

MarkIt to Market®

December 2019



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The December 2019 issue of Sterne Kessler's MarkIt to Market® newsletter discusses Pantone's color of 2020, a recent precedential decision about descriptive word marks in patent applications, and the new gTLD sunrise period. We also provide two noteworthy updates from the firm's Trademark & Brand Protection team.

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](#).

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COLOR TALK - PANTONE'S

COLOR FOR 2020 AND OTHER THOUGHTS

By: [Julie D. Shirk](#)

Earlier this month, Pantone announced that its color for year 2020 is PANTONE 19-4052 Classic Blue. Pantone describes Classic Blue as a timeless hue, one that is evocative of the sky at dusk, bringing “a sense of peace and tranquility to the human spirit” as we strive for stability and dependability in the next decade. ^[1]



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GET IN SYNC: THE INTERPLAY BETWEEN PATENT LANGUAGE AND DESCRIPTIVE WORD MARKS

By: [Shana L. Olson](#)

In a recent [precedential decision](#), the Trademark Trial and Appeal Board affirmed that the mark SEQUENCING BY BINDING is merely descriptive of goods and services in Classes 1, 9, 10, and 42 related to biological analytes (material that is evaluated in biological testing), and that Applicant’s use of the mark in patent filings is good evidence of the descriptiveness of the mark.

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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.

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STERNE KESSLER TRADEMARK PRACTICE UPDATES

In partnership with [Stockings from Karen](#), the Sterne Kessler Trademark & Brand Protection team stuffed 40 stockings for foster teen girls and boys in the Washington, D.C. area for the holidays. Each stocking contained necessary toiletries, accessories, and fun gifts for teens in foster care.



Additionally, congratulations to Counsels [Ivy Clarice Estoesta](#) and [Dana N. Justus](#), who were recently named IP "Rising Stars" by *Managing Intellectual Property* magazine! Read our press release announcing our attorneys named to the prestigious list [here](#).

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COLOR TALK - PANTONE'S COLOR FOR 2020 AND OTHER THOUGHTS




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PANTONE 19-4052 Classic Blue

Understanding color theory and the psychology of color is critical to the success of a brand. The right choice of color not only builds on a brand's aesthetic, but grabs the consumer's attention by eliciting a select emotional response. For example, as applied to fashion, Pantone says that Classic Blue is a “foundational anchor shade,” which speaks to heritage; in the realm of graphic design and packaging, Classic Blue's semblance to evening twilight evokes a feeling of tranquility, dependability, and constancy.[2]

Some brands such as , , and, not surprisingly,  have been using a blue similar to Classic Blue for years. If you're thinking about refreshing your brand with Classic Blue and its connotations, or any other color for that matter, consider the following before moving forward:

- Conduct a clearance search to determine whether the color of interest is available for use (short- or long-term) with your goods and services;
- If you plan to step away from the brand's current color in favor of another for a limited period of time, check any 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, or apply the new color to only part of the product's packaging or label, to allow you to maintain your existing registrations;

- Remember that the color of interest may have an industry- or product-dependent significance. For pharmaceuticals, for example, colors are often used to designate different drug strengths or forms, or may function as proprietary trade dress. Consult 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 consumer confusion or to cause harm.

If you are looking to secure a federal registration for the color of your brand, remember that the USPTO reviews single color mark applications very strictly, requiring extensive evidence of acquired distinctiveness or secondary meaning. Improve your chances of federally registering your color mark by:

- Referencing your brand's color in "look for" advertising – that is, advertising language that instructs the consumer to "look for" your brand's color, to confirm that they are choosing your product among competing products. Also list the color as a trademark in a legal line;
- Use the color consistently to reinforce its association with your brand in the mind of the consumer. To assist in this effort, develop a brand usage guideline, which sets forth the official color as well as the approved manner in which the color may be used, for your marketing department, authorized licensees, co-branders, and co-operative advertisers;
- Avoid making reference to any attributes of the color of interest, which could be considered "functional" in nature, since functional color marks are not registrable.

Whatever your branding choices, we hope your customers remain true blue in 2020 and beyond!

[1] www.pantone.com/color-intelligence/color-of-the-year/color-of-the-year-2020

[2] www.pantone.com/color-intelligence/color-of-the-year/color-of-the-year-2020-tools-for-designers

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In arguing against the refusal, Applicant noted that its use of the mark within its patent filings was a coined shorthand label for "a complex DNA sequencing technique...solely for patent procurement purposes." The Applicant also noted that third parties do not use the term to describe essentially the same concept, therefore there is no competitive need for others to be able to use the phrase descriptively. The Board disagreed, and affirmed that the patent documents are good evidence of the descriptiveness of the phrase because the phrase, as used in the patent filings, conveys information to the target audience.

Patent filings by trademark applicants often come into play when applicants seek to register trade dress; utility patent applications or patents claiming a feature or features described in an application for trade dress would likely result in a functionality refusal of the trademark application under Section 2(e)(5). However, as shown in this case, applicants seeking to register *word* marks in connection with patentable inventions must also ensure that they do not use their intended mark in a descriptive manner in their patent filings. Applicants should pay close attention to the way that marks are used in patent applications, but best practice in this case would be to not use trademarks in patent filings at all, if possible.

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As of December 31, 2019, ICANN lists a new Sunrise period as open for the following new gTLD that may be of interest to our clients. A full list can be viewed [here](#).

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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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