

September 30, 2011

Protect Your Brand from Association with XXX Domains

Change is Coming

Change is coming to domain name registrations and it could affect you. The international group that has assigned domain names for many years now, the Internet Corporation for Assigned Names and Numbers (ICANN) has created a new .xxx domain. This is the result of many years of discussion on how to segregate and distinguish adult-oriented websites from all others. Scheduled for implementation in December 2011, the .xxx domain registration means that the owner of a domain name that also is a registered trademark such as www.trademark.com can be associated with a new domain name www.trademark.xxx without any awareness, permission, or consent. Potential XXX domain registrants see obvious opportunity in being associated with familiar and famous domain names that are also registered trademarks. Needless to say, this pending change and closing deadline has given trademark and service mark owners reason to worry that their goodwill and brand recognition may be associated with adult websites. Thankfully, mark owners can take action to prevent this association.

Safe Harbor is Available in the 52-day Blocking Period

ICM Registry, LLC, (ICM), the entity that will host the .xxx domain, has created a 52-day blocking period in which mark owners can affirmatively prevent their mark from being used in conjunction with an .xxx domain by submitting a Reservation Request. By submitting a Request, the trademark owner will not become an owner of an .xxx domain, but will prevent others from registering their mark with the .xxx domain. This procedure, which is specifically set forth for those not affiliated with adult-entertainment sites, is known as Sunrise B. The Sunrise B period expires on October 28.

How to Protect your Brand

Reservation Requests submitted under Sunrise B must include information regarding the mark in question (e.g., mark name, mark number) and must be submitted through an accredited registrar. The mark may not contain .xxx as a portion of the mark, and must not include figurative marks or special characters presented to reserve dictionary words or common expressions. Sunrise B only applies to marks registered before September 1, 2011, and does not apply to unregistered marks, or marks protected by common law or U.S. state law. ICM may conduct an investigation upon receipt of Reservation Requests, and its decisions are final and non-appealable, provided those decisions do not affect rights under applicable law, ICANN policies, or ICM-provided dispute resolution procedures.

Act Today

Mark holders should act quickly to take advantage of the Sunrise B period. Once this period closes, mark owners only will be left with more costly and more cumbersome options to block their marks from association with .xxx domains. For example, they would have to purchase the domain name and have it redirected, or they would have to institute an Inter-Registrar Transfer procedure with ICANN. The latter would invoke numerous checks and balances ensuring that only the

rightful owner of the domain could affect a transfer of domain name ownership to another entity. These actions would be far more costly than proactively taking advantage of the Sunrise B Period.

Complete the Sunrise B Form

Please visit http://www.butzel.com/sunrise_b_form to receive a copy of the Sunrise B Form then fax, mail, or email it to us.

If you have any questions regarding the Sunrise B Form or would like additional information, please contact your Butzel Long attorney or the authors of this Client Alert

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