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Client Alert

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INTELLECTUAL PROPERTY

Looking for a New Domain Name? .BIZ and .INFO are Waiting For You... But You Better Act Now!

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On November 16, 2000, the Internet Corporation for Assigned Names and Numbers (ICANN) approved seven new top-level domain names (TLD's): .biz, .info, .name, .pro, .aero, .coop, and .museum. The first four TLD's—.biz, .info, .name, and .pro—will be relatively large TLD's that will be "unsponsored," meaning that they will operate under policies established by the global Internet community directly through the ICANN process. It is expected that the .biz domain will be used by businesses, .info will have unrestricted use, .name will be used as a registration for individuals, and .pro will be used by accountants, lawyers, and physicians. The other three TLD's—.aero, .coop, and .museum—will be smaller, "sponsored" domains that will have a sponsoring organization representing the specialized community most affected by that particular TLD. The .coop domain will be used by cooperatives, .aero will be used by the air transport industry, and .museum will be used by museums.

The TLD's .biz and .info have cleared the ICANN approval process. Initial registration periods have been established for .biz, and will soon be announced for .info. Since registration periods for the remaining TLD's have not yet been announced, any "pre-registration" offers for any domain names other than .biz and .info are utilized at your own risk. As a result, if you attempt to pre-register domain names in any manner or with any registrar not approved by ICANN, you cannot be assured that you will receive the "pre-registered" name once the TLD's become operational.

The U.S. Federal Trade Commission recently issued a consumer alert warning about the many "scam" entities offering pre-registration services. If you have any questions about whether a particular registrar is authorized to pre-register a name, please contact us.

The approved procedures for registration of the .biz and .info top-level domains are set forth below.

.BIZ TLD

The .biz domain name is designated for "a bona fide business or commercial use." Although the Registry for the .biz top-level domain, NeuLevel L.L.C., will not review applications to determine whether they comply with this designated use, registered .biz domain names that do not comply with this requirement are subject to a new mandatory administrative proceeding known as the Restrictions Dispute Resolution Policy (RDRP). The RDRP is similar to ICANN's current Uniform Dispute Resolution Policy (UDRP), and is intended to address the propriety of domain names that have been registered under the wrong category.

NeuLevel has set up a new process for registration of the .biz TLD that is unlike the registration process used for registration of other TLD's, such as .com, .org, and .net.

The .biz process consists of several stages, all or some of which may be utilized by registrants:

- 1) An IP Claim period;
- 2) A pre-registration period;
- 3) Random assignment of pre-registered domains;
- 4) A general registration period; and
- 5) An IP Claim dispute resolution period.

The dates for each stage are as follows:

PERIODS AND DATES	ACTIONS TO BE TAKEN
IP Claim Period May 21–August 6, 2001	Trademark owners may submit IP Claims to NeuLevel.
Pre-Registration Period June 25–September 17, 2001	Businesses and individuals may submit domain name applications to accredited .biz registrars. The accredited registrars will then submit “batch files” containing all .biz applications to NeuLevel.
Random Selection of Domain Names September 26–September 30, 2001	The .biz domain names will be randomly assigned to applicants.
Operational Date October 1, 2001	All assigned .biz domain names will become operational, unless they are the subject of an IP Claim.
IP Claim Dispute Resolution Period October 1–October 30, 2001	All .biz domains that match an IP Claim are placed on 30-day hold. Trademark owners who have submitted IP Claims will have 30 days after receiving notification from the .biz registrar of a match to take other appropriate action.

Each of the above periods are discussed below.

IP Claim Period

From May 21, 2001 to August 6, 2001, any owner of a common law, registered, or pending trademark or service mark may file with NeuLevel an “IP Claim,” *e.g.*, an intellectual property claim, for the trademark or service mark.

Filing an IP Claim is not a mandatory part of the domain name registration process, but it does provide several benefits to trademark owners seeking protection of their marks. First, any trademark owner who files an IP Claim will be notified by NeuLevel when a domain name identical to the trademark in the IP Claim is registered by a third party. Second, only those who file IP Claims will be entitled to use NeuLevel’s Start-Up Trademark Policy (STOP), a new dispute resolution process for .biz TLD’s that carries a lower burden of proof than the UDRP. Third, any .biz registration that is identical to a trademark in an IP Claim will automatically be placed on hold for 30 days from the date the .biz domain names go live, in order to give the trademark owner time to take whatever action may be necessary in order to protect its trademark rights.

