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Thank you for reading the October 2022 issue of Sterne Kessler's MarkIt to Market® newsletter. This month, we discuss an ongoing trademark suit involving a claim of irreparable harm, share the now open gTLD Sunrise periods, and feature analysis of Supreme Court copyright case *Andy Warhol Foundation for the Visual Arts Inc. v. Goldsmith*.

Our [Trademark & Brand Protection practice](#) here at Sterne Kessler is devoted to guiding companies of all sizes in developing and maintaining strong brands around the world. There is always something new and exciting happening in our unique IP niche, and we bring you updates each month to help you keep on top of it all. Thanks for your readership. If there is something you would like us to cover, please don't hesitate to reach out to us and let us know!

Kind Regards,

[Monica Riva Talley](#)
Editor

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Don't Delay, Act Today: Showing of Irreparable Harm Damaged by Delay in Filing Complaint



By: [Shana L. Olson](#)

In a [recent court order](#) out of the Eastern District of Washington, a judge denied the Plaintiff's request for a preliminary injunction against Defendant's use of the mark LEAVENWORTH OKTOBERFEST, based in part on Plaintiff's 10-month delay in filing its complaint, which negated a finding of irreparable harm.

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gTLD Sunrise Periods Now Open: October 2022

By: [Monica Riva Talley](#)

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.

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Copyright Compliance Tips Ahead of Justices' Warhol Ruling

Directors [Ivy Clarice Estoesta](#) and [William H. Milliken](#) authored the *Law360* article "Copyright Compliance Tips Ahead of Justices' Warhol Ruling," in which they provide analysis of the oral argument heard before the Supreme Court in *Andy Warhol Foundation for the Visual Arts Inc. v. Goldsmith* and offer practical tips for creators and copyright attorneys.

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Editor & Authors



Monica Riva Talley
Director
mtalley@sternekessler.com



Shana L. Olson
Associate
solson@sternekessler.com



Ivy Clarice Estoesta
Director
iestoest@sternekessler.com



William H. Milliken
Director
wmilliken@sternekessler.com

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The City of Leavenworth, Washington ("City") sued Project Bayern Association ("Association") in a conflict arising out of the parties' respective Oktoberfest celebrations. The parties had entered into a lease agreement that started in 2012; under that agreement, the Association leased a warehouse from the City for its annual Oktoberfest celebration. The City terminated the lease in 2021, and the Association last used the City's warehouse for its 2021 event.

However, unbeknownst to the City, the Association applied to register the mark LEAVENWORTH OKTOBERFEST in 2016 and received a registration from the USPTO in 2017. After terminating the Association's lease, the City then went on to plan its own Oktoberfest celebration for 2022 using a different vendor.

The Association sent cease-and-desist letters to both the new vendor and the City, demanding that they cease use of its registered mark. The Association also published a Facebook post advertising its own event, to be held in Wenatchee, Washington, and noted that there "is no Oktoberfest in Leavenworth this year." The City then sued and asked for a preliminary injunction, alleging false advertising and false association/designation claims under the Lanham Act and a claim of unfair or deceptive practices under state law.

To obtain a preliminary injunction, a plaintiff must demonstrate four factors under *Winter v. Natural Resources Defense Council*, 555 U.S. 7 (2008), including a likelihood of irreparable injury in the absence of an injunction. In deciding against a preliminary injunction, the judge found that the City's 10-month delay between when the Association posted on Facebook advertising its own event in Wenatchee and when the City actually sued implied a lack of urgency with respect to the irreparable harm. This case is still ongoing, but this order denying the preliminary injunction demonstrates the high burden that a plaintiff is required to meet to prove irreparable harm and serves a lesson to those involved in trademark disputes to act quickly to enforce their rights.

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As of October 28, 2022, ICANN lists new Sunrise periods as open for the following new gTLDs that may be of interest to our clients. A full list can be viewed [here](#).

.rsvp
.boo
.giving

ICANN maintains an up-to-date list of all open Sunrise periods [here](#). This list also provides the closing date of the Sunrise periods. 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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