

ALERT

TECHNOLOGY / INTELLECTUAL PROPERTY

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The Buzz on *.biz* and *.info*

On May 15, 2001, the Internet Corporation for Assigned Names and Numbers (ICANN) finalized the accreditation agreements with the new *.biz* and *.info* top-level domain (TLD) registries. Only a few days prior at the Annual Meeting of the International Trademark Association in San Francisco, Neulevel, the registry operator of the new *.biz* TLD announced that beginning Monday, **May 21, 2001**, it would open an Intellectual Property (IP) Claim Service (during which trademark owners could stake their claims to domain names corresponding to trademarks in which they have rights).

.biz

Neulevel describes the *.biz* TLD as “the first Internet domain dedicated solely to the needs of businesses around the world.” Although these domain names are intended to be restricted to businesses, Neulevel does not require any proof that a *.biz* domain name registrant is indeed a business. Therefore, it is expected that anyone will be able to register a *.biz* domain name.

Expecting a “land rush” to register domain names under the *.biz* TLD, Neulevel has established a three-stage launch process. The first stage is the IP Claim Service, which begins on May 21, 2001 and ends on July 9, 2001.

During the IP Claim Service, Neulevel intends to help businesses protect their trademark rights by allowing them to register claims of those rights with the *.biz* Registry. Importantly, the IP Claim Service is open to holders of registered trademarks, those who have pending applications to register their trademarks as well as those with common law rights in specific marks. During this period, a trademark holder or company that believes it has a legitimate intellectual property claim may file its IP Claim with the *.biz* Registry. The fee for filing an IP Claim is \$90 per claim.

In order to take advantage of the IP Claim Service, a trademark owner first must set up an account with Neulevel at its website at www.neulevel.com.

Once an account is created, the following information is required for the IP Claim Service:

- Account holder contact information
- IP owner contact information
- Name and contact information of person to receive legal correspondence regarding the IP Claim
- The character string for which IP rights are being claimed
- Payment Information
- Description of goods/services
- Date the company first used the mark
- Status of the mark (whether the mark is registered, applied for, or whether common law rights are asserted)
- For registered marks, the date and country of registration

Submitting a claim under the IP Claim Service provides trademark and brand owners a number of benefits during the second phase of the *.biz* launch which consists of the Domain Name Application and Domain Name Selection Process.

First, it provides notification to prospective *.biz* registrants of another company or individual's IP rights and possible infringement of those rights. If a company submits a domain name application that is an exact match to a mark submitted during the IP Claim Service, the domain name applicant will be notified of the potential conflict and must advise the *.biz* Registry of its decision to continue with the Domain Name Selection

Process. If the domain name applicant chooses to pursue registration of the domain name, the IP claimant will be provided contact information for the conflicting *.biz* domain name registrant. This provides an opportunity for the IP claimant and domain name registrant to resolve their conflicts before the domain name becomes active. Filing a trademark claim during the IP Claim Service also gives the IP claimant standing to pursue the *.biz* Start-up Trademark Opposition Policy (STOP). Only IP claimants have entry into Neulevel's STOP. The main feature of Neulevel's STOP is as follows: where an application to register a domain name is an exact match to a mark identified by an IP claimant during the IP Claim Service, an automatic 30-day hold or "cooling-off" period is put on the domain name application before it becomes active during which time the IP claimant has an opportunity to use Neulevel's STOP or pursue other appropriate action. This "cooling-off" period gives IP claimants time to pursue resolution of any conflict before the domain name is activated.

Significantly, Neulevel's STOP provides IP claimants with a less stringent burden of proof than ICANN's Uniform Dispute Resolution Policy (UDRP). Unlike the UDRP where trademark owners must show that a domain name is registered *and* being used in bad faith, under STOP, an IP claimant must show that a domain name is either registered *or* used in bad faith. Neulevel's STOP also contains an anti-speculation clause which provides that the registration of a domain name solely for the purpose of selling it to a third party is a violation of the STOP policy.

The Domain Name Application sub-phase of the second phase of the *.biz* launch process is scheduled to run from June 25, 2001 to September 25, 2001, and allows entities to submit applications for their desired domain name with a Registrar of their choice. If an IP claimant wishes to seek registration of a domain name corresponding to its trademark or marks, its IP claim submission is insufficient for seeking this registration and it also must submit a domain name application(s) during this period. This period allows entities the

opportunity to participate in the Name Selection process before general registration of domain names occurs. Companies may submit multiple requests for domain names during this period. Where numerous applicants have applied to register the same domain name, during the Name Selection Process sub-phase, the Registry will select randomly one applicant to register that domain name. As stated above, any domain name applications that have a claim against them will be automatically put on hold for 30 days at this time. Any domain name applications that have claims against them remain on hold. The Name Selection sub-phase is scheduled to run from September 26, 2001 to September 30, 2001.

