

Client Alert.

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Important Notice for Trademark Owners: *Protecting Rights In Light of New Adult- Entertainment Domains*

By Rosemary S. Tarlton and Julia D. Kripke

Earlier this year, the Internet Corporation for Assigned Names and Numbers (“ICANN”) approved .XXX as a sponsored top-level domain (“sTLD”). ICM Registry, which operates the .XXX registry, will launch the .XXX sTLD on September 7, 2011. ICM Registry has explained that the .XXX sTLD “is designed specifically for the global adult entertainment industry as a trusted brand, globally recognized and extolling responsible and safe behavior.”¹

From September 7, 2011 until October 28, 2011, there will be two concurrent procedures for reserving domain names using the .XXX sTLD: Sunrise A and Sunrise B. Sunrise A allows members of the adult entertainment industry to apply to register .XXX domain names. To participate in Sunrise A, these applicants must own either an active registered trademark for the domain they seek to register or already own a domain name with the same letter string under another top-level or country-level domain (“gTLD” or “ccTLD”).

Sunrise B allows trademark owners *outside* the adult entertainment industry to attempt to reserve or “block” their marks from use as .XXX domain names. By filing a Reservation Request, trademark owners may apply to reserve a domain name that matches the entire textual element of any of their active trademark registrations that were issued before September 1, 2011. A successful Reservation Request will result in a “blocking” domain name registration that is valid for 10 years. The trademark owner holding such a blocking domain will not be permitted to use the domain to access its own website or to link to another site. Rather, the blocked domain name will simply resolve to a standard informational page generated by the registrar. Trademark owners must file their Reservation Requests through one of ICM Registry’s accredited registrars, listed on the ICM Registry site, <http://www.icmregistry.com/registrars.php>. The fee for filing a Reservation Request is set by the selected registrar, but the fee is currently expected to be approximately between \$200 and \$350 per domain name. Trademark owners who do not currently have registered trademark rights may be able to use expedited registration procedures to obtain a registration before September 1, 2011, provided they make an expedited application immediately.

In the event that there are Sunrise A and Sunrise B applications for the exact same domain name, ICM Registry will notify both applicants and will provide the Sunrise A applicant with an opportunity to withdraw its application. The Sunrise A applicant will be given priority to register the domain name, but that applicant will have been put on notice of the Sunrise B applicant’s interest in the domain name should any subsequent dispute arise. If multiple Sunrise A applications are submitted for a domain name, ICM Registry will auction the domain name at issue. Finally, if there are multiple Sunrise B applications for a domain name, ICM Registry will block that domain name on behalf of all of the Sunrise B applicants.

¹ <http://www.icmregistry.com/>

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From November 8-25, 2011, there will be a “Landrush Period” for members of the adult entertainment community to apply for .XXX domain names. There is no trademark ownership requirement during the Landrush Period. The “General Availability Period” begins on December 6, 2011. At that time, members of the adult entertainment community may apply on a first-come, first-served basis to register .XXX domain names, and non-members may apply on a first-come, first-served basis to register “blocking” .XXX domain names, including for unregistered marks.

Registered .XXX domain names will be subject to the procedures of the Rapid Evaluation Service (“RES”), the Charter Eligibility Dispute Resolution Policy (“CEDRP”), and the Uniform Dispute Resolution Policy (“UDRP”). The RES procedures are designed to provide swift remedies in situations involving clear abuse of well-known marks or of personal or professional names of individuals. These procedures are intended to be made available to trademark owners who object to the registration of their marks as .XXX domain names but either did not participate in Sunrise B or did not successfully file a Sunrise B Reservation Request.

If you would like to discuss this process in further detail, have further questions, or would like to proceed with the filing of a Reservation Request or expedited trademark application, please contact Rosemary Tarlton, using the contact information provided below.

Contact:

Rosemary Tarlton

(415) 268-6810

rtarlton@mofocom

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