



Report: Substituted Service of Process by Electronic Mail

*Achieving Notice on Fictitious Owners of Commercial Websites for
Access to Judicial Remedies*

The Whois Subcommittee of the Internet Committee of the International Trademark Association

11 November 2009

This Report is the work of the Whois Subcommittee, issued for the purposes of information and of discussion with other stakeholders. It does not represent an official policy position of INTA. The subcommittee (known as the Domain Disputes, Ownership, and Whois Subcommittee, effective 2010) welcomes comments and input on the preliminary recommendations contained in this report and on methods of implementation, in order that further policy recommendations may be considered. Please e-mail eservicereport@inta.org.

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I. Introduction

Trademark owners support the expansion of the Internet as a marketplace for electronic commerce and the use of Internet websites for the advertising and sale of goods and services (hereafter, "commercial websites"). However, in addition to electronic commerce, the growth in commercial websites has given rise to widespread trademark infringement, trademark counterfeiting and consumer fraud.

In response, trademark owners strive to maintain the public's confidence in the quality of the goods and services that members of the public receive, to protect consumers from confusion, and to take appropriate measures to protect their trademarks in accordance with national laws. These appropriate measures depend on trademark owners' ability to institute legal action swiftly to prevent the abuse of intellectual property, Internet fraud, and other schemes that confuse and deceive Internet consumers. This, in turn depends, in many jurisdictions, on the ability to serve judicial documents providing notice of the proceeding on the defendants.

The importance of a reliable mechanism for the service of judicial and extrajudicial documents has been internationally recognized in the Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters, Nov. 15, 1965, 20 U.S.T. 361, T.I.A.S. No. 6638 (the "Hague Convention").

Active commercial websites owned by people and entities that conceal their identity and whereabouts by providing false information (often with the exception of a valid e-mail address), and/or by using proxy services that shield such information from public disclosure (hereafter, "fictitiously owned commercial websites") threaten the ability to serve judicial documents swiftly (and therefore to institute legal action swiftly, if at all). Therefore, the prevalence of fictitiously owned commercial websites has resulted in increased abuses of intellectual property, online fraud and other illegal schemes, resulting in decreased consumer confidence in the stability and security of the Internet marketplace.

A physical address for service is commensurate with commerce through physical locations, and many national laws require people and entities advertising and selling goods and services to register a name and physical address for accepting service of process in actions arising out of such commercial activity. However, when operators of a commercial website have not complied with such registration laws, electronic mail is a reasonable way of providing them actual notice of disputes arising out of their electronic commerce. In fact, courts considering the issue under present laws often permit substituted service of process via e-mail, but only after prolonged futile efforts to discover the location of the real website owner and to serve process at purported but ultimately fictitious addresses.

Therefore, this report considers the prospects for streamlining the process necessary before an aggrieved party may undertake substituted service of process on the hidden owner of a commercial web site by electronic mail. The subcommittee

proposes that legislative and treaty amendments should provide that in a civil action arising out of the advertising or sale of goods and services via a fictitiously owned commercial website, service of process by electronic mail on the e-mail address provided in the Whois record associated with the domain name for that website shall be effective against the named registrant without the need for a court order allowing for substituted service.

Naturally, such a proposal must live within the due process principle embedded in many national laws and constitutional precedent, that where a defendant whose rights will be adjudicated in court can reasonably be located, the plaintiff or the tribunal must take efforts reasonably calculated to achieve actual notice. Therefore, the proposal may apply only in the case of a “fictitiously owned commercial website.”

Registration of a domain name to an existing individual or legal entity under an assumed or fictitious trade name does not result in “fictitious ownership” if the name and location of the real or beneficial owner is ascertainable by reasonable effort. This might include situations where the fictitious name is recorded, as required by law, in the jurisdiction where the individual or entity is ostensibly located, or where there is an efficacious process for obtaining the name and location of the real owner (or “Licensee,” in the terms of ICANN Registrar Accreditation Agreement) from the domain’s proxy registration service. Thus, a domain name is not “fictitiously owned” if the corresponding website discloses the true ownership or information from which such ownership can reasonably be discovered. In such cases where the real party can be located, service must be effected through traditional means. A domain name is “fictitiously owned” for purpose of this request only if concealment of its true ownership is a direct result and necessary consequence of false or incomplete information.

While the plaintiff need not attempt a futile service of process, it should be prepared to demonstrate that futility—i.e. that the defendant’s true identity and location, however remote, could not have been ascertained through reasonable effort. The benefit of such a proposal would lie in relieving the plaintiff from attempting service futilely, or requesting permission from the court to make substituted service by e-mail. This could result in a savings of thousands of dollars and multiple weeks.

Furthermore, such a proposal should not create personal or subject matter jurisdiction where minimum contacts or other requisite elements of jurisdiction do not otherwise exist. Any legislative or treaty amendments would relate only to the conditions under which electronic service of process may be used, where the defendant has voluntarily engaged in conduct sufficient to invoke jurisdiction under the particular facts. Nevertheless, there are many cases in which, despite the difficulty of identifying the defendant, the court will be comfortable exercising personal jurisdiction over the website owner because the website’s activities intentionally aim to offer goods or services to, or to defraud citizens of the forum.

II. Origins and Conduct of this Analysis

Consideration of the need for measures to facilitate the electronic service of process in the case of anonymous and evasive Internet defendants began several years

ago in the INTA Anti-Counterfeiting & Enforcement Committee (ACEC), in the course of their investigation into measures to combat counterfeiting on the Internet. In 2007, the ACEC contacted the INTA Internet Committee leadership for its input on various policy proposals under consideration. The Internet Committee responded with the suggestion that national laws could be amended to allow for service of process through the contact points found in the Whois database. The ACEC accepted this recommendation which was included in its report to the Board in May of 2008.

