

The Global Brand Management Landscape: Strategies for 2017 and Beyond

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Overview of Program

- Elements of a Brand Management Program
- Trademarks and Brands
- Domain Names
- Social Media
- Policy and Advocacy Engagement for Brand Owners

Elements of a Brand Management Program

- Importance of a Cohesive Global Brand Management Program
- Trademarks – Domestic and International Portfolio
- Internet Presence – Domain Names, Social Media, and Other Web Content
- Policy and Advocacy Engagement – Domestic and Global

Trademarks and Brands: Trademark Portfolio Best Practices

- Trademark searching and clearance strategies
- Trademark applications and registrations
- Trademark enforcement strategy program
- Trademark in transitions – rebranding, mergers / acquisitions and more

Trademark Searching and Clearance Strategies: U.S.

PRELIMINARY KNOCK-OUT SEARCH

- A knock-out search locates blatant conflicts with existing marks that would prevent use and registration of the proposed mark
- This search saves time and money!
- Mayer Brown can usually provide results in approximately 48 hours, or on a more expedited basis if requested urgently

Trademark Searching and Clearance Strategies: U.S.

COMPREHENSIVE SEARCH

- Search involves:
 - Looking at many different databases
 - Evaluating the results
 - Conducting investigations, if necessary
- Diminishes the chances of overlooking a potentially problematic marks
- 7-10 days is best to complete comprehensive search; can be completed in as little as 1-2 days at client request

Trademark Searching and Clearance Strategies: U.S.

- Someone may be using a similar mark for similar goods and services
- Clarify and articulate your goals
 - Purpose of the mark
 - Anticipated life of the mark
 - Relative importance of the mark
- All of these factors weigh heavily in the evaluation process

Trademark Searching and Clearance Strategies: Asia

Adopt risk-based approach for class coverage:

- High-risk jurisdictions (e.g. China and Indonesia), conduct clearance searches in core and related classes
 - Particularly China - limited cross-class protection
- Medium or low-risk jurisdictions, conduct clearance searches in core classes

Devise a few alternative marks for searching:

- China receives largest number of TM filings – someone has probably already registered your mark or something close to it



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Trademark Applications and Registrations: U.S.

Use-based applications

- Trademarks must be used in “interstate commerce”
- Examples of interstate commerce
 - Goods shipped or services rendered over interstate lines
 - Services rendered to persons engaged in interstate travel or commerce

Intent-to-use applications

- Can apply to register a mark intend to use in the near future
- Allowed up to three (3) years from issuance of notice of allowance to file evidence of use of mark
- Allows time to do market research product development and regulatory clearance--and maintain rights in a clever mark!

Trademark Applications and Registrations: Asia

Which markets? – Focus on core and high-risk markets

- **China** – one of the largest markets, high risk for hijacking, first-to-file system, limited recognition of unregistered rights
- **Indonesia** – high risk for hijacking, first-to-file system, limited recognition of unregistered rights
- **Singapore, Malaysia, Hong Kong** – common law jurisdictions, relatively low risk, protection for unregistered rights (e.g. passing off)
- Other important jurisdictions to consider: Thailand, India, Philippines, Vietnam, Japan, Korea, Taiwan

Trademark Applications and Registrations: Asia

Local Language Marks

- Particularly important for China
- Most brands known by Chinese-language names
 - if you don't adopt one, consumers will create one for you
- Select with care – beware of negative connotations, cultural taboos
- Be aware of different local dialects (e.g. a mark may sound fine in Mandarin but not in Cantonese)
- Phonetic transliteration may not be the best method
 - resulting names often meaningless and difficult to remember



Trademark Applications and Registrations: Asia

Local Language Marks – Coca-Cola

- The first Chinese name they chose was: “蝌蚪啃蠟”
- Meaning “Bite the Wax Tadpole”
 - worst transliteration possible
- Renamed to: 可口可樂
 - now one of China’s best marked products meaning “Pleasure Can Come From Drinking Coke”



Trademark Applications and Registrations: Asia

Local Language Marks – Viagra

- Pfizer registered “万艾可” (i.e. “wan ai ke”) in China
 - direct transliteration of “Viagra”
 - never caught on in Chinese market
- Viagra became commonly known in Chinese market by unofficial name “伟哥” (i.e. “wei ge”), meaning “mighty brother”
 - Chinese pharma company filed for “伟哥” in China in May 1998, one month after Viagra’s launch in the US



Trademark Applications and Registrations: Asia

Trademark Squatting at a Glance – China

- Reasons: (i) first to file wins
(ii) bad faith application is not by itself illegal
(iii) difficult to prove bad faith and well-known mark
- Risks: (i) infringing the squatter's trademark registration
(ii) product off-shelf in China
(iii) export shipment detained by the Chinese customs
- Solutions: (i) buy back the trade mark
(ii) rebrand the product in China
(iii) fight for the brand through lengthy legal battles

Trademark Applications and Registrations: Asia

Get it or Lose it

Starbucks



上海星巴克



Trademark Applications and Registrations: Helpful Tips for China



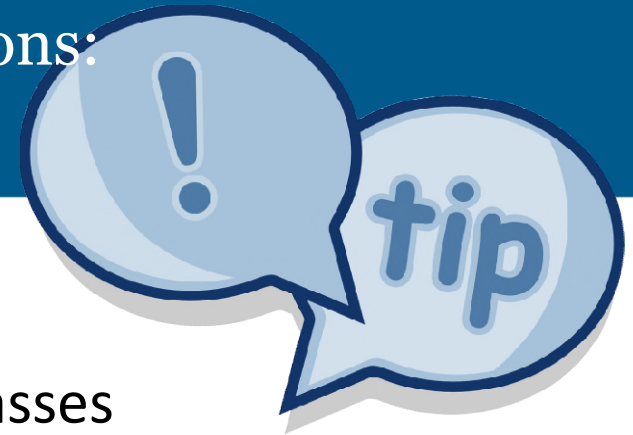
File *Before* Launch

- Hijackers pay close attention to media reports and act quickly
- Hijacker filed for Google's Chinese name in China within 45 minutes of press release introducing the new name

File Widely

- Cover as many classes as your budget will allow
- Filing fees are much cheaper than costs for recovering hijacked marks

Trademark Applications and Registrations: Helpful tips for China



Remember Subclasses

- Each Nice class is divided into subclasses
- Cover all subclasses within each class to pre-empt hijacking

Check Latest Classification Manual

- Make sure descriptions of goods/services conform with the current Classification Manual to avoid formality objections (or hire a good agent to do it for you!)

