

Noli IP Newsletter

NOLI IP Solutions,

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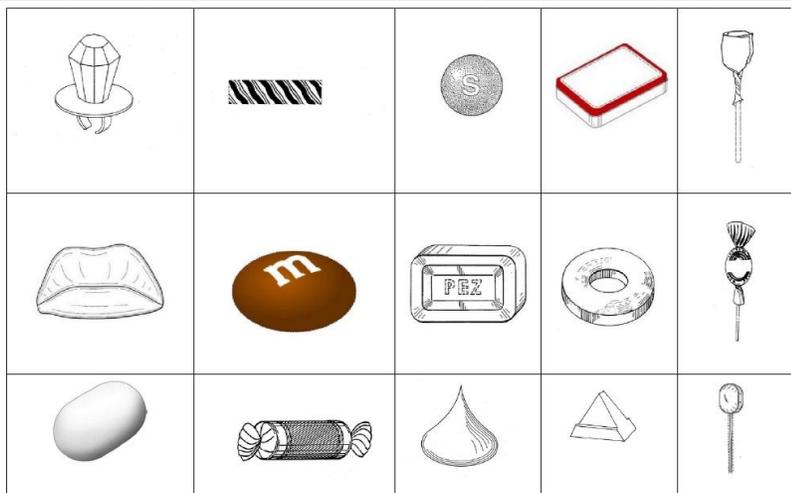
October 2017 Edition

Happy on IP Halloween

By Mariana Noli and Diane Fischer

With Halloween just around the corner, Diane had the great idea of dedicating the October edition of our Noli IP Newsletter to the intellectual property issues

rights are EVERYWHERE. Of course, it is impossible to cover every single intellectual property related issue on Halloween, but here are a few examples that may



that can come up during the holiday season. Don't you love her idea? What I like the most about it, is that while people think that intellectual property rights are some fancy terms that are foreign to their daily life; this article gives us the opportunity to see that IP

surprise you. When it comes to trademark and service marks, a quick search on the USPTO shows over 100 results for trademarks containing the term "HALLOWEEN". From Halloween Party to Halloween Store, from

Women in Business



A few weeks ago, Ms. Mariana Noli had the opportunity to participate in the San Diego Small Business Development Center Women in Business workshops and presentation sessions.



We congratulate these women for obtaining recognition as successful business owners and we thank the SBDC for putting together this inspiring event.



Halloween City to Halloween Scream to Halloween Spell; from Halloween Treats to Halloween Trick or Treat; all of these are registered trademarks. If you focused on trademarks covering candies alone, you will find many records on the US Trademark Register, such as Adams & Brooks' Halloween Hooties and Hershey Chocolate & Confectionery Corporation's Hershey's is Halloween.

So can you identify the candy in your Halloween trick or treat bag just by its *shape*? Absolutely! When talking about Halloween and candy, it is quite interesting to realize that many of our favorites are easily recognized by their shape! It is no wonder that the shape of many of these popular candies are protected by either trade dress or some other intellectual property right. The configuration or shape of products can be registered 'non-traditional' trademarks and in fact, many candy configurations are registered. Let's take as an example Hershey's Kisses. In 1924, Milton S. Hershey trademarked not only the Hershey's Kisses

name, but also the iconic shape of the top of the foil-wrapped Hershey's Kiss candy (US Registration No. 0186828). Reviewing the USPTO database today, there are more than 20 trademark registrations protecting the shape of the Kiss candy, such as US Registration Nos. 1,038,025; 1,889,409; 1,888,004; 1,731,429; 1,927,046; 1,986,822; 2,112,374; 2,138,566; 2,545,676; 2,843,129, to name a few.



Not only trademark but patent protection can be found behind a chocolate candy bar. Since we are talking about the popular Hershey's chocolate and candy bars, Mr. Hershey is also credited with a variety of other patents, including a "*Machine for Cutting Candy*" (US Patent No. 532,554, dated January 15, 1895) and a "*Candy Holder*" (US Patent No. 412,090, dated October 1, 1889) that "*can be used for toys after the candy is*

removed." Those patents never saw the popularity of the more typical Hershey products; and both of these patents are now expired. So when you are holding a candy next week, you will now be aware of all the trademark, trade dress, copyright and patent issues behind that piece of candy!

