

VEDDER PRICE

Intellectual Property & Technology Report

A periodic report designed to provide review and analysis of legal developments
in technology and intellectual property issues.

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July 2001

Protecting Trademarks Under New Top Level Domains

Two new global top-level domains (TLDs), ".biz" and ".info", have been created by the Internet Corporation for Assigned Names and Numbers (ICANN). For each new TLD, there is a time-limited opportunity for trademark owners to protect their marks from being registered as domain names by others. This memorandum provides information regarding actions necessary to protect trademarks and the steps necessary to obtain .biz and .info domain name registrations.

.biz TLD

.biz is a new TLD designed for use by businesses. This new domain name is administered by NeuLevel, Inc. and will be implemented with a three-step launch process.

STEP 1: Intellectual Property (IP) Claim Service (May 21, 2001 – August 6, 2001)

The IP claim service is designed to help IP holders protect their trademark rights by putting potential domain name applicants on notice of the IP holder's claim to rights in the potential domain name. IP holders of all trademarks that have been *registered* with any national trademark office, trademarks in the *application process*, and *common law marks* can file a claim through an ICANN-accredited registrar. The cost to file a claim is approximately \$90.00 per mark.

The trademark owner must provide the following information in the claim:

- ≈ claim account holder contact information
- ≈ trademark owner contact information
- ≈ person to receive legal correspondence regarding claims
- ≈ the character string for which the trademark owner is claiming trademark rights
- ≈ description of the goods/services, including international class
- ≈ date the trademark was first used in commerce
- ≈ status
- ≈ effective date of an application or registration if applicable
- ≈ the country where the trademark was first used

IP holders must file a separate application if they want an opportunity to register the domain name. Use of the IP claim service is not an application for the name itself.

There are three main advantages of the IP Claim Service:

- a. Notification:** When an application is submitted that is an *exact* match with an IP claim, the applicant will be notified of the potential conflict and given the IP holder's contact information. The applicant must then inform NeuLevel whether they intend to proceed with the application process. If the applicant decides to proceed and is awarded the domain name, the IP holder is notified of the domain name registrant's contact information. **September 25, 2001** is the final date to indicate the intent to proceed with registering a domain name application for an exact match to an IP claim. After this date, all applications without a response will be cancelled.
- b. Start-up Trademark Opposition Policy (STOP):** Only IP holders that have filed an IP claim will be able to take advantage of STOP, which is similar to the ICANN Uniform Dispute Resolution Policy (UDRP). The UDRP is available at www.icann.org/udrp/udrp.htm and requires the IP holder to prove that the domain name is registered *and* used in bad faith. Alternatively, STOP requires an IP holder to prove only that the domain name in question was registered *or* used in bad faith. IP holders (that files an IP claim) that wish to file a STOP action must do so within twenty (20) days of being notified of the registration.

- c. Cooling-off Period:** Any domain name application successfully registered during the start-up period that is an exact match to an IP claim will be placed on hold for thirty (30) days from the "go live" date for .biz. The IP holder that filed the claim has an additional opportunity to take action under STOP or to attempt to amicably resolve the conflict with the registrant before the domain name goes live.

STEP 2: Apply for .biz Domain Names (Until September 17, 2001)

In this step, applicants submit domain name applications before the actual launch of the .biz TLD with any ICANN-accredited .biz Registrar. In cases of multiple applications for the same domain name, all applications will be randomized prior to selection of the registrant. There is *no guarantee* that a domain name request will be successfully registered by submitting an application. Successful registrants will be required to pay a registration fee based on the length of the registration, where a minimum of two years is required.

Step 3: .biz Names Go Live

On **October 1, 2001**, the .biz TLD names "go live" and will be accessible via Internet browsers as are current TLDs such as .com and .org.

About Vedder Price

Vedder, Price, Kaufman & Kammholz is a national, full-service law firm with approximately 200 attorneys in Chicago, New York City and Livingston, New Jersey.

Technology and Intellectual Property Group

Vedder, Price, Kaufman & Kammholz offers its clients the benefits of a full-service patent, trademark and copyright law practice which is active in both domestic and foreign areas. Vedder Price's practice is directed not only at obtaining protection of intellectual property rights for its clients, but also at successfully enforcing such rights or defending its clients in the court and before federal agencies, such as the Patent and Trademark Office and the International Trade Commission when necessary.

.Info TLD

This is a new unlimited global TLD. Anyone can take advantage of a .info registration. The registry for this new domain will be administered by Afilias and will also be implemented with a three-step process.

Step 1: Sunrise Registration Period (July 25, 2001 – August 27, 2001)

Owners of trademarks that have been *registered* in a national trademark office prior to October 2, 2000, can pre-register the mark as a .info domain name. No variations can be registered; only the identical registered mark itself. *Pre-registration does not ensure that the trademark owner will get the domain name.* Where there are multiple trademark owners of the same mark, Afilias will process the domain name requests during this period using a randomized round-robin mechanism. However,

since the registry will process applications in batches, the earlier you file a Sunrise application, the better your chance of obtaining the desired domain name. A Sunrise Registration will only be accepted for a minimum registration term of five years and maximum of ten years. Fees will be posted at the Afilias web site, www.afilias.com.

Challenging a Sunrise Registration

Challenges can be made based on the following: the registrant did not own a current trademark registration; the trademark registration was not of national effect; the second level of the domain name is not identical to the trademark registration; or, the trademark registration did not issue prior to October 2, 2000. Challenges made during the period one hundred twenty (120) days following the end of the Sunrise Registration Period are subject to a fee of \$295, and dispute resolution services are provided by the World Intellectual Property Organization (WIPO). After one hundred twenty (120) days, parties who wish to challenge the registration must use UDRP or available courts of law.

Step 2: Start-Up Period (September 12, 2001-TBD)

This period, estimated to begin about 15 days after the completion of the Sunrise Period, will open registration to the general public. Domain registrations submitted during the Start-Up period will be processed with the same randomization process used during the Sunrise period.

Step 3: Post Start-Up Period (TBD)

The Post Start-Up Period is estimated to begin approximately three (3) days after the completion of the Start-Up Period. This period is open to anyone wishing to register a .info domain name and will allow for real-time registration on a first-come, first-served basis.

More TLDs to come in the future

Five more TLDs have been approved by ICANN and will be introduced in the future. They are .coop, .aero, .museum, .name, and .pro. The intended users are cooperatives, the air transport industry, museums, individuals, and accountants, physicians and attorneys, respectively. Information concerning registration of

We also have been principal counsel for both vendors and users of information technology products and services. Computer software development agreements, computer software licensing agreements, Year 2000 counseling, outsourcing (mainly of data management via specialized computer software tools as well as help desk-type operations and networking operations), multimedia content acquisition agreements, security interests in intellectual property, distribution agreements and consulting agreements, creative business ventures and strategic alliances are all matters we handle regularly for our firm's client base.

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domain names under these new TLDs will be provided as it becomes available.

If you have any questions regarding the information provided herein, please contact [Michael Turgeon](#) (312-609-7716) or any other Vedder Price Attorney with whom you have worked.. Please feel free to also contact [Angelo Bufalino](#) (312-609-7850), [Joe Krause](#) (312-609-7536), or [Chris Reckcamp](#) (312-609-7599) regarding any questions and comments you may have.

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