Trademark Applications and Registrations: Helpful Tips for Asian Jurisdictions

Avoid Multi-Class Applications in Indonesia

- Multi-class applications cannot be divided after filing
- E.g. if you cover 10 classes and 1 class encounters an objection, you cannot divide the multi-class application to allow remaining 9 classes to proceed while you deal with the objection



Trademark Applications and Registrations: Helpful tips for Asian jurisdictions

Beware extra official fees in China, India, Vietnam, Thailand, Taiwan (and some other countries)

- Charge official fees based on number of items of goods/services covered by application – fees can add up

Check formality requirements – ensure sufficient time for notarisation and legalisation

- Some jurisdictions require authorisation and corporate documents to be notarised and/or legalised (e.g. Thailand, Malaysia)



TRADEMARK ENFORCEMENT STRATEGY



Trademark Enforcement Strategy and Program: U.S.

PROPER USE OF MARKS

- Once obtained, trademarks must be protected and nurtured like any other property
- Proper use on all business documents, advertising, displays, packaging, labels, and correspondence is critical to survival

Trademark Enforcement Strategy and Program: U.S.

- The ® symbol is used only on trademarks that have obtained a federal registration
- The TM and SM symbols are used on unregistered trademarks
 - An organization need not file an application to register the mark before using the unregistered notice symbols
 - This is also the appropriate symbol to use after an application has been filed but prior to registration
- Use the ®, TM and SM trademark notices as frequently as possible!
- At a minimum, the notice should appear on the first and most prominent use of the mark in each document

Trademark Enforcement Strategy and Program: U.S.

DEFENDING MARKS

- Report infringement to your legal department or outside counsel
- Make sure that only those customers, affiliates with a license to use the marks use them
- DO NOT permit modification of your mark
- DO NOT permit the use of your marks on different goods or services
- Monitor the marketplace
- Document situations of confusion
- Help employees use your company's marks properly
- Honor and make proper use of other parties' trademarks

Trademark Enforcement Strategy and Program: Helpful Tips for China

- Engage TM watch service – monitor English and Chinese variants of your marks
- Monitor core and related classes, and classes that may affect reputation
 - E.g. company specialising in children's products would not want its marks associated with alcohol, tobacco, etc.
- Remember most deadlines in China are non-extendible, including opposition and appeal deadlines
- If opposition fails, consider diarising for possible non-use cancellation in 3 years
- Ensure invalidation actions are filed within 5 years after hijacked mark is registered
 - Otherwise plaintiff will need to prove well-known status of own mark

Trademark Enforcement Strategy and Program: Helpful tips for China

- Budget sufficient time and money for translation, notarisation and legalisation of authorisation documents and evidence for court and administrative actions
- File court actions in specialist IP courts in Beijing, Shanghai or Guangzhou if possible
 - to avoid local protectionism and judges with limited IP knowledge



TRADEMARKS IN TRANSITION – REBRANDING, M&A



Trademarks in Transition – Rebranding, M&A

- Ensure consistent rebranding across Asian jurisdictions
- For Chinese language marks, ensure rebranding occurs across Chinese-speaking jurisdictions
- Trademark assignments in China:
 - Assignments of Chinese TMs must be approved by CTMO to take effect
 - E.g. Danone case – Danone and Wahaha entered into JV, with Wahaha contributing its well-known “Wahaha” mark to the business; assignment rejected by CTMO on basis that “Wahaha” mark was national asset
 - Assignments may take time to be approved – in meantime, ensure appropriate licence agreements are in place and are recorded with the CTMO

COMPANY NAME HIJACKING



Company Name Hijacking – Hong Kong

Shadow companies – what are they?

Typically...

- Mainland Chinese directors
- Hong Kong secretarial company
- Nominal share capital (HK\$2)
- Incorporated in Hong Kong but carries on business in China – manufacturing, trading, licensing etc
- Hijacking of marks and domain names in Hong Kong & China



For example...

Italy Dunhill Dress Group (HK) Ltd



Patek Philippe International (HK) Ltd



MEMORANDUM
AND
ARTICLES OF ASSOCIATION
OF
**PATEK PHILIPPE INTERNATIONAL
(HONG KONG) LIMITED**
百達翡麗國際(香港)有限公司

Incorporated the 7th day of July, 2000.

HONG KONG

No. 722868

(COPY)
COMPANIES ORDINANCE
(CHAPTER 32)
CERTIFICATE OF INCORPORATION

— *** —
I hereby certify that

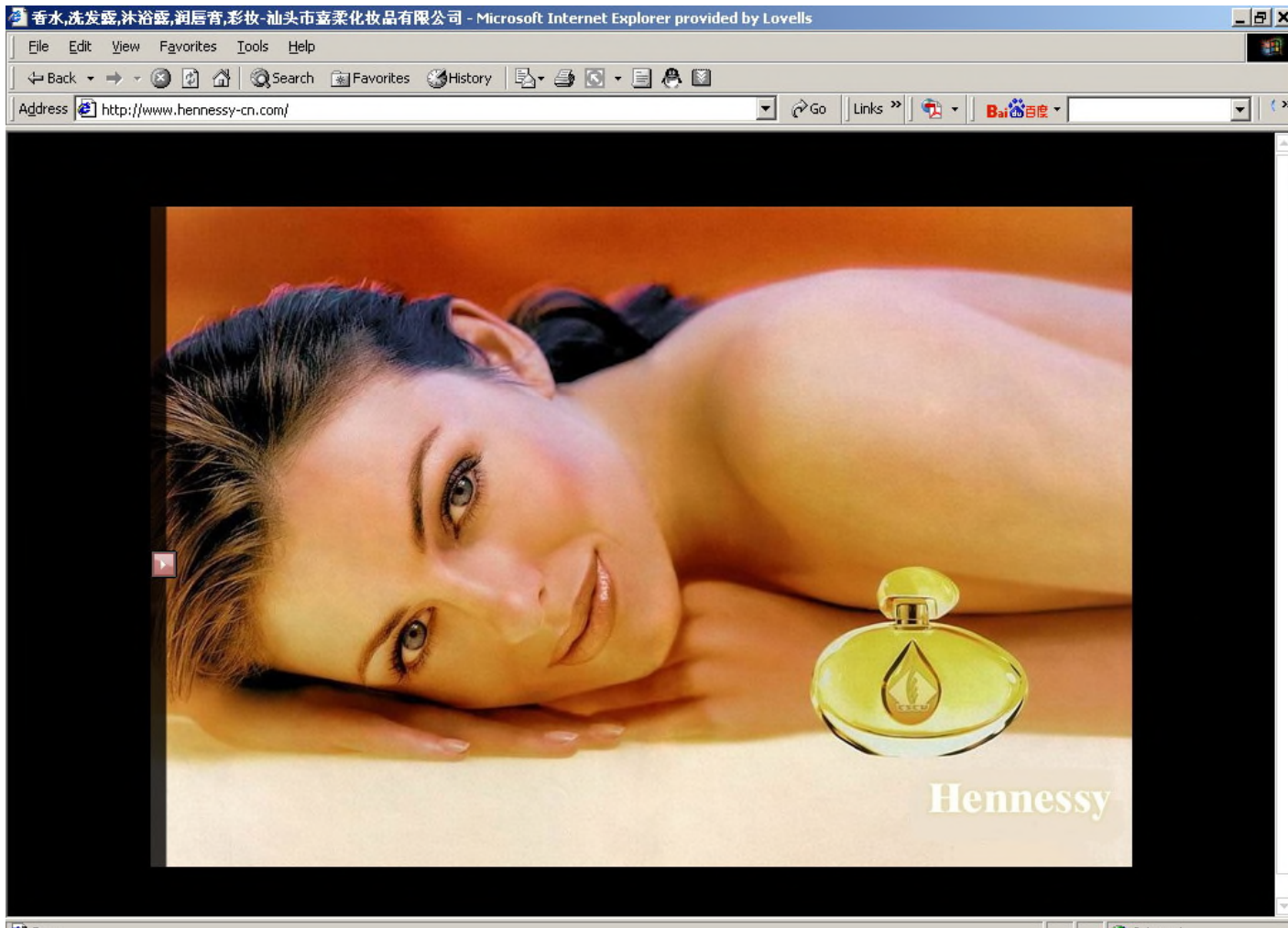
**PATEK PHILIPPE INTERNATIONAL
(HONG KONG) LIMITED**
百達翡麗國際(香港)有限公司

