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August 2019



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The August 2019 issue of Sterne Kessler's MarkIt to Market® newsletter discusses The Ohio State University's trademark application for the mark "THE" 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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By [Monica Riva Talley](#)

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language, while the less generous deemed the attempt [“one of the sillier sports filings since Tom Brady pursued a 'Tom Terrific' trademark”](#) and [pompous, stupid, ridiculous, and arrogant](#).

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gTLD SUNRISE PERIOD NOW OPEN

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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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All joking aside, The Ohio State University’s plan to register the THE trademark actually makes sense from a business and branding perspective; a quick look at the U.S. Patent and Trademark Office’s database reveals that quite a number of parties have registered the mark THE for everything from perfumes, metal hardware, career information services, and kitchen appliances, to battery chargers.

And, as University officials have been quick to explain, the trademark filing is part of a deliberate rebrand that started in 1986, when the University took steps to move away from OSU (which could also refer to Oregon State University and Oklahoma State University) to The Ohio State University. Evidently, the “The” has been part of the school’s name since 1878; The Ohio State University library [website](#) explains, “Legend... has it that 'The' was used to show the other colleges which institution was supposed to be the leader in the state - both in size and in financial support from the legislature.”

As a quasi Buckeye fan by marriage, it has always struck me how players, fans, and the school itself are all fanatics about emphasizing the THE portion of the name – whether while introducing players at the beginning of a football game, in recruiting ads, or when correcting my terminology when making plans for the upcoming game against Michigan (November 30). If anything, the school and the fans have set the groundwork for a secondary source argument, in the event the trademark application for the merchandise is refused on merely ornamental grounds.

In filing the application, The Ohio State University is also on trend in embracing brand nicknames – following in the footsteps of household nickname brands such as FedEx, Nick,

Bud, BK, and AmEx. As with any other trademark, the key to creating a strong brand is to use it consistently, file early, and monitor and enforce against infringers.

The bottom line is that the press generated by the trademark filing has done nothing but enhance the brand significance of the THE mark – as vast swaths of the public are now aware that The Ohio State University is staking a claim in this mark as its own. And it certainly has helped the public distinguish between various similarly-named Ohio universities. Not such a crazy plan after all.

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As of August 29, 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.

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