

Protect Your Brand From Unwanted .XXX Domain Registrations Before the October 28, 2011 Deadline

On September 7, 2011, ICANN, the organization that administers Internet domain names, began accepting applications to register domains in the “.XXX” top-level domain. While adult-oriented sites will continue to be able to register sites in the “.com” top-level domain, now they can also register domains such as “Live.xxx.” Unfortunately for brand owners, unauthorized parties will be able to register YourBrand.xxx and use it to display adult content.

Trademark owners can file online applications with .XXX registrars (such as GoDaddy or Network Solutions) to block their trademarks from being used in a .XXX registration. This application procedure is known as the “Sunrise B” process. While each registrar sets its own fees, most are charging about \$200 per domain. A successful Sunrise B application will prevent anyone — other than an adult site with a preexisting trademark registration that matches the domain and who also applies for the domain by October 28 — from registering the blocked domain for 10 years. The deadline to apply is October 28, 2011.

Only trademarks registered before September 1, 2011, by a national organization (such as the United States Patent and Trademark Office) or recognized international bodies are eligible for protection. Trademarks protected only by state registrations or common law rights are not eligible for the Sunrise B process. Other registrations, such as U.S. supplemental registrations and registrations made through the Madrid system that have not resulted in a registration of national effect, are also excluded.

The domain name sought to be blocked must exactly match the textual portion of a mark as registered. For example, the trademark BRAND can block the domain BRAND.xxx. However, spaces can be omitted (*e.g.*, YOUR BRAND can block YOURBRAND.xxx) and references to a trademark (*e.g.*, TM or SM) and company type (*e.g.*, LLP or Ltd.) can be omitted. Certain special characters such as, “@” or “%” can be omitted, transcribed, or replaced with a hyphen. Other exceptions apply for trademarks that contain letters not used in English, such as “ü” or “ñ.”

Once the application is submitted, the registrar may ask for additional information, such as proof of use of the mark in commerce. This information must be submitted by the deadline given by the registrar to ensure the success of the application.

Trademark owners who miss the Sunrise B deadline will still have the option of instigating a domain name arbitration or filing a lawsuit for unlawful use of their marks in a .XXX registration. However, the Sunrise B process is much simpler and less costly than either of those options, and, unlike an arbitration or lawsuit, it can stop harm to the brand before it happens. Any brand owner serious about protecting its trademarks and brands should consult with counsel about participating in the Sunrise B process.

For further information, please contact:

Paul C. Llewellyn

T: 212.836.7828

pllewellyn@kayescholer.com

Gregory P. Silberman

T: 212.836.8773

gsilberman@kayescholer.com

Rhonda R. Trotter

T: 310.788.1053

rtrotter@kayescholer.com

Oscar Ramallo

T: 310.788.1291

oramallo@kayescholer.com

Chicago Office
+1.312.583.2300

Frankfurt Office
+49.69.25494.0

London Office
+44.20.7105.0500

Los Angeles Office
+1.310.788.1000

New York Office
+1.212.836.8000

Palo Alto Office
+1.650.319.4500

Shanghai Office
+86.21.2208.3600

Washington, DC Office
+1.202.682.3500

West Palm Beach Office
+1.561.802.3230

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