In mid 2008, the proposal contained in the ACEC's report was referred to the Whois Subcommittee of the Internet Committee for further consideration. The subcommittee began work on the issue, and in January 2009, the Electronic Service Working Group was formed from members of the Whois Subcommittee, with additional members from the Courts and Tribunals Subcommittee of the INTA Enforcement Committee. The Working Group set about to research and identify the underlying problem of barriers to judicial relief created by the inability to serve unidentified website owners, with the hope of formulating a recommendation for appropriate advocacy to address the problem. Members of the Working Group included:

- Bruce A. McDonald*, Washington, D.C., Working Group Leader
- Adam Lindquist Scoville*, Denver, CO, Whois Subcommittee Chair
- Katja Grabienski*, Cologne, Germany
- Nathan J. Hole*, Chicago, IL
- Eric Macramalla*, Ottawa, Ontario
- Gregory A. Madera^, Boston, MA
- Fabrizio Miazzetto^, Alicante, Spain
- Aarón Montero^, San José, Costa Rica
- Mitchell Stabbe*, Washington, D.C.
- Katherine Treiber^, San Francisco, CA
- Tim Walden*, Hamilton, New Zealand
- Joi White*, Palo Alto, CA

* Member of the Whois Subcommittee

^ Member of the Courts & Tribunals Subcommittee

In September of 2009, the subcommittee's proposal was presented to the INTA Policy Development & Advocacy Executive Council and the INTA Board of Directors Executive Committee. Although in general the proposal was favorably received, it was decided that three key questions needed to be addressed prior to INTA taking a position on the issue:

1) Should the recommendation be limited to trademark infringement and cybersquatting cases? (To be clear, the Working Group and the Whois Subcommittee do not, in this report, recommend such a limitation because the recommendation is already limited in several ways discussed herein. Further, limiting it to trademark cases would provide preferential treatment for trademark owners without a compelling policy basis for doing so, although the exercise of restraint is admirable.)

2) What effect would the proposal have on non-trademark claims involving fictitiously owned commercial web sites?

3) Would other legal organizations and stakeholders support and/or have changes to the proposal?

III. Next Steps

- a) Following the presentation of the report to INTA's Board of Directors in November, the Whois Subcommittee (and its successor, the Domain Disputes, Ownership & Whois Subcommittee, during the 2010-2011 term) and the Working Group will embark on further discussion of the issue and consideration of potential solutions—including but not limited to those discussed in this Report—with other relevant INTA committees and with other relevant organizations, associations, and stakeholders.

The Whois Subcommittee and the Working Group have received overtures from other associations for a number of months requesting that they be provided with an opportunity to discuss possible co-sponsorship of the legislative and treaty amendments recommended in this report. Publication of this report will facilitate those discussions and provide a solid starting place for further consideration of the issue.

IV. Background - The Problem of Service in Cases of Fictitiously Owned Commercial Websites

A. Whois

The Internet Corporation for Assigned Names and Numbers ("ICANN"), which administers the Internet Domain Name System (DNS), requires generic Top-Level Domain (gTLD) registries and registrars to provide an interactive "Whois" service providing free public query-based access to up-to-date contact information for the owners of domain name registrations.¹ The Whois database has no single location, but exists as a distributed compilation of electronic information collected and reported by registrars for the domain registrations they sponsor. To engage in domain name registration services, registrars are required to enter into Registration Accreditation Agreements with ICANN that obligate them to ensure accurate and current contact data in the "Whois" database for Internet domain names registered by them.² However, ICANN is unable to enforce this requirement due to the exponential growth of Internet domain names registered to fictitious and pseudonymous entities and used for the advertising or sale of goods and services.

¹ See, e.g., Registrar Accreditation Agreement, May 21, 2009, available at <http://www.icann.org/en/registrars/ra-agreement-21may09-en.htm> (hereafter "RAA").

² See RAA, *supra* note 1, § 3.3.

B. Proliferation of Trademark Counterfeiting and Fraud in the Advertising and Sale of Goods and Services on the Internet

Consumer fraud on the Internet takes many forms, including “phishing,” “advance fee loan” fraud, false advertising, and the counterfeiting of trademarks and service marks. A common element is the fictitious ownership of the websites used for such activity. In many instances, the domains used for such websites are registered under fictitious identities, sometimes plausible or located at real addresses, sometimes patently false.

In addition, the growth of trademark counterfeiting and other forms of consumer fraud on the Internet has been fueled by the advent of “proxy” services offered by Internet domain name registration service providers. A recent study by ICANN and the National Opinion Research Center indicated that as many as a quarter of domain names may be registered using privacy or proxy services.³ When a member of the public attempts to ascertain the ownership of an Internet domain name registered to a proxy service, the most that can be identified is the name and address of an entity, usually the domain name registrar, that has, for a fee, agreed to shield the registrant’s identity and contact information.

C. Proxy Services

By means of proxy services, domain name owners are able to conceal all data about their ownership of a particular domain name until such disclosure is ordered by a court or arbitration panel, or the proxy receives evidence of actionable harm involving that particular domain name.⁴ While they have legitimate purposes, proxy services are also used to conceal the ownership of domain names registered and used in commerce on a large scale. Even when a proxy service discloses the identity of the customer that is using the domain, it is not uncommon for the information possessed by the proxy service itself to be fictitious.

D. The Viability of Notice via Electronic Mail

One common characteristic of domains registered using pseudonyms and fictitious contact information is that, while the name and contact address may be false, the e-mail address in the Whois database is often functional. The primary reason for this is that domain name registrars often validate the provided e-mail address before processing the domain registration.

