


October 2020

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

The October 2020 issue of Sterne Kessler's Markt to Market® newsletter discusses a trademark litigation case in the cannabis consumer goods space and the open gTLD sunrise periods.

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

[Get in the Weeds: Even Brands for \(Federally Illegal\) Consumables Need to Play by the Trademark Rules](#)

[gTLD Sunrise Periods Now Open](#)

[DOWNLOAD](#)

Editor & Author:



Monica Riva Talley

Director

mtalley@sternekessler.com

GET IN THE WEEDS: EVEN BRANDS FOR (FEDERALLY ILLEGAL) CONSUMABLES NEED TO PLAY BY THE TRADEMARK RULES

By: [Monica Riva Talley](#)

In a complaint filed late last month in the Northern District of Illinois, Edible Arrangements, purveyors of fancy fruit bouquets, initiated a trademark infringement suit against cannabis company Green Thumb Industries Inc., based on its use of the mark INCREDIBLES for edible marijuana products. ([Edible IP LLC et al. v. MC Brands LLC et al.](#)).



[Read More](#)

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.

[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.

© 2020 Sterne, Kessler, Goldstein & Fox P.L.L.C

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

Technical Minds. Legal Muscle.



October 2020



[VISIT WEBSITE](#)

[CONTACT US](#)

[SUBSCRIBE](#)

[FORWARD TO A FRIEND](#)

GET IN THE WEEDS: EVEN BRANDS FOR (FEDERALLY ILLEGAL) CONSUMABLES NEED TO PLAY BY THE TRADEMARK RULES

By: [Monica Riva Talley](#)

In a complaint filed late last month in the Northern District of Illinois, Edible Arrangements, purveyors of fancy fruit bouquets, initiated a trademark infringement suit against cannabis company Green Thumb Industries Inc., based on its use of the mark INCREDIBLES for edible marijuana products. ([Edible IP LLC et al. v. MC Brands LLC et al](#)). The suit seeks to enjoin Green Thumb from marketing edible cannabis products in connection with the mark INCREDIBLES, on the ground that it is confusingly similar to Edible Arrangements' EDIBLE and INCREDIBLE EDIBLE marks.

While the case garnered headlines, Edible Arrangements likely wasn't dancing with Mary Jane when it decided to pursue legal action to protect its brand. Instead, the case highlights the land grab currently surrounding CBD and cannabis brands, as even established consumer brands (think Martha Stewart) enter this lucrative space. In fact, Edible Arrangements asserts that cannabis-related products are within the zone of its natural expansion, related to the current food products it sells under its brands.

Lending credence to its claim is the fact that, a few years back, Edible Arrangements made a calculated move to stake its own claim in the CBD space. Perhaps in response to the ubiquitous use of the term "edible" for consumable marijuana products, Edible Arrangements sought to build on its existing consumer goodwill and debuted its CBD company Incredible Edibles in November 2019.

Even though this lawsuit was only recently filed, and is likely far from over, the background and fact that it was filed at all is interesting from a few different perspectives.

First, Edible Arrangements' pivot to CBD is a textbook example of how to extend the goodwill and equity of a mature brand into an emerging field. Edible Arrangements addressed the potential risk to its EDIBLE brand from the burgeoning "edibles" market by attempting to capture that goodwill for itself – perhaps revitalizing a staid brand in the process.

Second, this case is a good reminder that those seeking to earn a share of the cannabis space would be well-served to think more broadly about goods and services overlap when it comes to trademark clearance and adoption. While a spokesperson for Green Thumb argued that,

“[e]ven those who’ve consumed a generous serving of our delicious Green Thumb Mile High Mint bar wouldn’t confuse a pre-cut fruit bouquet delivery business with an edibles cannabis brand” ([Marijuana Business Daily](#)), the fact is that today’s brands do span more product categories than ever in the past. Consumers are accustomed to seeing the same brand on their tractors and their work boots, and savvy brands gain market share by expanding to new categories – either internally, or by strategic licensing programs or acquisitions. As cannabis brands become more mainstream, they need to think more like traditional brands, including taking steps to properly clear and protect their intellectual property.

Finally, cannabis brands face somewhat of an unequal playing field when it comes to protecting consumable brands. Marijuana is still illegal on a federal level in the U.S., which means that it is not currently possible to federally register a brand for marijuana or a CBD meant for human consumption. Thus, in a hypothetical reverse of the Edible Arrangements/Green Thumb case, the marijuana company would not be able to rely on a federal registration when asserting a mark for its edible product against an infringing food brand.

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.

© 2020 Sterne, Kessler, Goldstein & Fox P.L.L.C

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

Technical Minds . Legal Muscle.



October 2020



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

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.

As of October 28, 2020, ICANN lists new Sunrise periods as open for the following new gTLDs that may be of interest to our clients. A full list can be viewed [here](#).

.contact

.cpa

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.

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.

