

Trademark Owners Must Act Now to Block .xxx Domain Names

A new generic top-level domain (“gTLD”) designed for use by adult businesses will go live in December of 2011. The new gTLD will be .xxx, and trademark owners who operate in other industries should act soon if they wish to block adult businesses from using their marks in .xxx domain names.

In order to take advantage of this option, the mark owner must own a United States trademark registration on the Principal Register, or a foreign equivalent. Unregistered marks, including pending applications, registrations on the Supplemental Register, cancelled federal registrations and state registrations, are not eligible to block .xxx domains. Eligible trademark owners must submit an application to block the use of the .xxx domain name during the “Sunrise B” period, which runs until October 28, 2011. Only domain names that correspond exactly with the trademark reflected in the registration may be blocked. Domain name registrars offering the blocking service are charging approximately \$200-\$400 per mark.

The Sunrise B period is running concurrently with a “Sunrise A” period, during which businesses in the adult entertainment industry can apply to register .xxx domain names that correspond

to existing domain names from other gTLDs like .com, .net, and .org and/or their own trademark registrations. If a Sunrise B application is filed and no Sunrise A application is filed, the .xxx domain name in question will be made unavailable for registration, the domain will resolve to a standard information page, and the WHOIS information will list standard registry information rather than identifying the Sunrise B applicant.

If both a Sunrise A application and a Sunrise B application are filed, the Sunrise A party will receive the domain name. However, each applicant will be notified of the other’s application, and the Sunrise A party will be given the chance to withdraw its application in light of the Sunrise B application. If no Sunrise B application is filed and more than one Sunrise A application is filed, the domain name will be auctioned to the highest bidder. Shortly after the expiration of the Sunrise A and Sunrise B periods, on November 8, 2011, domain names that have not been pre-registered or blocked will be made available to the adult entertainment industry on a first come, first served basis. As of December 6, 2011, all remaining .xxx domain names will be available to the general public.

Failure to act before the October 28, 2011 deadline may result in the unwanted registration of a .xxx domain name. Although the Uniform Domain Name Dispute Resolution Policy

(“UDRP”) is in place to resolve disputes involving such domain names, the cost of an arbitration proceeding under the UDRP typically runs at least several thousand dollars, far more than the fee for a Sunrise B application.

For more information on this topic, please contact Gregory M. Krakau at gkrakau@mbbp.com.

If you have any questions or need assistance filing a Sunrise B application, you may speak to anyone in our Trademark Practice by calling 781-622-5930.

Morse, Barnes-Brown & Pendleton, PC maintains a robust **Trademark Practice** helping clients to select, acquire, maintain and protect trademarks and other branding elements as critical strategies for success in the marketplace.

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