



Trademark Owners are Urged to Block Their Marks from Use in .XXX Domain Names

September 27, 2011

As a result of a recent agreement between the Internet Corporation for Assigned Names and Numbers (“ICANN”) and the Internet Content Management Registry (“ICM Registry”), domain names which end with .xxx (i.e., company name.xxx) are now available for purchase through independent registrars. Although ICM Registry will not officially launch the .xxx top-level domain (“TLD”) until later this year, it will host a sunrise period from September 7th through October 28th during which trademark owners in the adult entertainment industry may register .xxx domain names. During this same period, ICM Registry will allow trademark owners outside the adult entertainment industry to block their marks from use in the .xxx TLD by filing reservation requests. Independent registrars will handle both sunrise registrations and sunrise reservation requests. The fees charged in connection with these transactions will vary depending on the registrar used.

A trademark owner is eligible to make a reservation request if it seeks to reserve a name in the .xxx TLD which corresponds to a federally registered trademark issued prior to September 1, 2011. The domain name sought must correspond to the complete textual component of the registered trademark (provided that such textual component is entitled to the full rights conferred by the registration).

To make a reservation request, a trademark holder must submit to an independent registrar an application containing specific information about its registered mark. A successful reservation request will result in the subject domain name being removed from the pool of domain names available for registration in the .xxx TLD. If more than one reservation request is submitted for the same mark, the domain name will be reserved in exactly the same manner as if only one request was submitted. If, however, a reservation request is made for a domain name which is also the subject of a sunrise registration application, priority will be given to the sunrise registration and the trademark owner making the reservation request will be forced to challenge the registration through dispute resolution procedures offered by ICANN and ICM Registry or in a court of law.

We advise all clients who do not want their federally registered trademarks used in .xxx domain names to submit reservation requests to independent registrars before the October 28th deadline. If you have any questions regarding whether you are eligible to block your trademark from use in the .xxx TLD or require assistance with making a reservation request, please do not hesitate to contact Karen Levin at 516-296-9110 or klevin@cullenanddykman.com, Joanna Silver at 212-510-2221 or jsilver@cullenanddykman.com or Hayley Kelch at 516-357-3727 or hkelch@cullenanddykman.com.

Practices

- Intellectual Property

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