

Protect Your Trademarks From .XXX Infringers—Reserve Marks Before Oct. 28

by Robert B. Burlingame

After more than a decade of heated debate, the .xxx Top Level Domain (i.e., domain names ending in .xxx rather than .com) is about to launch, and a critical “sunrise period” for trademark owners opened today, September 7.

It is expected that many people will rush to register numerous .xxx domain names, and trademark owners are justifiably concerned that cybersquatters and infringers may seek to register .xxx domain names containing the owners' marks. This is particularly concerning for some owners given that the .xxx domain names are intended for websites relating to the adult entertainment industry.

Sunrise Period for Trademark Owners Ends October 28

To address trademark owners' concerns, the .xxx registry has included several different registration periods preceding the launch:

- **Sunrise A:** From September 7, 2011, to October 28, 2011, members of the adult entertainment industry can apply to register .xxx domain names corresponding to their existing trademark and/or domain name rights.
- **Sunrise B:** Also from September 7, 2011, to October 28, 2011, trademark owners from outside the adult entertainment industry can apply to reserve (and thus block others from registering) .xxx domain names corresponding to their registered trademarks. The trademark can be registered in any country, and there are a few instances where the trademark in the reservation request may differ from the registered trademark (e.g., spaces and certain characters such as “&” and “@” appearing in the registered trademark may be removed or replaced with hyphens).
- **Land Rush:** From November 8, 2011, to November 25, 2011, members of the adult entertainment industry can apply to register any available .xxx domain names they desire. If more than one applicant applies for the same domain name, a closed “mini-auction” will be held between those competing applicants.

- **General Availability:** Starting December 6, 2011, anyone may register any available .xxx domain names they desire, and unlike the above-identified Sunrise and Land Rush periods, the registrations will be issued on a first-come, first-served basis. However, because .xxx domain names may only be used in connection with the adult entertainment industry, those who register .xxx domain names but are not members of the adult entertainment industry cannot have their .xxx domain names resolve (i.e., their .xxx domain names will not lead to any active webpage).

Fees and Process

Recognizing the dangers and costs associated with trying to recover an infringing domain name from an unauthorized user, many trademark owners outside the adult entertainment industry will request reservations during the Sunrise B period.

For such Sunrise B applicants, the fee for making a reservation depends on the domain name registrar through which the reservation is made (e.g., GoDaddy will apparently charge \$199.99 per mark), and most are charging approximately \$200-300 per mark (even if multiple parties reserve the same mark). The list of accredited .xxx registrars can be viewed at <http://www.icmregistry.com/registrars/>.

If the reservation is granted to the Sunrise B applicant, it does not give that trademark owner any right to own or use a .xxx domain name and instead simply blocks others (for 10 years in most instances) from registering .xxx domain names corresponding to that registered trademark. The reserving parties' names (again, it is possible that more than one Sunrise B applicant will request a reservation for the same mark, and in those instances, the applicants will be notified about each other's reservation request) will not appear in the WHOIS database for the blocked domain names, and the blocked domain names will lead to a standard informational webpage that states that the domain name is unavailable.

If a Sunrise A applicant requests a domain name that is subject to a reservation request by a Sunrise B applicant, each applicant will be notified, and the Sunrise A applicant will be given an opportunity to withdraw its request. However, if the Sunrise A applicant does not withdraw its request, the domain name will be awarded to the Sunrise A applicant.

Best Next Steps

Apart from the relation to the adult entertainment industry, this .xxx roll-out presents many of the same issues as previous roll-outs of domain name extensions (e.g., .BIZ, .INFO) and is subject to the same abuses as the existing domain name registration systems.

The costs of registering a domain name and reserving a .xxx domain name are relatively small compared to the costs of trying to recover or shut down an offending website, but the large array of trademarks and permutations thereof can present an enormous number of domain name possibilities and huge prophylactic expense to trademark owners.

Consequently, we recommend that trademark owners outside the adult entertainment industry:

- reserve, during the Sunrise B period (i.e., now through October 28), .xxx domain names corresponding to their primary registered marks; and then
- register, during the General Availability period (starting December 6), .xxx domain names of interest that were not covered/blocked by earlier reservations (e.g., unregistered trademarks, names containing

the trademark with additional terms, trademark misspellings) in order to further thwart cybersquatters and infringers.

If you have questions, please contact the Pillsbury attorney with whom you regularly work or the author.

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