

## CLIENT ALERT: REGISTRATION OF <.BIZ> AND <.INFO> DOMAIN NAMES

On November 16, 2000, the Board of Directors of the Internet Corporation for Assigned Names and Numbers (“ICANN”) announced the selection of registry operators for the following seven new top level domains (“TLDs”): <.aero>, <.biz>, <.coop>, <.info>, <.museum>, <.name> and <.pro>. On May 15, 2001, ICANN announced it had finalized accreditation agreements with NeuLevel Inc. (“NeuLevel”) of Sterling, VA, the registry operator for <.biz>, and Afilias, a consortium of 18 domain name registrars acting as the registry operator for <.info>.<sup>1</sup>

ICANN’s accreditation means NeuLevel and Afilias can begin the process of making <.biz> and <.info> addresses available, and both entities have announced plans to do so. <.info> will be an unrestricted TLD, open to any business or person to register for any purpose. <.biz> will be a restricted TLD available only for commercial or business purposes. Both NeuLevel and Afilias will allow trademark and service mark holders to reserve corresponding domain names first to discourage “cybersquatting,” or the practice of registering addresses with the intention of reselling them.

Generally, companies should consider registering under <.biz> and <.info> the same domain names they presently have registered and are using under <.com>, <.net> or <.org>. Even if a company or individual has no imminent plans to use these new domain names, defensive registration may be advisable to prevent registration by others of names confusingly similar to a company’s or individual’s name or registered marks. Companies claiming rights in common law or registered marks and wishing to register corresponding <.biz> domain names should submit claims to such trademark or service mark rights during the First Phase of NeuLevel’s <.biz> roll out, scheduled to begin May 21, 2001. Owners of trademarks and service marks registered nationally prior to October 2, 2000, that wish to register corresponding <.info> domain names should apply to register such names during Afilias’ Sunrise Period, scheduled to begin in late June 2001 and run until late July 2001.

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<sup>1</sup> NeuLevel’s Web site can be accessed at <[www.neulevel.com](http://www.neulevel.com)>. Afilias’ Web site can be accessed at <[www.afilias.com](http://www.afilias.com)>.

## I. <.biz> Roll-out

Companies claiming rights in common law or registered marks and wishing to register corresponding <.biz> domain names should submit claims to such trademark or service mark rights during the First Phase of NeuLevel's <.biz> roll out to prevent others from registering domain names that match the claimed mark. NeuLevel will employ a three-step approach to <.biz> registry services:

### A. Intellectual Property Claim Service

During the First Phase of the <.biz> rollout, from May 21 through approximately July 9, 2001, a business claiming rights in a registered and common law trademark or service mark may file a claim to such intellectual property ("IP") rights with NeuLevel,<sup>2</sup> which will be entered into the NeuLevel IP Claims database. NeuLevel's fee for filing such claim is expected to be published shortly.

During the Domain Name Application and Selection Phase, which runs from July through September 25, 2001, NeuLevel will monitor domain name applications for exact matches with character strings in the IP Claims database plus the <.biz> extension. Where there is an exact match, NeuLevel will notify the domain name applicant of the trademark or service mark claim.<sup>3</sup> An applicant submitting a domain name application that conflicts with a claimed mark that nevertheless decides to proceed with the selection process must notify NeuLevel of this decision, and NeuLevel will process the application and include it in the selection process of the Domain Name Application and Selection Phase. A domain name applicant that fails to notify NeuLevel of a decision to proceed (or that notifies NeuLevel it does not wish to proceed) will not have its application included in the name selection process.

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<sup>2</sup> The following information must be provided when filing a claim: (i) account holder contact information; (ii) IP owner contact information; (iii) name and contact information of the person to receive legal correspondence regarding claimed marks; (iv) the character string for which the business is claiming trademark or service mark rights (note that the associated domain name for this string will be an exact match with the character string plus the <.biz> extension); (v) a description of goods/services covered by the mark, including the International Class covering such goods or and services; (vi) the date the mark was first used in commerce; (vii) whether the IP rights are based on registration or an application pending in any national trademark office or are based on common law rights; (viii) the effective date of the application or registration, if applicable; and (ix) the country in which the mark was first used.

<sup>3</sup> Specifically, the domain name applicant will be provided with the following information: (i) the trademark or service mark being claimed; (ii) the company claiming ownership in the mark; (iii) details regarding the claim, including a description of the goods and services associated with the mark, the date and country of first use of the mark, and whether the mark is registered, an application is pending or common law rights are claimed; and (iv) the name and contact information of the person designated to receive legal correspondence regarding the claimed mark. The applicant also will be provided with a link to a Web site where the domain name applicant must go to confirm its desire to either proceed with the application or cancel the request.

