

The April issue of Sterne Kessler's **MarkIt to Market™** newsletter contains a cautionary tale regarding use of social media, a clarified test for false advertising standing, updates to Canada's Trade-marks Act, 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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#### R-E-S-P-E-C-T Those Rights of Publicity

Earlier this month, Katherine Heigl sued Duane Reade for \$6,000,000 for tweeting a paparazzi photo of her leaving a Duane Reade drugstore, together with the caption "**Love a quick #DuaneReade run? Even KatieHeigle can't resist shopping at #NYC's favorite drugstore.**" In the fifteen-page complaint, Heigl charges Duane Reade with (1) violating section 43(a) of the federal Lanham Act, (2) misappropriating Heigl's right of publicity under New York law, and (3) committing common law unfair competition.

This bit of celebrity-meets-Lanham Act news is the perfect opportunity for reminding brand owners that they should treat social media the same as they would any other advertising medium, and that it is impermissible to create the impression that a celebrity, or anyone else for that matter, is endorsing your product or service without their permission. As a brand owner, the rules for what constitutes acceptable content for posting or tweeting on social media are different than those for individuals or news outlets. While the posting and tweeting of editorial or factual content by a brand owner may be permissible, care should be taken to avoid anything that suggests a sponsorship, affiliation, or endorsement (unless authorized), or that is otherwise in violation of the rights of publicity or privacy.

If you have any questions on whether the content of a proposed social media posting is permissible, please contact us.



#### Supreme Court Establishes a New Test for False Advertising Standing under Lanham Act

On March 25, 2014, the Supreme Court issued its opinion in *Lexmark International Inc. v. Static Control Components Inc.*, holding that a two-prong analysis comprised of the "zone-of-interests" test and a "proximate-cause" requirement applies when determining who may sue for false advertising under Section 43(a) of the Lanham Act. This holding resolved at least a three-way split among the Circuit Courts over the appropriate test for determining standing to bring such claims.

▶ [Read more](#)



#### Proposed Changes to Canada's Trade-marks Act

Not to be upstaged by China, who recently proposed changes to its Trademark Law, the Government of Canada proposed substantial changes to its Trade-marks Act on March 28, 2014. Several of these changes were proposed to align Canada's trademark system with those of other countries, and to allow Canada to accede to certain international treaties with trademark provisions, such as the Madrid Protocol.

▶ [Read more to view the proposed changes](#)

#### 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](#)

