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Porn domain forcing companies to assess fear of .xxx cybersquatters

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For the next few months at least, it can be productive for brand owners to think about Internet porn.

Businesses have until Oct. 28 to file applications to block use of their registered trademarks in website addresses ending with the new .xxx domain for the adult entertainment industry, part of the expansion of allowed extenders from the familiar .com, .org and .edu. After that, they can enter the "land rush" to buy and park addresses for non-trademarked company and brand names. Sales to the general public start Dec. 6.

It's a new twist on the problem of cybersquatters who buy business domain names and hold them for ransom, opening the nightmarish, if distant, possibility that a patient searching online for the local hospital ends up seeing a whole different kind of anatomy.

Weighing costs, risks

The .xxx domains are owned by ICM Registry LLC of Palm Beach Gardens, Fla., but companies can go through any of dozens of Internet name registrars such as **GoDaddy.com Inc.** or **Network Solutions LLC**, which split fees with ICM.

Blocking the exact spelling of a trademark costs \$200 to \$300 for 10 years. For non-trademarked names, companies can buy the domain for up to \$100 yearly – much more than rights to a typical .com – so risk-benefit calculations on what to protect are complex.

"Engaging after the fact is always much more expensive," said **Samantha Quimby**, intellectual property attorney with **Frost Brown Todd LLC** in Columbus.

"I'm working with nonprofits and obviously they don't have the money to spend on this type of thing," Quimby said. "I certainly understand their pain. We have laws against trademark infringement that apply to us down here in the brick-and-mortar world. That doesn't mean somebody isn't going to do it."

Letting someone grab the domain and sully a brand with a parody porn site could lead to a more costly dispute resolution process, which attorneys said was really no different than fighting usual trademark knockoffs.

"Just because you have a (trademark) registration, that doesn't mean the government does anything to police and protect your rights," said **Susan Rector**, partner at **Schottenstein Zox & Dunn Co. LPA**. "If someone is knocking off OSU-licensed merchandise, OSU has to go after them."

Some are advising clients to cool their jets, however. Part of the guessing game is whether someone would go to the trouble of manipulating search engines or whether bogus sites could only be found by typing them exactly.

Eric Wright, head of technology advising at Pittsburgh-based Schneider Downs & Company Inc., thinks the risk is minimal because search engines likely will present users with multiple options.

"It looks like there's an effort to essentially scare people into spending money to register domain names in this space," said **Steve Barsotti**, director at **Kegler Brown Hill & Ritter Co. LPA**.

The decision depends on the brand and industry.

"For a retail brand, I think it's a worthwhile investment," he said. "For a middle-market manufacturing company in rural Ohio, I'm not worried."

What Ohio companies are doing

For **Abercrombie & Fitch Co.**, famous for its risqué advertising, the New Albany retailer wants to make sure imitators don't take things over the already blurred line.

"One of the priorities of Abercrombie is to control our brand, our image," in-house attorney **Reid Wilson** said.

Abercrombie is filing to block its most important trademarks, he said, but he would not divulge details or budget.

Ohio State University, which has trademarked terms such as Buckeyes and Ohio State Buckeyes, is evaluating what to protect, said **Rick Van Brimmer**, head of trademarks and licensing. The trouble lies in the infinite variations, such as Buckeyes Columbus, that would require buying domains outright.

"It would be an impossible task," he said.

The likely strategy is to protect the main trademarks and respond to any infringing sites only if they seek commercial benefit, just as OSU does now with .com or merchandise knockoffs, he said.

Equality Ohio, a nonprofit gay rights group, got donated help from Quimby's office to protect its trademarked name. Emphasizing sex is a common tactic for the group's political opponents, and it has been subject to hacking, Executive Director **Ed Mullen** said.

"Creating a sex site with our domain name would play into that pretty easily," he said. "It was a pretty easy decision for us."

Cincinnati-based **E.W. Scripps Co.** is willing to spend \$5,000 to \$10,000 to protect its best-known newspapers and broadcast stations, said **David Giles**, deputy general counsel. It's also protecting several iterations of the Scripps National Spelling Bee.

"It seems to be a way to create some revenue for (the registry companies)," Giles said. "Basically we saw it as a cost of doing business. The value we have in those brands is worth that investment."

Carrie Ghose covers health care and medicine, higher education, technology and business services for Business First.