

Expert Analysis

Keep My Trademark Clean, Please!

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The the top-level domain .xxx is now available to parties that provide adult entertainment services online for registration from ICM Registry through accredited registrars.

As of Sept. 7, adult-oriented businesses may file applications for .xxx domain names at <http://www.icmregistry.com/sunrise-a.php>. This means that trademark owners could be faced with seeing their valuable trademark associated with an adult-oriented online business.

It is settled trademark law that the mere use of a trademark as part of a domain name, without more, is not trademark use.

Suppose ABC Corp. owned the trademark Learn My ABC for its line of preschool educational materials. It might own the domain www.learnmyabc.com. To be used in commerce as a trademark or service mark, however, the mark Learn My ABC would need to appear on the educational materials or used prominently in the company's marketing.

ABC Corp. would be horrified to find that an online adult business was using www.learnmyabc.xxx and would be concerned that potential buyers of its educational materials might stumble upon the adult site by accident. But under general trademark law, the company might have little recourse.

THE SUNRISE B PROGRAM

Sensitive to that concern, owners of registered trademarks will be given a period of time during which they can register to have the domain names that correspond to their trademarks blocked from registry under the .xxx domain.

This program, the ICM Registry Sunrise B program (<http://www.icmregistry.com/sunrise-b.php>), allows a trademark owner to file an application that discloses the trademark to an accredited registrar within the "Sunrise B period," which began Sept. 7 and ends Oct. 28.

All applications received within that period will be deemed to have been filed on the same date; there is no priority for being the first to file in that period. The accredited registrar will determine the fee.

For example, Godaddy.com has announced that the Sunrise B blocking application will cost \$199.99 and will block the corresponding .xxx domain name for 10 years.

See GoDaddy sets prices for .xxx domain names, THEDOMAINS.COM (Aug. 11, 2011), available at <http://www.thedomains.com/2011/08/11>.

When the blocked domain is accessed, there will be an informational message display that will indicate that the name has been reserved or blocked from use.

If an adult business has also filed to reserve the same name, it will be notified that an owner of a registered trademark has filed a Sunset B blocking application.

The adult business will be given the opportunity to withdraw its application. If it does not withdraw, the adult business will be granted the domain name.

However, the adult business will be on notice of the potential for infringing the registered trademark, as well as the possibility of a future action under the Uniform Dispute Resolution Policy established by the Internet Corporation for Assigned Names and Numbers or other federal and state causes of action such as tarnishment and dilution.

Faced with notice of a trademark owner's desire to block the domain name, one would expect that the adult business would withdraw its registration and seek an alternative that would be less risky.

National corporate service companies are able to handle these filings for trademark owners that do not wish to do it themselves. Fees range from \$200 to \$250 per domain for 10 years of protection (including the fee charged by the registry).

Trademark owners that fail to take advantage of the Sunrise B program during the Sunrise B period must rely on the Uniform Dispute Resolution Policy or other federal and state causes of action such as tarnishment and dilution.

To cancel the registration of an .xxx domain under the UDRP, a trademark owner complainant must establish three elements:

- The domain name is identical or confusingly similar to the complainant's mark.
- The registrant of the .xxx domain does not have rights or legitimate interests in the domain name.
- The registrant registered the domain in bad faith (for example, the registrant registered the domain name to attract, for commercial gain, Internet users to the registrant's website by creating a likelihood of confusion with the complainant's mark).

While effective, using the UDRP procedure is much more expensive than the low-cost alternative provided by the Sunrise B program. Time is limited, so contact your brand managers and advisers now to take advantage of this program.

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