



Keep My Trademark Clean, Please!

Coming soon, the top level domain .xxx will be available to parties who provide adult entertainment services online for registration from ICM Registry through accredited registrars. Starting September 7, 2011, adult-oriented businesses may file applications for .xxx domain names.¹ 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 Corporation 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 servicemark, however, the mark LEARN MY ABC would need to appear on the educational materials or used prominently in its marketing. ABC Corporation would be horrified to find that an online adult business were using www.learnmyabc.xxx and would be concerned that potential buyers of its educational materials might stumble upon the adult site by accident; however, under general trademark law, ABC Corporation might have little recourse.

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 top level domain. This program, the ICM Registry Sunrise B program², allows a trademark owner to file an application which discloses the trademark to an accredited registrar within the "Sunrise B Period" which begins September 7, 2011, and ends October 28, 2011. 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 cost of the fee. For example, Godaddy.com has announced³ that the Sunrise B blocking application will cost \$199.99 and will block the corresponding .xxx domain name for 10 years. 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.

Applications must be filed within the 52-day period. 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, then the adult business will be granted the domain name, but will be on notice of the potential for infringing the registered trademark, as well as the possibility of a future action under the Uniform Domain-Name Dispute-Resolution Policy (UDRP) established by the Internet Corporation for Assigned Names and Numbers (ICANN), 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 who do not wish to do it themselves with fees in the range of \$200-\$250 per domain for 10 years of protection (including the fee charged by the registry).

1 <http://www.icmregistry.com/sunrise-a.php>

2 <http://www.icmregistry.com/sunrise-b.php>

3 <http://www.thedomains.com/2011/08/11> online newsletter dated August 11, 2011

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Trademark owners who fail to take advantage of the Sunrise B program during the Sunrise B Period must rely on the UDRP, or other federal and state causes of action such as tarnishment and dilution. In order to cancel the registration of a .xxx top level domain under the UDRP, a trademark owner complainant must establish that (1) the domain name is identical or confusingly similar to the complainant's mark; (2) that the registrant of the .xxx domain does not have rights or legitimate interests in the domain name; and (3) the registrant registered the domain in bad faith (e.g., 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, utilizing 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 advisors now to take advantage of this program.

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