

FENNEMORE CRAIG

I - Law

INTELLECTUAL PROPERTY LAW ALERT

REGISTRATION OF TRADEMARK CLAIMS TO PROTECT RIGHTS IN .BIZ AND .INFO DOMAIN NAMES

In November 2000, ICANN (Internet Corporation for Assigned Names and Numbers) approved several new generic top-level domain addresses ("TLDs") to ease congestion in the existing .com TLD and other registries. The first two new TLDs to come online will be .biz and .info. The .biz TLD is managed by NeuLevel Registry Services and registrants will be restricted to those having commercial purposes (although the means for enforcing this restriction is unclear). The .info TLD is managed by Afilias and is unrestricted and open to anyone for any purpose.

Because of trademark owners' concerns about infringers and cybersquatters, each registry is providing various phase-in and trademark claim services. This special edition of *I-LAW* outlines the relevant dates and procedures, all of which are subject to change as the registries continue to work out the details of the registration process.

THE PROCEDURES FOR .BIZ

Registration: The initial domain name registration period for .biz runs from now through **September 17, 2001**. During this initial period, anyone may file an application to register any domain name, and no domain name will be assigned until the close of this initial period. If multiple parties seek to register the same domain name, the successful applicant will be chosen by lottery. Filing multiple applications for the same domain name may increase the chances of obtaining the name.

After the initial registration period has ended, domain names will be registered on a first-come, first-served basis. Registration fees vary depending upon the length of the registration term. Additional information related to the .biz TLD registration can be found at www.neulevel.com.

IP Claim Service: NeuLevel has created an IP claim service that NeuLevel says protects trademark owners. Under this service, a trademark owner may file an "IP claim" with NeuLevel based on its trademark rights (registered, pending application or common law rights). This "IP claim" is completely distinct and separate from an application to register a .biz domain name. Rather, the "IP claim" will be used to put other applicants on notice of a trademark owner's claim of rights in a particular trademark. The deadline for submitting an "IP claim" is currently **August 6, 2001**. NeuLevel's fee for filing each "IP claim" is \$90.00.

During the initial domain name registration process, if an exact match occurs between a domain name application and an "IP claim," NeuLevel will notify the **applicant** of the potential conflict with a third party's trademark rights. The applicant must then notify NeuLevel within a designated time whether it intends to proceed with the application. A trademark owner's "IP claim" will not stop an applicant from registering the domain name if they choose to proceed after receiving the notice.

As of the official launch date of the .biz registry, currently scheduled for October 1, an automatic 30-day hold will be placed on any selected domain name exactly matching a trademark in an "IP claim" and the trademark claimant will be notified. Even small differences between an application and an "IP claim" will prevent the 30-day hold from being triggered. During this hold period, those who filed an "IP claim" may use NeuLevel's fast-track dispute resolution procedure. If there are multiple "IP claims," they each will be given the opportunity in serial fashion to object to the registration. NeuLevel says that under this procedure, trademark claimants will have a lower burden of proof for showing cybersquatting than under the current Uniform Domain Name Disputer Resolution Policy (UDRP). Trademark owners will be able to object to any .biz domain name registration using a standard UDRP proceeding after the launch date whether they file an IP claim or not.

THE PROCEDURES FOR .INFO

Afilias is offering a "sunrise" period wherein domain name registrations are accepted only for trademark owners, provided the trademark owner has a national trademark registration issued prior to October 2, 2000. Early registration begins **July 25, 2001** and will close on **August 27, 2001**. Within fifteen days thereafter, Afilias will accept applications from any applicant during the start-up period and selection will be random.

Trademark owners may challenge domain name registrations during a special challenge period open for 120 days after close of early registration. During this period, disputes will be handled by the World Internet Property Organization (WIPO), although the procedures for resolving the disputes have not been determined. After launch of the registry currently scheduled for September 19, applications will be registered on a first-come, first-served basis. Information regarding the .info registration can be found at www.afilias.com.

For further assistance with registration for the new TLDs, please contact the following members of our Intellectual Property Department.

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