



September 12, 2011

CLIENT ALERT

Preventing Issuance of .xxx Domain Names That Match Your Trademark

Trademark owners who do not want the new “.xxx” top level domain name to be based upon their registered marks may now file a blocking application.

From now until **October 28, 2011**, brand owners will be able to remove their brands from consideration as a .xxx top level domain name through the “opt out” application process established by ICM Registry, LLC, the registry of .xxx. The opt-out application is only available during this period, and is only available to brand owners of registered trademarks.

A successful opt-out application (called a Sunrise B application) will block a trademark from purchase as a .xxx domain name. While there is a one-time cost to file the opt-out application (approximately \$330, depending upon the registrar), it will be substantially less than the costs associated with a court or administrative proceeding to reclaim a domain name, or enjoin a third party from registering a brand owner’s mark as its .xxx domain name.

Once the opt-out application is accepted, the .xxx domain name will be blocked from live use and the domain name applied for will resolve to a standard informational page. The WHOIS information will refer only to ICM Registry LLC.

Applicants must own a trademark or service mark registration of national effect, issued prior to September 1, 2011, in a jurisdiction where the applicant conducts substantial *bona fide* commerce in connection with the goods or services covered by the trademark or service mark registration. Special characters in registered marks such as &, !, or @ may be transcribed, replaced with a hyphen, or eliminated. Similarly, references such as “TM” or “LLP” may be eliminated.

If a trademark owner misses the sunrise period, it may block others from obtaining a domain name by filing for the domain name once the General Availability Period begins on December 6, 2011.

For more information on the Sunrise Period, or assistance in completing an opt-out .xxx domain name application, please contact Nancy Rubner Frandsen, Esq. at Woodcock Washburn LLP at 215-564-1223.

About Woodcock Washburn LLP

Woodcock Washburn LLP, with offices in Atlanta, Philadelphia, and Seattle, has specialized in intellectual property law since 1946. Rated as one of the top IP law firms in the United States by *IP Law & Business*, the firm has also been named the top intellectual property firm in Pennsylvania by *Chambers USA* for nine consecutive years. The firm’s lawyers and scientific advisors provide national and international clients a full range of services that includes litigation, patent procurement, IP strategies, trademark and copyright prosecution, licensing advice, and standards and open source software counseling across a wide range of industries and technologies. For more information, go to www.woodcock.com.

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