



January 2020



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The January 2020 issue of Sterne Kessler's MarkIt to Market® newsletter discusses the following topics:

- The TTAB's affirmation to refuse a mark to distillery Jos. A. Magnus & Co.;
- Six trademark and copyright cases at the Supreme Court;
- Public confusion between the "coronavirus" outbreak and the CORONA beer brand, and strategy considerations if your brand is inadvertently associated with a negative news event;
- Implications for copyrighted works that entered the public domain on January 1.

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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Grab Some Limes? What to do When Your Brand Goes Viral - and Not in a Good Way

Out In with the Old, In with the New

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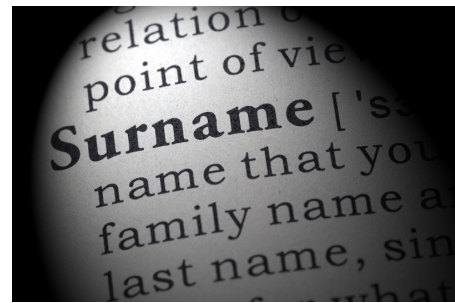


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THAT'S NOT MY [SUR]NAME

By: [Lauriel F. Dalier](#)

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"SOFT" IP TAKES CENTER STAGE AT THE SUPREME COURT

By: [Monica Riva Talley](#)

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Supporting its position that MAGNUS is not primarily merely a surname, the applicant argued that, despite its tradename, Jos. A. Magnus & Co., its website address of www.josephmagnus.com, and its marketing around a historical figure for and around whom its famed JOSEPH MAGNUS® whiskey is named and branded, no individual with the last name MAGNUS is or has been involved in the applicant's business. Additionally, as evidence that the PTO has previously found MAGNUS not primarily merely a surname, the applicant provided copies of 12 live, third-party registrations on the Principal Register for the mark MAGNUS for a variety of goods/services.

The opinion clearly lays out the prosecution history of the application and some of the factors considered by the Board, including the evidence in the record supporting the applicant's argument that that the mark is not primarily merely a surname. The Board took care to highlight their prior holding in *In re Olin Corp.*, 124 USPQ 2d 1327, 1330 (TTAB 2017), which explained that "whether the primary significance of an applied-for mark is merely that of a surname is a question of fact that must be resolved on a case-by-case basis." In reaching its decision, the Board "[found] it significant that the applicant has made and continues to prominently make a connection with a person having the surname MAGNUS," and observed that the evidence of record did not support a finding of an alternate non-surname meaning.

As the mother of a son whose first name is Magnus, and of a daughter whose name also arguably crosses over from surname to first name, this decision prompted me to contemplate and share some key considerations for brand owners who want to register an arguable surname as a mark:

1. Search baby name websites to check a) if the name has crossed over from surname to first name, b) the popularity of the name in the U.S., and c) any increase in popularity of the name used as a first name over the years (e.g., in 1996, 69 babies per million were given the

first name Magnus; by 2007, that number had increased to 116 babies per million; by 2015, the number was 173 babies per million; see: [here](#)). According to a 2016 [article](#) in the *Chicago Tribune*, Cleveland Evans, author of “The Great Big Book of Baby Names,” said the crossover of surnames to first names began in Tudor England, “when parents chose surnames of nobility.” The “surname-as-first name practice” snowballed because of the “genealogy craze,” added the CEO of [babynames.com](#) and author of “The One-in-a-Million Baby Names Book,” Jennifer Moss.

Social Security Administration data and reports from online media groups such as Nameberry and BabyCenter are just a few of the sources that contribute to the year-end lists of the most popular baby names (see [here](#)). These lists and others also inform to provide statistics about the increase in popularity of baby names.

2. Search for use of the name by famous people online, e.g., Will Ferrell, Kristy Swanson, and Elizabeth Banks all have children named Magnus; use by celebrities is credited for Magnus’s entrance into the Top 1000 baby names for the first time in 2013 (see: [here](#)).
3. Check for other associations with the proposed mark used as a first name, such as historical figures, e.g. Madison (also James Madison’s surname) or [Magnus Olafsson](#), better known as “Magnus the Good”; or literary figures, e.g. Magnus in *The Vampire Chronicles*; and, depending on the name, double entendres, other possible meanings (e.g., Mason), or English translations that have an alternate non-surname significance, e.g., Flores, which is Spanish for flowers.
4. When submitting third-party registrations for the mark as evidence that the PTO has found the mark not to be primarily merely a surname, consider submitting additional evidence from the prosecution history of those registrations to provide evidence of similar fact patterns and context.
5. In promotional materials containing the name/mark and on the “About” page on their website, brand owners should take care not to create a connection between the mark and any surname significance.

