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MarkIt to Market®

September 2019

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The September 2019 issue of Sterne Kessler's MarkIt to Market® newsletter discusses a component mark case study, LeBron James' recent trademark application, and the current gTLD sunrise period.

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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PERCEPTION IS EVERYTHING: USE OF COMPONENT MARKS IN

COMMERCE

By: Shana L. Olson

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By: Shalonda G. Arnold

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It turns out that one of basketball’s most beloved players, LeBron “King” James, is just like the rest of us. He shares his love for the favored weekday with videos on his social media celebrating Taco Tuesday nights with his family, friends, and the occasional celebrity guest.

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gTLD SUNRISE PERIOD NOW OPEN

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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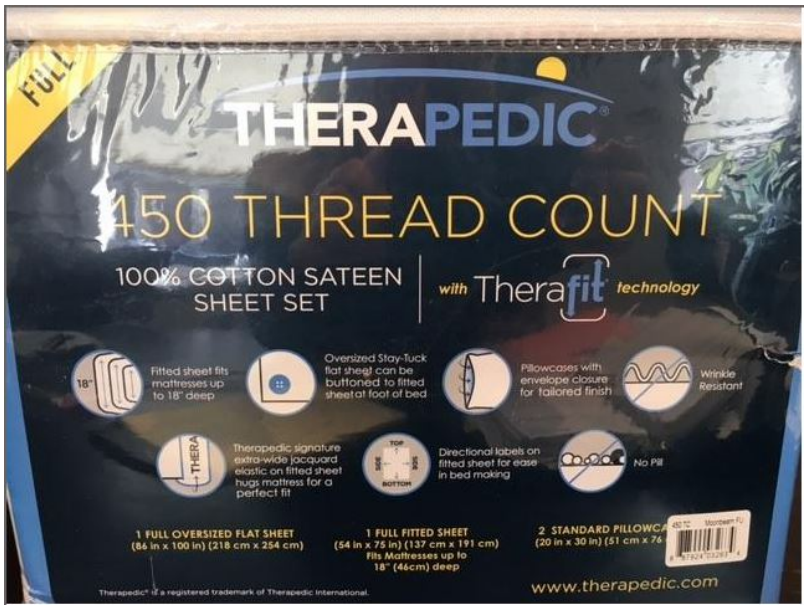
In a recent TTAB case, *In re Ther-A-Pedic Associates, Inc.*, Applicant Ther-A-Pedic's specimen of use for the mark THERAFIT was refused as not showing the mark in use with the goods, "bed sheets" in Class 24:



In the specimen, the mark is used as one of the larger phrases on packaging for THERAPEDIC sheets – "with Therafit technology." The Examining Attorney refused registration on the grounds that THERAFIT is used as a component mark to identify a component or feature of the goods, not the goods themselves. The Applicant argued that the mark refers to the finished bed

sheets, since any components of the sheets (i.e., the elastic feature identified by the mark) cannot be disassociated with the sheets, or otherwise sold separately. This argument was unsuccessful, and the TTAB affirmed the refusal.

What lessons can be learned from this case? When filing for a mark, carefully consider how the mark will be used – will it only identify a feature or component of the goods? If so, consider ways to work around the issue before filing. Perhaps the component mark should be filed for only the identified component of the goods; this could give the Registrant some future flexibility, if the feature or component is useful in a different finished product than originally anticipated. Another potential work-around is to revise the marketing plan for the goods so that the proposed mark identifies the goods as a whole. In the case of the Therapedic sheets, marketing the sheets as THERAFIT sheets (instead of THERAPEDIC sheets with Therafit technology), or as THERAPEDIC THERAFIT SHEETS, may have a been a way to avoid the component mark refusal.

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It turns out that one of basketball’s most beloved players, LeBron “King” James, is just like the rest of us. He shares his love for the favored weekday with videos on his social media celebrating Taco Tuesday nights with his family, friends, and the occasional celebrity guest.

In August of this year, James applied for a trademark for TACO TUESDAY in connection with downloadable audio/visual works, advertising and marketing services, podcasting services, and online entertainment services. News of the filing was met with mixed reactions, ranging from excitement to cries of cultural appropriation. Mostly there were the typical articles and blog posts criticizing James’ decision to file the application proclaiming that there is no way he could succeed in registering a “widely used term” in everyday speech.

As predicted, the application received a Nonfinal Office Action on September 11, refusing registration on the basis that TACO TUESDAY is a commonly-used slogan and does not function as trademark. The Examining Attorney went on to state that consumers would not view the mark as a source identifier but “as only conveying an informational message.” The TMEP states that a mark is merely informational when consumers are accustomed to use of the mark in everyday speech by a number of sources. In support of this refusal, the Examiner provided evidence of the mark’s vast use.

Perhaps showing his PR prowess, James is now issuing statements explaining that receiving a refusal was the purpose of his filing to begin with. A spokesman for James told ESPN's Dave McMenamin that the application was filed "to ensure LeBron cannot be sued for any use of 'Taco Tuesday'.”

The refusal is being positioned as allowing James to proceed with new ventures while protecting himself from litigious foes seeking big financial rewards in challenging his pursuits off the court. It is an interesting strategy, and one James evidently sees as a preemptive strike that will allow him to explore different ventures. James has until March 11, 2020 to respond to the Office Action, should his trademark protection strategy change.

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As of September 30, 2019, ICANN lists a new Sunrise period as open for the following new gTLD that may be of interest to our clients. A full list can be viewed here.

.madrid

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.