



NEWSLETTER | MarkIt to Market® - December 2017

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The December 2017 issue of Sterne Kessler's MarkIt to Market® discusses how ultra violet is the new black, a trademark practice update, and lists the new gTLD Sunrise periods.

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](#).

Editor:



Monica Riva Talley
Director
mtalley@skgf.com

Authors:



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

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Contact



Monica Riva Talley
Director
MTalley@skgf.com



Tracy-Gene G. Durkin
Director
TDurkin@skgf.com

Ultra Violet is the New Black

By: [Julie D. Shirk](#)

The color purple has long been associated with royalty, so perhaps it should come as no surprise that Pantone's color of the year for 2018 --the year of the next royal wedding-- is PANTONE® 18-3838 Ultra Violet, a blue-based purple. But this particular shade of purple has associations beyond royalty, wealth, and power. According to Pantone, this Ultra Violet purple is "nuanced and full of emotion," symbolizing "experimentation and non-conformity, spurring individuals to imagine their unique mark on the world, and push boundaries through creative outlets." [1]

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Trademark Practice Update: Scandalous? Immoral? It's all Good

By: [Monica Riva Talley](#)

On December 15, 2017, the U.S. Court of Appeals for the Federal Circuit held that the Lanham Act's prohibitions on registering scandalous and immoral marks discriminated based on content, and violated the First Amendment (*In re Brunetti*, No. 2015-1109, 2017 WL 6391161 (Fed. Cir. 2017)). The decision was not unexpected, given the U.S. Supreme Court's ruling earlier this year in *Matal v. Tam*, which similarly found the prohibition on disparaging marks to be unconstitutional (137 S. Ct. 1744 (June 19, 2017)).

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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 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](#)

Happy Holidays!

Sterne Kessler's Trademark, Advertising, and Anti-Counterfeiting practice wishes everyone a happy and prosperous New Year!



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Brand owners have long understood and capitalized on the ability of color to convey the brand's meaning and emotion to consumers. From "legacy" marks and long-term trade dress built around a single color, to products selectively tinged with colors in tune with the marketplace's collective mood, color captures a share of the consumer psyche. If you are looking to refresh or infuse your brand with the creativity and imagination of PANTONE 18-3838 Ultra Violet color, here are few things to consider before adopting this, or any other color.

- Just because this color is "new" to 2018, it may not be new to one of your competitors. As with any proposed color or mark, a clearance search should be conducted to determine whether it is available for use, short- or long-term, with your goods and services.
- If color is already a protected aspect of your branding, and you plan to step away from your current color in favor of another for a limited period of time, check your trademark registrations for the current color to see if they are due for maintenance during the "off-use" period. If so, consider adopting the new color for only select models/SKUs of your product line, or apply the new color to only part of the product's packaging, or to a label or hang tag. And if you're a service provider, thoughtful application of a new color to your web page may be more easily changed and economical than, say, a run of business stationary in a new color.
- Bear in mind that the color of interest may have an industry- or product-dependent meaning. In the pharmaceutical industry, for example, colors can be used to designate different drug strengths or forms, or can function as proprietary trade dress. Check with industry and regulatory teams before adopting a new color to confirm that it is neither misleading of the nature of your product, nor likely to create the potential for consumer confusion or even harm.

Here's to PANTONE 18-3838 Ultra Violet living up to its meaning for consumers and brand owners alike in 2018!

[1] <https://www.pantone.com/color-of-the-year-2018>

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What does this mean to brand owners? The ability to use a trademark was never at issue in either of these cases, simply the ability to protect a mark by federal registration. However, it will now be easier for the owners of disparaging, scandalous, and immoral brands to enforce their rights against infringers and counterfeiters. Federal registration provides notice of ownership, and certain presumptions in terms of ownership, validity, and exclusive rights as to the covered goods and services. Perhaps more importantly, federal registration allows the owner to record a registration with U.S. Customs and Border Protection, and can be used to enforce rights with online search engines, obtain social media user names, and used in combating online counterfeiting.

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As of December 27, 2017, ICANN lists Sunrise the period as open for the following new gTLD:

.rugby
.kfh
.بيتك

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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Pictured below are members of the Trademark Practice with some of the items they collected for SOME (So Others Might Eat), a local D.C. charity.



From Left to Right: Dana Justus, Shana Olson, Andrew Martins, Ivy Estoesta, Lauriel Dalier, Monica Riva Talley, and Shannon Thrash.

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