

Publications

Client Alert: Trademark Owners: Block Your Trademarks in the New .XXX Domain

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The new .XXX top-level domain that launches next month allows brand owners to “opt-out” and block their trademarks from being used in an .XXX domain name. Trademark owners may apply to reserve their trademarks, so they are not available for others to register in the .XXX domain.

The .XXX domain is for the adult entertainment industry and only individuals, businesses, entities, and organizations that provide online, sexually-oriented adult entertainment are eligible to register .XXX domain names. The .XXX domain is not part of the new domain program opening in January 2012, which allows businesses and organizations to apply for their own custom domain name extensions ([see our client alert at publications-450.html](#)).

ICM Registry LLC, the operator of the .XXX domain, is providing a Sunrise registration period for trademark owners not in the adult entertainment industry to block domain names that correspond to their trademarks. This “Sunrise B” registration period for trademark owners opens next month and runs from September 7 through October 28. Brand owners are eligible to apply if they hold a U.S. federal trademark registration, or an equivalent registration in another country, which issued prior to September 1, 2011. U.S. federal trademark registrations on the Supplemental Register, unregistered (“common law”) trademarks, trade names, domains, and U.S. state trademark registrations are not eligible. Brand owners must pay a one-time fee of approximately \$300 per trademark, which will block the .XXX domain for ten years.

A separate “Sunrise A” registration period is available for applicants in the adult entertainment industry that own registered trademarks, or have a domain registration in another top-level domain, if they wish to register an .XXX domain. If a trademark owner outside the adult entertainment industry and a qualified applicant in the adult entertainment industry both apply for the exact same .XXX domain, both parties will be notified, but priority will be given to the adult entertainment industry applicant to register the domain name.

Domain registrations in .XXX will be open to anyone in the adult entertainment industry after December 6.

Applying to block a trademark during the Sunrise registration period is not a perfect solution. Brand owners may only block .XXX domains that exactly match their eligible registered trademarks and cannot block common misspellings or confusingly similar terms. But reserving domain names that correspond to important registered trademarks is a simple and cost effective measure that may avoid problems in the future.

Trademark owners can currently pre-register to block their trademarks in the .XXX domain. A list of participating domain registrars is available at <http://www.icmregistry.com/registrars/>.