



Protecting Your Trademark from “.sucks” and “.porn”

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Thousands of new generic top-level Internet domains (“gTLDs”) are opening up for registration. While many of these new gTLDs provide marketing opportunities for companies and other entities—for example, financial institutions soon will be able to purchase a “.bank” domain—some of these gTLDs open the door to brand tarnishment.

Of major concern is the new “.sucks” domain, which is owned by the registry company Vox Populi and is specifically being promoted as a mechanism for consumer-led advocacy and debate. “Sunrise Period” registration for the “.sucks” domain began on March 30, 2015, and ends on May 29, 2015.

This Sunrise Period allows federally registered trademark owners to secure a “.sucks” domain before the general public is permitted to do so. However, to purchase a “.sucks” domain during the Sunrise Period, the trademark must first be registered with the Trademark Clearinghouse operated by the Internet Corporation for Assigned Names and Numbers (“ICANN”). At the close of the Sunrise Period, domains can be purchased by anyone on a “first come, first serve” basis. It is noteworthy that during the Sunrise Period for “.sucks” the registration fee for a domain is \$2,500 (and must be paid on an annual basis). This is generally much higher than the registration fee for other gTLDs and has led to widespread criticism from large institutions seeking to protect their marks.

Besides “.sucks” there are other new gTLDs which could become problematic for both companies and individuals alike. The gTLDs “.porn” and “.adult” opened for Sunrise registration on March 2, 2015, and provide obvious opportunities for reputational harm. Aware of the risks posed by the “.porn” and “.adult” domains, singer Taylor Swift preemptively purchased both “taylorswift.porn” and “taylorswift.adult.” It is likely that many celebrities and large companies will follow suit, securing “.sucks” and “.porn” domains before the general public can do so.

The Sunrise Periods allow federally registered trademark holders the opportunity to protect their marks by purchasing the domains themselves before anyone else has the opportunity. However, during a gTLD’s Sunrise Period, only trademark holders who have taken the step of registering their mark with the Trademark Clearinghouse will be able to purchase the domain. The domain must be identical to the trademark. For example, if a company’s trademark is “ABC Company” it can only seek to register the domain “ABCCompany.sucks” or “ABCCompany.porn” during the applicable Sunrise Period, and not “ABC.sucks” or “ABC.porn.” Registration for a domain during the Sunrise Period also requires certain legal filings to be uploaded to the Clearinghouse’s systems, including a declaration of use and a sample of proof of use of a trademark.

The benefits of registering with the Trademark Clearinghouse are two-fold. First, once a mark is registered, a trademark holder can take advantage of any Sunrise Period for a new gTLD. Accordingly, a financial institution might first purchase a “.sucks” domain to protect its reputation, and then secure a “.bank” domain as a marketing tool. Second, registration with the Trademark Clearinghouse allows a trademark holder to benefit from the Trademark Claims Period for a gTLD, which generally runs about 90 days from the close of a gTLD’s Sunrise Period.

During the Trademark Claims Period, if a party is attempting to register a domain name matching a mark in the Clearinghouse, the party will receive notification of the existing mark. If the party then goes on to register the domain despite this notice, the trademark owner will receive notification from the Clearinghouse of the registration. The trademark owner would then need to seek legal recourse against the domain name holder. It should be noted that the benefits of the Trademark Claims Period are available to marks registered with the Trademark Clearinghouse, irrespective of whether the holder of the mark purchases a specific gTLD. However, in order to receive notice during the Trademark Claims Period the mark registered must be identical to the trademark owner’s mark.

In sum, to ensure the registration of trademarks with a gTLD such as “.sucks” during the applicable Sunrise Period, pre-registration of a trademark with the Clearinghouse is a necessary first step. When the Sunrise Period ends, there will be no guarantee that a trademark holder will be able to obtain a gTLD that corresponds to their trademarks, and any other entity may register for a corresponding domain.

Please note that this advisory is a general overview of the requirements to obtain new top-level Internet domains. A number of other gTLDs that may be of interest to you are also available. If you have any questions regarding this matter or need assistance with registering a federally registered trademark with the Trademark Clearinghouse, please feel free to contact Karen Levin at 516-296-9110 or via email at klevin@cullenanddykman.com, Jennifer McLaughlin at 516-357-3713 or via email at jmclaughlin@cullenanddykman.com, Ariel Ronneburger at 516-296-9182 or via email at aronneburger@cullenanddykman.com, or Cynthia Thomas at 516-357-3853 or via email at cthomas@cullenanddykman.com.