

## IP News: .xxx-Domains

October 10, 2011

Dear clients and friends

As you are probably aware, new generic Top-Level-Domains (gTLD), such as for example .biz, .edu or .gov, have been introduced recently\*. Soon the new .xxx gTLD will be available which is for sites providing sexually-explicit content (adult entertainment) exclusively.

However, there is a risk that the reputation of a trademark might be affected in case a third party uses the .xxx gTLD in combination with trademarks (i.e. trade or service marks) belonging to someone else. In addition, there is the risk that third parties (so called cybersquatters) register such domains for the sole purpose of offering and selling them to the trademark owner at inflated prices.

In order to protect against such risks, trademark owners may themselves register .xxx domains containing their trademarks thereby gaining control over their use. However, the registration of .xxx-domains requires the prior recognition of the applicant as a member of an organisation of adult entertainment providers known as the "Adult-Sponsored Community".

This may in many cases not be desirable. An alternative route to protect owners of trade or service marks against abuse is to block the trademarks from being available to third parties by filing a reservation application by October 28, 2011 at the latest (the end of the so called "sunrise period").

In order to be eligible for reservation and hence blocking a trade or service mark, such mark must have been registered effective prior to September 1, 2011 with a national or international register. Mere trademark applications or other rights, such as e.g. (company) name rights, are not sufficient. International registrations through the Madrid system (IR marks) need to be based on or have resulted in a national registration effective prior to September 1, 2011.

Registration and reservation applications for .xxx domains have to be submitted to an accredited registrar (a list of such registrars is available online via the following link: <http://www.icmregistry.com/registrars/#europe>). The one-off fees for the reservation depend on the individual tariffs of the registrars. They usually range between EUR 250.00 and EUR 300.00 per trademark.

In our opinion trademark owners would be well advised to submit a reservation application within the sunrise period (i.e. by October 28, 2011) to an accredited registrar. This can be done online and is certainly more efficient and cost-effective than to claim the deletion or assignment of such domains in long and costly legal proceedings afterwards. In addition, it should be noted that in most cases there is probably no similarity between the services/goods provided on .xxx websites and the ones covered by the trademarks and hence no risk of confusion under trademark law aspects. Consequently there might be no basis to claim a trademark infringement.

Should you have any question or wish to get individual advice, we are at your disposal.

With kind regards

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\* Each domain is made up of a series of character strings (called "labels") separated by dots. The right-most label in a domain is referred to as "Top-Level-Domain" (TLD). There are country-specific Top-Level-Domains (such as .ch or .de) and generic Top-Level-Domains (such as .com or .org).

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