



NEWSLETTER | MarkIt to Market® - January 2018

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50th Issue

January marks the 50th issue of Sterne Kessler's MarkIt to Market® newsletter. This issue discusses Olympic marks ahead of the upcoming winter games, covers new protection for certification marks in the EU, provides an update on the recent trademark and copyright infringement lawsuit involving Grumpy Cat Ltd., and lists the new gTLD Sunrise periods.

Sterne Kessler's [Trademark, Advertising, and Anti-Counterfeiting practice](#) is designed to help meet the intellectual property needs of companies interested in developing and maintaining strong brands around the world. For more information, please contact [Monica Riva Talley](#) or [Tracy-Gene G. Durkin](#).

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Caution: Olympic Marks Ahead *Staying In-bounds with the U.S. Olympic Committee*

By: [Julie D. Shirk](#)

Beginning February 9th, the eyes of those interested in athletic endeavor and spectacle will turn to Pyeong Chang for the 2018 Winter Olympic Games. As a brand owner, it is tempting to get caught up in and exploit the excitement, spirit, and national pride of the Olympics. But unless your company is an officially-licensed sponsor, or you're offering journalistic, educational, or editorial content, your use of the word "Olympic" or other intellectual property of the International Olympic Committee/U.S. Olympic Committee (USOC) may be prohibited.

» [Read more](#)



European Union Welcomes Certification Marks

By: [Dana Justus](#)

Companies that attest to the quality of products or services under a "certification mark" – a type of trademark used to show consumers that particular goods or services (or their providers) have met certain standards – are now able to register such marks in the European Union.

» [Read more](#)



Be Like Grumpy Cat

By: [Monica Riva Talley](#)

News recently hit the wires that Grumpy Cat Ltd., the company behind the Grumpy Cat Internet "person"ality, was awarded over \$700,000 in a trademark and copyright infringement lawsuit. The defendant was a licensee who was found to have overstepped the terms of a trademark and copyright license agreement relating to iced-coffee, including by selling "Grumppuccinos."

» [Read more](#)

gTLD Sunrise Periods Now Open

As first reported in our December 2013 newsletter, the first new generic top-level domains (gTLDs, the group of letters after the "dot" in a domain name) have launched their "Sunrise" registration periods. Please contact us or see our [December 2013 Newsletter](#) for information as to what the Sunrise Period is, and how to become eligible to register a domain name under one of the new gTLDs during this period.

» [Read more](#)

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[VISIT WEBSITE](#)[CONTACT US](#)[SUBSCRIBE](#)[FORWARD TO A FRIEND](#)**Caution: Olympic Marks Ahead**
*Staying In-bounds with the U.S. Olympic Committee*By: [Julie D. Shirk](#)

Beginning February 9th, the eyes of those interested in athletic endeavor and spectacle will turn to Pyeong Chang for the 2018 Winter Olympic Games. As a brand owner, it is tempting to get caught up in and exploit the excitement, spirit, and national pride of the Olympics. But unless your company is an officially-licensed sponsor, or you're offering journalistic, educational, or editorial content, your use of the word "Olympic" or other intellectual property of the International Olympic Committee/U.S. Olympic Committee (USOC) may be prohibited.

Federal statute gives the USOC exclusive rights to the words "Olympic," "Olympiad," "Team USA," and "Pyeong Chang 2018" and to the symbols of the five interlocking rings, the Olympic flame and torch, and others. These exclusionary rights are heightened in that the USOC need not demonstrate the Lanham Act's "likely to cause consumer confusion as to source" to prove trademark infringement. Rather, a use merely "**tending** to cause confusion or mistake...or to falsely suggest a connection with the corporation or any Olympic, Paralympic, or Pan-American Games activity" is sufficient to invoke liability.^[1]

Given such protections, and the large sums paid by official sponsors, it is not surprising that the USOC aggressively polices unauthorized commercial uses of its intellectual property. But you may be surprised by what the USOC considers commercial use. For example, while the USOC encourages support and discussion of "Team USA" on **personal** social media accounts, use of USOC intellectual property on (non-sponsor) **company** social media accounts, such as #GoTeamUSA, or as re-postings from social media accounts of news organizations, is impermissible.

Before advertising or using anything evocative of or related to the Olympics --or a particular Olympic athlete-- commercially, we encourage brand owners to review the U.S. Olympic and Paralympic Brand Usage Guidelines [here](#), which provides guidance for all types of uses, or contact your trademark attorney.

^[1]36 U.S.C. § 220506 (emphasis added).

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By: [Dana Justus](#)

Companies that attest to the quality of products or services under a “certification mark” – a type of trademark used to show consumers that particular goods or services (or their providers) have met certain standards – are now able to register such marks in the European Union.

Although certification mark registrations have been available via many national trademark offices throughout Europe (and, of course, through the U.S. Patent and Trademark Office) for many years, they are a recent development at the EU level. As of October 1, 2017, companies can now apply for an EU certification mark.

Similar to U.S. law, the applicant for an EU certification mark must use the mark in question as a symbol of supervised quality for the certification of others – it cannot use the certification mark for its own products or services, and therefore cannot own or benefit from the goodwill in the mark. Another bar is that an EU certification mark cannot designate the geographical origin of the goods or services being certified, which differs from some national certification marks (such as, for instance, U.S. or U.K. certification marks).

This development means that companies offering quality control for the products or services of others now have another mechanism to protect their valuable certification marks in Europe.

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For those unfamiliar with this character, Grumpy Cat is an Internet sensation, known particularly for YouTube videos featuring her displeased mug. However, what separates Grumpy Cat from other fly-by-night online personalities are the practical steps Grumpy Cat’s owners took to protect and monetize the intellectual property associated with her persona. Since arriving on the scene, the business entity behind the feline has been very savvy in seeking trademark registration for the GRUMPY CAT name and her image for key product categories. The Grumpy Cat [website](#) features various merchandise for sale, including co-branded Gund GRUMPY CAT plush toys, books and paper products, and pet toys.

Interested in making your pet into the next YouTube sensation? Here are five steps to consider:

1. **Think like a marketer:** Come up with a catchy – and protectable -- name for your pet’s social media accounts.
2. **Promote:** Have your pet comment on current events with sharable memes featuring her furry face and brand.
3. **Protect:** If your pet’s antics have traction, consider filing for trademark protection for the entertainment services and potential licensable merchandise.
4. **Monetize:** Seek licensing opportunities – for the images and videos, and for co-branded merchandise.
5. **Police and enforce:** Monitor third-party usage, and move promptly to take down infringing content.

Who knows – done right, your pet may end up making you some serious scratch!

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As of January 31, 2018, ICANN lists Sunrise the period as open for the following new gTLD:

.nowruz

ICANN maintains an up-to-date list of all open Sunrise periods [here](#). This list also provides the closing date of the Sunrise period. We will endeavor to provide information regarding new gTLD launches via this monthly newsletter, but please refer to the list on ICANN's website for the most up-to-date information – as the list of approved/launched domains can change daily.

Because new gTLD options will be coming on the market over the next year, brand owners should review the list of new gTLDs (a full list can be found [here](#)) to identify those that are of interest.

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