

CLIENT UPDATE

Trademark Owners Given Limited Window to Block Registration of “.XXX” Domains

September 21, 2011. With the Internet Corporation for Assigned Names and Numbers (ICANN) having approved the new .XXX top-level domain (or, “domain suffix”) to be used by adult-entertainment websites, individual hosting companies will soon be issuing these .XXX domain names. They reportedly have already received tens of thousands of applications for advance registration. Inevitably, some of these soon-to-be-issued domain names will (intentionally or unintentionally) misappropriate a trademark belonging to another entity.

Consequently, those who would like to prevent their trademarks or trade names from being used in such fashion should review the following procedures:

(i) Sunrise B

Owners of federally registered trade or service marks issued prior to September 1, 2011 are eligible to take advantage of the “Sunrise B” program. Under Sunrise B, a mark owner submits an application to a participating web hosting company to block registration of the domain “[trademark].XXX”, where [trademark] is the exact spelling of the registered mark. The cost of the application varies depending on the hosting company used, but should range from \$200 to \$400.

Upon approval of the application, the submitted domain will be blocked from registration for a period of ten years or longer. Those attempting to visit the domain, or attempting to conduct a WHOIS search on its owner, will receive a standard message stating that the domain has been blocked from use and is on file with the ICM Registry (the administrator of the .XXX domain suffix). The message will provide no information on the identity of the mark owner.

The Sunrise B application period opened on September 7 and will close on October 28, 2011.

(ii) General Availability

Those who are not eligible for Sunrise B may apply for blocking in the General Availability pool, which opens on December 6, 2011, and allocates domains on a first come, first served basis. This option may be attractive to an applicant who wishes to block .XXX domains that contain the applicant’s unregistered trademarks, or that contain spelling variations of the applicant’s registered trademarks. Attempts to visit the domain in question, if procured under

General Availability, will simply return a “non-existent domain” response, rather than display a message from the ICM Registry. Additionally, a WHOIS search will display the registrant’s information, or the information of the registrant’s proxy agent. Finally, continued blocking under this program would require renewal per the hosting company’s registration policy, along with the payment of any associated fees.

If you have any questions about the foregoing, please contact your Morrison Cohen lawyer, or any of the Morrison Cohen lawyers listed below:

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