

Brandmarking

THOUGHTS ON THE CREATION,
PROTECTION, AND ENFORCEMENT OF
BRAND IDENTITY

DON'T FALL FOR THIS CHINESE DOMAIN NAME SCAM

Sooner or later (probably sooner – I've seen a flurry of these recently), someone in your organization is going to get an ominous-sounding email something like this:

Dear CEO/Principal,

We are the department of registration service in China. we have something need to confirm with you. We formally received an application. One company which called "XYZ Investment Limited".are applying to register "[your trademark]" as net brand and some CN domain names. After our initial examination, we found that the net brand applied for registration are as same as your company's name and trademark. If your company has not authorized the aforesaid company to register these, Please contact us as soon as possible. In addition, we hereby affirm that our time limit for dissent application is 7 days. If your company files no dissent within the time limit, we will unconditionally approve the application submitted by "XYZ Investment Limited."

The sender of the message reproduced above (with some elements changed) was not an official agency at all, just a domain name registrar trying to scare one of my clients into spending too much money on obscure domain names the client didn't need. **It looks like a classic protection racket: "Pay us to spare you the calamity we will otherwise bring down upon you."** But the threat is hollow – the alleged infringer ("XYZ Investment Limited") is almost certainly a complete fabrication, not someone who actually wants to register your trademark as a domain name. Even so, I've had several clients become alarmed by messages like this.

The giveaway (aside from the pidgin English) is the reference to the sender's "initial examination" of the third-party application, and the "discovery" of my client's trademark rights. **The fact is that domain name registrars do not – repeat, do not – examine proposed domain names, or investigate anyone's trademark rights.** Applying for a domain name is a purely automated process. If the particular string of letters and numbers you want isn't taken, it's yours – whether it infringes someone else's trademark or not.

When you get an e-mail like this, **ask yourself whether you really need any domain names with the China national suffix (".cn").** You probably don't: Dot-com web sites are readily accessible in China, which like all other countries in the world uses the ".com" suffix more than any other. And ".cn" domain names are actually quite complicated



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THIS MONTH:

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18 Holes' Worth of Brandmarking History

Who Owns "Boston Strong?"

ABOUT "BRANDMARKING"

The word is a combination of "branding" and "trademark." It reflects a conviction that marketing and legal professionals share a common goal, and that they need to learn to speak each other's language in order to reach it. That goal is simple: to develop powerful, durable brand identities and capture them in names, slogans, and designs that customers will associate with their products -- and with no one else's.

If you like what you find here, feel free to pass it along to others.

ABOUT THE AUTHOR



Attorney John Blattner helps businesses develop and protect brand identities. He does trademark counseling, clearance, prosecution, enforcement, and litigation, in the fashion, health and beauty, financial services, technology, retailing, publishing and media, automotive, sporting goods, and other industries. John also teaches Trademarks and Unfair Competition at Michigan State University College of Law.

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and expensive to obtain. If you do have reason to pursue a “.cn” domain name, ask your trademark attorney to put you in touch with a reputable agent in China. **Otherwise just hit the “delete” button on the bogus solicitation.**

18 HOLES’ WORTH OF BRANDMARKING HISTORY



A recent Saturday morning found your intrepid correspondent boarding a pre-dawn motor coach bound for a ritzy golf course in the oil-rich suburbs of Dallas, Texas.

It’s called Tour 18, and it’s one of a growing chain

of courses at which every hole is a life-size replica of a hole from some other well-known course that is steeped in PGA Tour history.

At the Dallas Tour 18, for example, the ninth hole is a virtual carbon copy of the island-green No. 17 at TPC Sawgrass, where the best golfers in the world routinely plop wedge shots into the water during The Players Championship. The three finishing holes at the Dallas course are replicas of Augusta National’s infamous “Amen Corner.” And so on.

So what, you ask, was I doing on this pilgrimage? Simple: conducting legal research.

The first Tour 18 course opened in 1992, and soon became the subject of (what else?) a lawsuit. **The plaintiffs were the owners of the renowned Pebble Beach, Sea Pines, and Pinehurst golf courses, who felt that their “trademark” holes were – well, were their trademarks.** The courts disagreed, which is why the original Houston course has since been joined by similar tracks in Dallas and elsewhere.

This rich legal history made Tour 18 the perfect venue for an outing sponsored by participants at the 2013 Annual Meeting of the International Trademark Association, attended by almost 10,000 branding professionals, including yours truly.

I can’t tell you my score, because we played as teams rather than as individuals. **I can, however, tell you that these golf holes didn’t become famous for being easy,** and that if I had played my own ball my score would have been stratospheric. As it happens, my team won, but I had very little to do with that. (I did, however, safely land my ball on the ersatz TPC Sawgrass island green. Take that, Sergio!)

WHO OWNS “BOSTON STRONG?”

In the wake of the April 15 bombings during the Boston Marathon, the phrase “Boston Strong” became a rallying cry for the city’s gritty resolve in facing the aftermath of the attack. **Proving once again**

that no cultural meme goes unexploited, the phrase also became a popular would-be trademark. Before a week had passed, no fewer than eight applications were filed in the US Patent and Trademark Office to register BOSTON STRONG as a trademark for goods ranging from t-shirts to jewelry to beer to coffee beans.

Some commentators expressed dismay that anyone might be allowed to claim exclusive rights in a slogan that came to prominence arose under such patriotically-charged circumstances. **A seldom-exercised provision of the Trademark Act permits the PTO to refuse registration to marks that “may disparage or falsely suggest a connection with... institutions, beliefs, or national symbols.”** Whether the phrase “Boston Strong” rises to the level of a “national symbol” remains to be seen.

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