An IP Claim filed with NeuLevel must include the following information:

- a. Account holder contact information;
- b. Trademark owner contact information;
- c. Legal contact for correspondence regarding claims;
- d. Trademark or service mark for which rights are claimed;
- e. Description of goods/services, including relevant international classes;
- f. Date the trademark was first used in commerce;
- g. Status of the trademark (indicate whether rights are based on a registration, an application with a national trademark office, or based on common law rights);
- h. The date the application was filed or the registration issued; and
- i. The country where the trademark was first used.

A trademark owner may submit a separate IP Claim for each mark in which it claims rights. The .biz Registry will not investigate the information provided in an IP Claim form to determine whether it is accurate.

Submission of an IP Claim is unrelated to submission of an application for registration of the trademark as a domain name under the .biz TLD. That is a separate process that begins on June 25 and runs through September 17, 2001.

Pre-Registration For The .Biz Domain Name

The .biz Registry will begin accepting applications for domain names from individuals or entities beginning June 25 and continuing through September 17, 2001. As the applications are received, the Registry will compare them against all the IP Claims that have been filed to determine whether there is any *exact* match between a domain name and a trademark for which a claim has been filed. If an exact match is found, the domain name applicant will be notified that a third party has submitted an IP Claim for that domain, and will be provided with all the information submitted in the IP Claim form. The domain name applicant will also be advised that the domain name will automatically be placed on hold if the name is

ultimately registered, and will be instructed to advise the Registry whether it wants to proceed with completing the registration process. If the applicant does not respond to this notification, a domain name registration will not issue.

Random Selection of Domain Name for Registration

Between September 26 and September 30, 2001, after the initial pre-registration phase has closed, the .biz Registry will select which applications will mature to domain name registrations. If there are multiple applications that have been filed for the same domain name, NeuLevel will combine them all and then randomly select one application for registration. The process has been set up this way to allow all domain name applicants an equal opportunity to register a domain name for which multiple applications have been filed. Once this “lottery” system has been completed, all successful and unsuccessful applicants will be notified.

Operational Date for .biz Domain Name Registrations

Beginning October 1, 2001, .biz domain name registrations will become operational, and all but those subject to an IP Claim will go live. From October 1, 2001 going forward, the .biz registrars will accept new .biz applications on a first-come, first-served basis. There will no longer be randomized selection of domain name registrations.

IP Claim Dispute Resolution Period

All domain name registrations for which an exact match with an IP Claim was located during the pre-operational period will be placed on hold for 30 days beginning October 1, 2001. During this 30-day period, those individuals who filed IP Claims may contest the registration of an “exact match” domain name under NeuLevel’s Start-Up Trademark Opposition Policy (STOP). *Only those who have submitted IP Claims during the claim period may use this process.*

The STOP process is similar to the current ICANN UDRP, with one important distinction: the claimant need only show that the domain name was registered *or* was used in bad faith in order to successfully challenge the registration. Under the UDRP currently in effect, the claimant must show that the mark was both registered *and* used in bad faith. The same dispute resolution arbiters who evaluate UDRP claims will evaluate STOP claims.

If there is more than one IP Claim filed for a particular trademark that has been registered as a domain name, the .biz Registry will randomly determine the order in which the IP Claims will be processed.

Only those that timely file IP Claims can utilize STOP. All other .biz domain name challenges of any nature will be

required to proceed under the existing UDRP policy, or other legal avenues for relief.

Additional information on the .biz domain name registration process can be obtained at <http://neulevel.com>

.INFO TOP-LEVEL DOMAIN

The new .info domain name has been equated with the well-known .com domain because it will be a fully open TLD available without restriction for anyone to use. The .info domain name Registry will be operated by Afilias L.L.C., a company based out of Ireland.

Unlike the .biz Registry, there will be no “IP Claim” process for the .info TLD. However, there will be a “Sunrise Period” during which owners of trademarks and service marks that are registered in a national trademark office prior to October 2, 2000 may pre-register the marks as .info domain names. The marks must be pre-registered in the identical textual form in which they appear in the registration.

