



**USPTO Announces Proposed New Rules; Clubhouse Trademark Infringement Suit; Atari Sues Pixels – News Digest**  
**World Trademark Review**  
**Bridget Diakun, Tim Lince, & Trevor Little**  
**May 18, 2021**

Every Tuesday and Friday, *WTR* presents a round-up of news, developments and insights from across the trademark sphere. In our latest round-up, we look at Ralph Lauren agreeing to sell the Club Monaco brand, General Mills picking up the Tyson Foods pet food business, the ICANN board signing off on its finances and much more. Coverage this time from Victoria Arnold (VA), Bridget Diakun (BD), Tim Lince (TJL) and Trevor Little (TL).

Legal radar:

USPTO announces proposed new rules – The USPTO has issued a notice of proposed rule-making entitled [Changes To Implement Provisions of the Trademark Modernisation Act 2020](#), a [few months after](#) Congress signed it into law. The rule proposal includes provisions to address attorney withdrawal requirements and strategies to combat fraud. Some of the proposals include: two new *ex parte* proceedings to cancel registered trademarks for non-use; a new ground for cancellation of a registration before the TTAB; shorter response times for office actions; letters of protest practice; attorney recognition until revocation or withdrawal; attorney withdrawal requirements; and court orders concerning registrations. Further, the USPTO has announced that it will hold public roundtables to discuss the proposed rules, on which it [is also calling for feedback](#) (with a comments deadline of 19 July 2021). Talking to *WTR*, [Nick Match](#), principal in McKool Smith’s IP practice group, shared his initial response to the proposed new rules: “Recently, the USPTO has had to devote significant resources to policing the erroneous or fraudulent registration of marks not actually used in commerce. The Trademark Modernisation Act and the proposed rule are both very positive and important steps towards improving the accuracy of the register. For trademark practitioners, the act and the proposed rule provide new mechanisms to clear out deadwood or fraudulently obtained marks for the benefit of their clients, but also a reminder of the importance of ensuring that the registrations reflect current use of the mark when it comes time to renew.” (TJL)

Clubhouse app faces infringement suit from sports networking site – Invitation-only social media app Clubhouse is being sued by an Arizona sports networking site for infringement of its trademark THECLUBHOUSE. SBS Consulting Group launched ‘[theClubhouse](#)’ in November 2018, before registering THECLUBHOUSE in December 2019. Its complaint, filed in the US District Court for the District of Arizona, seeks to prohibit Alpha Exploration Co – owner of the Clubhouse app launched last spring – from using the Clubhouse name, stating that the overlap between their services includes both content and features. However, [Insider sources are undecided](#) on whether the complaint has merit. “On the one hand, these two companies seem like they have some plausible overlap in terms of their services,” said Notre Dame Law School professor Mark P McKenna. “On the other hand, ‘TheClubhouse’ seems like a pretty weak mark to me — there are a lot of companies using some version of ‘clubhouse’ for different kinds of things, so we’d need to think the conflict between these two was pretty significant for there to be a claim.” Because the Clubhouse app was the second to market, the case will centre on whether there was a likelihood of reverse confusion. (VA)

Atari sues Pixels marketplace – Video game company Atari has filed a lawsuit against art marketplace Pixels.com, according [to Securing Industry](#). In the suit, Atari claims that Pixels’ print-on-demand platform is infringing its trademark registrations. Specifically, it references products sold by third-party sellers – including T-shirts and phone cases – that have the Atari logo and/or images from video games such as *Pong*, *Asteroids*, *Missile Command* and *Breakout*. While the items are being sold by third parties, they are being printed and posted by Pixels (and its sub-brand FineArtAmerica). “Pixels has profited from its unauthorised use of Atari’s intellectual property through the sale of the infringing goods and advertising and promotional uses of the Atari mark,” the complaint claims. “Pixels’ infringement has harmed Atari by

cheapening and diluting the Atari brand, diverting profits from the sale of authentic Atari goods, and causing Atari to lose profits and licensing fees from the authorized use of its intellectual property.” (TJL)

