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The Launch of the .xxx Top Level Domain Name Protecting your Brand's Reputation

The organization that controls most of the Internet's gTLD's (generic top level domain names, such as .com and .net) has approved the use of .xxx as a new gTLD. That has a number of trade-mark owners worried about the potential for reputational risk or damage to goodwill with the registration in the .xxx domain of their brands. The .xxx gTLD is for use by those involved in the adult entertainment industry. For everyone else, the thought of a brand being associated with this gTLD is somewhat concerning.

First proposed in 2000, the .xxx gTLD met with considerable resistance, and significant public opinion and commentary but was finally approved in the spring of this year.

To address the concerns of trade-mark owners, among others, particular procedures with respect to registration come into effect on September 7, 2011 and will run until October 28, 2011. This initial period, referred to as the "*Sunrise Period*" will enable trade-mark registrants to take steps to block the registration by a third party of their trade-mark in the .xxx gTLD. During the Sunrise Period, any trade-mark owner who wants to block the potential registration of their mark as a domain name can apply to have the trade-mark appear on a 'reserved list'. Reserved names will be set aside indicating and cannot later be adopted by an applicant.

In order to be protected, a trade-mark must be one that achieved registration prior to September 1, 2011 and which is in full force and effect at the time of application for reservation as a blocked domain. Reservation as a blocked domain name will be available on the WHOIS search engine to indicate that the name is 'taken' or reserved, but will not list the owner.

If during the Sunrise Period more than one applicant for the domain name (including an applicant for a blocked or reserved domain name and a competing application for a domain name reservation) has been submitted, both applicants will be notified. An application may then proceed, but the competing applicant will be deemed to have received notice of the application in any subsequent dispute resolution proceeding.

By making application under the gTLD, each applicant is required to submit to the uniform dispute resolution policies of the Registrar. The registry handling the .xxx gTLD (ICM Registry LLC) also has a 'rapid evaluation service' (RES) designed to address

objectively clear abuse of well-known, distinctive registered trade-marks or personal or professional names of individuals. Pursuant to the RES, a preliminary decision of a complaint will be made within 2 business days of a proper filing of complaint. If the panel of evaluators determines that the complaint presents a strong case of irreparable harm and no substantial likelihood of harm to the respondent, then the domain name will be immediately disabled.

If you have a registered trade-mark and are concerned about brand reputation, you might consider applying to block the registration during the Sunrise Period. If you do not have a registered mark for key brands, you might consider filing an application for registration, and in the meantime, establishing a watch over the trade-marks. If you discover what you believe to be an inappropriate use of your trade-mark by third party registration in the .XXX gTLD, then you should consider your options in filing dispute with the registry over the registration of the domain name and other potential trade-mark infringement actions.

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