The main obstacle in bringing legal action against the operator of a fictitiously owned website may be effecting service of process on the operator, insofar as, by definition, there can be no service of process on an unidentified defendant or on a

³ See Internet Corporation for Assigned Names and Numbers, ICANN’s Study on the Prevalence of Domain Names Registered using a Privacy or Proxy Service among the top 5 gTLDs (Sept. 28, 2009) available at <http://www.icann.org/en/compliance/reports/privacy-proxy-registration-services-study-28sep09-en.pdf>.

⁴ See RAA, *supra* note 1, § 3.7.7.3.

person, at an address, that does not exist. Against whom is the service of process effective? Courts have generally held that while a plaintiff is entitled to bring suit against a fictitious defendant, he must sufficiently identify the defendant to enable service of process that will allow the court action to proceed.⁵

V. Scope of Preliminary Recommendation

In order to facilitate trademark owners' ability to institute legal action swiftly to prevent the abuse of intellectual property, Internet fraud, and other schemes that confuse and deceive Internet consumers, legislative and treaty amendments should be considered to allow for substituted service of process by electronic mail as follows: In a civil action arising out of the advertising or sale of goods and services via a fictitiously owned commercial website, service of process by electronic mail on the e-mail address provided in the Whois record associated with the domain name for that website shall be effective against the named registrant without the need for a court order allowing for substituted service.

This preliminary recommendation attempts to adhere to existing precedent in respect to the identification and service of process on John Doe defendants, and has been carefully limited to actions arising out of the advertising and sale of goods and services, in order to avoid any issues relating to privacy, and to limit any freedom of speech issues by addressing primarily commercial speech. The legislative and treaty amendments advocated by this recommendation would not apply to any case in which the identity of the commercial website owner is reasonably discoverable. The recommendation comports with traditional notions of fair play and substantial justice because service would be effected through an address the domain owner has, by placing it in the Whois database, held out as a contact point for issues with the domain, in a situation where the ownership of the website has been effectively concealed, and service of process through other means cannot be effected.

The Working Group and the Whois Subcommittee also considered whether to restrict this recommendation to actions under trademark and unfair competition laws. However, if the unlawful conduct is correctly characterized as the fictitious ownership of commercial websites and resulting absence of transparency and accountability in the advertising and sale of goods and services on the Internet, and not just the trademark counterfeiting and intellectual property abuses for which fictitious websites are used, then victims of the unlawful conduct include not only brand owners, but also consumers and the public. Moreover, limiting the recommendation to trademark laws, even if intended as an exercise in discretion, has the effect of providing trademark owners preferential access to this procedural remedy. The Working Group and Whois Subcommittee decided against recommending such a limitation, in order that the

⁵ See, e.g., *Brooks v. Saucedo*, 85 F. Supp. 2d 1115, 1130 (D.Kan. 2000). "The court cannot order service of process on fictitious defendants." *Neumann v. Veal*, No. CIV S-07-0082 DFL CMK P, 2007 U.S. Dist. LEXIS 32062 (E.D. Cal. April 17, 2007).

application to other areas of law can properly be discussed with other stakeholders and experts, provided that the following limitations are nonetheless carefully observed.

A. Jurisdiction

The scope of any recommended statutory or treaty language providing for electronic service of process must be limited to avoid the creation of personal or subject matter jurisdiction where none exists. Nevertheless, there are many cases in which, despite the difficulty of identifying the defendant, the court will be comfortable exercising personal jurisdiction over the website owner because the website's activities are intentionally aimed at the forum, such as by offering goods or services to, or seeking to defraud citizens of the forum. Likewise, the website owner's demonstrated use of the e-mail address found in the Whois database or that originates the fraudulent communications at issue, and the fact that the address was held out as a means of contacting the domain owner, may in many cases satisfy the court that, failing the ability to identify and locate the true website owner, e-mailing the owner is reasonably calculated to achieve actual notice.

There is precedent for allowing service on a domain owner by the e-mail address found in the Whois database. Under the U.S. Anticybersquatting Consumer Protection Act ("ACPA"), a plaintiff may e-mail the summons to an anonymous e-mail address under certain circumstances as a means of obtaining *in rem* jurisdiction over the domain name itself.⁶ However, such service cannot invoke *personal* jurisdiction over a defendant unless it is known *upon whom* the process has been served. Similarly, ICANN's Uniform Domain Name Dispute Resolution Policy ("UDRP") for arbitrating commercial domain disputes provides for notice to the registrant by sending the complaint to the postal, facsimile, and e-mail addresses found in the Whois database (as well as other known contacts, and any e-mail address found at the home page of the web site).⁷

It is the subcommittee's recommendation that INTA not advocate the creation of personal or subject matter jurisdiction where minimum contacts or other requisite elements of jurisdiction do not otherwise exist under the facts. Any legislative or treaty amendments advocated by this proposal would relate only to the conditions under which electronic service of process may be used where the defendant has otherwise engaged in conduct sufficient to invoke jurisdiction under the particular facts. For purposes of jurisdiction, that conduct may take the form of consent.

B. Due Process Notice Requirements

Nevertheless, the proliferation of fictitiously owned commercial websites has given rise to a need for amendments to national laws, such as the civil procedure

⁶ 15 U.S.C. § 1125(d)(2)(B).

⁷ Internet Corporation for Assigned Names and Numbers, Rules for Uniform Domain Name Dispute Resolution Policy, (Oct. 24, 2009) available at <http://www.icann.org/en/dndr/udrp/uniform-rules.htm>.

codes, in the United States and other countries as a means of facilitating the service of process in cases arising from the advertising and sale of goods and services at commercial websites. Naturally, this proposal does not seek to disturb the due process principle embedded in many national laws and constitutional precedent, that where a defendant whose rights will be adjudicated in court can reasonably be located, the plaintiff or the tribunal must take efforts reasonably calculated to achieve actual notice. This is not a recommendation that national laws accommodate e-mail service in the first instance, but only in the case of a “fictitiously owned commercial website”—one that is registered pseudonymously, only if the pseudonymous registration prevents the public from ascertaining its true ownership. If limited in the manner proposed in this recommendation, such provisions should not raise any legitimate objections.

