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## LIMITED WINDOW TO PREVENT TRADEMARK USES IN INTERNET RED LIGHT DISTRICT DOMAINS (.XXX)

By Brian P. Gregg

As of September 7, 2011 the Internet Corporation for Assigned Names and Numbers (ICANN) will begin offering .xxx domain registrations. The registry will be operated by Florida-based ICM Registry (ICM), the company that first applied for the .xxx domain in 2004. ICM's intent is to create designated domains for adult content which are operated under its policies which are intended to reduce malware, SPAM, and intellectual property infringement. The .xxx domain also represents the creation of new internet real estate and, because any string ending with .xxx can be purchased, the launch of .xxx represents an opportunity for domain squatters and trademark infringers. In other words, your trademark could become associated with a .xxx domain and website. Fortunately, you have options to prevent this from occurring.

### Sunrise B Opt-Out Period

Owners of registered trademarks who are not involved in the adult entertainment industry, and who do not want their trademarks to appear in a .xxx domain owned by a third party will have the opportunity to prevent such domains from being purchased – but only if they act during a limited period of time. ICM



Registry has provided an opt-out period called Sunrise B for owners of registered trademarks to block .xxx domains that contain their registered marks. The key facts you should know about Sunrise B:

- The Sunrise B **opt-out period** will open **September 7, 2011** and close **October 28, 2011**.
- After the opt-out period closes, trademark owners will not be able to block the purchase by third parties of .xxx domains which contain their trademarks.
- Sunrise B only applies for **federally registered trademarks** which register as of September 1, 2011 and does not pertain to state registrations, common law marks, unregistered marks, business names, or other domains.
- Sunrise B will only allow trademark owners to block their exact marks; similar marks may still be registered by third parties.

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## Procedure To Block .xxx Domains

ICM's Comprehensive Launch Policies have not yet been published but trademark owners will be able to block .xxx domains, or obtain more information on blocking the registration of their trademarks as .xxx domain, by visiting ICM Registry's Sunrise B page at <https://www.icmregistry.com/launch/sunrise-b/>. There is a fee, expected to be between \$200-\$300, to block each .xxx domain and that protection would protect your trademark for up to 10 years.

### Defensive Moves for Those Without Registered Marks

For those unable to take advantage of the Sunrise B opt-out period, and after the Sunrise B period ends on October 28, 2011, the next best method to prevent registration by a third party of an .xxx domain containing a trademark is to register the domain defensively. In many instances, owning the .xxx domain for any trademarks or terms likely

to be confused with trademarks may be the best defense against abuse of a trademark through a .xxx registration.

For more information, or for assistance with filing to block your trademark from .xxx domain registrations please contact:

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