

REPORT OF MARK PROTECTION COMMITTEE ACTIONS

September 2011 - August 2012

Members of the Mark Protection Committee from September 2011 through August 2012 were as follows, with the expiration of membership listed in parentheses after their name: Stephen Boucher (elected until 2012 to fill seat vacated by Ruth Sachter), Scott Dennis (elected until 2012), Donald E. Eastlake III (elected until 2012), Tim Illingworth (elected until 2013), Dina Krause (appointed by ReConstruction until 2012), Kevin Standlee (elected until 2013), Ben Yalow (elected until 2013), Mark Linneman (appointed by Aussiecon 4 until 2012), Linda Deneroff, (elected until 2014), Sandra Levy (appointed by Chicon 7 until 2014), Ian Stockdale (appointed by Renovation until 2013), Dave McCarty (elected until 2014), Warren Buff (elected until 2014), and Randall Shepherd (appointed by LoneStarCon 3 until 2015). Mark Olson's term expired at the conclusion of the 2011 meeting, and the MPC thanks both him and Ruth Sachter for their services to this committee. Kevin Standlee was elected Chairman; Linda Deneroff, Secretary; and Scott Dennis, Treasurer.

The MPC Finance Report is appended at the end of this document.

Major accomplishments of the Mark Protection Committee between September 2011 and August 2012 were as follows:

1. One of the first things we did this year was to acquire the website, worldcon.com. Mike Scott, head of the Worldcon Website Working Group asked us to register websites in other countries, but Don Eastlake pointed out that traditionally we only consider registering websites in countries where a Worldcon has been held at least twice. The owner of Worldcons.com attempted to get us to purchase it from him, but when the domain expired he did not renew it, and we purchased it directly from the domain registrar.
2. Our second item of business this year was to re-appoint Craig Miller (unanimously) and Mark Olson (by a vote of 6 to 5) to the Hugo Awards Marketing Committee ("HAMC".)
3. As reported in last year's minutes, Ben Yalow successfully transferred the registration of worldcon.com to goaddy.com. In July 2012, Ben renewed the domain name, though technically it wouldn't come up for renewal until October. We now have until shortly after LSC3 until the next time it expires.
4. Eddie Chang, a professional meeting planner, contacted us about volunteering to help run Worldcon. We thanked him, and explained that each year's convention is an independent, stand-alone event and that we manage the intellectual property. Kevin Standlee provided him the websites of the current

standing Worldcons in case he wished to offer his services to them (without expecting that Mr. Chang would do so).

5. Kevin Standlee was working with Mike Scott, to prepare a list of people to work on the reconstituted Worldcon Website Working Group. Part of this group's mandate is to bring all our domains under a single registry (as we've wanted for at least a decade). There may be some costs involved with doing so, but as of this report no budget was brought before the MPC for approval.
6. In October, Bobbie DuFault enquired whether there was a copyright infringement <http://www.geekcal.com/Community-Videos/Film-Conventions/90-THE-LATEST-WORLD-CON-IV-2012-PROMO-with-Lana-Wood.html>, but Kevin Standlee reported that we've left it alone because it uses World-con, not Worldcon.
7. Warren Buff suggested we gently remind the Orlando in 2015 bid to use WSFS mark language on their bid materials. Kevin Standlee "pinged" them, and they have complied.
8. In November, Mike Scott submitted his list of candidates for the Worldcon Website Working Group ("WWWG"). All were appointed to the group as follows: Rick Moen (approved 5-0), Mark Olson (approved 4-1), Deb Geisler (approved 5-0), Barry Newton (approved 5-0), David Dyer-Bennett (approved 5-0) and Vincent Docherty (approved 5-0). Kevin Standlee was appointed to the committee *ex officio* as MPC Chair.
9. In December, René Walling suggested that it would be easier to convince third party websites that if an MPC member contact them is, in fact, a legitimate representative if there were a FAQ we could point to. Kevin created <http://www.thehugoawards.org/hugo-faq/> and linked it to <http://fancylopedia.wikidot.com/hugo-rules>.
10. January was a busy month. Kevin Standlee reported that the website, <http://awriter-atwork.blogspot.com/2012/01/worldcon-2013.html> was calling the 2013 World Fantasy Convention in Brighton "Worldcon," even to the extent of labeling the link to the 2013 WFC's web site <http://www.wfc2013.org/> as "Worldcon." He tried posting a comment pointing out that WFC isn't Worldcon, that the 2014 Worldcon will probably be in London, and asking would they please correct the post. This is just the sort of confusion of brands we need to watch out for, given the overlap between WFC and Worldcon. After being contacted by us, the site was renamed Fantasycon 2013.

