



Protecting Your Company Brands Against Sexually Explicit and Pornographic .XXX Domain Names – Deadline for Sunrise Period for Blocking Registrations is October 28, 2011

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[*Update - .XXX Domain Registry Has Received Over 42,000 Registrations – Deadline for Sunrise Period for Blocking Registrations is October 28, 2011**

ICM Registry, the registry handling .XXX top-level domain (“TLD”) registrations reported this week that it has received over 42,000 applications for .XXX domain names since the September 7, 2011 launch of the Sunrise Period “with thousands more pouring in each day.” “We are very pleased, but not surprised, by this overwhelming response to the availability of .XXX domains,” said Stuart Lawley, CEO of ICM Registry. The .XXX domain is intended solely for use by the “adult entertainment” industry.

ICM reported that the number of applications already received is over five times what ICM had anticipated. ICM also reported that the applications have been “well balanced” between brand owners inside the adult industry and those non-adult brands that want to protect their trademarks.

Trademark owners outside the adult entertainment industry with registered trademarks have only until **October 28, 2011** to take advantage of the sunrise period to file for a blocking registration that will prevent use of their trademarks in connection with pornographic uses. If a trademark owner does not have a registered mark, or misses the deadline, it must wait until December 6, 2011 to file registrations to block others from using their marks in the .XXX domain. See our August 18, 2011 blog post, below for details on the process. ***]

Protecting your brand and trademarks from infringement and tarnishment by uses on pornographic and other unsavory websites just got more difficult. As we reported in April, the Internet Corporation for Assigned Names and Numbers (ICANN) board approved the .XXX sponsored top-



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level domain (“sTLD”) name in March. <http://bit.ly/qOCikk> The .XXX domain is intended solely for use by the “adult entertainment” industry, and officially launches on December 6, 2011. The goal of the domain was to identify the websites as containing sexually explicit content – thus readily allowing adults to discover or avoid such sites, and to control access by children.

The new .XXX domain, however, only leads to greater enforcement problems. As the existence of the new domain is likely to increase the volume of sites associated with adult content, brand owners must now be concerned that others could use their trademarks to attract audiences to unrelated pornographic sites. Therefore, to protect the vast majority of brand owners which are not in the adult entertainment industry, but which face the risk of use of their marks in new .XXX domains, ICANN has developed rules allowing such trademark holders to “block” registered marks from the .XXX domain.

Prior to the launch of the .XXX domain, trademark owners may reserve their registered trademarks so that others may not register their mark with an .XXX sTLD. ICM Registry, the organization that implemented and is monitoring the .XXX sTLD, has organized the registration and blocking of .XXX sTLDs into four time periods known as Sunrise A, Sunrise B, Landrush, and General Availability. For trademark holders seeking to prevent use of their marks in the .XXX sTLD, the key time period is the “Sunrise B” period.

Sunrise A and Sunrise B both last from **September 7, 2011 to October 28, 2011**. All applications filed during this period are treated equally; there is no “first come-first served” treatment.

Sunrise A is for members of the “sponsored community” (*i.e.*, the adult entertainment industry) who own registered trademarks or domain names, to reserve their domain names with the .XXX sTLD.

Sunrise B applies to registered trademark owners who wish to protect their trademarks from .XXX registrations. The registered trademark must have issued with national or international effect prior to September 1, 2011. Under Sunrise B, registered trademark owners may apply to block their trademarks from the .XXX sTLD. There are a number of technical requirements relating to exact textual matches to the trademark, non-standard characters, and disclaimed words in a mark. All applicants must certify that the application complies with the Sunrise requirements and sign the application agreeing to indemnify ICM Registry from liability. Further, all applications are subject to verification.

The blocking of the .XXX sTLD will stay in place permanently, subject to certain conditions and the right of ICANN and ICM Registry to change the policy. Moreover, the public WHOIS information will only reflect the owner as the Registry, not the individual trademark holder that blocked the domain. Once a trademark is blocked, any attempt to link that trademark with the .XXX sTLD will lead the user to an informational web page indicating that the trademark is not available for registration in the .XXX sTLD.

While the ICM Registry holds responsibility for administering the .XXX domain name, it is working closely with individual domain registrars – the vendors handling the registration and exemption process for .XXX. There are several U.S. registrars, including Network Solutions, Go Daddy, Enom, Name.com, and Mark Monitor.

There will be a one-time fee to exempt domains, set by the individual registrars, to permanently safeguard intellectual property within the .XXX registry. This service, which ensures web addresses are not registered by others at a later date, will have no annual fees, and will only be available to rights owners during the restricted Sunrise period. ICM has not released the specifics on the manner in which a trademark owner will apply to block a trademark under Sunrise B. ICM has stated that it will provide further details on the blocking procedures before the Sunrise period opens in September. Separately, domain registrars are beginning to provide information about their procedures, and several are already allowing “pre-registrations.” Current indications are that registrars’ prices per each domain blocked will range from \$200 to \$400.

After the Sunrise periods, there is a short break before the Landrush period opens on November 8, 2011. Like Sunrise A, the Landrush period is for members of the adult entertainment community (those that do not own registered trademarks or domain names) to register their web sites with the .XXX sTLD.

Finally, the General Availability period begins on December 6, 2011. During this period, non-trademark owners or holders of common law trademarks may apply to block their business or personal names from the .XXX sTLD.

The new .XXX sTLD brings with it unique enforcement mechanisms as well. First, if competing Sunrise A and Sunrise B applications are filed, the ICM will first share the application with the competing applicants. Thus, should an applicant not then withdraw, it is deemed on notice of the competing applicant’s intellectual property claim in a subsequent dispute proceeding.

All registrants are bound by ICM Registry's Charter Eligibility Dispute Resolution Procedure (CEDRP) and Rapid Evaluation Service (RES) for any disputes that may arise, as well as routine Uniform Domain Name Dispute-Resolution Policy (UDRP) arbitration procedures.

CEDRP is a proceeding that allows any party to object to a registration in the .XXX sTLD domain on the ground that the registrant is not a member of the “Sponsored Community,” *i.e.*, that it is not in the adult entertainment industry. The RES proceeding is designed to provide very prompt protection of well-known trademarks and service marks, as well as personal and professional names in situations of “clear abuse.” ICM Registry will publish the rules for both the CEDRP and RES proceedings on September 7, 2011 as well. The Registry advises that the fees associated with these proceedings are likely to be in the \$750 to \$1,500 range.

Finally, If trademark owners/common law rights holders do not or cannot block their trademarks or trade names in either Sunrise B or the General Availability period, they may file a UDRP proceeding against a user attempting to link the protected trademark/trade name with the .XXX sTLD. Successful UDRP complainants will be allowed to block their names from the .XXX sTLD.

If you have a particular trademark which is not registered anywhere in the world, but want to obtain one for purposes of blocking an .XXX sTLD, a few jurisdictions – most notably the Benelux, where oppositions occur after registration – register marks for an expedited fee in a few days time. (We do not recommend this, however, without a search to confirm availability).

Stay tuned for more information as the rules are published.

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