is this day incorporated in Hong Kong under the Companies Ordinance, and
that this company is limited.

Issued by the undersigned on 7 July 2000.

(Sd.) MISS R. CHEUNG
for Registrar of Companies
Hong Kong

France Hennessy Int'l Group Limited



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What Could Be Done – Pre-2010



Complain to the Companies Registry

- Power to direct a company to change its name within 12 months of incorporation
- Power to strike off a default company, i.e. a company which is not carrying on business or in operation

Commence civil proceedings on the grounds of passing off/trademark infringement

- Apply for default judgment and obtain a court order
- Apply for winding up if the Defendant fails to pay the Plaintiff's costs in compliance with the costs order

What Can Be Done – Post-2010

Companies Ordinance amended to enhance enforcement efforts against shadow companies

Empowers Companies Registrar to act on Orders by HK courts:

- To direct shadow company to change company name to one not including prohibited name
- To replace company name with its registration number if shadow company fails to comply with direction



What Can Be Done – Post 2010 (contd)

Additional powers of HK Company Registrar to direct company to change its name if:

- It is the same/too similar to existing company name
- Misleading info has been given for the co's registration
- Any undertaking or assurance given for registration has not been fulfilled
- Name is one by which the company cannot be registered (e.g. name includes "bank" or "stock exchange")



What Can Be Done – Post-2010 (contd)

- Failure to comply with direction to change company name:
 - Prosecution of every responsible person of company
 - HKD100,000 fine, and daily fine of HKD2,000 for continuing default
- BUT still no requirement of the Companies Registry to examine proposed company name in advance!



Domain Name Strategy

Domain Names: Basic Registration Hierarchy














- Registry – organization in charge of database of domains ending with a particular top-level domain (including gTLDs such as .com or .net and ccTLDs such as .us or .jp).
- Registrar – organization that sells rights to use particular second-level domains (such as mayerbrown.com).
- Registrant – user who purchases right to use a second-level domain for a designated period of time (e.g., Mayer Brown LLP for the mayerbrown.com domain name).














Domain Name Strategy: Anatomy of a Domain Name



Source: icann.org

Historical Domain Name Landscape in Asia

	Country	ccTLDs	IDNs?
	Bangladesh	.bd	N
	Brunei Darussalam	.bn	N
	Bhutan	.bt	N
	China	.cn	Y
	Hong Kong	.hk	Y
	Indonesia	.id	N
	Japan	.jp	Y
	Cambodia	.kh	N
	Kyrgyzstan	.kg	N
	Republic of Korea	.kr	Y
	Kazakhstan	.kz	Y
	Lao People's Democratic Republic	.la	N
	India	.in	Y

	Country	ccTLDs	IDNs?
	Sri Lanka	.lk	Y
	Myanmar/Burma	.mm	N
	Mongolia	.mn	Y
	Macau	.mo	Y
	Malaysia	.my	Y
	Nepal	.np	N
	Philippines	.ph	N
	Singapore	.sg	Y
	Thailand	.th	Y
	Tajikistan	.tj	N
	East Timor	.tl	N
	Taiwan	.tw	Y
	Vietnam	.vn	Y

Historical Domain Name Landscape in Asia

- Chinese characters
 - Simplified
 - Traditional
- Domain Categories

Multilingual	China	Hong Kong
.com	.cn / .中国	.com.hk / .公司.hk
.net	.com.cn / .公司	.org.hk / .組織.hk
.biz	.org.cn / .組織.cn	.net.hk / .網絡.hk
	.net.cn / .网络.cn	.gov.hk / .政府.hk
	.gov.cn / .政府.cn	.edu.hk / .教育.hk
	.edu.cn / .教育.cn	

Historical Domain Name Landscape in Asia

ccTLD	DRP?	Yr DRP introduced	Modelled on ICANN's UDRP?	1 st requirement	2 nd requirement	3 rd requirement	DR or Arbitration
.hk	√	2001	√	same	same	same	A
.cn	√	2002	√	(1) "identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests" (2) no "and"	(1) "no right or legitimate interest in respect of the domain name or major part of the domain name" (2) no "and"	"domain name holder has registered <u>or</u> has been using the domain name in bad faith"	DR
.tw	√	2001	√	(1) "trademark(s), mark(s), personal name, business name, or other emblem(s) of the Complainant" (2) no "and"	no "and"	"The Registrant has registered <u>or</u> used the Domain Name in bad faith"	DR
.sg	√	2001	√	(1) "identical or confusingly similar to a <u>name</u> , trademark or service mark in which the complainant has rights" (2) no "and"	same	"domain name holder has registered <u>or</u> has been using the domain name in bad faith"	DR

