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Happy New Year! We're excited to share the January 2022 issue of Sterne Kessler's Markt to Market® newsletter in a newly updated format. This month's articles discuss the Pantone Color Institute's 2022 Color of the Year – including how brands can memorably link color to brand identity. We also explore a recent TTAB decision sustaining a dilution claim against the POTIFY mark – can you guess the opposer?

Our [Trademark & Brand Protection practice](#) here at Sterne Kessler is devoted to guiding companies of all sizes in developing and maintaining strong brands around the world. There is always something new and exciting happening in our unique IP niche, and we bring you updates each month to help you keep on top of it all. Thanks for your readership. If there is something you would like us to cover, please don't hesitate to reach out to us and let us know!

Kind Regards,



[Monica Riva Talley](#)
Editor

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Very Peri – Pantone's New Hue for 2022!



By: [Julie D. Shirk](#)

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Watching the Pot™

When Fame is the Name of the Game

By: [Lauriel F. Dalier](#) and [Monica Riva Talley](#)

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Grounded in color theory, representatives for Pantone expressed that this year’s choice combines the qualities of blues with a violet-red undertone to “encourage courageous creativity and imaginative expression,” which is important as we continue to forge our way through these transformative times.

Like the institute, marketers understand the psychology of color and how it contributes to the success of a brand. The right choice of color not only builds on a brand’s aesthetic, but also grabs the consumer’s attention by eliciting a select emotional response. Tying this year’s color to our current state of being, the institute shared that Very Peri – blending trusted or reliable blues with a spirited violet-red – is reflective of how our physical and digital lives are merging in new ways. Microsoft appears to have understood the assignment, and is already on-trend, as the color story for its TEAMS videoconferencing technology has employed periwinkle-hued elements for some time now.



And while many brands are exploring how to position themselves and their trade dress across various digital platforms, including in the metaverse, still others are creatively exploiting or celebrating their brand's colors out in the real world. For example, in celebration of the upcoming Chinese lunar New Year, Bottega Veneta recently displayed a greeting on the Great Wall of China, with its "Bottega Green" color serving as an eye-popping background.² Also earlier this month, the tower of the Empire State Building was illuminated in the iconic orange color of the TODAY show to commemorate its 70th anniversary.³

If your brand is considering a new hue for its trade dress or messaging – digitally, virtually, or in real life – we encourage you to consider the following before moving forward:

- Conduct a clearance search to determine whether the color(s) of interest are available for use with your goods and services;
- Check existing registrations for any current color marks you own to see if they are due for maintenance. If so, consider adopting the new color(s) for only select models/SKUs to allow you to maintain your existing registrations if they remain of interest;
- Consult with any relevant industry and regulatory teams before adopting a new color scheme to confirm that it is neither misleading of the nature of your product, nor likely to create consumer confusion or to cause harm.

Federal registration of color marks (particularly, single color marks) continues to be a challenge. To improve your brand's chances of registering a color mark, remember to instruct consumers to look for your brand's color in the marketplace, use the color consistently to reinforce its association with your brand, and avoid referring to any functional attributes of the color – e.g., the ease of visibility of the color orange – since functional color marks are never registrable.

[1] www.pantone.com/color-of-the-year-2022

[2] www.prestigeonline.com/th/style/fashion/bottega-veneta-lunar-new-year/

[3] www.today.com/news/empire-state-building-lit-orange-celebration-todays-70th-anniversary-rcna12176

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To succeed on a dilution (versus infringement) claim, the opposer must demonstrate that:

1. Applicant's mark is similar to Opposer's more senior mark;
2. Opposer owns a famous mark that is distinctive;
3. Applicant is using a mark in commerce that allegedly dilutes Opposer's famous mark;
4. Applicant's use of its mark began after Opposer's became famous; and
5. Applicant's use of its mark is likely to cause dilution by blurring or tarnishment.

To reach a conclusion on the dilution issue, the Board considered the degree of similarity of the marks (in that they differ by only one letter), the degree of consumer recognition of the SPOTIFY mark (the Board found SPOTIFY to be "exceedingly famous"), whether there is association between the marks SPOTIFY and POTIFY, and whether that association was intentional.

As for the Applicant, although its founder and CEO admitted that he became a SPOTIFY customer well prior to Applicant's use of and applications for the POTIFY marks, he claimed that the mark SPOTIFY never crossed his mind when coining the mark POTIFY. Instead, he explained the mark POTIFY was coined to connote a commerce platform, like SHOPIFY® – another registered mark – for the "weed industry."

The Board sustained the opposition, in light of the fame of SPOTIFY, and the degree of similarity between

the marks. In particular, the Board observed that Applicant's claim of "innocent adoption" of the term POTIFY would require a tremendous "leap in logic and common sense," given the similarity of the functionality of the software products at issue.

There are three key takeaways from this opinion:

1. First, while "homage" and humorous marks are popular with the marijuana and cannabis industries, these brands are still subject to the same rules as mainstream trademarks – trademark counsel can help provide the appropriate clearance when taking niche marks to the national level.
2. Second, it is important to remember that applications for cannabis-related marks can only cover federally legal products and services – typical examples include ancillary merchandise such as clothing and accessories.
3. Third, once you have selected and committed to a brand, keep careful records of how you use the mark – including archiving versions of the website, media "tear sheets," and social media posts; results of consumer recognition and engagement evidence; and advertising and PR expenditures – for use in demonstrating fame and recognition should you need to defend your brand down the road.

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