



January 2019



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The January 2019 issue of Sterne Kessler's MarkIt to Market® newsletter discusses Pantone Color Institute's 2019 color of the year, pointers on protecting logos through copyright registration, Korea's notable amendments to their IP rights guidelines, and lists 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

[New Year, New Hue!](#)

[It's a Bird! It's a Plane! It's Sufficiently Creative!](#)

[Korea Amends Various IP Rights Guidelines](#)

[gTLD Sunrise Periods Now Open](#)

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NEW YEAR, NEW HUE!

By: [Julie D. Shirk](#)

Last month, the Pantone Color Institute announced that the color of the year for 2019 is PANTONE® 16-1546 Living Coral.[1]

Brand owners have long understood the psychology of color in creating their brand identity. The right color choice not only builds on the brand's aesthetic, but draws in the target consumer by evoking a select emotional response.

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By: [Ivy Estoesta](#) and [Alexandra Lazea](#)

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KOREA AMENDS VARIOUS IP RIGHTS GUIDELINES

By: [Julie D. Shirk](#)

The beginning of 2019 brought some notable amendments to Korea's intellectual property rights guidelines. On the trademark side, effective January 1, 2019, Korea's Trademark Examination Guidelines were amended to include:

- **Heightened examination of applications for famous characters/character names by non-owners/bad actors**

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By: [Monica Riva Talley](#)

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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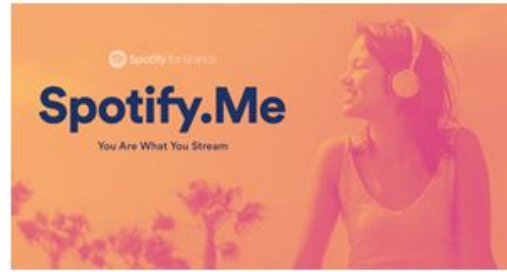
By: [Julie D. Shirk](#)

Last month, the Pantone Color Institute announced that the color of the year for 2019 is PANTONE® 16-1546 Living Coral.^[1]



Brand owners have long understood the psychology of color in creating their brand identity. The right color choice not only builds on the brand's aesthetic, but draws-in the target consumer by evoking a select emotional response. According to Pantone, the 2019 consumer is "seeking authentic and immersive experiences that enable connection and intimacy. Sociable and spirited, the engaging nature of PANTONE 16-1546 Living Coral welcomes and encourages lighthearted activity..., [s]ymbolizing our innate need for optimism and joyful pursuits."^[2]

Some brands --such as AIRBNB, ISSUU, and SPOTIFY-- are already swimming in this or a similar coral hue.



If you're thinking about adopting PANTONE 16-1546 Living Coral, or any other color, for your brand or its creative, consider the following before taking the plunge:

- As with any proposed branding element (color, design, sound, or literal element), a clearance search should be conducted to determine whether it's 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 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, or apply the new color to only part of the product's packaging, or to a label or hang tag;
- Keep 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 may 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 consumer confusion or to cause harm.

Cheers to you and to your brand in 2019!

[1], [2] <https://www.pantone.com/color-intelligence/color-of-the-year/color-of-the-year-2019-shop-pantone-living-coral>

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- **Heightened examination of applications for famous characters/character names by non-owners/bad actors**

Under the old guidelines, and absent prior registrations, an application for a famous character or character name filed by a non-owner could not be refused registration, unless the character or character name was already known among consumers as an identifier of source, based on use with merchandising, and beyond its general fame. This often made it difficult for the rightful owner of such properties to oppose trademark applications filed by others in bad faith. Under the new examination guidelines, such applications will be refused, regardless of any merchandising related to the character or character name.

- **No-go on registration of YOLO and other trendy terms**

The amended guidelines prohibit registration of trendy terms or "buzzwords" that were widely used by the public prior to being associated with a particular product or entity, on the ground that such registrations are contrary to public interest.

- **Stricter requirements for individuals applying for franchise marks in their own names**

In an effort to address the perceived abuse of trademarks by a number of Korean franchisors, the amended guidelines provide that any application to register a franchise mark in the name of an individual (rather than in the franchise company's name) will be rejected on the basis that

the individual lacks a bona fide intent to use the franchise mark for non-franchise-related purposes specific to the individual. To remove the rejection, the individual applicant must provide such proof, or put the application in the name of the franchise company.

