

# Could Your Trademark End Up As An Adult Website?

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How would you feel if your valuable trademark (e.g. "STARFLASH") or Internet domain name (e.g. "starflash.com") appeared in the newly created adult entertainment domain, .xxx, as a domain name for an adult website (e.g. starflash.xxx)? Recently the organization that controls issuance of top level Internet domain names (e.g., .com, .net, .us, etc.) approved a new top level domain, .xxx, for use by the adult entertainment industry. The idea is that, by having a unique top level domain for businesses in that industry, it will be easier to filter content so that it is not inadvertently provided to inappropriate audiences. The problem is that many non-adult-oriented businesses may not want their trademarks or their domain names associated with such websites, which some may find offensive. Accordingly, the operator of the .xxx domain is providing a process to enable owners of federally registered trademarks or registered domain names, to block others from registering those marks or domain names in the .xxx domain. This will prevent adult entertainment companies from associating their activities with prior-established domain names and trademarks used by non-adult-entertainment businesses.

## **How does it work?**

There will be a brief period of 50 days, September 7, 2011 - October 28, 2011 (the "Sunrise B period"), during which the owners of those pre-existing domain names and federally registered trademarks may submit an application to the domain operator, along with a fee of between \$200-\$300 per mark, to have that owner's trademark or domain name blocked from being used in connection with the .xxx domain. If this is successfully done, that domain name will be blocked from use by anyone in conjunction with the .xxx domain for at least the next 10 years. However, only domain names that exactly match the registered trademark or pre-existing domain name are eligible for this protection.

During that same 50-day period (in this case, called the "Sunrise A period"), verified members of the adult entertainment industry also may apply for early registration of .xxx domain names provided

those applicants currently possess either verifiable trademark rights in the term to be used with the .xxx domain or own exactly matching domain names in some other top level space, such as .com, .bus, .net, .us, etc.

### **What if I want to prevent registration of a domain name that is similar to my trademark from being registered in the .xxx space?**

As was noted above, the sunrise periods are intended to restrict domains that exactly match registered trademarks and domain names that are in use prior to the opening of the .xxx space. Sometimes, however, it is also important to protect domain names that are misspellings or the result of adding a derogatory term to a mark (e.g. "www.starflashstinks.xxx"). If the sunrise periods don't address variations, how can that be done?

The answer is that you need to register those domain names yourself if you wish to control them, just as you currently have to do with .com domains. If your products and services are not associated with the adult entertainment industry, then those domains will resolve to a holding page. That effectively prevents any adult websites from coming up in connections with those domains, but does not allow you to connect them to your regular website.

If you do not register the domain yourself, a provider in the adult industry could register such a domain name and direct it to a site that you or your customers may find offensive. Should that occur there are certain procedures that can be followed to take down the site. However, such procedures can be more expensive than registering the domain name yourself. They also can result in the site being left up for a period of time during which the dispute is being decided.

### **What should I do?**

What action, if any, you choose to take with respect to the new .xxx space will depend on a number of factors, including how important your marks and domain names are to your business, how protectable those domain names are under trademark law, and how damaging it would be if an adult site were to start using a similar domain name in the .xxx space. Accordingly, all trademark owners and domain name holders should review their portfolios now to determine if there are any such trademarks or domain names that they wish to seek to have blocked from use with the .xxx domain. Time is critical, because the opportunity for using the simplified procedure extends only from September 7, 2011 to October 28, 2011.

If you want to learn more about these procedures to protect your trademarks and domain names from association with salacious websites, please contact: **C. Douglas McDonald, Jr.** or **William (Ty) Giltinan**

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## Related Practices

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