California Underground Facilities Safe Excavation Board

May 11, 2021

Agenda Item No. 7 (Action Item) – Staff Report

Board Name Change

PRESENTERS

Tony Marino, Executive Officer

Jeff Brooks, Attorney

SUMMARY

On September 30, 2020, the Board's Executive Officer received a letter from attorneys for Dig Safe System, Inc. informing him of their trademark of "DIG SAFE" and demanding the Board cease use of "Dig Safe" and associated marks. Board staff have ceased using these on official documents and recommend engagement with the Natural Resources Agency and the Public Utilities Commission's Wildfire Safety Division on re-branding consistent with the new Office of Energy Infrastructure Safety, which the Board will join on January 1, 2022. Staff also recommend approving Resolution 21-05-01 to require DigAlert and USA North 811 to cease using the "Dig Safe" seal and instead authorize them to use the Great Seal of California.

STRATEGIC PLAN

2020 Strategic Plan Objective: Foster Compliance with New and Existing Laws through Education and Outreach

> Strategic Activity: Build Board Name Recognition through Education and Outreach

BACKGROUND

In the Dig Safe Act of 2016[1], the Legislature added Government Code § 4216.12[2], creating the Underground Facilities Safe Excavation Board and charging it with coordinating the State's education and outreach efforts, developing standards where none exist, investigating "dig-in" incidents, and enforcing—or recommending enforcement for—violations of the State's One-Call Law. By the Board's first meeting in January 2018, it had already adopted the familiar name

[1] SB 661, Chapter 809, Statutes of 2016
[2] Gov't Code § 4216.12

of "Dig Safe Board"—a name which the Legislature codified in SB 865[3]. In mid-2018 the Board began to use a seal with a ribbon containing the words "Dig Safe." On September 14, 2020, the Board adopted Resolution 20-09-01, authorizing Underground Service Alert of Southern California ("DigAlert") and Underground Service Alert of Northern California and Nevada ("USA North 811") to use the Board's name and seal[4].

DISCUSSION

On September 30, 2020, attorneys for Dig Safe System, Inc.—the one-call center for Massachusetts, Maine, New Hampshire, Rhode Island, and Vermont—sent Executive Officer Tony Marino a letter stating Dig Safe System, Inc.'s trademark of "DIG SAFE" and demanding that the Board cease use of it. Their concern is that our use infringes on the mark and dilutes it.

Staff have identified documents in which it uses the name "Dig Safe Board" and the seal and have stopped using them.

On January 1, 2022, pursuant to SB 865, the Board will move from the Department of Forestry and Fire Protection (CAL FIRE) to the new Office of Energy Infrastructure Safety. This Office is to be created as of July 1, 2021 through a transfer of the Public Utilities Commission's Wildfire Safety Division to the Natural Resources Agency[5]. Neither the Governor's Office nor the Natural Resources Agency (which will house the new Office) has released details of how the new Office will be branded or what marks or seals it may use.

RECOMMENDATION

Staff recommends that the Board, through its Executive Officer, engage with the Natural Resources Agency and the Public Utilities Commission's Wildfire Safety Division to determine how best the Board can integrate its branding with that of the Office of Energy Infrastructure Safety, to be created as of July 1, 2021. Staff recommends that the Board use its original statutory name and the Great Seal of California as its name and seal in the interim.

Staff also recommends the Board approve Resolution 21-05-01, requiring DigAlert and USA North 811 to cease using the Board's "Dig Safe" name and seal and authorizing them to use the Great Seal of California and original statutory name until the Board has chosen a new seal.

[3] SB 865, Chapter 307, Statutes of 2020
[4] Board Resolution 20-09-01
[5] AB 111, Chapter 81, Statutes of 2019

ATTACHMENTS

A. Letter to Tony Marino from Shannon Nolley, September 30, 2020

B. Resolution No. 21-05-01

GesmerUpdegrove LLP
Attorneys at Law
Boston

Shannon M. Nolley
shannon.nolley@gesmer.com

September 30, 2020

VIA EMAIL ONLY

Tony Marino, Executive Officer
The Dig Safe Board
Office of the State Fire Marshal
2251 Harvard Street, Suite 400
Sacramento, California 95815
email: tony.marino@fire.ca.gov

Re: Unauthorized Use of Registered Trademark DIG SAFE

We represent Dig Safe System, Inc. ("Dig Safe"), a non-profit corporation, with respect to the company's intellectual property matters.