Historical Domain Name Landscape in Asia

ccTLD	DRP?	Yr DRP introduced	Modelled on ICANN's UDRP?	1 st requirement	2 nd requirement	3 rd requirement	DR or Arbitration
.my	√	2003	√	same	n/a	"have registered <u>and/or</u> used the Domain Name in bad faith"	DR
.jp	√	2000	√	"the domain name of the Registrant is identical or confusingly similar to <u>any mark such as</u> trademark or service mark in which the Complainant has rights or legitimate interests"	same	"the domain name of the Registrant has been registered <u>or</u> is being used in bad faith <u>(unfair purpose)</u> "	DR
.ph	√	2001	√	same	same	same	DR
.th	X	n/a	n/a	n/a	n/a	n/a	n/a
.mo	X	n/a	n/a	n/a	n/a	n/a	n/a
.vn	X	n/a	n/a	n/a	n/a	n/a	n/a

Historical Domain Name Landscape in Asia

Asian Domain Name Dispute Resolution Centre (ADNDRC)

- Asian gTLD dispute resolution provider
- Applies both ICANN's UDRP and URS
- Joint undertaking
 - KLRC –Kuala Lumpur
 - IDRC – Seoul
 - Cietac – Beijing
 - HKIAC – Hong Kong



香港國際仲裁中心
Hong Kong International
Arbitration Centre

Historical Domain Name Landscape in Asia

- Internet Keywords
 - Letters from Chinese Registrars
 - What are they?
 - Should they be registered?

Following is price list, for your reference:

topsecretwriters.asia	30 USD/Per Year
topsecretwriters.in	30 USD/Per Year
topsecretwriters.co.in	30 USD/Per Year
topsecretwriters.cn	55 USD/Per Year
topsecretwriters.com.cn	55 USD/Per Year
topsecretwriters.net.cn	55 USD/Per Year
topsecretwriters.org.cn	55 USD/Per Year
topsecretwriters.com.hk	65 USD/Per Year
topsecretwriters.hk	65 USD/Per Year
topsecretwriters.tw	65 USD/Per Year
topsecretwriters.com.tw	65 USD/Per Year
topsecretwriters.cn.com	65 USD/Per Year
topsecretwriters.中国	65 USD/Per Year
Network Brand: Top Secret Writers	220 USD/Per Year

Domain Names: Portfolio Management Best Practices

- Domain Name Availability
 - Include desirable domain names in trademark clearance investigations for new marks and taglines
 - Develop strategy to address infringing domain names discovered
 - Consider strategy to acquire non-infringing desirable domains held by third parties
 - Consider budget to purchase domain name rights
 - Use a third-party investigator to broker purchase (outside counsel can coordinate) to avoid price inflation due to brand/company association
 - For desirable domains in ccTLDs and specialized registries, consider any local presence or other special registration requirements (outside counsel can provide guidance)

Domain Names: Portfolio Management Best Practices

- Organization of Domain Name Portfolio
 - Ensure a comprehensive list is maintained of domains registered by your brand, including:
 - Registrar used to completed registration
 - Registration term
 - Renewal deadline
 - Ensure renewal deadlines are docketed to avoid expiration – outside counsel can assist with maintaining records
 - Clarify who is authorized to register domain names (or requested registrations) on behalf of your portfolio, and process for doing so
 - Maintain consistent WHOIS information (registrant contact details) for domains registered by your brand – can avoid confusion as to authentic vs. infringing registrations

Domain Names: Portfolio Management Best Practices

- Domain Name Portfolio Maintenance – Portfolio Elements
 - Domain name registrations may include:
 - Domains registered and maintained for active use
 - Domains registered for defensive and/or future purposes
 - Domains relating to old/phased-out brands and promotions
 - Domains acquired through corporate mergers/acquisitions
 - Domains acquired through dispute resolution proceedings (i.e., recovered cybersquatted names originally registered by infringers)

Domain Names: Portfolio Management Best Practices

- Domain Name Portfolio Maintenance – Audit and Evaluation Strategies
 - Conduct periodic audits to “rightsize” the domain portfolio – good junctures are in connection with any mergers/acquisitions or rebranding efforts
 - Maintain all domain names currently being used or planned for future use
 - For domains associated with old/phased-out brands and promotions, consider maintaining for a time if there may still be a consumer association – can redirect to current brand information, or include historical information on the website
 - For recovered cybersquatted names, keep for a time and monitor traffic to determine whether a third party owning the name may need to consumer confusion
 - Consider commissioning a domain name valuation (outside counsel can coordinate) for potential sale/divestiture of domains no longer desired for your brand

Domain Names: Internet Corporation for Assigned Names and Numbers (ICANN) Basics

- A global multi-stakeholder organization that collaborates with companies, individuals, and governments to ensure the continued security, stability, and interoperability of the Internet
- Created and empowered in 1998 through actions by the U.S. government and U.S. Department of Commerce to privatize the Internet
 - Encourage greater international participation
 - Bolster commercial competition
 - Consumer Choice
- Memorandum of Understanding – Officially recognized ICANN as the entity that would oversee development and implementation of domain name policy and standards for technical operations
- Just completed a plan to transition the USG stewardship role to the multistakeholder community (the “IANA transition”)

Domain Names: What Does ICANN Do?

- Coordinates Internet Functions
 - Domain Name System (DNS)
 - Internet Protocol (IP) Address Allocation
 - Generic Top-Level Domain Name (gTLD) System Management
 - Country Code Top-Level Domain Name (ccTLD) Coordination
- Security and Stability: Best practice education and new security protocols like DNSSEC
- Interoperability: Secure connections between Internet Users
- Competition and Consumer Choice:
 - Accreditation for over 1,000 registrars
 - Introduction of new gTLDs
- Ensures an open and transparent policy development process for subjects within its remit

Domain Names: Overview of the New gTLD Program

“Old” gTLDs vs. “new” gTLDs:

- Previously 23 gTLDs in operation (e.g., .com, .net and .org).
- ICANN program allowed applicants to create their own (e.g., .law or .coupons).
- Successful applicants will execute a Registry Agreement with ICANN – 10-year commitment to operate the gTLD.
- Includes internationalized domain names (IDNs) such as Arabic, Cyrillic and Lao allowing for special (non-ASCII) characters.
- 1930 complete applications submitted; approximately 700 expected to be open to third parties to register second-level domains.
- First new gTLDs went live Q4 2013; over 1100 delegated to date.

