

# Noli IP Newsletter

NOLI IP Solutions, PC

5/11/2015

Trademark Edition, Vol. 2

## *Team Work Makes the Dream Work: Happy First Anniversary Noli IP Solutions* By Mariana Paula Noli

Last Saturday, May 2<sup>nd</sup> 2015, was a very special day for all of us. We gathered together with friends from all over the world at the Harbor House restaurant in Seaport Village to celebrate the 1<sup>st</sup> birthday of Noli IP Solutions PC.

home city of San Diego, we could not think of a better time and place to celebrate. Friends and colleagues from Brazil, India, Colombia, Mexico, Argentina, Chile, China, Italy, Uruguay, Paraguay,

*As the saying goes "If you want to go fast, go alone. If you want to go far, go together." If you ask me, we were all destined to be working together and Noli IP Solutions PC was meant to be.*



Given that 137<sup>th</sup> Annual Meeting of the International Trademark Association (INTA) was scheduled to take place from May 2-6 in our

Spain, and Turkey joined us toasting for many more years to come. We are so grateful to be where we are today. As I mentioned when giving a toast, things didn't happen overnight. Quite frankly, Noli IP Solutions is a childhood dream of mine. Some things in life are meant to be, I believe. You do your best at everything that you do and the rest is out of your

## *Seniority Claim: Being Old has its Benefits*

By Judit Marai

Although seniority and priority claims sound similar, they are different claims based on different international treaties. **Seniority claim** refers to the situation when you have a registration in a country member of the EU and apply for the same mark as a CTM or select the CTM in a Madrid application. The mark must be identical; the owner of the trademark as well as the goods/services protected must be the same. **Priority claim** refers to the situation when the owner of the trademark files a subsequent application within 6 months from the filing date of a foreign application and has already applied for registration in a foreign country for the same mark. The subsequent application will have an effective date of the previously filed application. The Paris Convention offers this possibility to applicants filing in countries members of this treaty. For more information, e-mail me at [judit@noli-ipsolutions.com](mailto:judit@noli-ipsolutions.com).

control. Over decade ago, I met Sergio at a PCT seminar who later introduced me to our esteemed patent agent Karim. Our patent attorney Raouf worked at the same law firm I worked for in the United States when I first arrived to this country. Judit was looking for an opportunity to work for a US law firm after graduating from the LLM program at the University of San Diego. A friend of mine highly recommended Olivia when I was looking for an administrative assistant; she turned out to be even better than my friend's recommendation. It is true that when it comes to Lucy, I

didn't have much of a choice; she is the only sister I have. Jokes aside, I could not have imagined a better group of people to help me make this dream of mine a reality.



As the saying goes *"If you want to go fast, go alone. If you want to go far, go together."* If you ask me, we were all

destined to be working together and Noli IP Solutions PC was meant to be.

Thanks again to all our friends and colleagues who came to celebrate with us! For those of you who were unable to be here in person but you are part of the reason we are in business today, special thank you for trusting us with your business. In your name, I raised a glass thanking you for your continued support and wished Noli IP Solutions many more exciting, challenging and successful years to come. Happy First Birthday Noli IP Solutions PC!

## *Madrid System in Latin America: Should We Join?*

*By Luciana Eugenia Noli*

The dilemma of the Latin American countries as to whether it would be beneficial for them to join the Madrid System is not a new one.

A few years ago, I remember having many discussions with Mariana about the pros and cons of joining the international registration system, known as The Madrid System, by a country in Latin America. Back on March 8, 2013 in Mexico City, Mariana

had the opportunity to offer a workshop for trademark lawyers at the IMPI (Instituto Mexicano de la Propiedad Industrial) about the practical aspects of The Madrid System.



Many of the attorneys who attended the workshop expressed their concerns and showed apprehension about the implementation of the new law. These fears are shared by trademark practitioners in other countries of the region.

For many years, the only countries in Central and South America members of the system were Cuba and Antigua y Barbuda. Three

changes have been crucial to the shift in Latin America in the past few years: (1) Spanish was added to English and French as a working language of the system in 2004; (2) International brand owners pushed for free trade agreements to include requirements that countries join Madrid; and (3) more local companies became in favor of the system.

The accession of Colombia, while feared by local lawyers, was welcomed by trademark owners. Mexico's succession was another cause for celebration since it is the

largest trading partner of the United States.

Expectations look at Brazil to be the next country in the region to join Madrid mainly because they have seen the advantages of being part of the system enjoyed by their competitors in Colombia. Other countries such as Chile and Argentina are likely to follow in the years to come. The most of world's biggest economies are already members. The Madrid System keeps growing whether some of us like it or not.

So does joining the Madrid System changes the trademark practice at a

national level? There is no question about that.

However, let's keep in mind that trademark practice is constantly evolving and clients don't just hire a trademark attorney for the filing. Fear often doesn't justify staying outside the action and you may end up missing out more than what you keep. When available, determining whether to choose the Madrid System route is good for a particular client or a business is a decision made on a case by case basis. Feel free to contact us if you have questions or need assistance.

## INTA 137<sup>th</sup> Annual Meeting in San Diego – May 2-6, 2015

*Our Noli IP team was well represented at the INTA Annual Meeting in San Diego, California. Special thanks to Luciana, Judit and Olivia for all the hard work setting up meetings, preparing for our anniversary party at the Harbor House, attending the INTA Opening Ceremony and Welcome Reception, as well as workshops and private events.*



For more information on the International Trademark Association Organization (INTA) and its annual meeting, please check the following link:

<http://www.inta.org/2015am/pages/home.aspx>