In the United States, the law has “long recognized that, in the case of persons missing or unknown, employment of an indirect and even a probably futile means of notification is all that the situation permits and creates no ...constitutional bar to a final decree foreclosing their rights.”⁸ Authorization for service of process by electronic mail has been routinely granted by U.S. and other courts where a defendant has attempted to evade service and is reasonably accessible only by e-mail.⁹ To obtain such

⁸ *Mullane v. Central Hanover Bank & Trust Co.*, 339 U.S. 306, 317 (1950) (allowing service by publication). *Accord*, *Rio Properties, Inc. v. Rio Int'l Interlink*, 284 F.3d 1007, 1016-17 (9th Cir. 2002) (applying the reasoning in *Mullane* to allow electronic service on “an elusive international defendant”); *Lidas, Inc. v. U.S.*, 238 F.3d 1076, 1084 (9th Cir. 2001) (applying *Mullane* in holding that IRS then met the standard to provide notice “reasonably calculated, under all the circumstances, to apprise the interested parties of the pendency of the action”). Other jurisdictions provide to similar effect. *See, e.g.*, the Australian *Federal Court Rules*, Order 7, Rule 9 (in relation to substituted service where “it is impractical to service a document in the manner set out in the Rules...”); UK *Civil Procedure Rules*, Rule 6.15 (“Where it appears to the court that there is a good reason to authorize service by a method or at a place not otherwise permitted by this Part, the court may make an order permitting service by an alternative method or at an alternative place.”). In Ireland, service by email is not generally regarded as possible under the Rules of the Superior Courts. However the courts have yet to rule definitely on this, and have not recently been afforded an opportunity to do so. Order 10 Rule 1 of the Rules of the Superior Courts does provide for substituted service of notice “by advertisement or otherwise” however that has not yet been used to allow service by email. English courts have on occasion allowed service by email in cases such as *Bernuth Lines Ltd v High Seas Shipping Ltd* [2005] EWHC 3020). Such variant systems in our view provide an effective shield to the individuals and entities who wish to avoid being served with process by IP rights holders.

⁹ *See, e.g.*, *Bank Julius Baer & Co. Ltd. v. Wikileaks*, C 08-00824 (JSW), 2008 U.S. Dist. LEXIS 14758 (N.D.Cal. Feb. 13, 2008); *BP Products North America, Inc. v. Dagra*, 236 F.R.D. 270 (E.D.Va. 2006); *D.R.I. Inc. v. Dennis*, 03 Civ. 10026 (PKL), 2004 U.S. Dist. LEXIS 22541 (S.D.N.Y. June 3, 2004); *D'Acquisto v. Triffo*, 05-C-0810, 2006 U.S. Dist. LEXIS 1225 (E.D.Wis., Jan. 5, 2006); *Hollow v. Hollow*, 193 Misc. 2d 691; 747 N.Y.S.2d 704 (Sup.Ct. 2002); *In re ILDK Solar Sec. Litig.*, C 07-5182 WHA, 2008 WL 2415186 (N.D. Cal. June 12, 2008); *Inc21.com Corp. v. Flora*, C 08-02967 WHA (N.D. Cal. Dec. 5, 2008); *In re International Telemedia Associates, Inc.*, 245 B.R. 713, 46 Fed.R.Serv.3d 188 (N.D.Ga. 2000); *Juniper Networks, Inc. v. Bahattab*, No. 07-1771 (PLF), 2008 U.S. Dist. LEXIS 6256 (Jan. 30, 2008); *Keller Williams Realty, Inc. v. Lapper*, No. 4:08-CV-1292, 2008 U.S. Dist. LEXIS 58079 (S.D.Tex., July 31, 2008); *MacLean-Fogg Co. v. Ningbo Fastlink Equipment Co., Ltd.*, 08 CV 2593, 2008 U.S. Dist. LEXIS 97241 (N.D.Ill., Dec. 1, 2008); *Nanya Tech. Corp. v. Fujitsu, Ltd.*, 2007 U.S. Dist. LEXIS 5754 (D. Guam. Jan. 2, 2007); *Navalmar (U.K.) Ltd. v. Welspun Gujarat Stahl Rohren, Ltd.*, 485 F. Supp. 2d 399 (S.D.N.Y. 2007); *Philip Morris USA Inc. v. Veles Ltd.*, 06 CV 2988 (GBD), 2007 U.S. Dist. LEXIS

authorization, however, parties are first required to attempt service by traditional means that are characteristically futile, expensive and time-consuming, and must then incur the time and expense of obtaining a court order allowing for substituted service by electronic mail.¹⁰ This is often preceded by seeking permission to engage in pre-service discovery on various Internet service providers in order to have diligently attempted to identify and locate the true owner of the domain. The process often requires the negotiation of time consuming, futile efforts and pointless procedural hurdles, during which time the harm to the plaintiff and public continues unabated.