Dig Safe is the owner of the registered trademark DIG SAFE (U.S. Reg. No. 2,363,736). This registration covers "Providing notification services to utility companies of the underground excavation and construction activities of others by monitoring telephone communications and global computer information networks for the purpose of promoting public safety and avoiding damage to underground public utility facilities." The mark has been in use since 1973 and was registered with the United States Patent and Trademark Office in July 2000. Enclosed is a copy of our client's registration certificate.

Dig Safe has nearly fifty years of experience helping consumers safely excavate underground facilities. As a result of widespread advertising and marketing, Dig Safe has developed valuable goodwill in its DIG SAFE brand and related services. Our client views its trademark as a valuable asset and the company fully intends to protect its rights in its mark to the extent permissible under law.

Your unauthorized use of the DIG SAFE mark in connection with directly competitive services is an infringing activity that could confuse consumers and diminish the value of our client's mark. This unauthorized use of the mark is likely to cause consumers to believe that your services emanate from, are affiliated with, or are in some way endorsed or sponsored by our client. As a result, your use of mark also dilutes the distinctive quality of the DIG SAFE trademark and violates the Federal Trademark Dilution Act.

Whereas our client believes that your unauthorized use of the DIG SAFE mark constitutes unfair competition, trademark infringement, and dilution under various federal and state laws, our client demands that your client cease all use of the mark, and any mark confusingly similar to it.

Please advise us of your client's intentions within fourteen (14) days of the date of this letter. If we do not hear from you within that time, we will assume that your client is not interested in an amicable resolution of this dispute and will advise and follow our client's instructions accordingly.

This letter is written without prejudice to any of our client's rights and remedies, all of which are expressly reserved.

Very truly yours,

Shannon M. Nolley

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,363,736

United States Patent and Trademark Office **Registered July 4, 2000**

SERVICE MARK
PRINCIPAL REGISTER

DIG SAFE

DIG SAFE SYSTEM, INC. (MASSACHUSETTS NON-PROFIT CORPORATION)
331 MONTVALE AVENUE
WOBURN, MA 01801

FOR: PROVIDING NOTIFICATION SERVICES TO UTILITY COMPANIES OF THE UNDERGROUND EXCAVATION AND CONSTRUCTION ACTIVITIES OF OTHERS BY MONITORING TELEPHONE COMMUNICATIONS AND GLOBAL COMPUTER INFORMATION NETWORKS FOR THE PURPOSE OF PROMOTING PUBLIC SAFETY AND AVOIDING DAMAGE TO UNDERGROUND PUBLIC UTILITY FACILITIES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 7-2-1973; IN COMMERCE 7-2-1973. SEC. 2(F).

SER. NO. 75-514,321, FILED 7-6-1998.

GEORGE LORENZO, EXAMINING ATTORNEY

CALIFORNIA UNDERGROUND FACILITIES SAFE EXCAVATION BOARD

RESOLUTION NO. 21-05-01

REQUIRING UNDERGROUND SERVICE ALERT OF SOUTHERN CALIFORNIA ("DIGALERT") AND UNDERGROUND SERVICE ALERT OF NORTHERN CALIFORNIA AND NEVADA ("USA NORTH 811") TO CEASE USE OF THE "DIG SAFE BOARD" NAME AND "DIG SAFE SEAL" AND AUTHORIZING THEM TO USE THE GREAT SEAL OF THE STATE OF CALIFORNIA ON INVOICES FOR BOARD REGULATORY FEES UNTIL THE BOARD HAS CHOSEN A NEW SEAL

WHEREAS, Government Code section 4216.16 authorizes the Board to collect a fee from members of the state's regional notification centers not to exceed the reasonable regulatory cost incident to enforcement of Government Code section 4216 et seq.;

