



August 2018



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The August 2018 issue of Sterne Kessler's MarkIt to Market® newsletter discusses requirements for registering a scent mark, the U.S. Trademark Trial and Appeal Board's confirmation on whether hashtags add distinctiveness to a trademark, and 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](#).

#### IN THIS ISSUE

Nose Ahead of the Competition: Protecting Play-Doh

#NOPOWER? will.i.am's Hashtag Problems

gTLD Sunrise Periods Now Open

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## Nose Ahead of the Competition: Protecting Play-Doh

By: [Monica Riva Talley](#) and Shelise Rupp

Since the Lanham Act was passed in 1946, trademark protection has encompassed an ever [expanding](#) list of attributes that can be perceived as denoting the source of a product or service. Recently issued [registrations](#) cover sounds, textures, and even the color of football fields. But one of the most recent – and interesting – developments has been in the field of “smell marks.” A smell mark is a scent that is unexpected (not functional) for a product or service, and instead communicates the origin of the product or service to consumers.

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By: Shana Olson

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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.

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Though the first smell mark was registered in 1990, only a handful have registered since. Notable examples include a “flowery musk scent” used in Verizon stores (Reg. No. 4618936), bubble gum scented footwear (Reg. No. 4754435), festive piña colada scented ukuleles (Reg. No. 4144511), rose scented marketing materials (Reg. No. 3849102), and motor fuels that smell like strawberries (Reg. No. 2568512).

Just recently, [another](#) smell mark registration made headlines—the iconic smell of Play-Doh, long a staple of American childhood.



LMoonlight, CCO

Described as “a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough,” for “toy modeling compounds” Federal Registration No. 5467089, is now proudly owned by Hasbro, Inc.

The recent uptick in smell marks may be a natural result of brands' continued need to differentiate themselves in a crowded marketplace, and suggests that this area of trademark law will continue to grow. For anyone wishing to add a smell mark to their stable of brands, there are two specific requirements owners must meet to register such a mark: nonfunctionality and acquired distinctiveness.

Nonfunctionality is a requirement for all registered trademarks. For scents, a gateway requirement is that the smell may not be essential to the use or purpose of the article, including one that affects the cost or quality of the article. Examples that have met this threshold include plumeria-scented thread, and the aforementioned bubble gum smell for shoes and tropical scent for musical instruments.

Second, a smell mark must also be distinctive – which, as with more traditional product configuration trade dress marks, means that the owner must prove that the mark has acquired distinctiveness before it can be registered on the Principal Register. Such evidence can include years on the market, sales figures, look-for advertising, and consumer declarations. If adequate evidence of distinctiveness cannot be provided at the time of filing, marks with the potential to acquire it may still be registered on the Supplemental Register.

Registrability hurdles aside, for brands looking for new ways to connect with consumers, it may just be that a smell mark can help you nose ahead of the competition.

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, also for clothing items in Class 25. In arguing against a likelihood of confusion, will.i.am put forth the theory that the hashtag symbol gives the #WILLPOWER mark a plainly different meaning from the WILLPOWER WEAR design mark, especially given consumer recognition of will.i.am’s use of #WILLPOWER as the title of his 2013 album. The Board disagreed, and noted that the use of a hashtag “at most simply appears as the social media tool to create a metadata tag.”

This decision affirms the PTO’s guidance about hashtags in TMEP §1202.18, which draws an analogy between the hashtag symbol and a generic top-level-domain (gTLD). With respect to both hashtags and gTLDs, the hashtag or domain symbols or lettering merely facilitate categorization and searching online, and do not provide a source-indicating function.

There are two takeaways from this case – first, while a hashtag can be part of a registrable mark, do not expect this symbol to be treated differently from any other generic component. And, second, be sure to consider use of hashtagged social media identifiers as part of normal trademark clearance.

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As of August 29, 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>.

.charity

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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