



Trademark Protection

ALERT

OCTOBER 2011

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“Last Call” to Protect Your Trademark in the “.xxx” Top-Level-Domain

ICM Registry LLC has launched the registration process for the new “.xxx” top-level domain (“TLD”), which will provide an exclusive domain for websites that contain adult orientated content. Although the .xxx TLD is designed specifically for the adult entertainment industry, trademark owners who are not in the industry can permanently block the registration of a registered trademark in the “.xxx” TLD during the pre-launch “Sunrise B” period, which ends on **October 28, 2011**. For trademark owners who are not in the adult entertainment industry, registered .xxx domain names will not resolve to the trademark owners’ websites but rather to a standard informational page reflecting the status of the name as reserved.

In order to qualify for a Sunrise B reservation, a party must own a valid trademark registration that was issued prior to September 1, 2011. Sunrise B reservations are relatively inexpensive, and are available through one of the accredited “.xxx” registrars, accessible here. Applicants for Sunrise B reservations will be required to submit the following information: (1) the registered trademark corresponding to the name to be registered or reserved; (2) the country, region, or organization in which the registered trademark is registered; (3) the current registration number of the registered trademark; (4) the date on which the trademark registration was submitted, and the date on which the registered trademark was issued; (5) the class or classes for which the trademark is registered; and (6) the status of the Applicant (e.g., the owner, licensee, or assignees of the registered trademark). Sunrise B applicants will be charged a non-refundable one-time fee to permanently register “.xxx” domain names.

It is important to note that there is also a “Sunrise A” period (also ending on October 28, 2011) during which companies in the adult entertainment industry may register .xxx domain names that correspond with their registered trademarks and/or domain names in other TLDs. A Sunrise A applicant will be

given priority over a Sunrise B applicant where the Sunrise A applicant requests registration of a “.xxx” domain name that is identical to a mark designated by a Sunrise B applicant.

The next pre-launch phase of “.xxx” registration, “Landrush”, begins on November 8 and lasts for 17 days. During the “Landrush” phase, companies in the adult entertainment industry who did not qualify for Sunrise A registrations will be able to register “.xxx” domain names on a first-come, first-served basis.

The general availability registration period for “.xxx” domain names begins on December 6, 2011. Beginning December 6, anyone may register a “.xxx” domain name on a first-come, first-served basis. Owners of pending federal applications that have not yet proceeded to registration, owners of previously-registered trademarks which have since lapsed or abandoned, owners of common law trademarks and owners of trademarks which otherwise do not qualify for the Sunrise B registration may defensively register their trademarks as .xxx domain names, if available, beginning December 6, 2011.

The pre-launch reservation and registration process does not prevent a trademark owner who is unsuccessful in obtaining its marks as corresponding domain names in the “.xxx” TLD from seeking to protect against unlawful use of its trademark(s) in the “.xxx” domain using currently available methods, such as the ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) proceeding and conventional civil causes of action under the applicable trademark laws. In addition, two new dispute procedures have been established to address grievances specific to the “.xxx” TLD. The Charter Eligibility Dispute Resolution Procedure (CEDRP) is designed to resolve challenges to registered names in the “.xxx” TLD (i.e., domain names resolving to websites) on the basis of alleged use

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inconsistent with the qualifications for registration; the CEDRP does not apply to reserved names in the “.xxx” TLD. The Rapid Evaluation Service (RES) policy addresses situations involving a clear abuse of (i) well-known, distinctive trade or service marks of significant commercial value; or (ii) personal or professional names of individuals. Determinations under the RES will immediately halt resolution of the name to the “.xxx” website, but will not prejudice either party’s election to pursue an alternative dispute mechanism. Both the CEDRP and the RES will be administered by the National Arbitration Forum. Copies of the CEDRP and RES policies are available on ICM Registry’s website.

If you have questions, or would like assistance in registering or reserving a domain name in the “.xxx” TLD, please contact David Grace at dgrace@loeb.com or Melanie Howard at mhoward@loeb.com.

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