

# PUBLICATION

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## **YOURTRADEMARKHERE.XXX: How Your Trademark Could Become Associated With the Adult Entertainment Industry**

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**July 1, 2011**

ICANN, the organization responsible for administering internet domain names, recently approved the .XXX top-level domain (TLD) for use by those in the adult entertainment industry. As a result, individuals, business, entities and organizations that provide online, sexually-oriented adult entertainment and those who provide products or services to the adult entertainment industry will soon be eligible to register domain names in the .XXX TLD. But what if a party in the adult entertainment industry registers your trademark in the .XXX TLD, thereby associating your brand with that industry? Can trademark owners do anything to prevent this?

### **Submit a Reservation Request for Your Trademarks in the .XXX TLD**

ICM, the registry that will operate the .XXX TLD, established a reservation request process that trademark owners can use to express interest in a particular .XXX domain name. There is no fee for submitting reservation requests, which can be submitted [here](#). Parties in the adult entertainment industry who already own a particular domain name in another TLD (such as .com) can use this reservation process to obtain an advantage in securing the corresponding .XXX domain name. For those outside of the adult entertainment industry, this reservation will enable the trademark owner to receive updates regarding when the trademark owner will be eligible to submit a blocked name application as detailed below.

### **Submit Blocked Name Applications for Your Trademarks in the .XXX TLD**

ICM is expected to have two initial registration periods for .XXX TLDs, often referred to as Sunrise Periods. Sunrise Period A is exclusively for members of the adult entertainment industry, and, as you would expect, domain names registered during this period will resolve to adult entertainment related sites. Sunrise Period B is intended for parties outside of the adult entertainment industry. .XXX domain names registered during Sunrise Period B will not resolve to an active website but rather to a generic page indicating that the name is reserved through ICM's rights protection program, thereby preventing third parties from registering that domain name in the .XXX TLD. At present, ICM indicates that these types of blocked name registrations will continue indefinitely without need for periodic renewal. The fees and timing for these Sunrise Periods have not yet been announced, but the Sunrise Periods are expected to begin in early fall. Making a .XXX reservation request as detailed above can help trademark owners stay informed.

### **Make Use of the Start Up Trademark Opposition Procedure and Rapid Take Down**

While the details have not yet been finalized, ICM has indicated that during the early .XXX registration stages they will make available to trademark owners a Start Up Trademark Opposition Procedure (STOP). ICM has stated that STOP will enable a trademark owner to notify a potential .XXX registrant of the trademark owner's claim and prevent the objectionable .XXX domain name from resolving for a fixed period while any challenge to the registration is made. Additionally, it appears ICM will also establish a Rapid Take Down procedure. Again, the details have not yet been published, but it appears trademark owners will be able to make a complaint asserting that a third party has in obvious bad faith registered a .XXX domain name incorporating the complainant's trademark. Within 48 hours a panel will decide whether the offending website should be

temporarily taken down pending a full proceeding under the Uniform Domain Name Dispute Resolution Policy (UDRP).<sup>1</sup> Unlike STOP, presumably this Rapid Take Down procedure would continue to be available for use even after the early .XXX registration stages.

## Conclusion

Trademark owners need to be mindful of the launch of the .XXX TLD in order to prevent their valuable brands from potential associations with adult entertainment. While it appears the .XXX registry will provide mechanisms for protecting intellectual property, it is up to trademark owners to become informed and take advantage of those mechanisms.

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*1. The Uniform Domain Name Dispute Resolution Policy (UDRP) is a process established by ICANN for the resolution of disputes regarding the registration of domain names and is commonly used to settle disputes involving domain names in the .com, .net and .org TLDs.*