Domain Names: Examples of .GENERIC Applications

- ads
- adult
- agency
- analytics
- app
- arab
- art
- associates
- audio
- baby
- barcelona
- bargains
- baseball
- basketball
- beauty
- blog
- book
- boutique
- broadway / bway
- broker
- buy
- buzz
- cafe
- camera
- care
- career(s)
- casa
- center
- ceo
- channel
- cheap
- christmas
- city
- click
- clothing
- club
- community
- company
- contact
- cool
- corp
- country
- coupon(s)
- cricket
- earth
- eco
- education
- email
- events
- exposed
- fail
- family
- fan(s)
- fashion
- film
- finance
- financial
- fit(ness)
- football / futbol
- forsale
- forum
- free
- fun
- fund
- game(s)
- gift(s)
- gives
- giving
- global
- golf
- gratis
- guru
- home(s)
- host
- hot
- how
- inc
- international
- investments
- joy
- juegos
- kid(s)
- lat(ino)
- life(style)
- like
- link
- live
- living
- lol
- lotto
- ltd(a)
- madrid
- man
- market(s)(ing)
- media
- miami
- mobile
- moda
- mom
- mov(ie)
- music
- network
- new(s)
- nyc
- one
- online
- page
- paris
- pay
- pet(s)
- photo(s)(graphy)
- pics / pictures
- porn
- press
- productions
- promo
- pub
- radio
- rent(als)
- report
- review(s)
- rocks
- rugby
- search
- seek
- services
- sex(y)
- shop(ing)
- show
- site
- smile
- soccer
- social
- song
- soy
- sport(s)
- spot
- store
- stream
- studio
- study
- style
- sucks
- support
- talk
- team
- tech
- technology
- tennis
- theater
- theatre
- tickets
- tienda
- tips
- today
- top
- toys
- translations
- tube
- tunes
- vacations
- viajes
- video
- vip
- vision
- vote / voting / voto
- voyage
- vuelos
- web
- webcam
- win(ners)
- world
- wow
- you

Domain Names: Sample IDN .GENERIC Retail Applications

.بازار(bazaar)

.كوم(com)

.ストア (store)

.セール (sale)

.企业 (company)

.公司 (business)

.商城 (mall)

.商店 (shop)

.商标 (trademark)

.网店 (web store)

.中文网 (website)

.信息 (info)

.购物 (shopping)

.通販 (online shopping)

.集团 (conglomerate)

.八卦 (gossip)

.娱乐 (entertainment)

.餐厅 (restaurant)

.珠宝 (jewelry)

.移动 (mobile)

.时尚 (fashion)

.ファッション (fashion)

Domain Names: Examples of .BRAND Applications



.jnj and others



.loreal and others



.walmart and others



.target



.macys and .bloomingdales



.mcdonalds and .mcd



.aarp



.heinz



.safeway and others

Examples of Asian .BRAND Applications



.alibaba, .alipay
.taobao and .tmall



.baidu



.citic and .中信



.icbc and .工行



.sina and .微博



.unicom and .联通



.shangrila, .盛贸饭店 and .香格里拉

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Domain Names: Enforcement Strategies

- Difficult to review every potential infringing domain across the entire Internet – so consider engaging a watch service to flag potential third-party domains for review
- Develop strategy to prioritize response to potential infringement
 - High priority, requiring immediate action – for example:
 - Registration of exact matches of key brands and branding elements, or of brands plus industry-related keywords
 - Association of brands/branding elements with damaging content, such as adult content, hate speech, etc.
 - Domains associated with websites offering counterfeit products/services (particularly if requesting consumer personal or financial details)
 - Domains redirecting users to competitor resources
 - Lower priority domains may include those associated with parked pages or some cybersquatting variants that may receive limited traffic
 - Some domains may be legitimate uses, for example, review/commentary sites that are clearly marked as third-party resources

Domain Names: Enforcement Strategies

Trademark Clearinghouse

- Purpose – central repository for information to be authenticated, stored, and disseminated pertaining to rights of trademark holders. Developed to ease enforcement strategy adjustments needed as a result of the exponentially expanded gTLD space as a result of the new gTLD program.
- Entry makes marks eligible for Trademark Claims and Sunrise services – both mandatory for all new gTLD registries.
- Operates separately from ICANN – Deloitte performs authentication functions and IBM performs technical database functions.
- Costs borne by registries (setup fee of \$7,000 to \$10,000) and trademark owners (filing fee generally about \$150 per mark per year, plus service provider submission fees).

Domain Names: Enforcement Strategies

Trademark clearinghouse basics – standards for inclusion:

- Nationally or regionally registered word marks from all jurisdictions.
- Any word mark validated through court of law or other judicial proceeding.
- Word marks protected by statute or treaty currently in effect or in effect on or before June 26, 2008.
- Does not include any common law rights other than the above.
- Proof of use required for participation in Sunrise services.

Domain Names: Enforcement Strategies

Example:

DealSafe – OHIM		DealSafe – US	
Trade mark name :	DealSafe		
Trade mark No :	005744313		
Trade mark basis:	CTM		
Date of receipt :	26/02/2007		
Number of results:	18 of 49		
Trademark		Word Mark	DEALSAFE
Filing date:	26/02/2007	Translations	The wording "DEALSAFE" has no meaning in a foreign language
Date of registration:	19/02/2008	Goods and Services	IC 035. US 100 101 102. G & S: Economic forecasting and consulting
Expiry Date:	26/02/2017		IC 036. US 100 101 102. G & S: Financial risk management consulting
Nice Classification:	35, 36 (► Nice classification)	Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Trade mark:	Individual	Trademark Search Facility Classification Code	SHAPES-COLORS-1 Design listing or lined for a single color
Type of mark:	Figurative	Serial Number	79040502
Vienna Classification:	27.5.1, 29.1.4 (► Vienna Classification)	Filing Date	May 25, 2007
Graphic representation		Current Basis	06A
		Original Filing Basis	06A
		Published for Opposition	June 24, 2008
		Registration Number	3499292
		International Registration Number	0929413
		Registration Date	September 9, 2008
		Owner	(REGISTRANT) DELOITTE FINANCE Société par actions simpli

Based on the above trademark, the recorded name of the mark is DealSafe. In no event would the Clearinghouse accept "DEAL", "SAFE" or "SafeDeal" based on the reported name of the trademark.