The third phase of the *.biz* launch is when the registry "goes live" which is scheduled to begin on October 1, 2001. At this time, *.biz* domain names will be available to anyone throughout the world and all registered *.biz* domain names will become active.

.info

Afilias describes the *.info* domain as "the first global, unrestricted top-level domain to be created since *.com*." Indeed, *.info* domain names are unrestricted and will be open to any business or person to register for any purpose.

Afilias is scheduled to commence a "sunrise period" in late June 2001. During this 30-day period, owners of trademark registrations issued prior to October 2, 2000 may apply to register their trademarks as domain names under the *.info* TLD. If trademark owners choose to take advantage of this period, they must provide an ICANN and Afilias-accredited registrar with the following information:

- ASCII character format identical to the textual or word elements of the mark only. (Hyphens may be used between spaces within a registered mark.)
- Date the trademark registration issued
- Country where the trademark registration issued
- Registration number

Afilias then will use a multi-round batch processing system whereby it randomly will select applications from each registrar's batch.

Domain name registrations made during the sunrise period must be for terms of at least five years.

Unlike the IP Claim Service offered by the *.biz* Registry, Afilias' sunrise period is not open to those who have pending trademark applications, those who obtained trademark registrations after October 2, 2000 or those who claim common law rights in a mark.

To accommodate disputes arising out of sunrise period registrations, Afilias, in conjunction with the World Intellectual Property Organization (WIPO), will provide special "Sunrise Challenge" procedures. These procedures are expected to begin on the last day of the sunrise period and continue for approximately 120 days. WIPO will provide dispute resolution services for these challenges. The only basis for challenging a registration made during the sunrise period is if the domain name does not meet the sunrise period registration requirements. Such challenges are subject to a fee of \$295 per party. A registrant who is successful in defending against a challenge will receive its fee back. Names awarded during the sunrise period will become active one week after the beginning of the general application and registration process.

Approximately 15 days after the end of the sunrise period, Afilias will begin accepting *.info* domain name applications from the general public. A multi-round batch processing system similar to the one used during the sunrise period will be used to randomly select applications from batches submitted by the registrars. This process will last about three weeks. Thereafter, Afilias will process applications on a first-come, first-served basis.

Implications and Conclusions

The preliminary stages of both the *.biz* and *.info* launch processes are approaching quickly. Because many consider the *.com* TLD market to be saturated, the

opportunity to register in these new TLD's has become very attractive to many businesses and individuals.

While the *.biz* Registry will not provide a period in which it will allow trademark owners to reserve domain names corresponding to their marks, it will provide a service whereby trademark owners, including trademark registrants, applicants and those claiming common law rights in trademarks may submit claims of intellectual property rights with respect to their trademarks. Under the IP Claim Service, trademark owners will be given the opportunity to challenge a domain name registration of an identical mark through the *.biz* STOP policy or resolve the conflict with a domain name registrant by alternative means. In order for companies to ensure they will be able to obtain a *.biz* domain name that corresponds to their trademark the company must submit an IP Claim and also seek registration of its mark as a domain name by applying to register the domain name during the Domain Name Application phase. The *.biz* Registry is touting itself as "a new world order for business" and as providing "an environment designed for businesses, while creating a platform for the Internet-based solutions of the future."

The *.info* Registry expects the *.info* TLD to "achieve strong market penetration worldwide and create a truly global forum for information exchange" and to be "an exciting opportunity for companies to rethink their Web strategy on a truly global scale." Afilias will provide a 30-day sunrise period during which trademark registrants will be afforded the opportunity to reserve domain names that exactly correspond to those covered by their trademark registrations.

The *.biz* and *.info* Registries, both, are expected to campaign for registration in these new TLDs as global alternatives to the United States' "*.com*" TLD.

At this point, companies seeking to protect their brands should consider whether they would like to register their trademarks as domain names in the *.biz* and *.info* TLDs, which marks they should register and whether they satisfy the requirements of Neulevel's *.biz* IP

Claim Service and Afiliias' *.info* Sunrise Period. At the very least, brand owners should be thinking about defensive maneuvers they can take to ensure their marks are protected against cybersquatting and other unauthorized registration of their marks as domain names.

The information set forth above is provided by Shaw Pittman for general informational purposes. For more information call Eric Fingerhut at 703.770.7971 or Alisa Key at 703.770.7781.

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