

New .XXX Top-Level Domain to Debut – Protect Your Trademark Now

The Internet Corporation for Assigned Names and Numbers (ICANN), in coordination with ICM Registry, LLC (ICM), has launched the .XXX top-level domain, which is intended for web sites related to the adult entertainment industry. Most trademark owners would prefer that their marks not be associated with adult entertainment. **To prevent your mark from being associated with the .XXX top-level domain (TLD), the time to act is NOW.**

ICANN and ICM are offering two "Sunrise" programs that allow trademark owners to prevent others from registering their trademarks in the new TLD. The Sunrise B program began on September 7 and continues through October 28. During this period, trademark owners not related to the adult entertainment industry may request that their registered trademarks be placed on a reserve list, preventing most others from obtaining a domain name equivalent to the registered mark in the .XXX TLD. (See below for details regarding the disposition of conflicts between the Sunrise A and B programs.)

In order to protect your trademark through the Sunrise B program, your trademark registration (1) must have national or international effect (e.g., a federal United States registration or European Union registration, but not a state registration); and (2) must have been issued before September 1, 2011. Your request to join the Sunrise B program must be accompanied by a fee of approximately \$200-300 per trademark. If accepted, your request will block the trademark from being used with the .XXX domain for ten years. **Remember, your request must be made on or before October 28.**

Simultaneously with the Sunrise B program, the Sunrise A program is available for applicants in the adult entertainment industry that wish to register an .XXX domain and that own either (1) a national or international trademark registered before September 1, 2011, or (2) a domain registered in another TLD before February 2010. If claims regarding the same domain are made through the Sunrise A and the Sunrise B programs, ICM will notify both parties, but priority will be given to the adult entertainment industry applicant to register the domain name.

Domain registrations in the .XXX TLD will be open to anyone in the adult entertainment industry after December 6, and from that point on, if trademark owners have not entered the Sunrise programs (or are dissatisfied with the result of the Sunrise programs), they will have to rely on the Uniform Dispute Resolution Policy (UDRP) and the court system to combat infringement and cybersquatters. ICANN has also developed an alternative to the UDRP process, called the Rapid Evaluation Service, for the quick take-down of .XXX domain names based on well-known, distinctive marks of significant commercial value or the names of individuals. The initial filing fee for the Rapid Evaluation Service will be \$1,300.

Owners of qualifying trademarks can currently submit their application for the Sunrise B program to block their trademarks in the .XXX domain through participating domain registrars (a list of registrars is available at www.icmregistry.com/registrars). If you would like to discuss your options or would like help registering for the Sunrise B program, contact one of the attorneys listed below. ♦

If you would like more information about this alert, please contact one of the following attorneys or call your regular Patterson contact.

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