

TOP-LEVEL DOMAIN .XXX WILL SOON GO LIVE AND APPLICATIONS FOR NEW GENERIC TOP-LEVEL DOMAINS BEGIN JANUARY 2012

The sunrise period to block use of your trademark on the new .XXX top-level domain begins **September 7, 2011**, and the application period for new generic top-level domain (gTLDs) begins **January 12, 2012**.

Are you ready?

As we reported back in February [[link](#)], ICANN (the Internet Corporation for Assigned Names and Numbers) is opening up the Internet to new gTLDs, the part of domain names "to the right of the dot," such as ".com." The move is expected to transform the Internet, with potentially hundreds of new gTLDs expected to go live in the next few years.

.XXX Sunrise Period Runs September 7, 2011 - October 28, 2011. The first new gTLD set to go live is .XXX. This means that thousands of new websites with domain names ending in .XXX will hit the Internet in the near future, posing a challenge for companies that monitor or protect use of their brands or trademarks online. But a fast-approaching sunrise period offers a rare and valuable mechanism for brand owners to protect their trademarks before infringement occurs. Owners of a national trademark registration may opt out of the .XXX online space by applying to have their trademark blocked from use for a one-time fee of only \$200 - \$300. The sunrise period runs from only **September 7 - October 28, 2011**, so brand owners need to decide quickly whether they want to take advantage of this rights protection mechanism.

Owners of non-nationally registered trademarks, such as state-registered and common law trademarks, may defensively register .XXX domain names incorporating their marks during the General Availability phase beginning **December 6, 2011**.

New gTLD Application Period Open January 12, 2012 - April 12, 2012. Under the new gTLD program, corporations, organizations, and institutions will be able to register common words, industry terms, or their own brands or trademarks as gTLDs, such as ".sports" or ".hitachi." New gTLDs will enable brand owners to control their own web space to secure corporate and client networks, prevent fraud, and protect and promote their brand. The application costs \$185,000, plus \$25,000 annual fees to ICANN. Applications must be submitted between **January 12 and April 12, 2012**.

Companies not interested in applying for a gTLD need to be aware of the potential for increased cybersquatting and other forms of online trademark infringement as a result of the new gTLDs. What will you do if someone else applies for a gTLD using your trademark? What if new domain names that infringe on your trademark are registered in the new web space?

Several mechanisms offer trademark owners some protection: The gTLD applications will be publicly posted on **April 27, 2012**, followed by a 60-day public comment period. Formal objections may be submitted until **November 2012**, with the fees for such objections estimated to be up to \$50,000 or more. Trademark owners also may submit their marks to a Trademark Clearinghouse to help prevent cybersquatting. Companies should take these avenues into account when planning their enforcement strategies.

Recommended Timeline. All companies or organizations that monitor or protect their brands or trademarks on the Internet should engage in strategic planning:

3rd Quarter 2011: (1) Decide whether to apply for your own gTLD, (2) reach out to others who also may have rights to your trademarks to coordinate a mutual gTLD strategy, and (3) decide whether to apply for sunrise protection on .XXX, and if so, apply on September 7.

4th Quarter 2011: (1) Prepare your gTLD application, (2) decide what defensive measures or monitoring you will use for others' gTLDs and domain names, (3) decide whether to register domain names defensively on .XXX, and if so, register beginning on December 6, and (4) **plan your 2012 budget** with your gTLD and trademark infringement plan in mind.

1st Quarter 2012: Apply for your gTLD between January 12 and April 12, 2012.

2nd Quarter 2012: Monitor posted gTLD applications beginning April 27, 2012, and submit public comment in 60-day window.

3rd Quarter 2012: (1) Consider whether you need to file a formal objection to a gTLD application, and (2) decide whether and which trademarks to submit to the Trademark Clearinghouse.

4th Quarter 2012: File your formal objection to a gTLD application by November 2012.

4th Quarter 2012, 1st Quarter 2013, and onward: (1) Monitor the newly approved gTLDs and consider participating in the sunrise period and Trademark Claims Service, and/or registering your trademarks as domain names, and (2) monitor infringing domain names on the new gTLDs and consider takedown proceedings.

With careful planning, a company can successfully manage its business online even in the era of an expanding Internet.

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For assistance in formulating or executing your strategy, or any question relating to your company's intellectual property, please contact any member of our **Intellectual Property** group.

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