

Intellectual Property & Technology Reporter

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

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PROTECTING TRADEMARKS UNDER NEW .US TOP LEVEL DOMAIN

A new top-level domain (TLD), “.us,” has been recognized by the Internet Corporation for Assigned Names and Numbers (ICANN) as the official country code TLD (ccTLD) for the United States. For this new ccTLD, 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 .us domain name registrations.

The new .us TLD is designed for use by those individuals or organizations that have a substantive connection to the United States. In order to obtain a .us domain name, a registrant must be in compliance with the U.S. Nexus requirement, which requires that all registrants for a .us domain name must be either:

1. A natural person (i) who is a citizen or permanent resident of the United States of America of any of its possessions or territories, or (ii) whose primary place of domicile is in the United States of America or any of its possessions, or
2. An entity or organization that is (i) incorporated within one of the fifty U.S. states, the District of Columbia or any of the United States possessions or territories or (ii) organized or otherwise constituted under the laws of a state of the United States of America, the District of Columbia or any of its possessions or territories, or
3. An entity or organization (including a federal, state or local government of the United States, or a political subdivision thereof) that has a bona fide presence in the United States.

The registry for this new domain will be administered by NeuStar and will be implemented with a three-step process.

Step 1: Sunrise Registration Period (March 4, 2002 – April 9, 2002)

Domain name applicants that own a United States trademark or servicemark that has been registered or applied for with the United States Patent and Trademark Office prior to July 27, 2001 can preregister the mark as a .us domain name. Requested domain names during the Sunrise period must exactly match the trademark application or registration on file with the U.S. Patent and Trademark Office. Special characters within a trademark, such as ~ ‘ @ # \$ % ^ & * () _ + = < > { } [] \ \ /, spaces and punctuation must be eliminated entirely or replaced with hyphens within a domain name.

All .us domain name applications submitted during the Sunrise period must contain the following information:

- Requested .us domain name
- Exact trademark
- Trademark’s date of application
- Trademark’s date of registration (if applicable)
- Trademark’s application number
- Trademark’s registration number (if applicable)
- Trademark’s international industry code
- Trademark owner’s organization name and address (exactly as it appears in the United States Patent and Trademark Office database)
- Names, addresses, telephone numbers, fax numbers and e-mail addresses of the domain name registrant, administrative contact, technical

contact and billing representative (*Note: Domain name registrant must be either the current or original owner of the trademark application or registration*)

- Name servers and their associated IP addresses
- Written confirmation of compliance with usTLD Nexus requirement

There is no fee for a domain name application to the Registry. A Sunrise registration will only be accepted for a minimum registration term of five years and will be processed only after registration fees are paid in full. Market-based retail prices for .us domain names will be established by .us-accredited registrars and their resale channel partners. A list of .us-accredited registrars now accepting Sunrise applications can be found on the website www.buy.us/register/dotus_registrars.html. The pricing structure will be an annual subscription fee with multi-year subscriptions available.

Step 2: Random Selection Process (April 10, 2002 – April 23, 2002)

Preregistration does not ensure that the trademark owner will get the domain name. Where there are multiple

trademark owners of the same mark, NeuStar will process the domain name requests during this period using a random selection process to select one registrant from each pool of qualified applicants for a given domain name.

Step 3: First Come, First Served (Begins April 24, 2002)

All .us domain names selected and registered during the Sunrise period will officially “go live” when the first-come-first-served registration opens. At this time, new .us domain names not registered during the Sunrise period or reserved by the Registry may be registered on a first-come-first-served basis.

If you have any questions regarding the information provided herein, please contact Michael Turgeon (312-609-7716). Please feel free to also contact Angelo Bufalino (312-609-7850), Joe Krause (312-609-7536), Chris Reckcamp (312-609-7599), or Chris Moreno (312-609-7797) regarding any questions and comments you may have.

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We welcome your suggestions for future articles. Please call Angelo J. Bufalino, the Intellectual Property and Technology Practice Leader at (312) 609-7850 with suggested topics (or other suggestions or comments concerning materials in this newsletter).

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Technology and Intellectual Property Group

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