This proposed recommendation is for legislative and treaty amendments to eliminate unnecessary requirements, expenses and difficulties, under circumstances that would otherwise warrant a court order authorizing substituted service of process by electronic mail. In the U.S., courts have allowed electronic service of process under these circumstances.¹¹

19780 (S.D.N.Y. March 12, 2007); *Popular Enterprises, LLC v. Webcom Media Group, Inc.*, 225 F.R.D. 560 (E.D.Tenn. 2004); *Rio Properties, Inc. v. Rio International Interlink*, 284 F.3d 1007 (9th Cir. 2002); *Shri Ram Chandra Mission v. Sahajmarg.org*, 139 F. Supp. 2d 721 (E.D.Val. 2001); *Snyder v. Alternate Energy Inc.*, 19 Misc. 3d 954, 857 N.Y.S.2d 442 (Civil Court of City of N.Y., April 4, 2008); *Tishman v. The Associated Press*, 05-4278, 2006 U.S. Dist. LEXIS 4622 (S.D.N.Y. Feb. 6, 2006); *Viz Communications, Inc. v. Redsun*, 2003 U.S. Dist. LEXIS 26104 (N.D. Cal. March 28, 2003); *Williams v. Advertising Sex LLC*, 231 F.R.D. 483 (N.D. W.Va. 2005); *Williams-Sonoma v. Friendfinder*, C 06-06572, 2007 WL 1140639 (N.D. Cal. Apr. 17, 2007). For other jurisdictions, see, e.g., *Equitrust Ltd v Bosiljevac* [2007] FCA 323 (Australia); *Bernuth Lines Ltd v High Seas Shipping Ltd* [2005] EWHC 3020 (in relation to arbitration where service was effected by email).

¹⁰ See *Brockmeyer v. May*, 383 F.3d 798, 806 (9th Cir. 2004) (holding that plaintiffs did not effect service properly where they failed to obtain court approval prior to serving via mail). There is also confusion and contention regarding the extent to which parties must engage in futile attempts to make service by alternative means before they are authorized to effect service by electronic mail. See, e.g., *Hi-Rise Technology Inc. v. amateurindex.com*, 07-cv-00349-MJK (W.D. Wash. June 27, 2007) (discussing split in authority under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), as to whether a court is required to order some form of publication before authorizing service by electronic mail or whether the publication requirement may be waived). *Compare Yahoo!, Inc. v. Yahooahtos.com*, 1:05cv1441 (JCC), 2006 U.S. Dist. LEXIS 54902 (E.D. Va. Aug. 8, 2006) (holding that publication of notice is discretionary and may be waived), with *Shri Ram Chandra Mission v. Sahajmarg.org*, 139 F. Supp. 2d 721, 723-24 (E.D. Va. 2001) (holding that publication of some form of notice is mandatory in an *in rem* proceeding under the ACPA).

¹¹ For example, in *Viz Communications, Inc. v. Redsun*, 2003 U.S. Dist. LEXIS 26104 (N.D. Cal. March 28, 2003), a magazine publisher brought a suit for trademark infringement against foreign website operators who incorporated the publisher's trademark in their website address. The court allowed the publisher to serve the website operators by e-mail because the publisher had attempted unsuccessfully to locate the website operators and because the e-mail address was the sole means of contact identified on the website. Those two criteria are encompassed in the present proposal. See also *RE/MAX International, Inc. v. Remax Financial*, Case No. 1:09-cv-00825 (N.D. Ill. Feb. 19 & Apr. 16, 2009) (granting, first, order for expedited discovery from telephone number providers, domain name registrar and host, and free e-mail account providers in order to identify John Doe defendants, and second, two months later, order for substituted service of process via e-mail).

For example, in the Hague Convention, an amendment to Article 5(b)¹² could provide that in any civil action against the ostensible registrant of a domain name corresponding to a fictitiously owned commercial website that arises out of the advertising or sale of goods or services at that site, registration of the e-mail address associated with the corresponding domain name shall constitute consent by the ostensible registrant to service of judicial and extra-judicial documents by electronic mail at that e-mail address.¹³

C. Existing Case Law Concerning John Doe Defendants

The Whois Subcommittee is not the first to consider the need for legislation allowing for the service of process on fictitious and evasive defendants.¹⁴ Possible amendments to Rule 4 of the Federal Rules of Civil Procedure for this purpose have been discussed.¹⁵

In the meantime, the challenges faced by trademark owners and consumers attempting to serve judicial and extrajudicial documents on fictitious website owners bear an important resemblance to issues considered by U.S. and other courts in the case of “John Doe” defendants.¹⁶ After filing a complaint against a fictitious defendant, the plaintiff is ordinarily permitted to amend the complaint to name and serve the identified defendant.¹⁷ Involuntary dismissal is proper only when it appears that the true

¹² Article 5 of the Hague Convention provides that “the Central Authority of the State addressed shall itself serve the document or shall arrange to have it served by an appropriate agency, either – (a) by a method prescribed by its internal law for the service of documents in domestic actions upon persons who are within its territory, or (b) by a particular method requested by the applicant, unless such a method is incompatible with the law of the State addressed.” Article 5(b) then states, “*the document may always be served by delivery to an addressee who accepts it voluntarily.*” *Id.* (emphasis added).

¹³ Similarly, Article 10(a) of the Hague Convention could be amended by inserting the phrase “including electronic mail,” to read: “Provided the State of destination does not object, the present Convention shall not interfere with – (a) . . . the freedom to send judicial documents, by postal channels, *including electronic mail*, directly to persons abroad[.]” (Emphasis added.) However, this resolution would not bind INTA to the endorsement of any particular legislative or treaty language.

¹⁴ Rice, “Meet John Doe: It is Time for Federal Civil Procedure to Recognize John Doe Parties,” 57 U. Pitt. L. Rev. 883 (1996); Vogel, “Unmasking ‘John Doe’ Defendants: the Case Against Excessive Hand-writing Over Legal Standards,” 83 Or. L. Rev. 795 (2004). The issue has also been considered in the international context. See Kotuby, “International Anonymity: The Hague Conventions on Service and Evidence and Their Applicability to Internet-Related Litigation,” 20 J.L. & Com. 103 (2000).

