

.xxx Domain Names to Become Available from September 2011

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The Internet Corporation for Assigned Names and Numbers recently approved the use of the .xxx suffix as a top-level domain name space, to be used by the online adult entertainment industry.

The Internet Corporation for Assigned Names and Numbers recently approved the use of the .xxx suffix as a top-level domain ('TLD') name space, to be used by the online adult entertainment industry. The .xxx domain name would be used alongside other TLDs name spaces including .com, .gov and .org. As of September 2011, existing trade mark owners or those with an existing domain name will be able to either 'opt-out of' or 'opt-in to' the newly formed domain name during the simultaneous 'sunrise periods'. Given that the opt-in and opt-out periods will only last for 30 days, those considering applying for the TLD (either actively or defensively) are advised to take action now, to ascertain which of their trade marks or brands should be protected when the Sunrise period begins.

Having initially received approval for the .xxx TLD in 2005, the approval was rescinded following protests from politically conservative groups. However, it is now widely recognised that such a domain name will make it easier to filter out inappropriate content.

Sunrise Periods

During Sunrise A (which will last for 30 days), members of the adult entertainment industry will be able to reserve a domain name, if they already own and operate an identical second level domain name in an existing TLD: the 'opt-in' period.

Concurrently, during Sunrise B (which also lasts for 30 days), brand owners from outside the adult entertainment industry with a prior-registered trade mark would be able to block their trade mark from being registered with an .xxx domain: the 'opt-out' period. To successfully register during Sunrise B, several criteria need to be satisfied: (i) a person must own and actively use a trade mark; (ii) the trade mark must be registered prior to the submission of a Sunrise B application; and (iii) the trade mark or domain name must corresponds exactly to the entire text of a work mark or textual component of a word and design mark. It is expected that once blocked, the ICM Registry, the group responsible for the .xxx TLD, will be required to remove the domain from the pool of available registrations for ten years. Those wishing to use the service will be required to pay a one-off fee of between US\$200 - \$300 for each trade mark or domain name they wish to block.

If a Sunrise A and Sunrise B application are submitted for the same trade mark, the Sunrise A applicant will be informed of the Sunrise B application, and thus given the opportunity to withdraw its application. However, if the Sunrise A applicant chooses to nonetheless proceed with the application, it will secure the domain name. This will be of importance in the future with regards to parties being put on notice, should a legal dispute arise.

A successful opting-out will mean that the trade mark in question will be removed from the pool of names available for registration. The corresponding domain name will link to placeholder page noting that the domain name is not available for registration. This will prevent the hijacking of the domain name. If a party does not own a trade mark, it will not be able to opt-out during the Sunrise B period, or register an .xxx domain, even if it is doing so for defensive purposes. However, there is expected to be a 'general availability' period during which it will be possible to block .xxx domain registrations for those whose trade mark is issued after the Sunrise B. The general availability period will start shortly after the end of Sunrise A and B.

Conclusion

Trade mark owners are advised to make use of the Sunrise B opt-out period, to block the potential registration of any of their trade marks. This would avoid potential future protracted legal battles. Those who use a brand or logo as a trade mark, which is not yet registered, are advised to apply for immediate registration, in order to be able to make use of the Sunrise B application. Furthermore, trade mark owners are advised to check whether or not their watch service providers monitor .xxx domain name registrations.

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