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May 20, 2011

## .XXXcluding Your Brand from the Online Adult Entertainment Industry

After many, many years of seeking its own domain on the internet, the adult entertainment industry will finally get its wish when the .xxx top-level domain name (“TLD”) launches in September. This article will help you keep your brand out of the .xxx domain.

### The .xxx Launch Plan

Beginning in early September 2011, a thirty day sunrise period will begin, during which trademark owners can opt-in or out of .xxx domain name registrations. The launch process will tentatively run as follows:



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Period	Date	What is Happening
<b>Sunrise A</b> (30 days)	September 2011	Opt-in period for members of the adult industry to reserve a domain name. Must have verifiable trademark rights and/or already own and operate an identical second level domain name in existing TLDs (e.g., .com, .eu)
<b>Sunrise B</b> (30 days)	September 2011 (coterminous with <b>Sunrise A</b> )	Opt-out period for trademark registration holders to block their brand from registration as a .xxx domain name
<b>Landrush</b> (14 days)	Begins 14 days after the end of <b>Sunrise A</b> and <b>Sunrise B</b>	Open registration period for members of the adult industry
<b>General Availability</b>	Begins after the <b>Landrush</b> period	Remaining domain names will be available on a first-come, first-served basis (opt-outs expected to be maintained for ten years)

### Pre-Launch Protection Measures

The ICM Registry, which is responsible for .xxx, has put in place a rights protection mechanism (“RPM”). The RPM allows for brand owners from outside the adult industry to opt-out<sup>1</sup> of .xxx and essentially block registration of their brand(s) as .xxx domain names. The ability to opt-out will only be available during the Sunrise B period. Opt-outs are expected to last for at least ten years (i.e., the length of ICM Registry’s contract with the Internet Corporation for Assigned Names and Numbers (ICANN)). There will be a one time fee set by individual domain name registrars (e.g., Network Solutions) for opting-out. The fee is expected to be in the range of \$200 to \$300 per

trademark. While this fee may seem somewhat expensive, actions to obtain ownership of an infringing .xxx domain name could easily cost in the thousands of dollars.

**To qualify for Sunrise B, a party must:**

1. Own a current trademark registration of national effect;
2. in a jurisdiction where the party conducts bona fide commercial activities under the mark; and
3. the trademark registration must have issued prior to the time the party applies to opt-out of .xxx.

The opt-out being sought must correspond to the entire text of a word mark or to the complete textual component of a word + design mark.

A successful application to opt-out of .xxx will be removed from the pool of names available for registration. The WHOIS ownership record for any such blocked domain names will simply list standard registry information and the corresponding domain name will resolve to a website noting that the domain name is not available for registration. The purpose of resolving to such a webpage is to prevent hijacking of the domain name.

If the opt-out being sought corresponds to a domain name sought by a Sunrise A applicant, the Sunrise A applicant will be notified and will have an opportunity to withdraw the domain name application. The Sunrise B applicant will also be notified of the Sunrise A application, but if the Sunrise A applicant chooses to proceed with the registration, it will be unable to claim lack of notice of trademark rights in a subsequent .xxx domain name proceeding.

If a party does not own a trademark registration, then it will not be possible to opt-out during the Sunrise B period. Further, it will not be possible for such a trademark owner ever to register a .xxx domain name for defensive purposes unless the trademark owner can demonstrate that it is a member of the sponsored community (i.e., the adult entertainment business). The ICM Registry has announced that it anticipates rolling out a service in 2012 for blocking .xxx domain names based on trademark registrations that issue after the Sunrise B period. The cost is expected to be higher than the cost of opting-out during Sunrise B. Nonetheless, if a party does not own a registration for a trademark that it does not want associated with the adult entertainment industry, then that party may wish to try to obtain a registration for that trademark.

**Post Launch Protection Measures**

The ICM Registry intends to provide a rapid takedown service modeled after the takedown procedures under the Digital Millennium Copyright Act. The ICM Registry's current documentation states that "a response team of independent experts (qualified UDRP panelists) will be retained to make determinations within 48 hours of receipt of a short and simple statement of a claim involving a well-known or otherwise inherently distinctive mark and a domain name for which no conceivable good faith basis exists. Such determinations will result in an immediate termination of resolution of the domain name, but will not prejudice either party's election to pursue another dispute mechanism."

Thus, if a trademark owner wishes to obtain an infringing .xxx domain name—rather than simply to have content removed from the corresponding website—then traditional measures, such as Uniform Domain Name Resolution Policy (UDRP) proceedings are available.

Trademark owners should also check with their watch service providers to find out whether the service will begin to monitor .xxx domain name registrations.

### **Conclusion**

For trademark registration owners who wish to protect their brands from being registered as .xxx domain names, we recommend taking advantage of the Sunrise B opt-out application process described above. Dorsey & Whitney's Trademark, Copyright and Brand Management Group would be pleased to assist your company by preparing and submitting Sunrise B opt-out applications or by filing new trademark applications that can be used to take advantage of the opt-out service that will be offered by ICM Registry after the .xxx TLD goes live. If you have questions, please contact one of our trademark attorneys.

<sup>1</sup>IPRota has been retained to assist with implementation of the RPM and to process and validate all sunrise applications. IPRota's .xxx whitepaper can be found at: [http://www.xxxempt.com/IPRotaXXX%20Whitepaper\\_FINAL.pdf](http://www.xxxempt.com/IPRotaXXX%20Whitepaper_FINAL.pdf).

<sup>2</sup> <http://www.icmregistry.com/docs/preventing-abusive-registrations-20jul10-en.pdf>

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