

E-ALERT | Domain Names

August 3, 2011

PROTECTING YOUR MARKS AGAINST ABUSE IN .XXX

The .xxx Top Level Domain will launch on September 7, 2011. ICM Registry, the registry operator, intends .xxx to serve individuals and entities that provide “online sexually-oriented Adult Entertainment for consenting adults,” and representatives of and suppliers to those providers (the “Adult Entertainment Industry”). To protect their marks from abuse in .xxx without having their marks associated with an .xxx website, trademark owners can register “non-resolving” or “blocking” .xxx domain names. A rapid take-down process for abuse of well-known registered word marks or personal or professional names of individuals will be available. Trademark owners should prepare now their defensive registration and offensive enforcement strategies for .xxx.

SUNRISE “BLOCKING” REGISTRATIONS IN .XXX

The Sunrise period runs from September 7- October 28, 2011. During Sunrise, a trademark owner or its authorized licensee may request the .xxx domain name that matches the word elements of its nationally or regionally (e.g., Community Trade Mark) registered trademark that registered before September 1, 2011. The qualifying trademark registration must issue where the trademark owner is engaged in bona fide commerce, but no evidence of use is required. Sunrise A is for Adult Entertainment Industry trademark owners and domain name registrants, who can request the .xxx domain names that match their second-level domain names (to the left of the dot) in other TLDs. Sunrise B is for trademark owners outside of the Adult Entertainment Industry.

A Sunrise B “blocking” domain name registration may cost \$200-\$350 per domain name, and the registration is valid for 10 years. Sunrise B “blocking” domain names will resolve to a standard information page that states the domain name is not available. The Whois record for a blocking domain name will list standard registry information; it will not identify the trademark owner that secured the blocking registration.

ICM Registry will not process Sunrise requests on a first-come, first-served basis. If Sunrise A and B requests are submitted for the same .xxx domain name, each party will receive an IP Claim that identifies the other party and its domain name request basis. Sunrise A requestors have preference over Sunrise B requestors. The Sunrise A requestor can withdraw its request, but will be deemed to have notice of the Sunrise B requestor’s rights if it chooses to register the domain name. The registry will auction .xxx domain names that are the subject of multiple Sunrise A requests. If there are multiple Sunrise B requests and no Sunrise A requests for the same .xxx domain name, the registry will block the .xxx domain name at issue.

LANDRUSH AND GENERAL AVAILABILITY .XXX LAUNCH PHASES

During Landrush (November 8 - 25, 2011), Adult Entertainment Industry members may request .xxx domain names without having to demonstrate ownership of a trademark registration or domain name registration in another TLD that matches the requested .xxx domain name. The registry will auction .xxx domain names that are the subject of multiple Landrush requests. The General

Availability phase, which is first-come, first-served, begins on December 6, 2011. Trademark owners that are not Adult Entertainment Industry members and wish to obtain non-resolving registrations of domain names that consist of their trademarks + key terms (abcwidgets.xxx), misspellings of their marks, or common law marks may do so during General Availability.

POST-REGISTRATION RIGHTS PROTECTION MECHANISMS IN .XXX

Domain names registered in the .xxx TLD will be subject to the Rapid Evaluation Service (RES), the Charter Eligibility Dispute Resolution Policy (CEDRP), and the Uniform Dispute Resolution Policy (UDRP).

The RES is a rapid take-down process for abuse of well-known registered word marks or personal or professional names of individuals. A successful Complainant must prove that (i) the disputed domain name is identical or confusingly similar to a registered word mark of national effect that the Complainant owns and uses; (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and (iii) the disputed domain name was registered and is either being used in bad faith or, if not used, cannot possibly be used in good faith. A successful RES proceeding will not result in domain name cancellation or transfer. Instead, the domain name will resolve to a registry-designated web page that reports the name's de-activation. National Arbitration Forum ("NAF"), the RES dispute resolution provider, will conduct an initial evaluation, which may result in a temporary take-down pending decision, within two business days.

Third parties may initiate a CEDRP proceeding, which will be handled by NAF, to challenge .xxx domain names that were improperly registered during Sunrise or that were registered and are being used in violation of the Adult Entertainment Industry eligibility requirements. A successful CEDRP proceeding will result only in cancellation of the challenged domain names.

A party that files a RES or CEDRP Complaint can also file a UDRP Complaint for the same disputed .xxx domain name. However, filing a UDRP Complaint will suspend action on a pending RES or CEDRP proceeding. A UDRP Complainant may request transfer of the disputed .xxx domain name, but the domain name will not resolve if the Complainant is outside the Adult Entertainment Industry.

Finally, ICM Registry has reserved the right to disqualify any registrant that is found to have repeatedly engaged in abusive registrations.

If you have any questions concerning the material discussed in this client alert, please contact the following members of our trademark practice group:

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