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Two of the three trademark cases will likely influence the cost/benefit analysis of bringing a trademark infringement case. The first, *Romag Fasteners Inc. v. Fossil Inc.*, will address a split in the circuits as to whether willful infringement is required for an award of the infringer’s profits. The second, *Lucky Brand Dungarees Inc. v. Marcel Fashion Group Inc.*, will consider whether a defendant is precluded from raising defenses that were not litigated or resolved at some earlier point in litigation between the two parties.

The third trademark case, *U.S. Patent and Trademark Office v. Booking.com B.V.*, will look at whether the addition of a generic gTLD (.com) to an otherwise generic term can create a protectable trademark.

On the copyright side, two of the three cases relate to the interplay between government publications and copyright law. In the first, *Georgia v. Public.Resource.Org Inc.*, the Court will consider whether government entities can charge for access to certain legal texts – in this case, an annotated version of the Georgia state code, despite the long standing rule that “government edicts” are not covered by copyright law. The second, *Allen v. Cooper*, will evaluate whether state governments have sovereign immunity from copyright lawsuits, notwithstanding the Copyright Remedy Clarification Act (CRCA), which aimed to allow infringement suits against states; a lower court ruled the CRCA unconstitutional.

The final copyright case, *Google LLC v. Oracle America Inc.*, involves the question of fair use relating to software code, and will be the first case ruling on the copyrightability of software. Of the six, this case will likely get the most press, and have the farthest reaching ramifications for the tech community - outside groups have already submitted over two dozen amicus briefs, and Oracle asked for \$9 billion in damages.

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While coronavirus is understandably eliciting concern from international travelers, public health officials, and epidemiologists, another group is taking close note – beer drinkers. Yes, apparently some people are worried that the coronavirus outbreak is related to... CORONA brand Mexican beer. [USA Today](#) reported an interesting reveal from Google Trends on January 29th, as searches for “Corona beer,” “Corona beer virus,” and “beer virus” have all recently skyrocketed in frequency on the search engine.

For brands, even though the bad press isn’t your fault, it is still your problem. So what’s a brand to do when it gets caught up in a negative viral news cycle? A carefully designed/quick acting PR campaign can work to clarify the facts and help the brand gain control over its own memes, and perhaps enhance its own brand cache at the same time.

An analogous situation occurred over the recent holidays when Peloton was called out for an ad portraying a husband who gifted his already-fit wife a stationary bike. While Peloton itself hasn’t addressed this apparent disconnect between its message and its audience (or, perhaps, it is profiting from the old adage that any press is good press), the quick response by Aviation Gin is a case study in brilliant real-time marketing. For those who haven’t seen it, the Aviation ad featured the same actress from the Peloton ad, drinking gin martinis at a bar with her friends after presumably leaving her controlling husband.

The timely delivery of Aviation’s response, not to mention its hilarious content and execution, made it an instant sensation. And while Aviation’s brand was not the one subject to a negative viral news cycle, its tactic is a textbook example of how to capitalize on a viral moment – even when not of your own making.

So, it is good news that the coronavirus is not caused by drinking CORONA beer. And hopefully, there will be a resolution to the coronavirus situation very soon. In the meantime, we are staying tuned to see if Corona is able to find a way to turn a negative viral moment for their brand into a positive.

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For many, January 1 marks the beginning of a new year, which is often associated with looking forward. Ironically, some celebrate January 1 by looking backwards, in observance of Public Domain Day. Public Domain Day 2020 looked specifically to the year 1924. Why? Because copyrighted works from 1924 (which would have entered the public domain on January 1, 2000, had Congress not extended the 75-year copyright term to 95 years) would finally enter the public domain.

Among the works that entered the public domain this year are:

- Edward Hopper's painting *New York Pavements*
- E. M. Forster's novel *A Passage to India*
- the first film adaptation of *Peter Pan*
- Al Jolson's musical composition *California, Here I Come*
- George Gershwin's musical composition *Rhapsody in Blue*

Now that these works (among [others](#) from 1924 and earlier) are part of the public domain, they are available for anyone to reproduce or distribute freely for others to rediscover. And copyright may no longer be asserted as a legal basis to request taking down, for example, the showing of *Peter Pan* [here](#). Or the reproduction of the complete novel *A Passage to India* [here](#). Or the sheet music for *Rhapsody in Blue* [here](#).

Additionally, copyright may no longer be relied upon to prevent anyone from appropriating and adapting works in the public domain into new works. Though no one may claim exclusive copyright in a work in the public domain, an adaptation of the work may contain sufficiently original authorship to itself qualify for copyright.

With all this in mind, we hope you celebrate this new year not simply by looking backwards to rediscover past works—but by looking forward and reimagining those past works into something new. In with the old, and in with the new!

Cheers to an inspired new year!

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