11. Kevin Standlee also noted that Locus continues to use the term “worldcon” as if it were a generic entity, and that we should encourage the current Locus regime to honor our mark.
12. To continue in this vein, Isaac Alexander, pointed out the FaceBook site for “World Conspiracy”: <http://www.facebook.com/WorldCon>. But Dave McCarty pointed that that for any FaceBook user/group there is some shortened acronym or “user name,” but that doesn’t make it meaningful. (If you search for "worldcon" on FaceBook, that page doesn't turn up—or doesn't turn up high enough to hit it when paging through the top few pages of what it shows). Dave also pointed out that the only way to really run across it is to straight out type it into the URL, and that’s not the way most people use FaceBook, and the group is not actually using the name “worldcon”. No action was taken.
13. Kevin Standlee reported that Mike Scott was moving forward with the project of rebuilding the WSFS web site. Therefore, Kevin created an “association” account in the name of WSFS at gandi.net, the registrar with which Mike was working, and Kevin would be one of the contacts on the account. Mike was going to talk to Don about moving the domains Don has control of to the new domain, leaving only one domain that seems to be stuck with Michael Wallis, who has gafiated.
14. Deb Geisler reported that http://www.reddit.com/r/SF_Videos very likely violated our service mark on the Hugo Award logo. They appeared to be using a derivative form of the Hugo Award Logo for their logo. Kevin Standlee added that this was more of a protection issue than a marketing issues, so it would fall under the MPC, not HAMC. Kevin contacted the site manager and received a very nice apology, and they immediately removed the offending logo.
15. As our last act of January, Kevin Standlee wrote to our attorney, Esther Horwich, asking her where things stood with our registrations on the Logo and the Rocket. Kevin, working with HAMC Chair René Walling, continued to correspond with Esther throughout the year to clarify our filing. (See related items below.)
16. As we entered February, Nick Mamatas wrote on his Live Journal page that he would “like to get a smith to make some pins that look very much like but not identical to Hugo nominee pins. Say, a couple thousand. And I’d like to leave them, in a pair of wheelbarrows, in the lobby of the hotel for Chicon 2012 along with a sign reading ‘FREE! TAKE ONE!’” Kate Kligman later reported that “Nick says he has no plans to proceed with this, and that it was just a joke.”

17. Mike Scott (WWWG) reported that

Don Eastlake, George Mitchell, Don's folder of Network Solutions correspondence and I sat down together at Boskone, and we have successfully (with quite a bit of effort) logged into the primary accounts for worldcon.org, nasfic.org and hugo.org and set the transfers in progress to the new Gandi.net account that I created. They may take a month to go through, as Network Solutions seem to have blocked them for 30 days because of "suspicious activity" (which is probably that we changed the contact email address right before starting the transfer, since they had an old and no longer working email address for Don on those accounts), but they should go through in the end. And I have access to the Network Solutions accounts if they need kicking from that end again. George is listed as technical contact for wsfs.org, which will be more difficult as the primary contact [Michael Wallis] is not co-operating, and will see what [George] can do about recovering that domain as well."

Ben reminded us that we still have worldcon.com parked at godaddy.

18. Kevin Standlee heard back from Esther Horwich, who said we could register the [Hugo] Logo as a service mark, with date of first use of August 2009. Kevin said he would ask Rene Walling if he could provide Esther with electronic versions of the logo in the format that USPTO wants. A discussion ensued, however, regarding which date-of-first-use to claim for the design of the trophy Rocket as "trade dress" since we could either declare it to be September 1984 (the first use of the Weston redesign) or September 1955 (the first version recognizably similar to the current design). If we chose the latter, we would need to remove the material from the web site discussing the 1984 Weston refinements to the McKnight/Jason design. Ben Yalow suggested going "with the 1984 first use date" and "keep[ing] the unregistered trade dress for the three decades before that, if there's a challenge." Kevin reported that the consensus was to "use the 1984 version. That's still nearly thirty years ago now (yikes!) and probably should give us pretty good protection against anyone else trying to create a rocket-type trophy for SF/F."

We asked if "all color/shade variations of the logo [would] be covered," the answer was no. Esther had assumed the mark was black and grey only and told us that there could be a problem if we use color.

After a lengthy explanation from Esther, the decision was to register the Hugo Logo and register the black-and-grey rocket design as "Trade Dress." But after some additional back-and-forth with Esther, the actual design will be more like the black-and-white design shown in the header of the Hugo Awards website.

