



Trademark Advisory

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TRADEMARK OWNERS BEWARE... Of Unofficial Trademark Registers and Domain Name Solicitations from China and Hong Kong

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If you haven't received a communication from an unofficial trademark "register" that looks like an invoice, chances are you will receive one in the near future. Companies such as the Intellectual Property Agency Ltd., World Patent and Trademark Index, TM Worldwide and Official Registration, Inc., send out notices, often bearing a logo that looks like an official governmental shield, to trademark owners when they file applications to register their marks with official trademark registrars like the United States Patent and Trademark Office (USPTO), the European Community Trademark Office (formally known as the Office of Harmonization for the Internal Market or OHIM) or the World Intellectual Property Organization (WIPO) and/or when their trademarks have been approved and published for opposition purposes in official trademark journals and gazettes published by the latter trademark agencies. The notices typically state that by paying a fee, oftentimes \$900 or more, the unofficial trademark registrar will enter the trademark owner's mark in official sounding publications and "registers." For example, Official Registration, Inc. of California offers to print a trademark, the goods and services associated with the mark, and the alleged owner's contact information in its "TM REGISTER/ The International Trade Marks and Service Marks" catalog for \$950. The publication will supposedly be available in the United States, Europe, Asia and Australia and printed publications will be shipped in March 2011. Official Registration, Inc. recommends that trademark owners take advantage of its registration offer because it will provide notice to others that a particular trademark is already taken.

Don't Be Fooled into Paying that Unsolicited Letter or Invoice

Entry of your trademark information into the "registers" of these "wannabe" trademark registration companies has no legal effect and does not grant any trademark rights. These companies also cannot provide any legal protection for your trademarks because they are not affiliated with any official government trademark institutions. Moreover, the most cost-effective way for a trademark owner to inform the public that it is claiming rights in a trademark or service mark as its brand identity is to simply affix the trademark or service mark designations, TM or SM, to marks that have not been registered with the USPTO or other official trademark registration offices or the registration notice, and ®, to marks that are the subject of official certificates of registration granted by the USPTO or other official registration agencies. Therefore, if you receive unsolicited mail inviting you to apply for entry in a trademark "register" in exchange for a fee—beware. Do not submit the requested payment. Instead, consult with your trademark counsel about whether you should respond to or disregard the notice. Also, please note that, if you retained a trademark attorney to file trademark and service mark applications for you or your company in the United States or abroad, you should not receive any communications directly from the USPTO or other official trademark registration offices. Any "official looking"

communication that you receive is probably a solicitation or scam so please bring this to the attention of your trademark attorney.

...And About Those Domain Name Solicitations from China and Hong Kong

In addition to receiving unsolicited offers from unofficial trademark registers, don't be surprised if you receive or continue to receive e-mails from what purports to be an official China- or Hong Kong-based domain name registrar advising you that another entity or individual is trying to register your trademark, brand name or company name as a domain name or Internet keyword. For instance, Oriental International Network, which claims to be one of the leading professional International Domain Registration Firms in Asia and whose website can be found at www.orientalnetworks.net, has been sending these types of e-mails for years both within and outside of China. Typically, the senders of these unsolicited e-mails advise the trademark and brand owner that its registry has received applications for the registration of domain names and Internet key words that include the trademark, brand or company name of the e-mail recipient. The e-mails also state that the sender is deeply concerned that the applications may not be authorized, and that the trademark/brand owner should contact them by a specified date so that their interests and trademark rights may be protected. However, despite what is said in these e-mails, the domain names and Internet keywords in question are, in fact, available and the e-mails are an attempt to get the trademark and brand name owner to register various domain names with the .cn (China), .hk (Hong Kong) or other top-level domain extensions (TLDs). As a general rule, accredited registrars in China and Hong Kong, such as Beijing China Great Wall Telecommunication Technology Development Center and HKNet Co. Ltd. In Hong Kong, do not send out e-mails soliciting domain name registrations to trademark owners.

If you receive an e-mail of an urgent nature requesting you to contact a company in China or Hong Kong about the registration of your trademark, brand name or trade name as part of a .cn or .hk domain name by another party, please consult with your trademark attorney in order to determine whether the solicitation sets forth a legitimate concern. Under no circumstances should you pay any fees to the e-mail sender before checking with your trademark counsel.

So, how does one register a domain name in China or Hong Kong?

Like in the United States, domain names are registered on a first-come-first-served basis in China and Hong Kong. That is, applicants do not need to show that they have legitimate rights or interests in a particular domain name in order to register them, and accredited registrars, such as the ones mentioned above, do not conduct substantive reviews of applications. Therefore, it is very easy to secure a domain name registration in China and Hong Kong, especially one that includes the trademark, brand name or trade name of another.

While receiving unsolicited e-mails to register domain names in China or Hong Kong can be annoying, it should prompt you to audit your domain name portfolio and determine exactly where you currently own domain names and where you do not. If you currently conduct business in Asia or plan to do so in the near future, you should consider registering your trade name and core trademarks in the relevant jurisdictions. Mintz Levin works with several reputable trademark agents in Asia and can assist you with the domain name registration process. Alternatively, if you have an information technology specialist in charge of registering and managing domain names for your company, he or she can find a listing of accredited domain name registrars on the websites of the official agencies responsible for administering the domain name registration system in China and Hong Kong, namely, the China Internet Network Information Center (CNNIC) and the Hong Kong Internet Registry Corporation (HKIRC), whose websites are located at www.cnnic.net.cn and www.hkirc.hk.

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