
Intellectual Property Legal Alert: Trademark Owners Able to Pre-Register .CO Domain Names

Legal Alert

April 7, 2010

The country of Columbia is assigned the country code top-level domain ".co" and regulates the use of all domain names ending in ".co", such as the domain <http://www.google.com>. For the first time, Columbia is opening the availability of ".co" domains to the public and permitting companies and individuals around the globe to register and use these domains. This is significant because ".co" websites are a common destination for internet users mistyping website addresses ending in top-level domains such as ".com", ".co.uk", ".ca", and ".co.au". For example, it is estimated that 15,000 internet users per day unintentionally visit <http://www.google.com>.

Between April 26, 2010 and June 10, 2010, trademark owners around the globe are able to pre-register domain names ending in ".co" containing their brand names and to prevent these domains from being made available to the general public. To qualify, the trademark owner must own a valid trademark registration in a recognized jurisdiction (a registration in the United States Patent and Trademark Office, for example), issued before July 30, 2008. The pre-registered domain name must be identical to the registered trademark. However, if the registered trademark consists of multiple words or a phrase (i.e. "Google Books"), the trademark owner will be able to pre-register the phrase in multiple formats (<http://books.google.com/>). In the event two trademark owners own qualifying registrations for the same trademark, an auction will be conducted to determine the owner.

For qualifying trademark owners, this is a key opportunity to own a valuable ".co" domain containing their trademark for the minimal cost of registration. Perhaps more importantly, it is also an opportunity to prevent others ("cybersquatters") from registering their brand names and using those brand names to divert internet traffic away from the trademark owners in a manner that is misleading and harmful to the trademark owners. If cybersquatting is discovered at a later date, the cost of taking domains away from the cybersquatter can be higher than the cost of registering valuable domains containing trademarks in the first instance.

For trademark owners that own unregistered trademarks, trademark applications, or trademark registrations issued *after* July 30, 2008, they can still register a ".co" domain name containing their trademark as early as June 21, 2010, when the domains are more publicly available. They should also be vigilant regarding the potential for cybersquatting at ".co" domains, particularly given the likely popularity of the new ".co" domains and the potential for confusion with ".com" domains.

For more information regarding the ".co" pre-registration program, or for questions about whether you qualify for participation in this program, please feel free to contact Alexis Arena or any member of the Intellectual Property Practice Group at Flaster Greenberg PC.

Trademark, Copyright and Internet Practice

Members of Flaster Greenberg's Intellectual Property Practice Group have expertise in areas of trademark, copyright, and unfair competition strategic counseling, litigation, licensing, and prosecution matters. These matters include trademarks, trade dress, product configuration, unfair competition, trade secrets, copyrights, false advertising, and Internet-related intellectual property issues. They have experience combating cybersquatting around the globe and have successfully won rights to domains in domain dispute proceedings before the World Intellectual Property Organization, the National Arbitration Forum, and the Hong Kong International Arbitration Forum. Our attorneys practicing trademark, copyright and internet law advise clients on how online trademark infringement can be monitored and prevented.