

Protecting Your Trademark From Salacious Use: Action Required to Opt-Out of Domain Extension

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The Internet Corporation for Assigned Names and Numbers (“ICANN”), the agency that is responsible for creating and implementing sponsored top-level domains (sTLD), recently approved the implementation of the domain “.xxx” to be used for adult or pornographic sites on the Internet. While the implementation of this sTLD had been debated for many years and was previously rejected by ICANN for a variety of reasons, it is now available for use and registration.

For companies and individuals who do not want to be associated with the adult entertainment industry, and do not want their trademarks to be registered as domains with the “.xxx” sTLD, there is an opt-out option by which you can file an application and pay a fee to block your trademark registration from being registered as an “.xxx” domain. While some companies may not want to pay the fee to block their registration, such payment could prove to be cost-effective considering that the costs to enforce against a potential infringer and take legal action may be far greater.

In order to block your trademark from being registered with the “.xxx” sTLD, the mark you are trying to block must be a registered trademark and must have been registered in any country prior to September 1, 2011. Applications will need to be filed with an accredited domain registrar between September 7, 2011 and October 28, 2011. The cost of filing the application is between \$200-300 per trademark. By filing the application, other parties will be prevented from registering your trademark in connection with the “.xxx” domain name.

It is important to note that registration of domains by those in the adult entertainment industry are given priority. For instance, Applicant A owns a trademark registration for adult entertainment related goods or services. Applicant B owns a trademark registration for

the same trademark but for non-adult entertainment goods or services. If Applicant A files an application for the domain, and Applicant B subsequently files an application to opt-out, Applicant A will be given priority and the domain will be registered.

Clients with trademarks who wish to file applications to opt-out should contact counsel before the October 28, 2011 deadline for assistance with the filing.



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