¹⁵ Colby, “You’ve Got Mail: The Modern Trend Towards Universal Electronic Service of Process,” 51 Buffalo L. Rev. 337 (2003).

¹⁶ See, e.g. the “John Doe” style order made by the Federal Court of Australia in a trade mark infringement case in *Tony Blain Pty Ltd (t/a Acme Merchandising) v Jamison* (1993) 41 FCR 414.

¹⁷ See *Maggette v. Dalsheim*, 709 F.2d 800, 803 (2d Cir. 1983).

identity of the defendant cannot be learned through discovery or the court's intervention.¹⁸

In some cases, courts have held that the naming of fictitious defendants is “not favored.”¹⁹ Courts have sometimes stated that the practice is prohibited by Rule 10(a) of the Federal Rules of Civil Procedure, which requires the plaintiff to include the names of the parties in the action.²⁰ The majority of decisions refusing to allow the naming of “John Doe” defendants may be distinguished, however, because the defendant is not only fictitious but is also *incapable of being identified* under the particular facts.

In the circumstances contemplated by this proposal, in contrast, the identity of the defendant is unknown prior to the filing of a complaint, but his or her actions are alleged with sufficient specificity that his or her identity is, in theory, *capable of being ascertained*. In such cases, courts have held that the plaintiff should be given an opportunity through expedited discovery to identify the unknown defendants unless it is clear that discovery would not uncover their identities, or that the complaint would be dismissed on other grounds.²¹ It has even been held that a district court may *sua sponte* issue an order directing revelation of facts necessary to determine the true name of a John Doe defendant.²²

¹⁸ See *Schiff v. Kennedy*, 691 F.2d 196, 198 (4th Cir. 1982).

¹⁹ See, e.g., *Ontiveros v. Arpaio*, No. CV 05-1776-PHX-DGC (VAM), 2005 U.S. Dist. LEXIS 23636 (D. Ariz. Oct. 13, 2005).

²⁰ See, e.g., *Gossett v. Stewart*, No. CV 08-2120-PHX-DGC (ECV), 2008 U.S. Dist. LEXIS 101836 (Dec. 8, 2008). Rule 10(a) provides, “Every pleading must have a caption with the court’s name, a title, a file number, and a Rule 7(a) designation. The title of the complaint must name all the parties; the title of other pleadings, after naming the first party on each side, may refer generally to other parties.” Fed.R.Civ.P. 10(a).

²¹ See *Estate of Rosenberg by Rosenberg v. Crandell*, 56 F.3d 35, 37 (8th Cir. 1995) (permitting a suit naming fictitious parties as defendants to go forward because the allegations in the complaint were “specific enough to permit the identity of the party to be ascertained after reasonable discovery”); *Maclin v. Paulson*, 627 F.2d 83, 87 (7th Cir. 1980) (approving of fictitious name pleadings until such time as the identity of the parties “can be learned through discovery or through the aid of the trial court”); accord, *Wakefield v. Thompson*, 177 F.3d 1160, 1163 (9th Cir. 1999); *Gillespie v. Civiletti*, 629 F.2d 637, 642 (9th Cir. 1980)); *Pember v. Schrivvo*, No. CV 05-1412-PHX-SMM (BPV), 2005 U.S. Dist. LEXIS 24971 (D. Ariz. Oct. 21, 2005); *Munz v. Parr*, 758 F.2d 1254 (8th Cir. 1985); *Duncan v. Duckworth*, 644 F.2d 653, 656 (7th Cir. 1981). The Federal Court of Australia has specific power under the *Federal Court Rules* to order identity discovery against any person. See *Federal Court Rules*, Order 15A, rule 3. This power has been exercised to assist intellectual property rights owners, particularly in copyright infringement cases. See, e.g., *Sony Music Entertainment (Aust) Ltd v University of Tasmania* (2003) 129 FCR 472.

²² *Bivens v. Six Unknown Named Agents of Fed. Bureau of Narcotics*, 403 U.S. 388, 390 n.2, (1971) (noting that the trial court had ordered the United States attorney to identify “those federal agents who it is indicated by the records of the United States Attorney participated in the . . . arrest of the [petitioner]”).

Mechanisms to assist in the identification of John Doe trademark infringers exist in other jurisdictions.²³ The leading U.S. case on the identification of John Doe trademark infringers is *Columbia Ins. Co. v. Seescandy.com*, 185 F.R.D. 573, 51 USPQ 2d 1130 (N.D. Cal. 1999). In *Seescandy.com*, the plaintiff moved for a temporary restraining order and order to show cause why a preliminary injunction should not issue. The court found that granting a temporary restraining order against the fictitious defendants would be futile because the plaintiff was not able to collect the information necessary to serve the complaint on the defendants. However, because the plaintiff made a sufficient showing to demonstrate that the individual defendants committed an unlawful act, the plaintiff was granted leave to make a filing with the court in respect to the process the court should consider ordering. Accordingly, the plaintiff's motion for a temporary restraining order was denied without prejudice.

In allowing the plaintiff to proceed with discovery aimed at identification of the John Doe defendants, the court in *Seescandy.com* articulated four criteria that a plaintiff must show in order to obtain pre-service discovery in an action against a fictitious defendant, holding that the plaintiff must:

- (1) identify the missing party with sufficient specificity such that the court can determine that defendant is a real person or entity who could be sued in federal court;
- (2) identify all previous steps taken to locate the elusive defendant;
- (3) establish to the court's satisfaction that plaintiff's suit against defendant could withstand a motion to dismiss; and
- (4) file a request for discovery with the court, along with a statement of reasons justifying the specific discovery requested as well as identification of a limited number of persons or entities on whom discovery process might be served and for which there is a reasonable likelihood that the discovery process will lead to identifying information about defendant that would make service of process possible.