Upon the October 1, 2001 launch of the <.biz> registry, an automatic 30-day hold will be placed on registration of any domain name subject to an IP Claim (*i.e.*, a domain name that exactly matches a mark in NeuLevel's IP Claims database). At this time, the mark owner will be notified of the match between the proposed domain name and the mark in which it claims rights. This 30-day hold period will provide mark owners the opportunity to use the Start-up Trademark Opposition Program ("STOP") or to take other appropriate action. STOP is a domain name dispute resolution procedure designed for the <.biz> launch, which carries a lower burden of proof than ICANN's Uniform Dispute Resolution Policy ("UDRP") and provides a more rapid process for resolving conflicts.<sup>4</sup>

Note that NeuLevel's IP Claims database will only be used during the Domain Name Application and Selection Phase. After the October 1, 2001 launch, registrations for domain names will no longer be checked against the IP Claims database.

Thus, registering a mark with NeuLevel's IP Claims database during the First Phase of NeuLevel's <.biz> roll out will have the following advantages: (i) potential <.biz> domain name registrants will be notified of potential infringement of a trademark or service mark owners' IP rights, and required to acknowledge such rights before proceeding with registration; (ii) mark owners will be provided with contact information about potentially successful domain name registrations that may infringe their rights; (iii) mark owners will obtain standing to initiate proceedings under STOP; and (iv) an automatic 30-day "hold" will be put on potentially infringing domain name registrations, providing mark owners with time to take appropriate action against such registrations.

## **B. Domain Name Application and Selection**

During the Domain Name Application and Selection Phase, from July to September 25, 2001, businesses may file <.biz> domain name applications with ICANN-accredited registrars. Registrars will, in turn, submit these applications to NeuLevel. In cases where multiple domain name applications are submitted for the same name, NeuLevel will select one application through a random process, ignoring the order in which the applications were received and attempting to avoid preference toward any registrar. Successful and unsuccessful domain name applicants will be notified of the outcome of the selection process through their registrars.<sup>5</sup>

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<sup>4</sup> Under the UDRP, a trademark owner must demonstrate that a domain name was both registered *and* used in "bad faith." Under STOP, trademark owners need only demonstrate that a domain name was either registered *or* used in bad faith. Thus, registration of a domain name solely for the purpose of selling it to a third party would constitute a violation of STOP. More information on STOP can be found at <<http://www.icann.org/tlds/agreements/biz/registry-agmt-appm-27apr01.htm>>.

<sup>5</sup> Successful applicants will be required to pay a registration fee, as determined by the individual registrar, after successful registration of the domain name. The fee will depend on the length of the registration period, with a minimum of 2 years required.

**C. Launch of the <.biz> Registry**

Beginning October 1, 2001, <.biz> domain names that have been awarded during the Domain Name Application and Selection Phase will become operational. However, as noted, the registry will automatically place a 30-day hold on domain names for which there is a match within the IP Claims database.

Also beginning October 1, 2001, NeuLevel will allow for real-time registration of <.biz> domain names on a first-come, first-served basis, and will no longer check domain name applications against the IP Claims database. <.biz> will use a Restriction Dispute Resolution Process (RDRP), similar to the UDRP process, to resolve challenges related to the business-only restricted nature of the registry.<sup>6</sup> Other disputes will be settled according to the UDRP.

**II. <.info> Roll-out**

Owners of trademarks and service marks registered nationally prior to October 2, 2000 that wish to register corresponding <.info> domain names should register such marks during Afilias' Sunrise Period to prevent others from registering domain names that match the claimed marks. Afilias will employ a three-step approach to launch the <.info> registry services:

**A. Sunrise Period**

From late June to late July 2001, Afilias will offer a 30-day Sunrise Period during which owners of national marks registered prior to October 2, 2000<sup>7</sup> may apply through an ICANN-accredited registrar for a <.info> domain name identical to the textual elements of the trademark or service mark.<sup>8</sup> Domains submitted during the Sunrise Period will only be accepted for registration terms of 5-10 years.

During the Sunrise Period, registrars will collect and deliver applications to Afilias. Afilias will then implement a multi-round batch processing system in which it will randomly select

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<sup>6</sup> Under the RDRP, several types of disputes, for example, a <.biz> domain name used exclusively for personal noncommercial use, may be addressed. Further information on the RDRP can be found at <<http://www.icann.org/tlds/agreements/biz/registry-agmt-appm-27apr01.htm>>.

<sup>7</sup> Trademark or service mark registrations from the supplemental or equivalent registry of any country, or from individual states or provinces of a nation, will not be accepted.

