

Think before you trade mark a wink: Registering emojis and emoticons

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Is your business developing emojis and emoticons as part of its marketing strategy?

The emoticon and its cousin the emoji are now synonymous with expressing emotions and ideas.

Emojis are small digital images or icons used to express an emotion or idea, for example, hello:



Emoticons, on the other hand, are representations of a facial expression such as a smile or frown, formed by various combinations of keyboard characters – for example, winking:

;))

Emojis and emoticons have become internationally recognised and adopted symbols in text messages, email communications and social media posts. “Face with Tears of Joy”, “Red Heart”, “Smiling Face With Heart-Eyes”, “Rolling On The Floor Laughing” and “Smiling Face with Smiling Eyes” are reported to be five of the most popular emojis currently in use.

Advertisers commonly use emojis or emoticons, or are developing emoji-like or emoticon-like symbols for Apps. Coca Cola was reported to have created customised cola emojis in 2015 on Twitter, and in some places you can even order a pizza or taco using an emoji!

So, can you get an emoticon or emoji registered as a trade mark to add to your stock of registered IP assets?

Emoticons have been incorporated as part of brands. For example the following mark is registered in Australia under Registration No 1967856 for *medical services, and hygiene and beauty care*:

m:)

Whether a mark incorporating an emoji or emoticon is registrable as a trade mark involves the same considerations as other logo or graphic device trade marks:

1. Is the emoji / emoticon sufficiently distinctive, and not merely descriptive of your products and services, or a commonly used symbol for your line of business?
2. Are there any pre-existing similar marks in use or on the Trade Marks Register that may pose obstacles to your marketing plans?
3. Does the trade mark applicant own copyright in the emoji / emoticon?

So here's how to emote your brand.

Be distinctive

Don't use a common generic symbol. Create an original emoticon or emoji that is particularly striking or unusual, or can be incorporated:

- Within a logo
- As part of a combination mark with other distinguishing words and / or other distinctive graphic elements
- Into a single letter
- Around a word

Clear your mark for registration and use

As with all brands, care should be taken to make sure that an emoji or emoticon is not in conflict with prior similar marks that are already used or have been applied for or registered by someone else. Pre-filing register and use clearance searches should be conducted to assess this.

Make sure you own copyright

Bespoke emoji are valuable business assets. It is always best practice to ensure that copyright ownership is vested in your business. Obtain a signed written assignment if the emoji has been developed by an external artist.

If you are developing emojis and emoticons as part of your marketing strategy and would like some IP guidance, please contact the Dentons Intellectual Property and Technology team for a confidential discussion.

Your Key Contacts



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