

Article

**Block Registration of
Your Trademarks on
the .XXX Domain**

Biography

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international intelligence
Bulletin:



LEGAL ALERT:

**Block Registration of Your Trademarks on
the .XXX Domain**

by Kenneth E. Horton and Chad A. Grange

Recently, the Internet Corporation for Assigned Names and Numbers (ICANN) approved a new “.XXX” top-level domain for use by the adult entertainment industry. This approval raises serious concerns of infringement and/or brand dilution if your trademarks are used by others in combination with this .xxx domain (i.e., nike.xxx).

ICANN has provided the opportunity for trademark owners to preclude use of their registered trademarks in combination with the .xxx domain. The option to “opt-out” of such use runs from September 7, 2011 to October 28, 2011 and requires payment of a one-time fee, typically in the range of \$200 to \$250 *per domain name*. Once blocked, the protected domain name will be removed from the registration pool. Additionally, that url (www.nike.xxx) will direct a user to a web page stating the excluded domain name is not available for registration as an .xxx domain.

Opting-out of this registration will not preclude someone in the adult entertainment industry from trying to secure that domain. Given that the .XXX domain was created for the adult entertainment industry, members of the adult entertainment industry who have a registered trademark or another top level domain can still seek that domain, potentially causing a conflict with “regular” trademark owners. There can be procedural advantages by regular trademark owners of filing an “opt-out” request if there is a conflict.

For additional information or assistance, please contact either Ken or Chad.

BIOGRAPHY

Kenneth E. Horton

Mr. Horton is a member of Kirton & McConkie's Intellectual Property Practice Section. His practice includes domestic and foreign patent prosecution, patent opinions, intellectual property litigation (including both state and federal court actions), domestic and foreign trademark prosecution, trademark opinions, copyrights, trade secrets, intellectual property evaluations and due diligence, as well as technology and intellectual property agreements. Mr. Horton has extensive experience in both pharmaceutical and semiconductor technologies. He is a frequent speaker on the topic of intellectual property law and strategy, speaking both at the 2007 and 2010 A.I.C.H.E. annual conferences and the 2009 A.C.S. annual conference. Additionally, Mr. Horton is an Associate Professor in these topics in the MBA Technology Management Program at the Gore School of Business of Westminster College.

Chad A. Grange

Mr. Grange is a member of the firm's Corporate and International Practice Sections. Mr. Grange has a broad international and domestic background in general corporate, M&A, private equity, hi-tech/digital media, alternative energy technologies, direct sales, MLM, international and domestic distributorships, medical device, pharmaceutical and other life science company representation. He has worked as an attorney in Tokyo and New York City, where he represented publicly-traded and privately-held clients in all facets of M&A transactions such as cash/stock deals, reverse subsidiary mergers and other matters. He also advised clients on hi-tech and alternative energy transactions, project finance work including geothermal, natural gas, clean-coal, wind, biodiesel and ethanol facilities. As noted by *Utah Business* magazine, Mr. Grange was recognized by his peers as one of Utah's Legal Elite in 2010.