19. There were two other issues regarding our marks in March. The first one involved <http://sandwalk.blogspot.com/2012/03/john-mattick-wins-hugo-award-for.html>. The award in question was the Chen Award, given out by the Human Genome Organization (HUGO). The organization does not call itself “Hugo”; the issue arose solely because of slopping reporting by the website, which was taken to task in public by others. (The first comment on the site complained about “the hijacking of the term ‘Hugo Award’.”) The author replied at <http://sandwalk.blogspot.com/2012/03/john-mattick-wins-hugo-award-for.html?showComment=1332074067586#c5809328494742503358>. He changed the title “reluctantly,” and criticized us for being “irony deficient,” even though he admitted that he was playing off the name of our award in his title.
20. The second item came from Colin Harris, who created a Renovation lending team on Kiva, a micro-finance organization supporting people and businesses in developing countries. This was an unofficial activity promoted informally to Reno members; and they had about 20 lenders. The members want to continue to grow it and therefore renamed the group “Worldcon.” (See <http://www.kiva.org/team/worldcon>. As Colin pointed out, this group was formed by Worldcon members, and we let the matter drop.
21. The biggest issue of the year (and that has just concluded) regards the Chicago International Film Festival (“CIFF”) Awards. As we’ve reported in previous years, they use the terms “Gold Hugo” and “Silver Hugo”, and we never contested that use. However, in April, Dave McCarty reported: “Right now, I am watching a broadcast on our local PBS channel (channel 11) entitled ‘The 2012 Hugo Awards’.” After much discussion and research, on June 29, 2012, Esther Horwich wrote a letter to the festival asking them to assure us by August 1, 2012, that they “will take the reasonable steps . . . to prevent confusion with our mark. . . . We are open to suggestions on how to avoid confusion between the two marks.” We continue to receive emails regarding the CIFF Gold/Silver Hugos, and upon advice of our lawyer, Kevin has been compiling a “confusion” file in case we have to prove that CIFF is causing confusion. In late July, Esther also suggested that we include the following language when responding to these enquiries:

Please note that the Hugo Award is a registered trademark of the World Science Fiction Society and any use of this mark other than through authorization of the World Science Fiction Society is not permitted.

We are pleased to report that on August 2, 2012, CIFF agreed, without admitting any liability, to refrain from calling their awards the ‘Hugo Television Awards’ or “Hugo Awards.” However, Esther is going to try and negotiate further with CIFF’s attorneys because we want them to avoid using

the words “Hugo Award” sequentially (i.e., “Gold Hugo Award”) and will suggest they use “Gold Hugo Trophy.”

22. In June René Walling pointed out a possible infringement from a Danish group at <http://vimeo.com/44796484>, but no action was taken.
23. June also provided us with a few more details to work out regarding the precise Hugo logo format. The mark examiners at USPTO are apparently quite picky. On the advice of our attorney, Esther Horwich, we will be registering the rocket logo itself **without** the words “Hugo Award” since we already have registration on the words “HUGO AWARD” in general form and do not specifically need it as part of the logo.
24. Linda Deneroff reported more possible confusion with our mark at <http://airlockalpha.com/specials/portal-awards-2012.html>, but it was not a direct infringement.
25. In July, Don Eastlake reported a possible junk mail regarding registering domain names for NASFiC. But we do not really care about foreign domain names for this mark outside North America and did not respond.
26. In an act of tremendous generosity, at the beginning of August, Aussiecon 4 donated A\$4200 to the Mark Protection Committee. At current exchange rates that’s a bit more than \$US 4400. This generous grant will help a lot, particularly given the expenditures we’ve had in resolving the CIFF matter.

– Linda Deneroff –

Financial Report – Mark Protection Committee – World Science Fiction Society

1 August 2011 through 31 July 2012

	Amount	Balance
Cash on hand as of 1 August 2011		7766.09
Balance as of 31 July 2012 A current financial report is unavailable at this time		

Hugo Award Marketing Committee Report to Mark Protection Committee September 2011 - August 2012

- We have started distribution of the Hugo Award Winner Logo.
- We have started creating translated versions of the Hugo logo for foreign language editions of winning works. So far we have translations for French, German and Japanese. The committee thanks Tomoko Adams, Johan-Martijn Flaton, and Alison Wall for their help in the translation of the logo.
- We have consolidated all usernames and passwords for the website (www.TheHugoAwards.org) and various Hugo Awards-related social media accounts in a single location accessible by multiple people. We expect to maintain this in order to avoid needing to hunt down passwords as has happened in the past.
- We have kept in touch with the Worldcon Heritage group in order to avoid duplication of efforts and to share information if need be.