Domain Names: Enforcement Strategies

Sunrise Service:

- All new gTLDs must provide a Sunrise period, i.e. a priority opportunity for owners of marks recorded in the TMCH to register these marks as second-level domain names in new gTLDs before the TLD is made available to the general public for registration.
- Dates and requirements published 30 days pre-Sunrise period.
- Offered for a minimum 30-day period; some applicants voluntarily extending the Sunrise period.
- Fee for registering domain names set by registries – ICANN will not regulate prices.
- Trademark owners should be judicious in determining in which sunrises to participate – choose gTLDs most important to the brand and business.
- System became functional on August 16, 2013.

Domain Names: Enforcement Strategies

- Like Sunrise, all new gTLDs must provide Trademark Claims Service.
 - Trademark Claims Service is really comprised of two services, both of which apply only to “identical matches” – no plurals, variants, contained-in, etc.:
 - Trademark Claims Notice
 - Notice of Registered Name
- Trademark Claims Notice:
 - Provides a warning notice of potential trademark infringement to potential second-level domain name registrants seeking to register a domain name that matches a mark recorded in the Trademark Clearinghouse.
- Notice of Registered Name:
 - Provides notice to trademark owner in the event a second-level domain name is registered that exactly matches the trademark owner’s Clearinghouse-recorded mark
- Trademark Claims Service must be provided for a minimum of 90 days after the completion of the Sunrise period

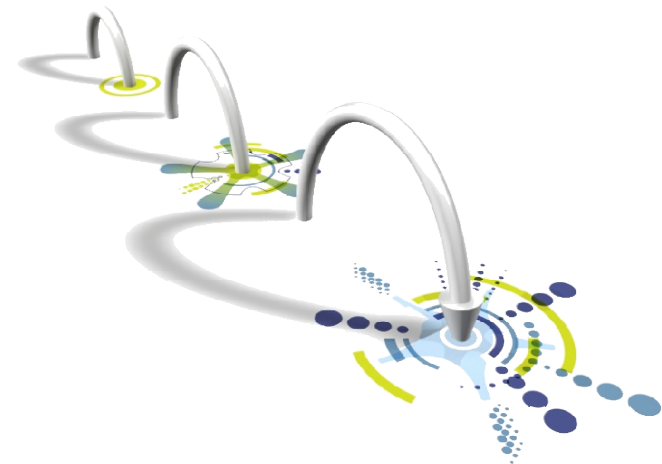
Domain Names: Enforcement Strategies

- The Trademark Clearinghouse has begun to offer a free Extended Claims Service wherein it will provide Notice of Registered Name service to brand owners whose marks have been recorded in the Clearinghouse indefinitely, even after the end of the minimum 90 day Trademark Claims Service period.
 - Brand owners must opt-in for the service.
- The Trademark Claims Service system became functional on September 11, 2013.
- According to Deloitte, 95% of queries for TM terms resulting in Claims Notices do not result in a live registration – significant deterrent effect.

Domain Names: Enforcement Strategies

Thinking about trademark clearinghouse strategy:

- TMCH is a valuable tool, but to enter every mark in your portfolio may be cost prohibitive.
- One potential strategy: select “Crown Jewels” – marks you’ll want to defensively register during Sunrise or for which monitoring is critical to your business.
- Determine which marks are your Crown Jewels and get them into the TMCH now.



Domain Names: Enforcement Strategies

- Next, identify “Top Tier” gTLDs most relevant to your business model. Some examples for the food and beverage industries:

- **.ads**
- **.auction**
- **.bargains**
- **.beauty**
- **.bid**
- **.blackfriday**
- **.buy**
- **.cafe**
- **.cards**
- **.clothing**
- **.company**
- **.cooking**
- **.cool**
- **.coupon(s)**
- **.deal(s)**
- **.direct**
- **.discount**
- **.eat**
- **.ecom**
- **.fashion**
- **.food**
- **.forsale**
- **.free**
- **.fun**
- **.gift(s)**
- **.gratis**
- **.guide**
- **.kaufen**
(shop in German)
- **.life**
- **.living**
- **.luxe**
- **.menu**
- **.new**
- **.organic**
- **.pay**
- **.promo**
- **.qpon**
- **.report**
- **.recipes**
- **.restaurant**
- **.rich**
- **.sale**
- **.save**
- **.shop(ping)**
- **.store**
- **.style**
- **.tienda**
(shop in Spanish)
- **.wedding**

Domain Names: Enforcement Strategies

Trademark Clearinghouse Fees

TMCH Registration (including up to 10 domain labels)

- 1, 3 or 5 years at \$150, \$435 or \$725 per registration

Previously Abused Labels (up to 50, claims service only)

- \$1 per label per year
- Verification fee per case: \$50–75 (UDRP) \$150–200 (Court)



Domain Names: Enforcement Strategies

Brand Owner Strategies for New gTLDs

- Will have to reevaluate your existing domain name and brand protection strategy.
- Defensive registrations are like insurance: brand owners pay a little now (cost of defensive registration) to avoid having to pay a lot later (cost of enforcement action).
- But perhaps that insurance equation is changing with the new gTLDs. More gTLDs means more defensive registrations, and if the cost of the insurance exceeds the cost of the thing that you're trying to insure against then it no longer makes sense.



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Domain Names: Enforcement Strategies

Brand Owner Strategies for New gTLDs

Understand and think about your defensive registration costs.

- What are you spending now? How many domains are in your portfolio? Any you can live without?
- How aggressive should you be with defensive registrations in the new gTLDs?
- Again a tiered approach can help:

- Top Tier (same as before); More defensive registrations

- Middle Tier

- Lower Tier. (Fewer in the Lower Tier.)

Domain Names: Enforcement Strategies

- After identifying potentially infringing use, take screenshots and print websites and WHOIS information – important to begin creating a record in case content changes while investigating
- If WHOIS information indicates a privacy/proxy service, consider contacting the registrar to obtain actual contact details (infringing activity should be a violation of registrar-registrant agreements that may otherwise permit such services)
- Consider ordering a reverse WHOIS to determine if the potential infringer has a history of cybersquatting
- In most cases, a demand letter requesting transfer of the domain name to the rightful owner is a good next step
 - Some registrants may be willing to agree to negotiate a transfer and avoid the dispute resolution process
 - Non-response or type of response to demand letter can also establish bad faith
 - May choose to skip this step and go straight to dispute resolution if dealing with registrants with a history of cybersquatting

Domain Names: Enforcement Strategies

Dispute Resolution

- Rights protection mechanisms available to combat infringing domain name registrations include:
 - Uniform Domain Name Dispute Resolution Policy (UDRP)
 - Uniform Rapid Suspension (URS) (new gTLDs)
 - National anti-cybersquatting or trademark infringement legislation (e.g. ACPA in the United States)
- Each of these has pros and cons, depending on the circumstances and remedial needs.