Updates with Customs

At the border, and as of January 21, 2019, Korea amended its guidelines for Import and Export Customs Clearance Procedures to:

- Extend the term of the recordation from 3 years to 10 years (the recordation will still expire if the underlying IP right expires);
- Simplify the process for recording patent and design rights, by abolishing the requirement to submit evidence that one or more importers or exporters may be infringing such rights (making the recordation process for patent and design rights consistent with that for trademarks and copyrights); and
- Allow for filing of a renewal application as early as one year prior to the expiration date of the customs recordation (the renewal period still ends 10 days prior to the expiration date).

The majority of these amendments should make it easier for IP rights owners to protect their properties against bad actors in this jurisdiction.

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

.dev

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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Last month American Airlines, Inc. successfully landed its turbulent pursuit to register its “Flight Symbol” logo with the Copyright Office, after the Copyright Office Review Board (CORB) electively revisited and reversed its [initial decision](#) refusing registration of the logo for lacking sufficient creativity. Ultimately agreeing with American Airlines, the CORB found that the logo modifies and combines otherwise simple shapes and shading in a way that provides for the minimum amount of creativity necessary to satisfy the originality requirement for formal copyright registration.

American Airlines’ battle emphasizes the important role logos play in any brand strategy – more so than other forms of marks, logos are easily recognizable, and are a shorthand way of differentiating and communicating brand value in the marketplace. When a logo is sufficiently creative, applying for a copyright registration can provide an added level of intellectual property protection for relatively little cost. Presumably for that reason, American Airlines applied for a copyright registration for the Flight Symbol in 2016, despite already owning a U.S. trademark registration for the same logo.



American Airlines’ unwavering efforts to register its logo with the Copyright Office—including filing a [lawsuit](#) against the Copyright Office for refusing to register the logo—provide

considerable insight for brand owners seeking how best to protect two-dimensional designs.

Pre-filing considerations. Because commercial use is a prerequisite to obtaining a federal trademark registration in the U.S., and each class of good/service intended to be covered by a trademark registration requires a separate fee, most brand owners necessarily seek registration covering only their primary goods and services offerings, versus a full line of ancillary promotional products.

However, obtaining a copyright registration can be a cost-effective way for a brand owner to extend the scope of its rights in a two-dimensional design to secondary goods and services, and in different geographic markets, for several reasons.

First, commercial use of a two-dimensional design is not a prerequisite to obtain a copyright registration; instead, all that is required is that the design be fixed in a tangible medium (e.g., created on a computer or drawn on paper) and original.

Second, the copyright application fee (\$55) is significantly less than the per class trademark application fee (\$225 – \$400, depending on the application form), and copyright applications are typically processed more quickly than trademark applications.

Finally and significantly, a copyright registration for a two-dimensional design may be enforceable against substantially similar copies, regardless of whether such copies are used with goods/services related to the copyright owner's business. In other words, unlike in a determination of trademark infringement, the underlying goods/services are not considered when determining copyright infringement. Additionally, a U.S. copyright registration can serve as a basis for a DMCA takedown request for products sold on online platforms, and may be a useful enforcement tool in Berne Convention member countries, like China.

Thus, brand owners may want to consider seeking registration of two-dimensional design logos with both the Trademark Office and the Copyright Office.

Filing considerations. Before a copyright application can be processed, a “deposit,” a representation of the work, must be submitted. For two-dimensional works, deposits are typically photographs or digital images of the work, and may be submitted electronically as an electronic [file](#) or mailed in as a hard copy.

The Copyright Office's [online registration portal](#) makes it easy to submit deposits electronically, but some degradation of image quality might occur. Such was the (alleged) case with respect to the electronic deposits provided for the Flight Symbol; as the CORB's supplemental decision explained, it was difficult to appreciate features of the design in the electronic deposit versions, that were easier to discern in the subsequently-submitted paper deposits. According to the CORB, the physical deposits of the Flight Symbol “depicted additional details that had not been clear from the original [electronic] deposits,” and these details supported the CORB's finding that the Flight Symbol is sufficiently creative for copyright protection. For nuanced images, applicants should consider submitting physical deposit copies to the Copyright Office by mail or in-person submission.

Prosecution considerations. If, during examination, the Copyright Office refuses registration of a work for lacking sufficient originality because, for example, the design is arguably simple, or comprises relatively few elements, it is important that the response to the refusal avoid likening those elements to geometric shapes, and instead highlight other features of the work, like shading and arrangement, that significantly distinguishes those elements from common regular shapes. Discussing these visually objective indicia may be more persuasive than how the work is intended to be received by the public (i.e., the work's symbolic meaning),

how it is in fact received (i.e., its commercial value), or the time and effort put into creating the work.

Armed with these considerations, brand owners can be better equipped to assess whether their logos may be good candidates for copyright registration.

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