<sup>8</sup> In addition to the regular contact and name server information required for normal domain name registrations, domains registered during the Sunrise Period must also include the following information: (i) the date the registration issued; (ii) the country where the mark was registered; and (iii) the registration number. Where there is a space between the textual elements of a mark, the registrant may elect to use a hyphen or combine the elements together. For example, the mark "SERVICE MARK" could be registered as <servicemark.info> or <service-mark.info>.

applications from each registrar's batch.<sup>9</sup> In the event that separate applicants submit registration requests for identical marks, the first request (as selected by the randomized process) to be processed by the registry that meets the criteria for a Sunrise registration will be awarded the domain name. The World Intellectual Property Organization ("WIPO") will administer a challenge procedure through which any third party may challenge a Sunrise Period registration to ensure it complies with the applicable requirements. The Sunrise Challenge Period will begin at the end of the Sunrise Period and continue for 120 days.<sup>10</sup>

To ensure that all registrations in the <.info> domain become operational at the same time, domains registered during the Sunrise Period will be placed "on hold" until approximately 7 days after the start of the Start-Up Period.

## **B. The Start-Up Period**

Within 15 days after the conclusion of the Sunrise Period, Afilias will begin accepting applications for <.info> domain names from the general public. Those interested in registering a <.info> domain during the Start-Up Period must submit requests through ICANN-accredited registrars, which will submit domain name registration requests to the registry. During the Start-Up Period, in order to ensure that Internet users have an equal chance to register names during the initial launch phase, and to prevent preferential treatment of any one registrar, <.info> names will be processed using a multi-round batch process similar to the one used for Sunrise Period applications. Afilias estimates that the Start-Up Period will last for approximately 18 days or until the volume of registrations submitted through the randomized process is completed. When the Start-Up Period is over, Afilias will process applications on a real-time basis.

Domain names submitted during the Start-Up Period must be registered for 2-10 years. Disputes over domains registered during the Start-Up Period may be settled according to the UDRP or through litigation. Domains registered during the Start-Up Period will become operational promptly after processing.

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<sup>9</sup> For more information on randomized domain name selection during the Sunrise and Start-Up Periods, see <<http://www.afilias.com/faq/name-selection.html>>.

<sup>10</sup> A third party may challenge a domain registered during the Sunrise Period on the basis of the following: (i) the domain name registrant does not own a current trademark registration for the same name; (ii) the valid and enforceable trademark registration was not of national effect; (iii) the second level portion of the domain name is not identical to the trademark registration; or (iv) the trademark registration was not issued prior to October 2, 2000. The fee for asserting such a challenge will be \$295. After the Sunrise Challenge Period, parties disputing the validity of a Sunrise domain must utilize ICANN's UDRP process or litigation.

**C. The Post-Start-Up Period**

The Post-Start-Up Period, which will continue indefinitely, is estimated to begin approximately 3 days after the completion of the Start-Up Period, will be open to anyone wishing to register a <.info> domain and will allow for real-time registration on a first-come, first-served basis.

Those interested in registering a <.info> domain during the Post-Start-Up Period must contact an ICANN-accredited registrar to submit their requests. Domain names registered during the Post-Start-Up Period must be registered for 2-10 years. Disputes over domains registered during the Post-Start-Up Period may be settled according to the UDRP or through litigation. Domains registered during the Post-Start-Up Period will become operational promptly after processing.

**III. Conclusion**

Clients should consider registering under <.biz> and <.info> the same domain names they currently have registered under <.com>, <.net> or <.org>. Companies claiming rights in common law or registered marks and wishing to register corresponding <.biz> domain names should submit claims to such rights during the First Phase of NeuLevel's <.biz> roll out, scheduled to begin May 21, 2001. Owners of marks registered nationally prior to October 2, 2000, and wishing to register corresponding <.info> domain names should register such marks during Afiliias' Sunrise Period, scheduled to begin in late June 2001.

Note that there are no officially sanctioned *pre-registration* services. As stated by ICANN, the processes to be followed by the new registry operators are designed to be fair to all applicants regardless of when they submit their applications (although in some phases, earlier filed applications will be given priority). Costs will vary based on the ICANN-accredited registrar used and on the services provided by that registrar. It is expected that retail pricing for both <.biz> and <.info> names should be comparable to those for existing TLDs.

If you have questions regarding registration of domain names in any of these new domains or desire our assistance in registering new domain names, please contact William M. Ried (212-728-8729 <[wried@willkie.com](mailto:wried@willkie.com)>) or Christine Lombardi (212-728-8767 <[clombardi@willkie.com](mailto:clombardi@willkie.com)>) in our New York office.

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