

Protecting Your Trademarks in the World of .XXX Domain Names

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As you may have heard, to go along with .com, .net, and the other current top-level domains ("TLD"s), the Internet Corporation for Assigned Names and Numbers ("ICANN") has recently approved the formation of a new .xxx TLD for websites related to the adult entertainment industry.

Since the .xxx TLD is intended for the adult entertainment industry, applicants who want to set up .xxx websites will need to certify that they are in the industry; however, there is little doubt that cybersquatters and other entities will attempt to register .xxx domains related to well-known brands. Because of this, many trademark owners are asking: how can I prevent my trademark from being associated with pornography and adult entertainment services? Thankfully, a system has been set up to deal with this question.

While the .xxx domains are not available yet, a registry known as ICM has been picked as the registry that will administer .xxx. On March 31, ICM and ICANN signed their contract officially appointing ICM as the .xxx registry. As part of its initial set-up of the .xxx system, ICM is putting in place a series of protections for trademark owners.

First, trademark owners can "pre-register" their marks with ICM through its website. This is available right now, and more than 500,000 marks have been pre-registered in the past several weeks.

Second, there will be a pre-launch "sunrise" period, for trademark owners whose products and services are not related to the adult entertainment industry. During this sunrise period, trademark owners will be able to reserve/block specific .xxx domain names from becoming available to others. According to current information, the sunrise period should start approximately 60-90 days after the March 31 signing of the ICANN contract. The sunrise period will likely last for approximately 30 days, during which time brand owners can pay a (not yet established) one-time fee to block their mark from being registered as an .xxx domain. While a proper sunrise registration will be necessary to reserve and block .xxx domains, a benefit of pre-registering is that, according to ICM, it will contact



pre-registered brand owners with all the necessary information, forms, etc., as soon as the sunrise period opens. Once registered, Internet users who attempt to access YourTrademark.xxx will get a generic parked web page with a message to the effect of: "this name has been reserved from registration under the ICM registry IP protection program."

Third, a "Start Up Trademark Opposition Procedure" (STOP) will be available for 90 days, starting around May 30. During the STOP period, brand owners can prevent a proposed infringing name from being activated for a limited time while a (not yet specified) opposition procedure takes place.

Fourth, ICM will institute a "Rapid Takedown" procedure for clearly abusive registrations. A trademark owner need only supply a "simple statement of a claim involving a well-known or otherwise inherently distinctive mark and a domain name for which no conceivable good faith basis exists." A "response team" will decide within 48 hours whether to suspend the domain pending a full Uniform Domain Name Dispute Resolution Policy (UDRP) proceeding.

While still subject to tweaks and changes, these are the current protections in place for trademark owners, according to ICM and the ICM/ICANN contract. After the sunrise period is over, it appears that trademark owners will still be able to make "defensive registrations" that will resolve to the "reserved from registration" web page. These defensive registrations will likely be less expensive than regular .xxx registrations, but they may be subject to annual fees (rather than the one-time fee available in the sunrise period).

Although legal avenues are available to go after infringements and squatting violations when they occur, use of ICM's pre-registration, sunrise and STOP programs to block specific .xxx domains at the outset will be a quick and cost-effective way of preventing some headaches.

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