed, it may only be used for registration period until it expires and returns to the registry), with 2 DAVID A. THOMAS, THOMPSON ON REAL PROPERTY § 17.02 (3d ed. 2024) (discussing characteristics of fee simple ownership as "absolute" and "indefinite," and that fee simple estates holders are not "beholden to any person except to the extent that the sovereign has not limited such right of use"). Whereas real property retains inherent economic value based on its distinctive physical characteristics and its suitability for different land uses, domain names are valuable insofar as they correspond with branding elements, such as trademarks or formative marks, and attract internet traffic to the website. See MCCARTHY, *supra* note 2, § 25A:13 (discussing the demand for memorable domain names, ones which consumers will associate with a business's brand or trademark).

⁷⁶ Compare MCCARTHY, *supra* note 2, § 25A:10 (characterizing domain names as a means to identifying a particular website on the internet and generally navigating the internet), with Jean Folger, *What Is Real Property? Definition and Types of Properties*, INVESTOPEDIA (May 13, 2024), <https://www.investopedia.com/terms/r/real-property.asp> [<https://perma.cc/R3SH-6A7N>] (listing the various purposes of real property, such as residential, commercial, agricultural, and industrial purposes). Moreover, in judicial proceedings, domain names are not fully treated as property. See MCCARTHY, *supra* note 2, § 25A:11 (observing differences between domain names and real property, such as the fact that domain names do not function as "chattels" in tort trespass claims and ambiguity as to whether a debtor's domain name is a property a court may seize and garnish in order to pay a defaulted debt).

⁷⁷ See *Jysk Bed N' Linen v. Dutta-Roy*, 810 F.3d 767, 777 (11th Cir. 2015) (pointing out that the Ninth Circuit relied on property law instead of contract law, unlike the Third Circuit).

⁷⁸ See MCCARTHY, *supra* note 2, § 25A:13 (describing process by which a registrant registers a domain name with a registrar); see also *FAQs for Registrants: Domain Name Renewals and Expiration*, *supra* note 76 (noting that terms and options for registrations agreements vary by registrar); Nicholas Foss Barbantonis, *Is Domain Name Classification a Property Right or a Contractual Right? The Circuit Split and a Clear Path*, 6 WAKE FOREST L. REV. 1, 13 (2016) ("[T]he registrar always retains the right to cancel the registration if the registrant breaches the agreement.").

registrar may cancel the registration for breach of contract.⁷⁹ Considering a domain name as a contractual right enables one to conceptualize a re-registration as a new contract between the registrant and registrar—qualifying as a “registration” under the ACPA.⁸⁰

CONCLUSION

In 2023, in *Prudential Insurance Co. of America v. Shenzhen Stone Network Information Ltd.*, the United States Court of Appeals for the Fourth Circuit joined the Third and Eleventh Circuits in adopting a broad interpretation of “registers” under the Anti-Cybersquatting Protection Act, holding that re-registrations using another’s registered trademark can give rise to liability. In doing so, the Fourth Circuit further placed the Ninth Circuit’s exclusion of “re-registrations” under the ACPA in the minority of approaches. Indeed, a narrow construal of “registers” negates Congress’s purpose for enacting the ACPA: to eliminate cybersquatting. Moreover, the conventional definition of “registers” encompasses the various forms of re-registrations that must occur for a registrant to maintain control continuously over a domain name. By analyzing domain name ownership as a contract right instead of a tangible property right, courts may subject re-registrations to liability under the ACPA and, as a result, safeguard the integrity of online commercial spaces, eliminate consumer confusion, and protect brand identity.

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⁷⁹ See RESTATEMENT (SECOND) OF CONTRACTS, § 205 (AM. L. INST. 1981) (exploring different contextual meanings of “good faith,” including “faithfulness to an agreed common purpose and consistency with the justified expectations of the other part” and excluding “bad faith,” “violate[s] community standards of decency, fairness, or reasonableness.”); see also 15 U.S.C. § 1125(d)(1)(B)(ii) (permitting conduct that one believed and had reason to believe was “fair use or otherwise lawful” while expressly prohibiting bad-faith registrations of domain names).

⁸⁰ See *Schmidheiny v. Weber*, 319 F.3d 581, 582 (3d Cir. 2003) (holding that “‘registration’ includes a new contract at a different registrar and to a different registrant”).