

Introduction of .xxx websites – protecting your brand

October 12th, 2011 by [Fladgate LLP](#)

This year sees the introduction of “adult” website domain names, with a “.xxx” suffix (or TLD) (as opposed to the usual .com, .co.uk etc.).

This new TLD is designed for the adult industry, but trademark owners that are not in the adult industry can apply to block the registration of .xxx domain names that correspond to their registered trademarks during a “sunrise period” that ends on 28 October 2011. Blocked domain names will point to a standard informational page indicating that the domain name is unavailable for registration.

Brand owners will want to ensure that their brand is not “hijacked” by adult content providers, so we can expect immediate applications to block names such as “apple.xxx”, “pepsi.xxx” and “hilton.xxx”. Any brand which trades on its reputation would be well advised to consider registering a blocking application.

To be eligible to submit such an application, you must own a registered trademark that:

- is a trade or service mark registration of national or regional international effect; and
- was issued prior to 1 September 2011.

It appears from the guidance that this reservation provision will only cover the exact mark as it is registered; third parties will still be able to register misspelled or other variations of the mark in .xxx domains.

During the sunrise period, members of the adult industry may apply to register a .xxx domain name. They must either be able to satisfy the same trademark ownership criteria identified above, or they must already operate the same domain under a different domain extension, such as .com.

At the end of the sunrise period, if no conflicting application is made by a member of the adult entertainment industry who is able to establish a claim to the mark, the .xxx domain name can be blocked from registration for a period of up to ten years (renewable).

If a member of the adult industry submits an acceptable application to register a domain it may still register the domain, even if it conflicts with a trademark owner’s application to block a registration. However, it will be notified of the rights of the trademark owner that



wishes to block the registration. This may assist the trademark owner if they later wish to object to the registration as abusive.

Having a registered mark is the only way to secure an opt-out from .xxx during the sunrise period. After the sunrise period ends, members of the adult industry may apply to register any .xxx domain name that is still available, whether or not they can prove any claim to the domain.

As with any current domain name registry, once the general availability phase is open, the registry will be run on a first come, first served basis with no pre-emptive rights protection in place. Although there will be post launch rights protection mechanisms in place, these would be limited in scope, and we believe that “prevention is better than cure” is the best approach to take.

Brand owners that wish to apply to block the registration of a specific .xxx domain name need to apply via an accredited registrar. Each registrar may set their own end user pricing but fees generally range between £100 and £400 per mark.

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