


**June 2021**

[VISIT WEBSITE](#)
[CONTACT US](#)
[SUBSCRIBE](#)
[FORWARD TO A FRIEND](#)

The June 2021 issue of Sterne Kessler's Markt to Market® newsletter discusses recent litigation surrounding copyright registration invalidation and implications of the increase in trademark application filings at the USPTO. For this month's edition of Watching the Pot™, please enjoy solving a cannabis crossword puzzle!

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](#).

### IN THIS ISSUE

[Unicolors Regroups and Gets Supreme Court to Consider Copyright Invalidation Standard](#)

[Dealing With the Surge: U.S. Trademark Applications Up 63%](#)

[Watching the Pot™](#)

[DOWNLOAD](#)

#### Editor & Author:



**Monica Riva Talley**

Director

[mtalley@sternekessler.com](mailto:mtalley@sternekessler.com)

#### Author:



**Ivy Clarice Estoesta**

Counsel

[iestoest@sternekessler.com](mailto:iestoest@sternekessler.com)

#### Author:



**Lauriel F. Dalier**

Counsel

[ldalier@sternekessler.com](mailto:ldalier@sternekessler.com)

#### Author:



**Deborah Sterling, Ph.D.**

Director

[dsterling@sternekessler.com](mailto:dsterling@sternekessler.com)

**UNICOLORS REGROUPS AND GETS SUPREME COURT TO CONSIDER**

# COPYRIGHT INVALIDATION STANDARD

By: [Ivy Clarice Estoesta](#)

Earlier this month, the Supreme Court granted Unicolors' request for review of the Ninth Circuit's decision in *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.* (9th Circ. 2020). According to Unicolors, the Ninth Circuit's decision, which considered the validity of Unicolors' copyright registration for a group of works (see recap [here](#)), broke with its own precedent, and that of other circuits, by removing the intent-to-defraud requirement for copyright registration invalidation.

[Read More](#)



## DEALING WITH THE SURGE: U.S. TRADEMARK APPLICATIONS UP 63%

By: [Monica Riva Talley](#)

The USPTO issued an alert earlier this week reporting that as of June 17, 2021, U.S. trademark application filings had increased 63% over the prior year, translating into about 211,000 more applications. And, while this sounds like great news for the economy, it is not necessarily good news for trademark applicants.

[Read More](#)

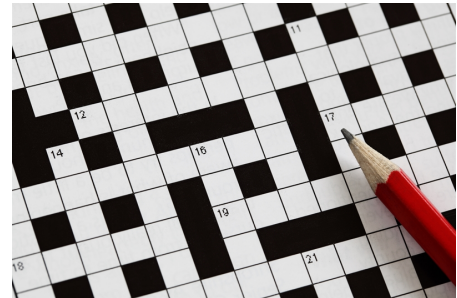
## WATCHING THE POT™

### Cannandrum: Can You "Hash" It Out?

By: [Lauriel F. Dalier](#) and [Deborah Sterling, Ph.D.](#)

With summer now underway, please enjoy this cannabis-themed crossword puzzle! Stay tuned for the answers in next month's issue of *MarkIt to Market*®.

[Read More](#)



The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2021 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**



June 2021



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

## UNICOLORS REGROUPS AND GETS SUPREME COURT TO CONSIDER COPYRIGHT INVALIDATION STANDARD

By: [Ivy Clarice Estoesta](#)

Earlier this month, the Supreme Court granted Unicolors' request for review of the Ninth Circuit's decision in *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.* (9th Circ. 2020). According to Unicolors, the Ninth Circuit's decision, which considered the validity of Unicolors' copyright registration for a group of works (see recap [here](#)), broke with its own precedent, and that of other circuits, by removing the intent-to-defraud requirement for copyright registration invalidation. H&M argues, however, that a showing of intent-to-defraud is not required to invalidate a copyright registration under 17 U.S.C. § 411 of the Copyright Act. Section 411(b)(2) states:

In any case in which inaccurate information [was included on the application for copyright registration with knowledge that it was inaccurate]...is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.

The high court's decision is expected to bring clarity to the issue of whether § 411 challenges to copyright registrations for including known inaccuracies require evidence of intent to defraud before referral to the Copyright Office.

In the meantime, copyright owners wishing to enforce their copyrights would be wise to double check the accuracy of the information listed in their copyright registrations before bringing suit, and consider whether any discovered errors in the registration may be corrected by obtaining a [Supplementary Registration](#), or warrant obtaining a new copyright registration. Parties accused of copyright infringement may likewise want to verify the accuracy of information listed in asserted copyright registrations to consider whether their defensive strategy can incorporate an offensive copyright invalidation suit—at least in the courts in the Ninth Circuit.

