



March 2019



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The March 2019 issue of Sterne Kessler's MarkIt to Market™ newsletter addresses a Supreme Court ruling about suing for copyright infringement, the 2018 Farm Bill and CBD products, and lists the new 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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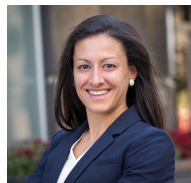
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**THE SWITCH BY NINE COMPELS "A STITCH IN TIME" APPROACH TO**

## COPYRIGHT FILINGS

By: [Ivy Estoesta](#)

*The Switch by Nine.* Earlier this month, the U.S. Supreme Court clarified when a copyright owner can sue for infringement, settling the conflicting interpretations of the Copyright Act's "registration" requirement, which we discussed in a prior [newsletter](#).



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## WHAT'S THE ANSWER: DOES THE 2018 FARM BILL CREATE A PATH FOR FEDERAL TRADEMARK REGISTRATION OF CBD PRODUCTS?

By: [Pauline Pelletier](#) and [Deborah Sterling](#)

Consumer products containing cannabidiol (CBD) are part of a growing market segment that—legal or not—is booming. Because cannabis is largely viewed as a commodity, branding and intellectual property in this space are tremendously important. Indeed, many players are already in the hunt to become national household names.

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## gTLD SUNRISE PERIODS 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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## RECENT NEWS

Thanks to your readership, we have an award-winning newsletter!

The firm has announced Monica Riva Talley and Dana N. Justus have been recognized as "Top Authors" by *JD Supra* in the online publication's 2019 "Readers' Choice Awards."

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## THE SWITCH BY NINE COMPELS "A STITCH IN TIME" APPROACH TO COPYRIGHT FILINGS

By: [Ivy Estoesta](#)

*The Switch by Nine.* Earlier this month, the Supreme Court clarified when a copyright owner can sue for infringement, settling the conflicting interpretations of the Copyright Act's "registration" requirement, which we discussed in a prior [newsletter](#).

*"A Stitch in Time" approach.* While the Supreme Court's decision may be unsettling (especially to those in the circuits that had previously followed the application approach), the good news is that there are steps that copyright owners can take to minimize pendency of their copyright applications before the Copyright Office and, in turn, possible delay to filing a copyright infringement suit.

- 1. File a copyright application for a finished work before it is commercially released.** Because the Copyright Office's average [processing time](#) for most copyright applications is 7 months from the time of filing a complete application, filing an application immediately after it is finished, and before steps to commercialize have been taken, can improve the likelihood that the Copyright Office has approved or refused registration of the work before copying of the commercialized work can even occur. Additionally, filing an application electronically, instead of by mailing it in, can reduce average processing times by half.
- 2. File a "preregistration application."** This option is available for owners of [certain types of works](#), namely, unpublished and to-be-commercially-distributed works of the type that have historically been infringed before publication, like motion pictures, books, and computer programs. The fee for a preregistration application is almost three times more than the \$55 fee for a regular copyright application, however, its processing time is much faster. A preregistration application is generally processed within five business days and, like a registration, a preregistration allows a copyright owner to sue for copyright infringement of a preregistered work. However, because preregistration is not a substitute for actual registration, the copyright owner must eventually file a regular application to register the work with the Copyright Office within the prescribed period, to avoid dismissal of its infringement suit.
- 3. File a copyright application with a request for "special handling."** This option is available only in limited circumstances, like impending litigation, and requires

payment of an \$800 processing fee. Like the preregistration option, special handling shortens an application's processing time significantly but, unlike the preregistration option, the Office issues an actual registration (instead of a preregistration) within five business days.

By keeping these options in mind, copyright owners can better position themselves to file suit when necessary with minimal delay, and avoid possibly missing the relatively short three-year-statute of limitations to bring a copyright infringement claim.

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In brief, federal trademark registration for hemp-derived CBD products will depend on how the Food & Drug Administration (FDA) and Department of Agriculture (USDA) decide to regulate CBD and CBD-containing products. While the 2018 Farm Bill removed “hemp” from Schedule I of the Controlled Substance Act, the USDA has yet to promulgate regulations or approve plans for legal cultivation. And, to date, the FDA has taken the position that even lawfully cultivated CBD-containing consumer products would be subject to FDA regulation.

Several lawmakers, state and federal, are putting pressure on these agencies to solidify their positions soon and create a pathway for legal CBD. Thus, while federal trademarks for hemp-derived CBD products remain largely subject to the same limitations as before, what is “lawful under federal law” may soon change. In the meantime, whether for purposes of competition or valuation or both, protecting a cannabis brand starts with creating an intellectual property strategy that can work around some of these unique legal obstacles, including seeking protection for differentiating aspects of the product and brand image through patent and copyright filings.

For more information on protecting cannabis-related IP, please visit our website [here](#).

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As of March 28, 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](#).

### **.inc**

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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