

Trademark Alert

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Do You Want Your Name to Be Part of a New .XXX Domain? What Trademark Owners Need to Know

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There is a great deal of controversy and debate among brand owners about how to deal with the issuance of new top-level domains (TLD) by the Internet Corporation for Assigned Names and Numbers (ICANN). Should they defensively register all their trademarks under every newly issued TLD to avoid potential problems with cybersquatters or should they refuse to be forced into doing so and just address specific problems when they arise?

In most cases, the issue involves a fairly innocuous TLD. However, the recently approved .XXX TLD is of a different variety. ICANN has designated this TLD for specific use in domains for websites with adult content, something with which many brand owners may not want their trademarks associated in any form.

The ICM Registry has been selected to maintain the .XXX TLD. Preceding the rollout of the .XXX TLD, the Registry is offering two mechanisms intended to protect trademark owners who do not want their trademarks associated with the .XXX domain.

- Preregistration is a free service whereby specific domains using the .XXX TLD can be prerequested. The benefit of this no-obligation request is that notification will be sent to all who preregistered when a date is set for formal registration to begin. This communication will provide the specific forms, details, and procedures for filing defensive registrations during the "Sunrise B" period described below.
- Upon commencement of the Sunrise B period, trademark owners who are *not* members of the adult entertainment industry will be allowed to file defensive registrations to block .XXX domain names corresponding to their trademarks. For a one-time fee (which has not yet been disclosed), a trademark owner can register the relevant trademark.xxx domain and have it indefinitely blocked from active use.

Firm dates for the beginning of Sunrise B are not yet known, but reports indicate that it could begin as early as June of this year. Further, priority is given to parties who held domain names in other TLDs prior to February 1, 2010.

In making a decision on how to deal with this new TLD, keep in mind that obtaining a defensive registration is a much more cost-effective method of preventing cybersquatting than is attempting to obtain the domain name later from a third party through, for example, the Uniform Domain-Name Dispute-Resolution Policy or the Anti-Cybersquatting Consumer Protection Act.

If you have any questions or would like us to assist you in protecting your assets during this process,

please contact your Mintz Levin attorney or one of the trademark attorneys located via the link below.

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