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**



June 2021



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

## DEALING WITH THE SURGE: U.S. TRADEMARK APPLICATIONS UP 63%

By: [Monica Riva Talley](#)

The USPTO issued an alert earlier this week reporting that as of June 17, 2021, U.S. trademark application filings had increased 63% over the prior year, translating into about 211,000 more applications. And, while this sounds like great news for the economy, it is not necessarily good news for trademark applicants. The number of applications waiting to be examined this year has doubled, resulting in longer wait times for processing applications at all stages of prosecution. Examination of post registration filings has also been delayed. The USPTO maintains a dashboard of current processing times [here](#).

The USPTO explains that the surge in filings appears to be from both foreign and domestic filers, and believes it to be in part attributable to a change in consumer behavior and purchasing patterns necessitated by the pandemic.

While the USPTO is taking steps to address the backlog – including hiring more examining attorneys and staff, brand owners need to be mindful of the increased time to examination when making branding decisions. For example, the time it takes for the USPTO to make its initial registrability assessment can be critical to decision making for products such as pharmaceutical names, where it is common industry practice to apply for several potential marks at the same time. It can also impact foreign filing decisions, which can be based in part on U.S. examination results. The prosecution timeline can also have serious business consequences when it comes to online or Customs enforcement, where an official registration certificate is often needed to stop counterfeiters.

Brands looking to manage the risk posed by these extended timelines can help manage the uncertainty by building more time into the branding life cycle – selecting and filing for new marks 6-9 months earlier than in previous years. For those anticipating issues with counterfeits and knockoffs, consider other forms of IP protection, such as copyrights, to protect unique designs. And, for those looking to clear marks, it is a good reminder to look closely at whether “live” registrations comply with maintenance requirements. Given the expected delays in examination for maintenance filings, it would follow that the population of “zombie” registrations (marks that are technically dead, but appear as “live” on the register) will similarly grow.

not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2021 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**





June 2021



[VISIT WEBSITE](#)

[CONTACT US](#)

[SUBSCRIBE](#)

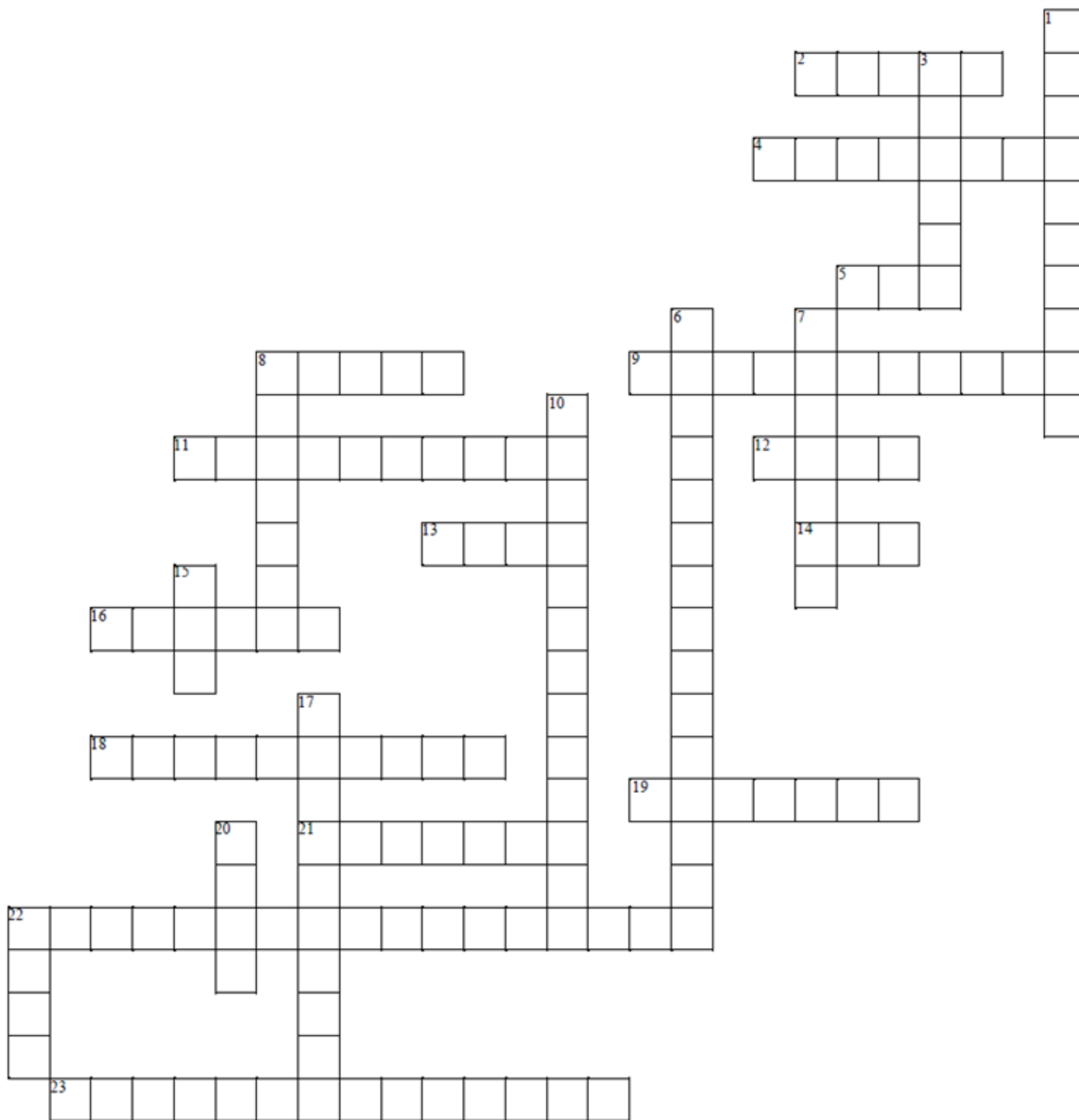
[FORWARD TO A FRIEND](#)

