

## Bullet Point<sup>®</sup>

### Trademark Owners Have an Opportunity to Protect Their Marks from Registration as Domain Names in New .XXX Sponsored Top Level Domain (“sTLD”)<sup>1</sup>

A new .xxx sTLD, specially created for the adult entertainment industry, will soon be open for Internet domain name registration. If you would like to block your registered trademark from registration as a .xxx domain name (*e.g.*, “yourbrand.xxx”) you should act soon. From September 7, 2011 to October 28, 2011 (the “Sunrise B Period”) registered trademark owners not wishing to have their valuable brand names associated with adult entertainment websites can apply to accredited registrars to prevent others from registering a .xxx domain name that matches the applicant’s federally registered trademark.

Blocking requests during the Sunrise B Period must be based on currently registered trademarks on the “Principal Register.” Requests based on pending applications, expired registrations, registrations on the “Supplemental Register,” state registrations or unregistered trademarks in which a client may have common law rights will not be granted. Further, the blocking process will not work in all cases. If a member of the adult entertainment industry already owns a substantially equivalent registered trademark for adult entertainment goods or services or already had an active domain name incorporating a trademark in another TLD, the adult entertainment company will be able to register in the .xxx sTLD even if a another trademark owner submits a Sunrise B Period blocking application.

Although each registrar will set fees for Sunrise B Period applications independently, fees are expected to be fairly high – on the order of several hundred dollars per request. Concomitantly, registration fees for the .xxx domain names are expected to be much higher than registration fees for other TLDs. However, if the Sunrise B Period application is granted, it will block the .xxx domain name for at least ten years (so long as the registration is maintained).

Filing a Sunrise B Period blocking application is the best way to keep your brand out of the .xxx domain, but it is not the only option if you miss the Sunrise B Period. A trademark owner could also later defensively register its brand name as a .xxx domain name and not use it. This is also a potential option for owners of unregistered trademarks. It is, however, a more expensive option for registered trademark owners

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<sup>1</sup> This memorandum provides general information on the subject matter described, should not be relied on for legal advice in any jurisdiction and may constitute attorney advertising.

because instead of paying a one-time fee for a Sunrise B Period application, a substantial annual fee for the domain name registration will be due.

If you would like to make a Sunrise B Period application, find out more about the process, or have other questions about protecting your trademarks in the United States or internationally, please call or email L. Donald Prutzman, (212) 508-6739, [prutzman@thsh.com](mailto:prutzman@thsh.com), or the Tannenbaum Helpern partner which whom you usually deal.

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