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# IP INSIGHTS

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Vol. 2, No. 6

June 2001

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## Trademark alert: .info and .biz are here!

Has this ever happened to you?

You protected your company's name by registering it as a trademark, but then discovered that someone else had already registered it as a domain name, limiting its commercial value to your business. If so, keep reading.

The Internet Corporation for Assigned Names and Numbers (ICANN) recently authorized the creation of seven new Top Level Domains, equivalent to .com. For limited time periods, the domain name registries for .info and .biz are offering special services to trademark owners.

However, trademark owners must act now to take advantage of opportunities available through the .info and .biz domains that may help protect their marks against infringement and cybersquatters.

### .info

Between June 25 and July 25, 2001, the "sunrise period," any trademark owner may register an .info domain name that is identical to its registered trademark (provided the registration has been issued in the U.S. or abroad prior to October 2, 2000).

During this period, a trademark owner has the exclusive right to register its mark with the suffix .info. Non-trademark owners are barred from registering an .info domain during this period.

Therefore, a trademark owner is guaranteed use of its mark in the .info domain, unless another entity owns the same mark (for different goods or services, for example) or claims to own it.

Afflias, the .info registry operator, does not verify the truth of such claims. It has, however, created a special dispute resolution process called the "sunrise challenge." Dispute resolution services will be provided

exclusively by the World Intellectual Property Organization (WIPO) during the sunrise period.

**Example:** Canine Helpers, which owns a trademark registration for HANDY PAWS, discovers that handypaws.info has been registered by a third party during the sunrise period. Believing the third-party registration to be fraudulent, Canine Helpers initiates sunrise challenge proceedings before WIPO with the hope of obtaining the handypaws.info domain registration.

### .biz

The .biz domain has been created exclusively for commercial or business purposes.

NeuLevel, Inc., the registry operator for .biz, has created an IP Claim Service. Through July 9, 2001, a trademark owner may submit an IP claim by providing details about the mark it wishes to claim.

After a trademark owner submits an IP claim, NeuLevel will notify the owner if a third party applies to register the claimed mark as a domain name, once the registration period opens on June 25.

This process offers several benefits. The owner expends fewer resources to discover infringement, and can respond quickly to protect its mark. NeuLevel will also notify the party applying to register the name that someone else has claimed it, putting that third party on notice that its chosen name may infringe another's trademark. Finally, submitting an IP claim gives the trademark owner access to NeuLevel's dispute resolution process, potentially a faster and less expensive process than a traditional lawsuit.

Submitting an IP claim does **not** provide registration of the claimed mark as a .biz domain. Instead, it functions solely to advise third parties of the trademark

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owner's claim to a given mark. NeuLevel accepts claims from any party without authenticating them, so that multiple parties could claim the same mark or a nonowner could fraudulently claim another's mark.

While this will not prevent a bona fide owner from claiming its mark, it could complicate the dispute resolution process. NeuLevel charges about \$90 per mark for its service.

**Example:** Hypothetical Promotions, Inc. owns a registration for the trademark STAR for use on promotional items, and files an IP claim with NeuLevel during the IP Claim Period in order to prevent others from using the domain name. When registration opens on June 25, Rival Promotions Corporation applies to register star.biz as its domain name. NeuLevel notifies Hypothetical that Rival has applied for the star.biz domain name. It also notifies Rival that Hypothetical has already claimed rights to that domain name. Rival refuses to withdraw its application and registers star.biz. Hypothetical can initiate dispute resolution proceedings against Rival.

### **A caution**

A final word of caution: many domain-name registrars offer preregistration processes that they

claim will help anyone wishing to obtain a particular domain name. These preregistration offers are not the same as the IP Claim Service and sunrise period described above. They are not officially sanctioned by either ICANN or the registry operators.

While the methods used by some of the registrars may increase an applicant's chances of obtaining a particular name, there is no guarantee. Therefore, ICANN and the FTC caution consumers against **paying** for such services.

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