See 185 F.R.D. at 578–80.

D. Privacy

The need for pre-service discovery in actions against John Doe defendants has arisen in recent years in cases involving allegations of illegal file sharing brought by copyright owners against fictitious and pseudonymous defendants, followed by the

²³ *E.g., Norwich Pharmacal v Commissioners of Customs and Excise* [1974] AC 133 (regarding the equitable jurisdiction of UK courts to order discovery to identify proper defendants to a proposed action) and Federal Court Rules Order 15A rule 3 (regarding the power of the Federal Court of Australia to order identity discovery).

service of subpoenas on the defendants' Internet service providers.²⁴ These cases raise difficult privacy issues. While the Whois Subcommittee has looked to such decisions for guidance, this proposal would not apply to such cases because it is limited to actions arising from the use of a website *actively advertising or selling goods or services* and where there are negligible privacy issues.

E. Non-Commercial Speech

The issue of electronic service also arises in defamation actions filed by corporations against fictitious and pseudonymous bloggers.²⁵ While the Whois Subcommittee has looked to these decisions for guidance, this proposal is limited to actions against the ostensible registrant of a fictitiously owned commercial website arising out of the advertising or sale of goods or services *at that website*, and would not apply to non-commercial speech, or representations about goods and services advertised or sold *at another website*. The proposal thereby avoids any possible restriction on the freedom of speech or the right to engage anonymously and pseudonymously in non-commercial speech.

F. Cases Arising from the Sale and Advertising of Goods and Services

As noted above, the Working Group considered whether this proposal should be limited to actions arising under the trademark laws. However, if a case over which the court has subject matter jurisdiction already exists under the facts, and the court has personal jurisdiction over the website operator, then there is no apparent reason why this method of service should be limited to causes of action arising under the trademark law. In addition, as discussed above, the Working Group believes that the discussion whether electronic service should appropriately extend to other causes may best be had with other stakeholders with expertise in those areas, and that limiting the proposal at this stage may give rise to the impression that INTA is advocating a unique procedure for trademark owners.

On the other hand, the Whois Subcommittee believes that significant issues can be avoided by limiting the treaty and legislative language that the subcommittee is proposing to causes of action arising from the use of an Internet website for the advertising or sale of goods or services. As discussed above, this limitation avoids any

²⁴ E.g., *Elektra Entertainment Group, Inc. v. Does 1-9*, No. 04 Civ. 2289 (RWS), 2004 U.S. Dist. LEXIS 23560, Copy. L. Rep. P 28,873 (S.D.N.Y. Sept. 7, 2004); see "Right of Corporation, Absent Specific Statutory Subpoena Power, to Disclosure of Identity of Anonymous or Pseudonymous Internet User," 120 A.L.R.5th 195.

²⁵ See Reder and O'Brien, "Corporate Cybersmear: Employers File John Doe Defamation Lawsuits Seeking the Identity of Anonymous Employee Internet Posters," 8 Mich. Telecomm. Tech. L. Rev. 195 (2001-2002); O'Brien, "Putting a Face to a (Screen) Name: the First Amendment Implications of Compelling ISPs to Reveal the Identities of Anonymous Internet Speakers in Online Defamation Cases," 70 Fordham L. Rev. 2745 (2002); Lee, "Anti-Employer Blogging: Employee Breach of the Duty of Loyalty and the Procedure for Allowing Discovery of a Blogger's Identity Before Service of Process is Effected," 2006 Duke L. & Tech. Rev. 2 (2006).

issue regarding the privacy of individuals and organizations and does not qualify or limit the ability of any person to use the Internet for anonymous communications protected by the rights to freedom of speech.

G. Purposeful and Unlawful Concealment

This proposal applies only the concealment of ownership information that prevents the public from discovering the origin and source of goods and services advertised or sold on the Internet. The proposal does not apply to cases where the identity of the party in interest or appropriate contact information can otherwise be ascertained, *e.g.*, at the website, at the state corporation office, at the local recorder of deeds, or any other source. If ownership of a website or appropriate contact data can be ascertained by *other* means, then it has not been “concealed,” and the website does not meet the definition of a fictitiously owned commercial website found in the proposal.

The concealment must also be unlawful to be within the scope of this proposal. For example, corporations are not required to identify their owners in filings with state corporation offices. However, corporations must designate an agent for service of process. The same is true for any person or business engaged in the sale and advertising of goods and services. The business and fictitious trade name laws of the United States²⁶ and other countries typically require vendors of goods and services to designate themselves or an agent for service of process in actions arising out of the advertising or sale of goods and services. In the United States, the surreptitious conduct of business via mail, wire, radio or television using a fictitious name to conceal one’s identity and location is an indictable offense.²⁷

