

The November issue of Sterne Kessler's **MarkIt to Market™** newsletter includes a case study on *bona fide* intent to use, a resolution to Anthropologie's opposition to the **anthō** mark, and an updated list of the Sunrise periods currently open for new gTLDs.

Sterne Kessler's Trademark, Advertising, and Anti-Counterfeiting [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](#), [Tracy-Gene G. Durkin](#), [Ivy Clarice Estoesta](#), [Julie D. Shirk](#), or [Shana L Olson](#).



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Good(s) Intentions - What's Enough to Establish *Bona Fide* Intent to Use?

When used effectively, brand and merchandise licensing can increase the value of a brand by extending it into new, relevant product categories and by further monetizing brand equity. And when seeking to protect a brand in extension categories with a federal, intent-to-use application, it is good practice for a brand owner to document its intention and extension efforts, both before and after filing an application. This is true regardless of a recent TTAB decision in which a licensor Applicant was found to have a *bona fide* intent to use its mark, despite not having pre-filing documentation that specifically referenced the goods of its brand-extension application.

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Look Beyond the Registration to Determine Likelihood of Confusion

Just in time for the holiday shopping season, the Trademark Trial and Appeal Board's recent decision in *Anthropologie, Inc. and Urban Outfitters Wholesale, Inc. v. Happy Green Company LLC* is a good reminder of why, when clearing a new trademark for use and registration, it is important to (1) consider the totality of the circumstances of how marks are actually used in commerce, and (2) not rely on a search of the U.S. Patent and Trademark Office database alone to determine if a mark is available.

Anthropologie opposed registration of the **anthō** mark for bath salts, bath soaps, cosmetics and fragrance, among other things, in International Class 3, on the ground that the Applicant's mark, when applied to their goods, is likely to cause confusion with their own mark, ANTHROPOLOGIE, for retail department store services, and their previously used common law mark, ANTHRO, for their [loyalty card program](#).

The Board found that although Anthropologie did have common law rights to the mark ANTHRO for its customer loyalty card program, it did not establish additional rights in the mark for any goods or services beyond the loyalty program. However, the Board did find that the ANTHRO loyalty card, when combined with Opposer's retail services featuring beauty and cosmetic products, is similar enough to the beauty and cosmetic goods offered under the **anthō** mark to weigh in favor of Anthropologie. The Board concluded that purchasers familiar with Anthropologie and the products offered in the course of their retail services would be likely to mistakenly believe that goods using the mark **anthō** originate from the same entity, and sustained the opposition to the mark.



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 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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