Brand radar:

Ralph Lauren agrees to sell Club Monaco chain to PE firm – Ralph Lauren [will sell](#) its Club Monaco chain of clothing stores to private equity firm Regent LP. The deal is expected to close by the end of June. The divestiture is part of a reevaluation of the company’s portfolio of brands. “As we increase our focus on our core namesake brands, we want to ensure the Club Monaco brand is also well-positioned for long-term success,” said Ralph Lauren CEO Patrice Louvet. (BD)

Coca-Cola cuts energy drink – Coca-Cola is discontinuing its Coca-Cola energy drink in North America due to its underperformance. The decision is part of a broader pruning of the product portfolio, with Coca-Cola working towards an offering of about 200 “master” brands (a 50% reduction from the current level). (BD)

Matica introduces new cannabis brand – [Matica Enterprises](#) has brought its latest cannabis brand, [CITOYEN](#), to the market. CITOYEN is positioned as “a more accessible brand of quality cannabis to come out of Montreal’s West Island, The People’s Flower” and comes in two product families; CITOYEN<sup>T</sup> Gold Star products are high tetrahydrocannabinol (THC) craft products, while CITOYEN<sup>Red</sup> Star craft products have a mid to high THC range. On *WTR* we recently presented [in-depth analysis](#) of the growing cannabis market in the United States and Canada, arguing that brand owners are having to act quickly and be forward-thinking to ensure that their rights are protected. Clearly, the sector is the source of significant brand building and innovation at present. (TL)

Goldman rebrands oil services to reflect green shift – Goldman Sach is rebranding its coverage of drilling and fracking providers, signifying a wider shift away from fossil fuels, reports [Bloomberg](#). “We are renaming our coverage to ‘Energy Services,’” Goldman analysts wrote to investors. “We believe investors should evolve the framework of evaluating this sector from ‘traditional oil services’ to ‘energy services’ to better capture emerging drivers of long-term growth.” Those within the oil industry have been [removing](#) the term ‘oil’ from their brands over the years as investors and activists pressure these companies to limit their output of greenhouse gases. (BD)

General Mills to pick up Tyson Foods’ pet food business – General Mills has [agreed](#) to acquire Tyson Foods’ pet food business, including the Nudges, Top Chews and True Chews brands, for \$1.2 billion. People have purchased and adopted dogs and cats at an increasing rate as the pandemic has raged on, making pet food a hot market. The deal will add to General Mills’ Blue Buffalo products, a brand which the company acquired for \$8 billion in 2018. (BD)

Market radar:

SAIP reveals number of counterfeits destroyed – The Saudi Authority for Intellectual Property destroyed around 5 million IP infringing products over the past year, [reports Arab News](#). Of these, the outlet notes, counterfeit goods accounted for about 40% (or 2 million products), while nearly 3 million products were defined as a violation of IP rights. (TL)

Office radar:

*(For more of the latest coronavirus-related updates from national IP offices, please [read our dedicated article](#) which is being continuously updated.)*

TIDO joins TMclass – The Trademarks and Industrial Designs Office of Egypt (TIDO) has joined [TMclass](#) with goods and services in Arabic. TMclass enables users to search and translate goods and services to and from any of the 44 available languages, as well as to verify the correct classification of terms according to the Nice Classification system. The addition of the Egyptian office brings the total number of national and regional IP offices that participate in the tool (including the African Intellectual Property Organisation, the African Regional Intellectual Property Organisation, the EUIPO and WIPO) to 82. The EUIPO writes: “The integration of TIDO in TMclass is a concrete result of the EU funded project called Intellectual Property Rights Action for Africa, which is directed by the European Commission and executed by the EUIPO.” (TL)