²⁶ For example, Nevada law provides that “[E]very person doing business in this state under an assumed or fictitious name that is in any way different from the legal name of each person who owns an interest in the business must file with the county clerk of each county in which the business is being conducted a certificate containing the . . . real name and physical address of the person using the fictitious name. Nev. Rev. Stat. Ann. §§ 602.010, 602.020. The purpose of the requirement is “to inform the public of the true identity of those with whom they conduct business.” *Brad Assocs. v. Nevada Fed. Fin. Corp.*, 109 Nev. 145, 848 P.2d 1064, 1066 (1993). Similarly, Section 35-1(a) of the Connecticut Fictitious Name Statute, Conn. Gen. Stat. § 35-1(a), provides that failure to file a fictitious name certificate “shall be deemed to be an unfair or deceptive trade practices” under the Connecticut Deceptive Trade Practices Act, Conn. Gen. Stat. § 41-110b(a). Another example, Virginia Code § 59.1-69, prohibits entities from conducting business in the Commonwealth under an assumed or fictitious name unless the entity signs a certificate identifying the fictitious name. The purpose of this provision is to protect third parties against possible fraud and deceit. See *Tate v. Atlanta Oak Flooring Co.*, 179 Va. 365, 18 S.E.2d 903 (1942); *Bryant Elec. Co. v. Joe Rainero Tile Co.*, 84 F.R.D. 120, 123 (W.D.Va.1979) (“The purpose of this section is to prevent fraud and to compel an individual or a corporation to disclose the name of the real owner of the business, in order that the person or corporation may sue in or be sued by the proper name.”). Failure to comply with this provision is chargeable as a misdemeanor, the conviction of which is punishable by a fine up to \$2,500 or by incarceration not to exceed one year, or both. See Va. Code § 59.1-75.

²⁷ See, *e.g.*, *United States v. Frank*, 494 F.2d 145 (2d Cir. 1974); *United States v. Brockway*, Nos. 90-50064, 1991 U.S. App. LEXIS 8842 (9th Cir. May 3, 1991) (unpublished). The federal fictitious name statute provides, “Whoever, for the purpose of conducting, promoting, or carrying on by means of the Postal Service, any scheme or device [to defraud] or any other unlawful business, uses or

Thus, the proposal does not apply where ownership of a domain name has been concealed but ownership of the corresponding *website* (or accurate contact information for the website owner, such as an agent for service of process) is otherwise available. This limitation vitiates any issue regarding the right of an organization to shield the identity of its directors, shareholders or members by means of registration and identification of an agent for service of process pursuant to the corporation and fictitious trade name laws of the relevant jurisdiction.

H. Consent

This proposal contemplates service of process on an unidentified e-mail recipient without raising an issue about the identity of the entity on which process has been served. One reason that courts are likely to be comfortable with e-mail service as a means of achieving actual notice upon the defendant is that the defendant has voluntarily provided the e-mail address during registration of the domain name, as a means for third parties to contact the otherwise pseudonymous registrant concerning the commercial website. While the problem of executing a judgment against the fictitious or pseudonymous defendant remains to be addressed in post-trial proceedings instead of constituting an obstacle to the filing of suit. This may be sufficient for key elements of injunctive relief, such as the termination of e-mail addresses and website hosting used with the offending website, or the transfer of the infringing domain name at issue, even a monetary judgment may not be capable of execution.

The voluntary decision to register a domain name for use with a commercial website, and to place an e-mail address in the corresponding record for that domain name, lies at the heart of this proposal. After all, the registrant proffered the address as a means for contacting her concerning issues with the registration and use of the domain name, and moreover is obligated by the registration agreement to keep that contact information up to date. Where the ownership or legal responsibility for the sale and advertising of goods and services at a website has been concealed from public disclosure, this proposal construes the voluntary designation of an e-mail address by the owner of that website as a consent to service of process—or at a minimum that the registrant should not equitably be heard to complain about receiving notices at the address—in an action arising from the advertising or sale of goods and services at that site.

assumes, or requests to be addressed by, any fictitious, false, or assumed title, name, or address or name other than his own proper name, or takes or receives from any post office or authorized depository of mail matter, any letter, postal card, package, or other mail matter addressed to any such fictitious, false, or assumed title, name, or address, or name other than his own proper name, shall be fined under this title or imprisoned not more than five years, or both.” 18 U.S.C. § 1342. *See also* 18 U.S.C. § 1343 (“Whoever, having devised or intending to devise any scheme or artifice to defraud, or for obtaining money or property by means of false or fraudulent pretenses, representations, or promises, transmits or causes to be transmitted by means of wire, radio, or television communication in interstate or foreign commerce, any writings, signs, signals, pictures, or sounds for the purpose of executing such scheme or artifice, shall be fined under this title or imprisoned not more than 20 years, or both.”).

VI. Conclusion

The inability to identify the source of goods and services advertised and sold at commercial websites owned by fictitious and pseudonymous entities frustrates the trademark owner's ability to institute legal action to enjoin the infringement and protect consumers from fraud and confusion. Legislative and treaty amendments are needed to address this growing problem. The Whois Subcommittee encourages further discussion of the issue and consideration of potential solutions with other relevant INTA committees and with other relevant organizations, associations and stakeholders as a first step toward the enactment of legislative and treaty amendments to address the current the lack of transparency and accountability in the advertising and sale of goods and services on the Internet.

Appendix – Table of Authorities

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- BP Products North America, Inc. v. Dagra**, 236 F.R.D. 270 (E.D.Va. 2006).
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- Columbia Insurance Co. v. Seescandy.com**, 185 F.R.D. 573, 51 USPQ2d 1130 (N.D.Cal. 1999).
- Commodity Futures Trading Commission v. Lake Shore Asset Mgmt. Ltd.**, 07 C 3598, 2008 U.S. Dist. LEXIS 85084 (Sept. 17, 2008)(granting plaintiff's motion for default judgment and approving service by publication; court may fashion means of service on individual in foreign country so long as the means (1) is not prohibited by international agreement, Fed. R. Civ. P. 4(f)(3); and (2) comports with constitutional notions of due process).
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- Forum Fin. Group, LLC v. President, Fellows of Harvard Coll.**, 199 F.R.D. 22, 25 (D. Me. 2001)(although the court may order service under Rule 4(f)(3) that does not comply with the laws of the foreign country. a failure to comply with a foreign nation's service rules may impair the plaintiff's chances of ultimately enforcing a judgment in that country).
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attempted unsuccessfully to locate web site operators and e-mail was sole means of contact on web site).

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