The timeline for the .info domain name pre-registration, challenge, and operational periods is as follows:

PERIOD AND DATES	ACTIONS TO BE TAKEN
Sunrise Period July 25-August 27, 2001	Trademark owners may pre-register their registered marks as domain names through a randomized, round robin system.
Quiet Period August 28-September 11, 2001	
Sunrise Challenge Process Begins August 28, 2001 and will continue for 120 days	120-day challenge period following Sunrise Period during which third parties can challenge Sunrise registrations on specified grounds.
Start-up Period Begins September 12, 2001—no termination date yet	The domain name registration process will be opened to anyone, and all applications submitted will be processed on a randomized, round robin system basis.
Post-Start-Up Period Estimated to begin approximately 3 days after completion of the Start-up Period and continuing indefinitely	Domain name registrations are available to general public on a first-come, first-served basis.

Sunrise Period

All those owning trademarks registered at a national level before October 2, 2000 can apply for a .info domain name during this period. A trademark owner must provide the following information when registering for a domain name during the Sunrise Period:

- a. The trademark or service mark (in ASCII characters);
- b. The date of the trademark registration;
- c. The country of registration; and
- d. The registration number.

Sunrise Period registrations will be accepted for a minimum term of five years and a maximum term of 10 years. Registrations will be awarded based upon a randomized, round robin selection system to provide all owners of identical trademarks with an equal opportunity to obtain the .info domain name for their mark. Following the selection process, all applicants will be notified whether or not they have been awarded the registration.

The randomized, round robin process will be somewhat different from the process used to award registrations under the .biz domain name. It is anticipated that there will be five separate rotation periods from which randomized selections will be made from the applications received up to that point, as follows:

- First Round* There will be an initial 7-day period for submission of applications to Afilias, followed by a 3-day processing period.
- Second Round* During the 3-day first round processing period, additional applications will be submitted to Afilias, followed by another 2-day processing period.
- Third Round* During the 2-day second round processing period, additional applications will be submitted to Afilias, followed by another 2-day processing period.
- Fourth Round* During the 2-day third round processing period, additional applications will be submitted to Afilias, followed by a 2-day processing period.
- Fifth Round* During the 2-day fourth round processing period, a final group of applications will be submitted to Afilias, followed by a final 2-day processing period.

Quiet Period

Afilias has indicated that it may institute a 15-day “quiet period” to evaluate the results of the round-robin system and make modifications before the general pre-registration period opens.

Challenges to Sunrise Period Registrations

A third party may challenge a Sunrise Period registration using the Sunrise Challenge process. Challenges may be filed for 120 days following the conclusion of the Sunrise Period. After the

expiration of the 120-day Challenge period, all challenges to .info registrations must utilize ICANN’s existing UDRP proceeding or other available legal avenues for relief.

In order to assert a Sunrise Challenge, a third party must establish:

- a. The registrant does not own a current, non-expired trademark or service mark registration; or
- b. The trademark or service mark registration was not a national registration; or
- c. The second level of the domain name is not identical to the trademark or service mark registration; or
- d. The trademark or service mark registration was issued after October 2, 2000.

The World Intellectual Property Organization (WIPO) will provide all dispute resolution services under the Sunrise Challenge procedures.

Start-Up Period

After the Sunrise Period closes, the Start-Up Period for registration will open. Anyone can file an application to register a domain name during the Start-Up Period. As during the Sunrise Period, these registrations will be awarded using the same randomized process as during the Sunrise Period, except that only a minimum two-year registration period will be required, with a maximum ten-year registration period available.

Real Time Registrations

After completion of the Start-Up registration period, real time registration will begin and domain name registrations will be awarded on a first-come, first-served basis. All registrations registered during this period will be subject to ICANN’s UDRP proceedings.

Further information on the .info domain name registration process can be obtained at www.afilias.com.

Recommendations

.biz Domain Names

1. Consider filing IP Claims for valid trademarks and service marks.
2. Submit applications for desired domain names during the pre-registration period. Multiple applications may be submitted for the same domain name and will increase your chance of obtaining registration through the randomized selection system.
3. Respond timely to all STOP notifications.

.info Domain Names

1. Submit applications early in the Sunrise Period for trademarks registered before 10-2-2000.
2. Monitor .info registrations issued so challenges under the Sunrise policy, rather than the UDRP, can be asserted.

Further information on ICANN, the UDRP, and general domain name issues and policies can be obtained at www.icann.org