



NEWSLETTER | Markt to Market® - May 2018

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The May 2018 issue of Sterne Kessler's Markt to Market® discusses how counterfeiting can help your brand strategy, considers the trend of "branding" clinical trials, and lists the new 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](#).

Editor and Author:



Monica Riva Talley
Director
mtalley@sternekessler.com

Authors:



Julie D. Shirk
Patent and Trademark Specialist
jshirk@sternekessler.com

Contact



Monica Riva Talley
Director
mtalley@sternekessler.com



Tracy-Gene G. Durkin
Director
tdurkin@sternekessler.com

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The Upside of Counterfeiting? (Market Intelligence and Opportunity)

By: [Monica Riva Talley](#)

It is hard to find something positive to say about counterfeiting. It costs businesses billions of dollars in lost sales and eroded goodwill every year. It poses a real threat to consumer health and safety. And it funds criminal organizations and even terrorism.

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Upping Your Branding Game, Clinically Speaking

By: [Julie D. Shirk](#)

The process of developing and bringing a drug to market is long and expensive, and from test tube to pharmacy, the competition for resources – including clinical trial participant and investor resources – is fierce. To better capture these resources, drug companies have started to “brand” their clinical trials with catchy names or acronyms evocative of study objectives or compounds, or with names more closely associated with the sponsor’s brand.

▶ [Read more](#)



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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The Upside of Counterfeiting? (Market Intelligence and Opportunity)

By: [Monica Riva Talley](#)

It is hard to find something positive to say about counterfeiting. It costs businesses billions of dollars in lost sales and eroded goodwill every year. It poses a real threat to consumer health and safety. And it funds criminal organizations and even terrorism.

However, counterfeiting can sometimes provide more accurate, real-world data about your market, your brand, your consumers, and your business strategy than even the most sophisticated marketing models. Counterfeiters are businesses too, and ones that exploit your weaknesses or white spaces to survive. So, how can counterfeiters help your brand strategy?

1. **Geographic Interest** — first, counterfeiters often exploit geographic markets in which a brand is not yet sold, but may already be known. Sales in new territories can provide information as to the appeal of the brand outside its current market, provide insight on possible distribution channels, and provide a wake-up call as to the necessity of taking brand protection steps outside of the current market.
2. **New Product Categories** — second, counterfeiters don't always sell products that are exact replicas of the brand's offerings; instead they may sell branded ancillary merchandise that appears to be related to the brand— common targets are clothing and electronics accessories. Counterfeiters are also known to offer different flavorings or styles of products that may be appealing or culturally attuned to a new market.

This type of information can be invaluable from a marketing and product development perspective. Even if a brand doesn't have the capacity to expand into new categories at a certain time, the brand could explore capturing this market (and revenue) via licensing or partnerships with local entities. This information can also provide important intelligence on new categories of offerings to protect via trademarks and other forms of IP.

3. **Purchaser Behavior** — finally, counterfeiters can provide insight as to how consumers like to engage with your brand. A few years back, "purse party" fundraisers were all the rage with the private school set; these events took place in private homes, and the host sold counterfeit designer purses to raise money for the local school (seriously!). In any event, a savvy brand who gets wind of such activities may consider marketing a line of their product directed to such fund raising activities. Similarly, some people prefer to do all of their shopping online, via a certain platform. Working with that platform to ensure it only offers authentic products can help direct genuine products to your consumers, helping to starve out the demand for counterfeits.

In short, counterfeiting is absolutely a threat to innovation, productivity, and even health and safety.

However, while taking all possible steps to protect your brand from counterfeiters, also think about what the counterfeiters are doing from a business perspective. Perhaps there is a way to beat them at their own game.

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The process of developing and bringing a drug to market is long and expensive, and from test tube to pharmacy, the competition for resources – including clinical trial participant and investor resources – is fierce. To better capture these resources, drug companies have started to “brand” their clinical trials with catchy names or acronyms evocative of study objectives or compounds, or with names more closely associated with the sponsor’s brand. For example, don’t you find “The AVIATOR Study” easier to remember than “Trastuzumab and Vinorelbine With Avelumab OR Avelumab & Utomilumab in Advanced HER2+ Breast Cancer?” Of equal import, if a clinical trial shows efficacy of the drug under study, any recognition of the trial name can be leveraged to garner funding for further research, or to steer patients and health practitioners to the drug when it’s brought to market.

Like any type of brand, it is wise to consider whether a term proposed for a clinical trial is available for use. While clinical trial names are not subject to the same FDA scrutiny as propriety drug names or trademarks, in the interest of source distinction and consumer safety, consider at least:

- a search of the records of the USPTO (and other relevant registers and databases) for identical or confusingly similar marks for identical or confusingly similar goods and/or services; and
- a search of www.clinicaltrials.gov for active/recruiting trials having the same or similar name for similar drugs/study objectives.

Keep in mind, too, that although clinical trial and related research services for a company’s own benefit are not eligible for registration, it may be possible to shore-up protection for the clinical trial brand by registering it as a trademark, domain name, and/or social media handle for providing information on the drug and condition under study to the public and other interested communities. And if the drug of the study is eventually approved, this same website can be used as a companion site or other marketing piece to direct patients and healthcare providers to the drug’s primary website, successfully building on that initial brand awareness to bridge the trial to the drug.

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As of May 30, 2018, 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 at: <https://newgtlds.icann.org/en/program-status/sunrise-claims-periods>.

.abudhabi	.catholic
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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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