

## Merchant & Gould Domain Name Enforcement Team Alert: .XXX Domain Names Due In Months – Tips to Protect Your Brand

Brand owners take note –the .XXX domain name will be live on September 7, 2011. This notice provides an overview of the .XXX domain names and provides guidance on the rights brand owners have to take action to protect their domain names.

### Overview of .XXX Introduction

- The .XXX domain name extension is planned to go live on September 7, 2011.
- Rules regarding the timing and registration requirements were published on July 15, 2011.
- The extension is by rule restricted for use by adult entertainment businesses, though brand owners are at a risk of cyberpiracy and abuse of non-adult entertainment brands.
- September 7, 2011, marks the start of the sunrise period. That period will run 50 days and close on October 28, 2011.<sup>1</sup> Brand owners may apply during the sunrise period to block others from registration of .XXX domain names that match their brands. The block will not be available after the sunrise period.
- The blocking fee is estimated between \$200-500 per domain name. That fee is set by individual registrars who will handle the registration and exemption process for the .XXX domain names. The block is currently set as a permanent block, without annual fees, though that may change.
- The landrush period will open on November 8, 2011 and will run for 18 days. Unlike the sunrise period, no qualification is needed during the landrush period. Brand owners will not be allowed to block use of the marks during the landrush period. General availability will start after the landrush period on December 7, 2011.
- The .XXX domain names will be subject to the Uniform Domain Names Resolution Policy (UDRP) that will provide a dispute mechanism to cancel or transfer domain names. A Rapid interim suspension service has also been discussed.

### Trademark Protection Guidelines

- Brand owners can apply for a block provided they have a national or regional trademark registration that was issued prior to September 1, 2011, and is in use by the owner.
- Pending trademark applications are not sufficient. Likewise, brand owners may not rely on existing domain name registrations, common law trademarks, trademarks listed on the supplemental register, or Madrid international registrations unless those registrations are based on or have resulted in a national registration.
- Blocking is only permitted where the brand owner's mark is identical to the word mark or the word elements of a design mark. Brand owners may not rely on elements of a registration that are disclaimed.
- Brand owners may not block variations or misspellings of their brands. However, exceptions are available for certain elements of a brand, such as spaces, hyphens, and special characters.
- Blocked domain names must contain at least three characters, which is a current requirement for all .XXX domain names.
- Proxies are not permitted to file blocking applications during the sunrise period. The application must be filed

in the name of the brand owner or a licensee. The current rules provide that blocked domain names will be classified as “reserved” and publicly available WHOIS database records will identify the domain name registry as opposed to the brand owner. Blocked or reserved names will resolve to a standard “reserved” website with information detailing the status of the domain name.

- If there are multiple parties requesting to block or apply a particular domain name (including adult and non-adult entertainment applicants), all applicants will be notified of the dispute. Any applicant that proceeds to register the domain name at issue will be deemed on notice of the brand owner’s rights in connection with subsequent dispute proceedings.

#### Links from the Registry for More Information

- <http://www.icmregistry.com/launch-plan.php> (launch plan - details the rules and requirements to register and block domain names)
- <http://www.icmregistry.com/ICM-Trademark-White-Paper.pdf> (White paper on trademark issues)

#### Contact Us For More Information

Please contact us if you would like further information related to the .XXX domain names and protecting your brands. Our team can assist you with the following:

- Provide further information regarding the .XXX domain names
- Create a brand protection strategy related to your brand portfolio
- Prepare documentation related to sunrise application submissions
- Work with .XXX registrars to submit applications
- Monitor the .XXX process and assist you in enforcing your brand against any abuse.

We understand that there are many domain name extensions available and that there are limited budgets to protect against domain name abuse. Please contact us to review strategies that will maximize your brand’s protection on a cost efficient basis.

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<sup>i</sup> <http://www.icmregistry.com/press/pressrelease13.php> (detailing Sunrise period)