## **WATCHING THE POT™**

### **Cannandrum: Can You "Hash" It Out?**

By: [Lauriel F. Dalier](#) and [Deborah Sterling, Ph.D.](#)

With summer now underway, please enjoy this cannabis-themed crossword puzzle! Stay tuned for the answers in next month's issue of MarkIt to Market®. A PDF version of the puzzle is available [here](#).



### ACROSS

- 2 This agency (abbrev.) registers trademarks and patents.
- 4 In 2018, the U.S. FDA approved Epidiolex®, a cannabidiol oral solution, for the treatment of seizures associated with two rare and severe forms of \_\_\_\_\_.
- 5 House Judiciary Committee Chairman (10 Down) reintroduced the MORE Act in \_\_\_\_\_ 2021.
- 8 Not sharp or a hollowed-out cigar filled with ground cannabis.
- 9 On June 22, 2021, \_\_\_\_\_ became the 19th state to legalize use of marijuana for people aged 21 and over.
- 11 Use of a trademark as a verb could put it at risk of being subject to \_\_\_\_\_.
- 12 In the US, the legal allowable amount of total THC in industrial \_\_\_\_\_ is 0.3% on a dry weight basis.
- 13 \_\_\_\_\_ (hops) is in the same family of flowering plants as cannabis.
- 14 Enacted December 27, 2020, this act (abbrev.) codifies the Letter of Protest process and authorizes new procedures for third parties to challenge applications and registrations.
- 16 Trademarks can be comprised of a word, \_\_\_\_\_, phrase, or combination thereof, and indicates the source of the goods/services.
- 18 One type of fair use of another's trademark is \_\_\_\_\_ fair use.
- 19 Coin + plastic container = \_\_\_\_\_ (2 words).
- 21 It is \_\_\_\_\_ to market CBD by adding it to food or labeling it as a dietary supplement.
- 22 The U.S. Copyright Office is part of the (3 words) \_\_\_\_\_.
- 23 \_\_\_\_\_ (3 words) Hint: Marin and Tommy.

### DOWN

- 1 What protects intellectual property created by artists?
- 3 The patent term for utility patents covering a cannabis product is \_\_\_\_\_ years.



- 6 To be patentable inventions must be \_\_\_\_\_ and \_\_\_\_\_ (two words).
- 7 Copyrights owned by the author last for \_\_\_\_\_ years after the death of the author.
- 8 Reintroduced in March 2021, the SAFE Banking Act aims to provide a safe harbor for \_\_\_\_\_ institutions providing services to cannabis clients.
- 10 The Marijuana Opportunity, Reinvestment and Expungement (MORE) Act, sponsored by House Judiciary Committee Chairman \_\_\_\_\_ (first and last name), cleared the chamber 2020 but did not advance in the Senate under GOP control.
- 15 In the U.S., trademark rights arise from \_\_\_\_\_.
- 17 First state to ban marijuana (1913).
- 20 The \_\_\_\_\_ Bill removed hemp from the Controlled Substances Act (CSA).
- 22 Great volume of cannabis with very strong odor.

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2021 Sterne, Kessler, Goldstein & Fox P.L.L.C.

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**