



Client Alert

September 7, 2011

Protecting Your Trademarks In The New .xxx Domain Space

Beginning on September 7, 2011, a new sponsored top-level domain (sTLD), .xxx, will be available for domain name registration. This action has been approved by The Internet Corporation for Assigned Names and Numbers (ICANN). The .xxx sTLD is specifically designed for the online adult entertainment industry. For trademark owners outside of the adult entertainment industry, .xxx presents a concern. Specifically, the YourBrand.xxx domain name could soon be used to provide pornographic materials.

There are steps available that can be taken to avoid this potential problem. Concurrent sunrise periods will run from September 7, 2011 through October 28, 2011, during which owners of registered trademarks both inside and outside the adult entertainment industry may take action to reserve .xxx sTLDs corresponding to those marks before the domains are available for purchase to the general public. "Sunrise A" is reserved for owners of registered trademarks or other top-level domains that are already being used in the adult entertainment industry. "Sunrise B" is for non-adult industry owners of registered trademarks, who can reserve their YourBrand.xxx domains, thus preventing another from registering and using those domains for adult content.

To reserve a YourBrand.xxx domain during the Sunrise B period, trademark registrations must be in effect as of September 1, 2011, and the registration for the exact corresponding mark must be either on the USPTO's Principal Register or with the trademark office of a foreign jurisdiction. Details of that trademark registration, along with a one-time fee must be provided. To reserve (block) your registered trademarks from being registered in the .xxx domain space, a registration filing will need to be made with one of the approved .xxx registrars, such as *GoDaddy.com* and *Network Solutions*. It is estimated that the registrar's fee for this filing will be in the \$200-\$400 range. If this registration is completed, the specific .xxx sTLD will resolve to an informational page stating that domain has been reserved. You, as the trademark owner, will not actually own the .xxx domain and will not be listed in public WHOIS database.

An application to reserve a YourBrand.xxx domain name during Sunrise B may not be successful if someone else applies for the same domain based on a registration for the same mark with adult products or services. In that case, the owner of that registration (for adult products and services) will obtain the domain.

Once the Sunrise B period is closed, it will still be possible to pursue domain name disputes related to the .xxx sTLD through the existing Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP is applicable to the bad faith registration and use of second level domain names that are identical or confusingly similar to another's trademark. Reservation of domain names during the Sunrise B period will be much less costly than trying to recover domain names later through a domain name dispute proceeding or other legal action. Owners of registered trademarks should consider which of those marks are of most importance and submit reservation requests for the corresponding .xxx sTLDs once the Sunrise Period opens.

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