



Mark It to Market™

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The February issue of Sterne Kessler's Mark It to Market™ newsletter contains the latest news in the "use in commerce" requirement relating to service mark applications filed in the U.S. 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 or Tracy-Gene G. Durkin.



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Service Marks Must be Used in Rendering of Services, Not Just Advertising

In February, the Trademark Trial and Appeal Board (TTAB) voided a trademark registration because the mark in question was not used in the rendering of services prior to the filing of the applicant's use-based application (see *Playdom, Inc. v. Couture, Cancellation No. 9205115, February 3, 2014*). Although the applicant was using the mark on his website at the time he filed his use-based trademark application, he had not actually provided the services advertised on the site to any customers at the time of filing.

This case serves as a good reminder that the "use in commerce" requirement means that you must have actually sold, transported, or rendered all of the different types of goods and services covered by your application in order to claim that the mark is in use – either at the time of filing a use-based trademark application, or when submitting a Declaration of Use. It is not enough to advertise that your products and services are for sale.



Generic Top Level Domains - Current Sunrise Periods 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.



► Read more to see the list of Sunrise Periods currently open

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