There would be no real Halloween parties without dressing up. Wearing scary outfits and dressing up as certain movie characters, Freddy, Jason, Pinhead, etc., reminds us that those are copyrighted characters by their various studios. Though the fact they make costumes and masks grants some form of implied license to dress up like them in public, it's unclear if that license would extend to professional or even charity haunted houses. It is safe to say that if you are using the outfits for your personal enjoyment and not for any activity generating profit, you are not infringing upon anyone's rights. Masks, at least the part of them that makes them a costume element, are essentially sculptures, which are copyrighted works. Though in selling them as a mask there is an implied license to wear

them in the intended manner, it's unclear how far that implied license would go. There is no evidence to date of anyone being threatened or sued for doing this and any mask maker who did would likely go right out of business. Still, it's an interesting copyright question without a clear answer. Given the fair use, implied license and other defenses in this case, we don't worry about it too much.

As far as music goes, it is not any different than what we discussed when writing about wedding ceremonies and parties. A great haunted house needs "good Halloween" music.

Playing a music inside a haunted house or a restaurant is a public performance of the work and is not allowed without a license.



Non-commercial use, such as what most of us do, has much greater leeway but professional haunters need to obtain music licensing from ASCAP and BMI if they are going to use recorded music in their haunted house. You can always record your own music or make sure that the

music you play is part of the public domain.

With only a few days left to go there are still some final preparations and decisions that need to be made. It is going to be a fun time for all of us, whether trick or treating with the kids and/or dressing up and attending fun costume parties. Just remember that intellectual property rights may be there where you least expect. Happy Halloween everyone! See you guys in November!

Changes in the European Union Trademark Registration II

By Judit Marai

The change of the European trademark system started years ago. As you might remember, part of the Trademark Regulation (Regulation (EU) 2015/2424) entered into force on March 23, 2016. As of October 1, 2017, the second set of rules in the Basic Regulation entered into force along with the Implementing Regulation (Regulation (EU) 2017/1431)

and Delegated Regulation (Regulation (EU) 2017/1430).

The regulation introduces the certification marks in the European Union. The certification marks are signs of supervised quality and their main function is to attest that the goods or services bearing them comply with certain certification requirements. It is a familiar

type of trademark in many jurisdictions, including the U.S., but a new idea in the European Union Trademark System. For the application and prosecution of trademarks, one of the biggest change is the elimination of the graphical representation requirement - the mark can be represented in any appropriate representation as long as the representation is

clear, precise, self-contained, easily accessible, intelligible, durable and objective. (E.g. A link to the electronic file is the representation.) This makes it easier to file non-traditional marks with the EUIPO. E.g. sound marks can be represented by an audio file or musical notation, motion marks with video file or still images, multimedia marks with audio-visual file, and hologram marks with video file, graphic or photographic reproduction.

The regulation brings other smaller changes in the procedures as well. A few of them are as follows: Priority

claims have to be filed together with the application: there is no 2-month window to do it anymore. The office does not examine the priority claim ex officio, only if an inter partes procedure occurs in the case (opposition, cancellation etc.) Acquired distinctiveness is a subsidiary claim, it does not have to be the first option. It can be used after the applicant exhausted the appeal. If the submitted documents are in one of the 5 official languages, no need to translate it to the language of the procedure, unless the office requires it. For proving earlier rights, there is no need to submit physical

documents: a link to the specific database is acceptable. Hand delivery and deposit in a post box is no longer available. The rules of cancellation and opposition are aligned to each other as much as possible.

As we can see, the goal and the result of the change is to make the procedure easier, more transparent, and cost effective for the EUIPO and the parties. If you are interested in further details, or we can be any of your help with your trademark in Europe, please contact us at judit@noli-ipsolutions.com, or mail@noli-ipsolutions.com.

ADVOCATING FOR OTHERS: NON-PROFIT & PRO-BONO WORK

As a firm, we encourage our members to give back to society whenever possible. All of us, separate and together, are committed to advocate for those who sometimes cannot advocate for themselves. This is what it truly means to be an attorney for us. Many of us have been involved in different non-profit organizations and have active participation in non-profit organizations. We take this moment to thank all of our team members who take time to give back to society. Thank you!

