

Easy Steps To Avoid Having Your Brand Used In An Adult Website Address

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Practice Area: Trademarks & Intellectual Property

Corporations spend tens of millions of dollars each year to file trademark registrations and to protect their brands. So imagine explaining to the CEO why your trademark is now being used in an adult website (domain name) address.

Domain names are controlled by an international organization known as ICANN—The Internet Corporation for Assigned Names and Numbers. ICANN has the job of assigning names and internet protocol (IP) addresses to websites.

ICANN recently approved the registration of domain names using a (.xxx) suffix for the website address. The (.xxx) suffix was created to be used only by adult websites. This new domain name suffix is intended to make it less likely for a web browser to unwittingly reach an adult website.

To reduce the possibility that a company's brand might be misused by an adult domain name owner, ICANN created an "optout" procedure for owners, assignees, or licensees of "traditional" trademarks who want to prevent their trademarks from being used for registration of an adult website (.xxx) domain name. Any trademark owner whose trademark was registered anywhere in the world prior to September 1, 2011, is eligible to apply for opt-out treatment. If a trademark owner chooses the optout treatment, that trademark will not be eligible for registration as an (.xxx) adult domain name for a period of (10) years.

To apply for an opt-out, you must file an opt-out application with an accredited website registrar (in the U.S. those include Go Daddy and Melbourne IT). **The deadline for filing the application is October 28, 2011.** Some registrars are recommending that trademark owners file their applications by **October 21, 2011**, in order to ensure that your optout applications are properly processed and verified.

Trademark owners have to file one application per trademark and pay a fee of approximately \$250 per mark.

Companies are not required to file opt-out applications and may choose to continue relying on the traditional legal remedies for attacking a misuse of their trademark — i.e. filing an arbitration with ICANN under the Uniform Domain Name Dispute Procedures or filing a suit under the Anticybersquatting Consumer Protection Act. However, these methods can be far more costly than the \$250 per trademark fee required to file an opt-out application.

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