## Domain Radar:

ICANN board signs off on finances – ICANN has announced that its board of directors has adopted [ICANN's FY22-26 Operating and Financial Plan and FY22 Operating Plan and Budget](#). The organisation states: “The FY22-26 Operating and Financial Plan outlines the feasibility and timing of services, activities, and milestones identified to achieve the objectives and goals outlined in the ICANN Strategic Plan FY21-25. The FY22 Operating Plan and Budget provides greater detail on the planned activities and resources for the upcoming fiscal year starting 1 July 2021 and ending 30 June 2022. Under ICANN's bylaws, the Empowered Community may consider whether it will reject any of the plans adopted by the ICANN board. If no Empowered Community rejection process is pending, then the adopted plans will go into effect on 1 July 2021.” (TL)

## Media Watch:

Story of Pfizer vaccine brand revealed – A new brand name for Pfizer and BioNTech's covid-19 vaccine has been announced: Comirnaty (pronounced ‘koe mir na tee’). The two pharmaceutical companies hope that the new brand will soon become well known and replace the current common name, ‘the Pfizer vaccine’. The name has already been filed at the USPTO. According to [Fierce Pharma](#), the name “mashes up community, immunity, mRNA and covid” and was developed by marketing company Brand Institute. “The name is coined from covid-19 immunity, and then embeds the mRNA in the middle, which is the platform technology, and as a whole the name is meant to evoke the word community,” claims Scott Piergrossi, president of operations and communications at Brand Institute. “Identifying those word parts and plugging into the community concept really executed nicely at the end of the day.” The creation of a name with such a meaning is a reminder that even when it comes to a vaccine for a global pandemic, a strong brand remains important. (TJL)

## On the move:

Saul Ewing Arnstein & Lehr hire Courtland Merrill – Courtland Merrill has [joined](#) Saul Ewing Arnstein & Lehr as a partner in the IP and IP litigation practices. He will be based in the firm’s Minneapolis office. “We are thrilled to welcome Courtland to Saul Ewing Arnstein & Lehr,” said Al Coleman, managing partner of the Minneapolis office and a member of the firm’s executive committee. “The industry-leading companies headquartered in the Twin Cities understand that protecting their patents and trade secrets, along with enforcing non-compete agreements and other contracts, are key to their competitiveness. Courtland has two decades of experience handling these types of matters, which represents a significant enhancement to our already strong intellectual property and related litigation practices.” (BD)

Trademark and advertising partner returns to Foley – Foley & Lardner has announced that [Jeffrey Greene](#) has rejoined the firm’s trademark copyright and advertising practice group as a partner in its New York office. Greene, who was previously a partner at Foley from 2007 to 2017, joins from Cooley LLP, where he had chaired its trademark and advertising practice. Greene’s practice focuses on strategic foreign and domestic brand counselling and protection, including the creation, development, expansion and management of global trademark portfolios, creative brand enforcement strategies, the licensing of brand assets and advertising. “Jeff was a valued member of the IP department during his 10 years at Foley, and we are pleased to welcome him back to the team,” said [Mark Diliberti](#), co-chair of the firm’s trademark, copyright and advertising practice. “His wealth of experience will add significant depth to our established bench of IP attorneys and the services we offer our global clients.” (TL)

## And finally...

WTR launches major new Special Report series – Whether they are specific individuals or particular jurisdictions, the rise to prominence of mass filers over the past few years has had a significant impact on the trademark landscape. For the first of our [new quarterly Special Reports](#), WTR has taken a deep dive into the data behind the trend, charting the rise of mass filers, analysing their activity, investigating the real-world effect that they are having and, crucially, exploring how rights holders and registries can mitigate their impact on brand development and protection efforts. The report is the first of a new series of quarterly offerings, which will deliver an in-depth exploration of a key theme or topic, with practical

takeaways and unique insights. The full report is available exclusively to *WTR* subscribers [here](#), and in the [WTR Report Centre](#).