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Domain Names: Enforcement Strategies

Uniform Domain Name Dispute Resolution Policy

- In use for many years to protect brand owners from cybersquatting and infringement in legacy TLDs.
- Lower standard of proof than URS -- “preponderance of evidence.”
- Fees to file range from \$1,300 to \$1,500 depending on the dispute resolution provider selected.
- Generally decided within 30-60 day span, appeal must be made to court of competent jurisdiction.
- Relief available includes cancellation or transfer of domain name to complainant – no damages available.

Domain Names: Enforcement Strategies

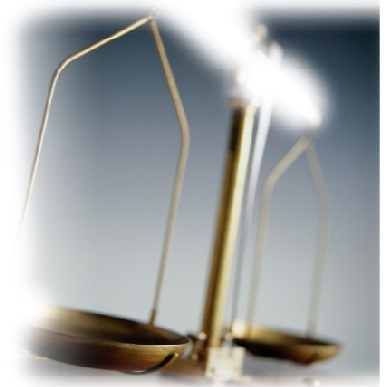
Uniform Rapid Suspension

- Designed as a lower-cost, faster alternative path to relief to complement the UDRP.
- For use to combat the most clear-cut cases of infringement.
- Fees to file are around \$300-\$500.
- Can be decided in 14 day span, although lengthy de novo review and appeals processes even in event of default by respondent (potentially a year or more).
- Relief limited to suspension of the domain for remainder of registration period, plus additional year.
- Generally evaluated to be of limited use, as most brand owners prefer to be able to recover domain names and add them to their portfolios, as allowed by the UDRP.

Domain Names: Enforcement Strategies

Anti-Cybersquatting Consumer Protection Act (ACPA)

- U.S. law integrated into Lanham Act that provides avenue of relief in U.S. federal court for cybersquatting.
- Can proceed in rem against foreign-registered domain names, so long as U.S.-based domain registration authority involved.
- Similar standard of proof to UDRP (preponderance of the evidence).
- Cost similar to general civil litigation in U.S. court.
- Relief similar to UDRP – cancellation or transfer.



Domain Names: Enforcement Strategies

URS / UDRP / ACPA Elements

URS	UDRP	ACPA
Domain name is identical or confusingly similar to mark in which complainant has rights pursuant to (i) national/regional registration, (ii) court-validation of mark, or (iii) statute/treaty;	Domain name is identical or confusingly similar to mark in which the complainant has demonstrated rights;	Defendant has a bad faith intent to profit from a protected mark; and
Registrant has no legitimate right or interest to domain name; and	Registrant has no legitimate right or interest to domain name; and	Defendant registers, traffics in, or uses a domain name that is identical or confusingly similar to that mark, or is dilutive of the mark if the mark is famous at the time of registration.
Domain name registered and being used in bad faith.	Domain name has been registered and used in bad faith.	Bad faith intent shall not be found in any case in which the defendant reasonably believed that the use of the domain name was a fair use or otherwise lawful.



Social Media Users Statistics 2016



DigitalSapiens[®]
MEDIA
<http://www.digitalmediasapiens.com>

Social Media Explained

SOCIAL MEDIA EXPLAINED With Coffee

- f** I Like Coffee 
- t** I am drinking #Coffee 
- in** I am good at drinking Coffee
- You Tube** Watch me as I drink coffee. 
- +** I am 13 and I drink coffee when I'm not taking pictures of myself.
- p** Here is a collection of pictures and recipes of coffee drinks.
- Q** What is the difference between a Latte and a Macchiato? 
- Meetup** Let's Get together (in person) and drink coffee together.
- +** Here are a bunch of popular articles about coffee.
- +** I am a Google employee who drinks coffee. 
- +** Here is where I drink coffee. I come here alot, I am the Mayor.
- +** Here is a vintage picture of me drinking coffee. *(more than likely also making the "duck" face)*

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Credits: This is based on the White Board Picture with the Donut analogy. I do not know who created that analogy!

Social Media Strategy

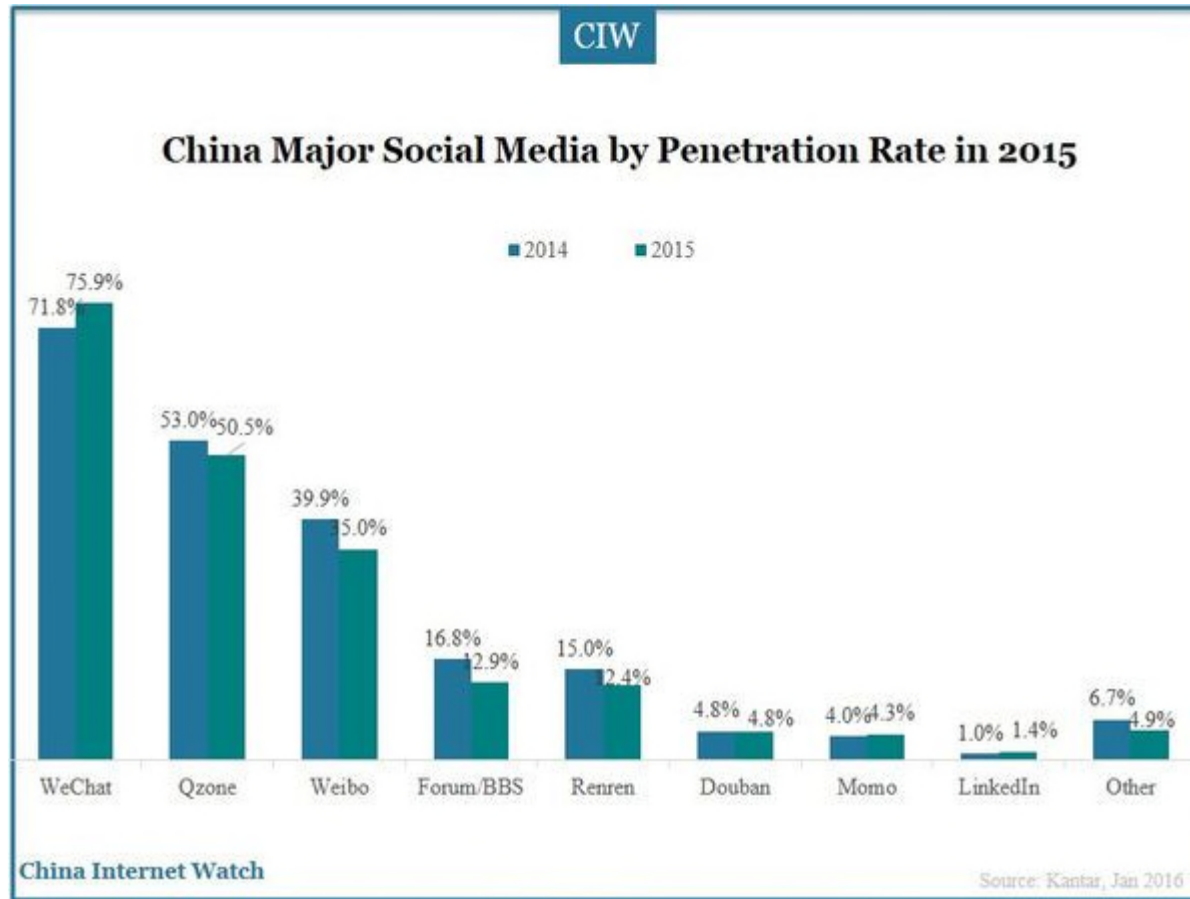
Who uses social media?

