



NEWSLETTER | MarkIt to Market® - September 2017

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The September 2017 issue of Sterne Kessler's MarkIt to Market® discusses consent agreements, positive developments in the European community, and lists the new gTLD Sunrise periods.

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](#) or [Tracy-Gene G. Durkin](#).

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Beyond Mere Consent: It's All in the Details

By: Shana Olson and [Monica Riva Talley](#)

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Positive Developments – EUTM

By: [Monica Riva Talley](#)

Trademark owners should take note of two new types of trademark protection available in the European Community as of October 1, 2017.

1. Certification Marks – although certification marks have been available in some EU member states, it has not been possible to obtain a European Community registration covering a certification mark. As of October 1, 2017 it will be possible to register certification marks in the European Community.

2. Marks no Longer Need Graphic Representation – it will now be possible to file for sound, hologram, motion, and multimedia marks; marks can now be represented in any form using generally available technologies. Unfortunately, it is still not possible to file for tactile, smell, and taste marks in the EU.

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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 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.

» [Read more](#)

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Beyond Mere Consent: It's All in the Details

By: Shana Olson and [Monica Riva Talley](#)

Consent agreements - in which a prior U.S. Patent and Trademark Office (USPTO) rights-holder provides consent to registration of a later-filed trademark - can be an efficient path to registration in situations where the parties agree that confusion between their respective marks is unlikely. The USPTO typically gives "great weight" to properly constructed consent agreements, and the USPTO's rules of practice caution that it should not "substitute its judgment concerning likelihood of confusion for the judgment of the parties in interest without good reason."

However, while such agreements are accorded great weight, they are still "but one factor" to be taken into account when evaluating likelihood of confusion. Moreover, consent agreements must meet certain minimum standards in order to be accorded substantial weight.

In a recent case before the Trademark Trial and Appeal Board, *In re A-Plant 2000 ApS*, the Applicant attempted to register the stylized mark **Norðic** (NORDIC disclaimed apart from the mark as shown) for "[h]orticultural and forestry product, namely, live shrubs, flowering plants in the nature of perennials, and groundcover plants; natural plants and flowers" in Class 11, with a consent agreement from the owner of a prior registration for the mark **NORDIC** in standard characters for "live plants, namely holly cultivars" in Class 11. The Board held that the consent agreement between the Applicant and Registrant was insufficient to overcome a likelihood of confusion for several specific reasons – all of which provide a helpful roadmap for crafting acceptable consent agreements going forward.

- 1. Any restrictions on use of either party's mark must be reflected in the identifications.** In this case, Applicant's agreement not to use the mark on "holly cultivars" was not reflected in its identification of goods.
- 2. A consent agreement should accurately reflect the realities of the marketplace for the goods.** In this case, even if Applicant had restricted its identification to exclude "holly cultivars," the Board found that the remaining goods were so closely related as to render the consent ineffective.
- 3. Consent agreements should consider and address all potential customers when discussing channels of trade and consumer sophistication.** In this case, Applicant addressed the level of sophistication of landscape contractors, re-wholesalers, and independent garden centers. However, the agreement was silent about the level of sophistication of the ordinary consumer exercising ordinary care; no provision of the agreement addressed the likelihood of confusion of *those* consumers, who presumably made up a good portion of the parties' customers.
- 4. When the marks are identical or highly similar, consent agreements with restrictions on**

only the Applicant's use of the mark may not be sufficient to adequately distinguish the marks in the marketplace. The Registrant in this case holds a registration for the mark NORDIC in standard characters, meaning that they are "entitled to use the mark in the same or similar style, lettering, alphabet, color or font as Applicant." While the Applicant promised to only use the NORDIC mark in its stylized format, the consent agreement did not contain any restriction on Registrant's use of its mark, meaning there was nothing in the agreement to preclude the Registrant from using a stylization similar to Applicant's in the marketplace.

5. Effective consent agreements must contain specific measures the Applicant and Registrant agree to take to prevent consumer confusion. Here, though the agreement included a provision relating to "mutual notification in the event of consumer confusion," it lacked any requirement on the part of either party to proactively prevent consumer confusion, making it a "naked" consent.

This case serves as a good reminder that consent agreements should be thoughtfully drafted, giving great weight to the consumer perception of the marks, and carefully considering the relevant marketplace(s) and consumers of the goods. If a consent agreement does not consider some of these real-world conditions, it may be considered a naked consent, and will not be given due weight in the registration analysis.

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As of September 29, 2017, ICANN lists Sunrise the period as open for the following new gTLD:

.radio

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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