WHEREAS, the Board adopted in Resolution 18-08-01 Section 4010 of Title 19 of the California Code of Regulations to establish fees pursuant to Government Code section 4216.16, and the regulations required the regional notification centers to collect the fees on the Board's behalf;

WHEREAS, subsequently, several members of the state's two regional notification center have expressed concern that the invoices sent by the regional notification centers on the Board's behalf do not look official;

WHEREAS, during the Board's June 8, July 13, and August 8, 2020 meetings representatives of the regional notification centers had expressed a desire to use the Board's seal on the invoices the regional notification centers send on the Board's behalf to convey the legitimacy of the invoices;

WHEREAS, Business and Professions Code section 17533.6 states that it is unlawful for any person, firm, corporation, or association that is a non-governmental entity to use a seal, emblem, insignia, trade or brand name, or any other term, symbol, or content that reasonably could be interpreted or construed as implying any federal, state, or local government, military veteran entity, or military or veteran service organization connection, approval, or endorsement of any product or service unless the nongovernmental entity has an expressed connection with, or the approval or endorsement of, a federal, state, or local government, military veteran entity, or military or veteran service organization;

WHEREAS, Section 4010 of Title 19 of the California Code of Regulations creates an expressed connection between the state's two regional notification centers and the Board for the purpose of collection of the Board's regulatory fee;

WHEREAS, the Board approved Resolution 20-09-01 ("Authorizing Underground Service Alert of Southern California ("DigAlert") and Underground Service Alert of Northern California and Nevada ("USA North 811") to Use the Board's Seal on Invoices for Board Regulatory Fees") to allow the State's two one-call centers to use the Board's seal on their invoices if the document containes the following language:

"Use of the Dig Safe Board seal is authorized pursuant to Board Resolution 20-09-01.";

WHEREAS, pursuant to Senate Bill 865 (Hill, Chapter 307, Statutes of 2020), the Board shall join the new Office of Energy Infrastructure Safety on and after January 1, 2022;

WHEREAS, the Board has chosen to cease use of the Dig Safe Board seal and name in response to a demand from Dig Safe Systems, Inc. to cease use of the name and associated marks and instead use its statutory name and the Great Seal of the State of California until it has developed integrated branding with the new Office of Energy Infrastructure Safety;

THEREFORE, BE IT RESOLVED by the California Underground Facilities Safe Excavation Board as follows:

1. Underground Service Alert of Southern California ("DigAlert") and Underground Service Alert of Northern California and Nevada ("USA North 811") shall cease use of the name "Dig Safe Board" and its "Dig Safe" seal invoices requesting a member pay of the Board's fee, a statement informing a member of balance due for the Board's fee, or communication informing a member of the consequences of late payment or nonpayment of the Board's fee, and shall cease using the following language:

   "Use of the Dig Safe Board seal is authorized pursuant to Board Resolution 20-09-01."

2. Until the Board has adopted a new seal, Underground Service Alert of Southern California ("DigAlert") and Underground Service Alert of Northern California and Nevada ("USA North 811") may use the Great Seal of the State of California on an invoice requesting a member pay of the Board's fee, a statement informing a member of balance due for the Board's fee, or communication informing a member of the consequences of late

payment or nonpayment of the Board's fee, if the document contains the following language:

"Use of the Great Seal of California is authorized pursuant to Underground Facilities Safe Excavation Board Resolution 21-05-01."

3. Once the Board has adopted a new seal, Underground Service Alert of Southern California ("DigAlert") and Underground Service Alert of Northern California and Nevada ("USA North 811") may use the Board's seal on an invoice requesting a member pay of the Board's fee, a statement informing a member of balance due for the Board's fee, or communication informing a member of the consequences of late payment or nonpayment of the Board's fee, if the document contains the following language:

   "Use of the Underground Facilities Safe Excavation Board seal is authorized pursuant to Board Resolution 21-05-01."

4. This resolution shall take effect immediately upon approval.