- Users are decision-making consumers with strong purchasing power—78% of Internet users with \$75k+ annual household income use social networking sites.
- Over 70% of Internet users between the ages 30 of 49 use Facebook; 16% of Facebook users earn \$100k+ annually.
- More than one billion unique users visit YouTube each month.
- Each global Internet user spends an average of over 106 minutes per day on social media activities.
- Over 2.3 billion social media users globally as of April 2016.
- Users are increasingly accessing social media through mobile devices.

Social Media Usage in Hong Kong

- 90% of all households in Hong Kong are connected to the internet
 - With the online population standing at 4.3 million, the penetration rate is 83%, the highest in the world
- 96% of Hong Kong smartphone users browse the internet daily on their smartphones
 - This is the highest rate of mobile internet usage in Asia
- Social media penetration rates at around 64%, the top sites are
 - Facebook, WhatsApp, and Weibo top the list
 - There are 4.4 million Facebook users in Hong Kong, which is more than 50% of the population
 - 44% of Facebook users say Facebook is their first point of contact when it comes to reading breaking news

Top Social Media Sites in China



Social Media Strategy

Why and how should brand owners use social media?

- Social media usage can serve as evidence of secondary meaning to support trademark rights.
- Brand owners are starting to register “hashtag + trademark” to help build and enforce brands in social media.
- Brand owner social media accounts should be “verified” whenever possible to protect credibility, reputation and accountability.
- Avoid pitfalls that can bring negative publicity, such as overbroad enforcement targeting, including fan sites or fair use.
- Ensure any paid sponsorships include clear disclosures (the FTC recently threatened the Kardashians with legal action for failure to disclose paid product endorsements appearing in social media).

Official Social Media Profiles and Resources: Asia

Use of social media may breach disclosure regulations for listed companies

- In Hong Kong, disclosure of inside information on social media may breach requirements under the Securities and Futures Ordinance and the Listing Rules mandating full and complete disclosure and equal access by the public



Brand-Related Social Media Policies

- Maintain library of information on major platforms' terms and conditions and enforcement policies.
- Facebook has takedown procedures for copyright infringement and other IP infringement, as well as an impersonation reporting mechanism.
- Twitter also has copyright, trademark and impersonation reporting options.
- YouTube allows for submission of copyright complaints; videos that violate community guidelines can be flagged.
 - <https://twitter.com/tos>
 - <https://www.facebook.com/legal/terms>
 - <http://www.youtube.com/t/terms>
 - <https://foursquare.com/legal/terms>
 - http://www.tumblr.com/policy/en/terms_of_service



Strategies for Social Media Enforcement

- Before uploading your content to any social media platform, there are several key questions to ask about ownership and control of your IP on that platform.
- Key questions:
 - ? Do you retain ownership of content?
 - ? What rights are you granting and to whom are you granting them?
 - ? What happens when you delete your content?
 - ? What steps should you take to make sure your use of your IP does not diminish your rights in trademarks and trade secrets?

Strategies for Social Media Enforcement

- Brand owners have primary enforcement responsibility.
- Social media should be a part of an overall brand enforcement strategy.
- Localize strategy by geographical regions as needed.
- Ensure customers are not misled and have access to accurate information.
- Failure to enforce may lead to consumer confusion, loss of business and goodwill, or dilution or loss of trademark rights.
- Devote adequate human and financial resources to enforcement efforts.
- Assess customer and user demographics to allocate resources appropriately.
- Partner with knowledgeable and experienced counsel.
- Develop custom watch tools to supplement watch efforts.

Strategies for Social Media Enforcement

- Monitor at least Facebook, Twitter and YouTube for unauthorized third-party content – depending on industry and products/services, image sites such as Instagram and Pinterest and e-commerce/auction sites such as eBay and Amazon.com may also be priorities to monitor.
- Monitor pool of mobile applications for unauthorized third-party apps.
- Enforcement in other platforms should be determined by type of infringement that usually affects the company's brands.
- Consider monitoring regional platforms popular outside the United States in key markets.
- Maintain list of authorized, official social media resources to ensure enforcement efforts are efficient.
- Have a go-to resource who can coordinate between marketing and brand enforcement teams.

Strategies for Social Media Enforcement

Immediate Action

- Direct infringement
- Derogatory/defamatory speech
- Blatantly false information
- Impersonation of company personnel
- Obscene/pornographic content

Potential Action – Research

- Unauthorized but non-malicious trademark use
- Misleading information

Likely No Action

- Non-defamatory blog and message board posts
- Product or service reviews

Policy and Advocacy Engagement for Brand Owners: United States and International

- Develop relationships with a variety of organizations, such as:
 - Government organizations, such as the USPTO in the United States, other international trademark/IP offices
 - Organizations developing policy that may affect your brand presence, such as ICANN
 - IP-focused organizations, such as INTA, IACC, and MARQUES
 - Industry organizations relevant to your brand, such as the American Apparel & Footwear Association (AAFA) or CTIA (for companies in the wireless industry)
- Partner with counsel to explore advocacy opportunities, such as public comments and working groups
- Opportunities may arise on tight deadlines – don't miss out!



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Policy and Advocacy Engagement for Brand Owners: Asia

Industry and Professional Associations

- US-China Business Council offers resources and support for advocacy relating to US-China commercial matters, including subscription-based access to research reports on Chinese government and sector-specific business issues
- American Chamber of Commerce provides support for advocacy on public policy issues, including regular meetings and visits with Chinese government officials



Thank You!

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