



# Attention Trademark Owners: How To Defend Yourself With New .xxx Top-Level Domains

Author: Cheryl Burbach at Hovey Williams, LLP

The Internet Corporation for Assigned Names and Numbers (ICANN) recently approved the .xxx as the newest top-level internet domain (TLD). ICM Registry is the selected accredited domain name registrar to register .xxx domain names. The “dot triple X” TLD was designed as a voluntary online home for the adult entertainment industry (“the Sponsored Community”).

Schools should strongly consider preemptively registering .xxx sites with at least the school’s name or some version thereof. Only members of the Sponsored Community can activate and use .xxx domain names for use with a proprietary website, but schools can register .xxx domains as a defensive maneuver. Because schools are not members of the sponsored class, they cannot activate and use the site to redirect visitors back to their legitimate school site. They can, however, at least keep the domains out of the hands of others.

New TLDs always concern trademarks owners because they present opportunities for cybersquatters—those who register another’s trademarks as a domain name either to extort the trademark owner or divert internet traffic. Here, trademark owners outside the adult entertainment industry should be concerned that their valuable trademarks may be used with a .xxx TLD and related pornographic site. Owners of federally registered trademarks that are not members of the adult entertainment industry were able to block their trademarks from being used during the sunrise period. That period is now closed.

The period has now opened for those in the adult entertainment industry to register .xxx domains. However, many applications for those domains have been filed by people only seeking to profit by extorting monetary payment from trademark owners outside the adult entertainment industry. In fact, many of the applicants do not offer services in the adult entertainment industry and have no intention of doing so. Even if someone registers a .xxx domain, the site will not be activated unless it is used with adult entertainment services.

If someone contacts you offering to the sell the .xxx domain they have secured with your name or trademark, a decision will need to be made on whether it’s more economical and

important enough to pay for the registration. On the other hand, if the purchase price is excessive, then it might be evidence of a bad faith registration, which is actionable. The trademark owner will need to consider whether it is important to control the domain, or allow it to be owned by another. It is possible the domain will just be used in an inactive manner. Of course, the risk is that the domain may ultimately be sold to someone in the Sponsored Community, which could result in harm to the trademark owner. The answer on how to proceed will not be the same for everyone in every circumstance and, should that situation arise, legal counsel is recommended.

Trademark owners also have other ways of protecting themselves. Should someone register your organization’s name with a .xxx domain, you may still enforce your registered and unregistered trademark rights if the website at the .xxx domain misuses the trademark owner’s trademark. Trademark owners may assert claims under The Trademark Act, 15 U.S.C. § 101 et seq. Additionally, trademark owners may take advantage of a simplified and more cost-effective domain name dispute proceeding under the Uniform Domain Name Resolution Policy. Often, a “cease and desist” letter about that risk to the registrant can preemptively address the issue.

Notably, this is just the “tip of the iceberg.” ICANN will be accepting applications, beginning in January 2012, for new top level domains. For instance, it is possible that new TLDs may consist of .school or .college. In order for trademark owners to take advantage of future sunrise periods, they must own trademark registrations for the trademarks they seek to protect. Therefore, it is a good idea for PlattForm’s clients to audit their trademarks and obtain federal protection for important marks, whenever possible.

If you have questions, feel free to contact Cheryl Burbach at Hovey Williams, LLP.

**[cburbach@hoveywilliams.com](mailto:cburbach@hoveywilliams.com)**  
**[www.hoveywilliams.com](http://www.hoveywilliams.com)**  
**913-232-5037**



1.877.326.5281

15500 W. 113th Street, Suite 200  
Lenexa, KS 66219

PlattFormAd.com