

Noli IP Newsletter

NOLI IP Solutions, PC

12/22/2017

December Edition

Happy Holidays from Noli IP!

By Mariana Paula Noli

As 2017 is coming to an end next week, I want to take another opportunity to thank you for entrusting us with your businesses' intellectual property and corporate needs. As I look back at the months

we want to provide you with the best legal service possible.

It is quite interesting to me that many businesses today, whether start-up businesses or more



behind us to reflect on what we can do better for next year, I believe we have come a long way, but I know we can always be better. Please let us know about your experience working together and do not be shy to share where you think we can improve. We are here because of you and

established entities, still may not realize at times how important it is to protect their intellectual property rights. I am happy to see that our clients know better.

Take the holiday season as an example on how your intellectual property rights have an effect well after

Women in IP

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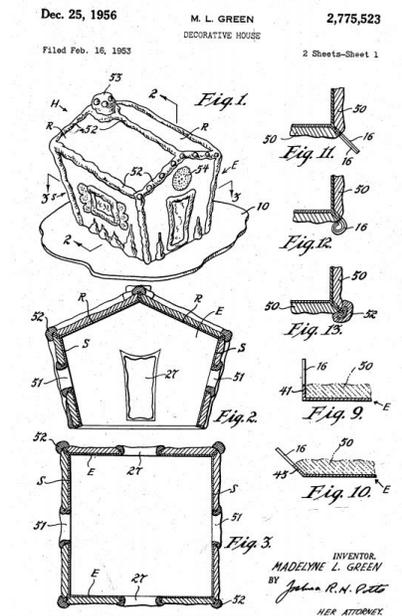
It was only a little over two years ago, that our founder together with some colleagues and friends decided to create a non-profit organization in California to promote women's rights in the workplace. Yes, of course, women have many rights today that we did not have in the past...



Women's IP Today, was created to raise awareness of unspoken issues. It provides a space where women can motivate and encourage each other, while balancing the required skills to be competitive in today's world without forgetting to be women! For information about this organization, please visit: www.womensiptoday.org

you come up with your novel creations. And then it is your decision whether you will enforce your rights or not. Think of Christmas carols like “Rudolph, the Red-Nosed Reindeer”, “Frosty, the Snowman”, “Silent Night”, “Little Drummer Boy”, “Jingle Bells”, many of these are now part of the public domain but all were protected under copyright at some point in time. Or, how about those famous Gingerbread Houses, which at some point may have been protected under a design patent. See US

Design Patent No. 2,775,523 below.



Whether or not you decide to enforce your rights against third parties, it is crucial that you take the business of protecting your creations and “ideas” seriously. In some instances, you may still be ok seeking protection of your IP rights after you made your creations known to the public, but in others, it may already be too late. So, this holiday season just remember before you start sharing your “creative ideas”, consult with our experts and protect yourself ahead of time! Salud!

New Trends in Immorality of Trademarks

By Judit Marai

We have seen a new trend in trademark prosecution in the past few months in the United States: the First Amendment (Free Speech) prevails over immoral and scandalous marks, leaving decades of trademark practice behind.

Cir. 2017)) accepted the trademark “FUCT” for registration. After the SLANT decision earlier this year (*Matal v. Tam*, No. 15-1293 (U.S. June 19, 2017), see our July 2017 Newsletter), this decision shows the future of disparaging or scandalous mark applications.

them into contempt or disrepute ... “15 U.S.C. §1052(a). In real life practice, courts do not make any differentiation between immoral and scandalous, and the determination whether a mark is immoral changes over time. However, immorality of the mark in the FUCT case was not the matter.

United States Court of Appeals
 for the Federal Circuit

IN RE: ERIK BRUNETTI,
 Appellant

2015-1109

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85310960.

Decided: December 15, 2017

JOHN R. SOMMER, Irvine, CA, argued for appellant.

JOSHUA MARC SALZMAN, Appellate Staff, Civil Division, United States Department of Justice, Washington, DC, argued for appellee Joseph Matal. Also represented by DANIEL TENNY, MARK R. FREEMAN, BENJAMIN C. MEZER, NATHAN K. KELLEY, THOMAS L. CASBERGIANE, CHRISTINA HIEBER, MARY BETH WALKER, MOLLY R. SILPES, THOMAS W. KRAUSE, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA.

Before DYK, MOORE, and STOLL, Circuit Judges.
 Opinion for the court filed by Circuit Judge MOORE.
 Concurring opinion filed by Circuit Judge DYK.

Section 2(a) of the Lanham Act provides that the Patent and Trademark Office (“PTO”) may refuse to register a trademark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring

Mr. Brunetti has owned the clothing line “FUCT” since its foundation in 1990. Although, the application was originally filed by two individuals other than Mr. Brunetti in 2011, Mr. Brunetti acquired the application via assignment. The Examiner refused the registration due to its immoral/scandalous matter, and the Trademark

The Federal Circuit Court in its latest decision (In re Brunetti, No. 15-1109 (Fed.

Trial and Appeal Board affirmed the decision. Mr. Brunetti appealed claiming that the mark is not vulgar; therefore, it should be registered. Alternatively, Mr. Brunetti challenged the constitutionality of the Section 2(a) bar of the Lanham Act.

In the decision, the court stated that the TTAB correctly determined that "FUCT" is a vulgar expression, and vulgarity is enough for being

immoral. However, the court determined that the bar on scandalous and immoral marks in Section 2(a) of the Lanham Act is unconstitutional under the First Amendment. The court defined that the bar of immoral/scandalous matters is a content-based restriction; the trademark registration is not a government subsidy program, and not a public forum; moreover, there is no reasonable definition of the

statutory terms scandalous and immoral which would preserve their constitutionality.

Perfect timing and strategy. The SLANT decision was definitely a big help. Also, Mr. Brunetti would not have prevailed if he had not claimed unconstitutionality of Section 2(a) of the Lanham Act. And that is how this case become so influential in the world of trademarks.

Bye Bye 2017 ... a Year at a Glance!

As 2017 is quickly coming to an end, here are some highlights of another year in business. To all our clients, colleagues, and friends, thank you for your support always! Cheers and Best for 2018!

- ✓ Last May, during the INTA 149th Annual Meeting in Barcelona, Spain, Noli IP Solutions had a booth at the Exhibition Hall for the very first time. We had over 300 colleagues and friends from all over the world stop by to wish us Happy Third Anniversary in their native languages! What a wonderful experience we won't forget!
- ✓ Ms. Marai and Ms. Noli took a trip to Alicante to visit colleagues and friends and took a tour of the EUIPO (European Union Intellectual Property Offices). Thank you Mr. Izquierdo Perin for receiving us and for the guided tour!
- ✓ In June, part of our Noli IP Team was present in Budapest, Hungary, participating in the ECTA (European Communities Trademark Association) 36th Annual Meeting for the first time.
- ✓ Ms. Fischer became more involved in the activities of the Federal Bar Association, San Diego Chapter and attended a Brown Bag Luncheon hosted by one of our favorite judges in our community, Honorable Gallo.
- ✓ In November, Ms. Noli represented our Noli IP team during the ASIPI Annual Conference in Panama City, Panama and visiting many local clients in such jurisdiction, reinforcing alliances.

