



NEWSLETTER | Markt to Market® - March 2018

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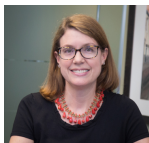
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The March 2018 issue of Sterne Kessler's Markt to Market® discusses the impact of Brexit on trademarks, the inception of the PTO's Trademark Specimen Protest Email Pilot Program, and lists the new gTLD Sunrise periods.

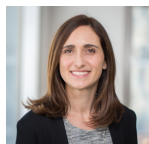
Sterne Kessler's [Trademark & Brand Protection practice](#) is designed to help meet the intellectual property needs of companies interested in developing and maintaining strong brands around the world. For more information, please contact [Monica Riva Talley](#) or [Tracy-Gene G. Durkin](#).

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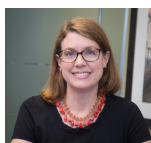


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Countdown to December 2020: Brexit Draft Agreement Provides Some Clues for Trademark Impact

By: [Dana Justus](#)

BREXIT! A word that might have been unthinkable a mere two years ago now raises so many questions for today's trademark professionals – but some of those key questions were recently answered, at least for now.

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True Use or True Lies?

By: [Lauriel Dalier](#) and [Monica Riva Talley](#)

Earlier this month the PTO announced the inception of its Trademark Specimen Protest Email Pilot Program; as the name suggests, the program encourages the public to report any specimens that do not appear to exhibit marks as actually used in commerce. The program covers pending applications, and was instituted to remedy a spike in digital imagery suspected of having been created simply for the purpose of obtaining U.S. trademark registrations.

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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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BREXIT! A word that might have been unthinkable a mere two years ago now raises so many questions for today's trademark professionals – but some of those key questions were recently answered, at least for now.

The European Commission published a draft agreement last month that details key issues related to the United Kingdom and Northern Ireland's withdrawal from the European Union, which is now slated for a 19-month transitional period beginning on March 29, 2019 and ending in December 2020. Title IV of the extensive draft contains eight Articles (50 – 57) that address the treatment of intellectual property, including trademarks in addition to designs, geographical indications, databases, and plant variety rights.

In a fortunate turn for current EUTM (European Union trade mark) registrants, the draft agreement proposes "continued protection in the United Kingdom of registered or granted rights" – specifically, that a registered or granted EUTM will convert to a comparable, enforceable UK right. This new UK registration will convey the same renewal date as the corresponding EU registration.

The draft agreement does not indicate whether there will be a fee for the conversion of rights, a pressing question which will be included among those debated by the EU and UK negotiators in the coming months.

As to new and pending applications, the draft provides that EU applications filed before the December 2020 transition date will have a six-month period to claim priority via a newly filed UK application.

In a somewhat mystifying turn, the draft agreement does not address whether IP practitioners in the UK will be able to represent clients before the EU IP Office – a key outstanding matter for those attorneys, in addition to their clients and fellow attorneys around the world.

Although the draft agreement provides helpful guidance on the potential future of post-Brexit EU trademark rights, it is still very much a work in progress – and we, along with the rest of the global trademark community, are closely monitoring for further updates as December 2020 draws closer.

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Imaging software has made it easier than ever to create and alter images for use as specimens. The PTO has recently seen situations where trademarks are noticeably added to electronic imagery; in the most egregious cases, the same imagery – with only the mark modified -- has been used to support numerous applications by ostensibly different applicants. The PTO is asking for help from stake holders to help police the use of such fraudulent specimens.

The PTO's pilot email program allows users to email specimen concerns to a single email address: TMSpecimenProtest@uspto.gov. Submissions should include either:

- Objective evidence of third party use of the identical image as that shown in the specimen or record without the mark in question, or
- prior registration or serial number(s) of applications in which identical images or mocked up websites, all with different marks, have been submitted to the PTO

For more information on the submission process and requirements, [click here](#).

The institution of this pilot program will not only assist the PTO in ensuring the integrity of the Register, but will also help applicants address uncertainty in the clearance and prosecution process. At any time during the pendency of an application – and up to 30 days after publication – interested third parties can submit evidence that a specimen is fraudulent. The program provides a streamlined pathway for clearing a mark for use and registration, and for overcoming citations based on fraudulent filings.

With an engaged user base, the pilot program will hopefully allow the PTO to say **“Hasta la vista, baby!”** to marks registered based on fake trademark specimens.

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As of March 29, 2018, ICANN lists Sunrise the period as open for the following new gTLD:

.app	.餐厅
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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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