

September 2011

### TRADEMARK AND TECHNOLOGY LAW ALERT

#### PROTECTING YOUR TRADEMARK: PREVENTING THE USE OF A REGISTERED TRADEMARK IN A .XXX DOMAIN NAME

*Trademark Owners Have Until October 28 To Block the Registration of Their Trademarks as Adult Content Domains*

The Internet Corporation for Assigned Names and Numbers (ICANN) has approved a new .xxx top-level domain that is intended for use by the adult entertainment industry to identify websites with adult content. ICM Registry (ICM) began the administration of the new domain earlier this year.

From now until **October 28, 2011**, under the pre-launch "sunrise" rules of ICM, owners of trademarks registered before September 1, 2011 are eligible to block their trademarks from being registered as .xxx domains.

During the so-called "Sunrise B" period, registered trademark owners outside the adult entertainment community may apply to block the use of their trademark as a .xxx domain for a period of ten years by reserving the name through an accredited registrar of the .xxx domain and paying a one-time processing fee, typically between \$200 and \$400, depending on the registrar used. GoDaddy and Network Solutions are among the larger registrars based in the United States that are processing applications relating to the .xxx domain. A complete list of the participating registrars is available at <http://www.icmregistry.com/registrars>. Not every ICANN-accredited registrar is participating in this program, so trademark owners should check this list carefully.

As part of the application process, registered trademark owners will be required to provide the registration number of their trademark, the date that the trademark was registered and the country of registration. The trademark must correspond to the .xxx domain for which a blocking application is being filed.

Brand owners who successfully block a .xxx domain will likely enjoy this protection for at least ten years. However, they will not have the right to use the blocked domain, nor will anyone else.

Because the process does not involve the registration of the actual domain name, once the .xxx domains become active, if a user enters the reserved domain name in a browser address bar, it will return a standardized information page indicating that the domain name is reserved rather than resolving to an actual website.

Members of the adult entertainment community that are owners of registered trademarks used in connection with an adult entertainment business or that have an existing domain name in another domain are given an opportunity under the so-called "Sunrise A" application process to apply by October 28, 2011 for a .xxx domain name corresponding to the registered trademark or the existing domain name.

If there are competing applications between Sunrise A and Sunrise B applicants, notice will be given to both applicants but priority will be given to the Sunrise A applicant to register the domain name. If a member of the adult entertainment community (the Sunrise A applicant) proceeds with the registration of the domain name, it will be deemed to be on

*(Please see next page for more information.)*

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notice of the intellectual property rights of the Sunrise B applicant and may not claim lack of notice in a domain name dispute proceeding.

Owners of unregistered (common law) trademarks and those having other rights such as trade names and registered domain names in other domains, as well as those having pending trademark registration applications, are not eligible to submit an application to block their use as .xxx domains but can register for a non-resolving .xxx domain name beginning on December 6, 2011 during the general availability period on a first come, first served basis. Registrants during the general availability period will be required to pay a domain name registration fee and an additional registration fee each time the registration is renewed. Owners of registered trademarks outside the adult entertainment community who miss the October 28 deadline for applying to block their trademarks from being registered as .xxx domains can also apply beginning December 6, 2011 to register for a non-resolving .xxx domain, but by waiting run a greater risk that the domain will no longer be available.

**All registered trademark owners are urged to consider seriously acting now to reserve a .xxx domain for their trademark, thereby blocking someone else from obtaining a .xxx domain in which their trademark appears before the “.xxx.” Cybersquatting is an ever present danger online. There is a substantial risk that a cybersquatter may seek to register your trademark as a .xxx domain and create an unwanted and harmful association between your trademark and adult content.**

We are available to provide counsel concerning these issues, as well as other trademark and technology-related issues. For additional information, please contact the attorneys named below or the attorney with whom you have a primary relationship.

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