

The February issue of Sterne Kessler's **MarkIt to Market™** newsletter provides takeaways from the Supreme Court's *Hana Financial* decision, identifies a new anti-counterfeiting tool for owners of Canadian trademarks and copyrights, and provides 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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Top 5 Takeaways for Trademark Owners from the Supreme Court's *Hana Financial, Inc. v. Hana Bank* Tacking Decision

By **Monica Riva Talley**

Many commentators have weighed-in on the Supreme Court's recent *Hana Financial* decision, which involved two competing HANA-formative marks for financial services, including one that had been modified over the years to couple HANA with different additional descriptive/generic terms.

The decision is noteworthy in that the Supreme Court held that the issue of "tacking" -- which allows a company to slightly modify a trademark while maintaining the original first-use date, so long as the marks create the same impression in the eyes of consumers -- is a factual question, to be decided by juries. The court explained that juries should decide whether tacking is warranted because this question "operates from the perspective of an ordinary purchaser."

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New Tool to Fight Counterfeiting – Customs Recordation Now Available in Canada

By **Monica Riva Talley**

Many U.S. brand owners already work with U.S. Customs and Border Protection (CBP), a division of the U.S. Department of Homeland Security, to keep counterfeit products out of the U.S. CBP examines cargo at more than 300 ports of entry into the U.S., and seizes goods that appear to infringe registered trademarks and copyrights on record with CBP.

CBP also has the authority to seize any goods entering the United States, even if the goods are not intended for the U.S. market and the shipment is simply passing through the United States to another country. CBP can also issue monetary fines, request that the U.S. Attorney's Office criminally prosecute the offenders, and/or coordinate and participate in raids on international counterfeit production facilities.

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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 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.

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