

IntellectualProperty

About the Author

JonathanBrown

Jonathan W. Brown is a partner in the firm's Intellectual Property and Commercial Litigation departments. Jonathan focuses his practice on the following areas of law:

- Intellectual Property
- Intellectual Property Litigation
- Commercial Litigation
- Copyright Law
- Trademark Registration
- The Rights of Privacy and Publicity

Jonathan has handled numerous matters in both California and New York including contractual disputes, license disputes, trademark infringement claims, copyright infringement claims, proceedings before the Trademark Trial and Appeals Board, and the U.S. International Trade Commission.

In addition, Jonathan helps to manage international trademark portfolios for several global entertainment and novelty companies.

For questions on any Intellectual Property related matter, please contact Jonathan at 716 849 1333 or via e-mail at jbrown@lglaw.com

Protect Your Trademark In The New ".XXX" Top Level Domain

The Internet Corporation for Assigned Names and Numbers (ICANN), the organization that determines how the Internet's infrastructure is run, has approved the creation of a new "top level domain" (TLD).

TLDs with which you are likely already familiar include .com, .net, and .org. The new TLD, ".xxx," is intended for use by the adult entertainment industry (the Adult Community) and will be operated and managed by ICM Registry LLC.

While the focus of the .xxx initiative is on the Adult Community, it has serious implication for owners of registered trademarks outside of that community; namely mark owners who wish to prevent unwanted affiliation between their brands and adult entertainment.

The good news is that a "defensive registration" process is in place that allows registered trademark owners to opt-out, or "block" their marks from being abusively registered as a .xxx domain by a cybersquatter or other bad faith registrant.

The bad news is that the cost is set by the individual registrars, and the fees are expected to range from \$199 to \$500 per domain name.

Your Options

As a trademark holder, you must decide what action, if any, you are going to take in response to the new .xxx TLD. Essentially there are three approaches you can take to address the emerging TLD:

1. Register to obtain a .xxx domain
2. Register to block others from obtaining a .xxx domain associated with your brand
3. Do not participate in the .xxx domain defensive registration process

If you elect option 3, you still have the right to protect your trademark. You may be able to seek redress against bad faith registrants by traditional means such as filing a Uniform Domain-Name Dispute-Resolution Policy (UDRP) complaint or filing an action in U.S. Federal Court.

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Important Dates

The “defensive registration” process mentioned on the previous page, also referred to as “The Sunrise B” time period, is available to trademark holders between **September 7, 2011 and October 28, 2011**.

Frequently Asked Questions

Q1 What happens to blocked marks if the ownership or management of ICM changes?

A. ICM Registry has resolved to maintain the blocks for the length of its current ICANN contract (10 years).

Q2 Why should I block my marks from the registry during Sunrise Period B?

A. Sunrise Period B provides pre-emptive rights protection. As with any new domain name registry, once the Landrush and General Availability periods arrive, the registry will be run on a first-come/first-served basis.

Q3 Does the trademark I submit during Sunrise Period B need to be an exact match, or can it be a substantial match? For example, I own the trademark “Corky’s Lobster Shack,” but I use “cls.com” as my primary website, and I don’t own the “CLS” trademark.

A. An exact match is likely required.

Q4 The cost of registering a .xxx domain is higher than that associated with most other TLDs. Is it possible that the inflated price will deter some potential bad faith registrants?

A. Registration of a .xxx extension by those within the Adult Community will be running between \$60 and \$75. Thus, it is not unreasonable to conclude that some bad faith registrants will be put off by the higher-than-usual registration price.

Next Steps

While this alert provides an overview of the defensive registration process for the new .xxx domains, there are several variables to consider with regard to the upcoming Sunrise Period. If you have specific questions or would like additional information regarding any aspect of the defensive registration, please contact me at any time by calling **716 849 1333 ext. 371** or via e-mail at jbrown@lglaw.com.

Also, for those interested, additional details regarding the .xxx domain defensive registration process, including an FAQs on the Sunrise Period, can be found at www.lglaw.com. Simply click on “Jonathan Brown” under the Attorneys Section of www.lglaw.com for additional information. Information can also be found at www.icannregistry.com.



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