

Noli IP Newsletter

NOLI IP Solutions, PC

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Special Edition

ASIPI in Panama City

By Mariana Paula Noli

Last Month, I represented our team at **Noli IP Solutions, PC** during last XX Jornadas de Trabajo y Consejo de Administración of ASIPI (Inter-American Association of Intellectual Property),

managers of law firms all over Latin America, but also in two working luncheons with legal marketing experts. They spoke to the committee members about the



which took place at the Hilton hotel from November 26-29, 2017 in Panama City.

As part of the ASIPI's Law Firm Management Committee (Comité de Administración de Despachos), I participated in not only our regular yearly meetings where we discussed many issues of interest to

importance of creating and maintaining a professional image as well as advising on how to use social media and the media in general for business generation and publicity purposes. It has been a pleasure to be able to continue to serve as part of ASIPI's Law Firm Management Committee

Lunch with the Judge

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Earlier this month, **Ms. Fischer** attended the Federal Bar Association, San Diego Chapter Brown Bag Luncheon with the Honorable William V. Gallo. During the meeting, Judge Gallo discussed useful practice pointers for civil and criminal cases before Magistrate Judges as well as his chamber rules and procedures.



Judge Gallo completed his LLM in intellectual property law at the University of San Diego with another one of our esteemed colleagues at Noli IP, Ms. Marai, a few years back.

for the 2016-2018 period. I am a big fan of always learning new ways of how to do things better. It is a big part of our culture at our firm, to provide top quality service to our clients. Many thanks to my fellow colleagues Mr. Martin Pittaluga (Pittaluga IP, Uruguay) and Mr. Carlos Valdez (Abril Abogados, Spain) for their leadership skills and for coordinating

these interesting workshops. During the ASIPI Meeting in Panama City, I also had the opportunity to join our esteemed colleague Ms. Raquel Arauz and ASIPI's Copyright Committee (Comité de Derechos de Autor) for a guided tour of the Copyright Office and Intellectual Property Office in Panama. It was quite fascinating to me to learn

from the Office's Director about the differences between the processes for registering creative works of authorships in the United States of America and in Panama.

For more information on the work of this organization, please visit www.asipi.org.

Tequila, the Champagne of Mezcal

By Judit Marai

Do you know the three most common types of alcoholic drinks I see in trademark applications? Beer, wine and tequila. Did you know that tequila never has a worm in it? That is mezcal. And did you know that you cannot use the term tequila for any type of fermented agave liquor anymore? Besides the fact that the Alcohol and Tobacco Tax and Trade Bureau has recognized Tequila as a distinctive product of Mexico since 1972, now the TTAB took its part in affirming this decision. In the future, it is not only the Alcohol and Tobacco Tax and Trade Bureau that rejects the possibility to use the word tequila for liquors that do not originate from certain part of Mexico, but the Trademark Office as well.

Luxco v. Consejo Regulador del Tequila AC, Opposition No. 91190827 (Trademark Trial and Appeal Board, Jan. 23, 2017) decision: It all started with the application of the Consejo Regulador del Tequila (Tequila Regulatory Council) in Mexico for registering "tequila" as a certification mark. A "certification mark" is any word, name, symbol, etc., used by a person other than its owner, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization. 15 U.S.C. §§ 1054, 1127. In our

case, "[t]he certification mark "Tequila", as used by persons authorized by the Consejo Regulador del Tequila, A.C. ("CRT" or "Certifier"), certifies that (1) the goods are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards; (2) the goods are manufactured in Mexico in compliance with Mexican law and standards including fermentation, distillation, aging, the percentage of blue agave sugars and physical- chemical specifications; and (3) the finished product is or contains within it the goods manufactured in accordance with (1) and (2) above."

Not surprisingly, right after the publication, one of the major distilled beverage

manufacturer and producer in the U.S. opposed claiming that the word tequila is generic, therefore it cannot be registered by one applicant and used solely by that company. (We should not forget that until a few months ago, tequila was in the list of the Trademark Acceptable Terms Of Goods And Services.) The legal battle lasted for 14 years, but at the end, the TTAB decided that "Tequila" does not refer to a generic type of liquor, but the one specific form of distilled spirits, that is made of blue agave in certain part of

Mexico: in the state of Jalisco, and in small parts of four other states. Tequila is the champagne of mezcal: it has to have the specific origin, and the specific manufacturing process.

After the TTAB decision, the USPTO immediately registered "Tequila" as a certification mark, and the Tequila Regulatory Council in Mexico suddenly became the guardian of the quality of tequila is the Consejo Regulador del Tequila in the U.S. as well. Without the certification from this

Mexican official body, no hard liquor can be called and registered as tequila. This is a big change for every member of the hard liquor business, so it is worth keeping it in consideration for the next (or the first) business plan. We offer our services in brand and portfolio building, as well as trademark prosecution and protection. If you would like a copy of this decision or have any questions, please do not hesitate to contact us at mail@noli-ipsolutions.com.

IALA California Supreme Court Night

Last Wednesday, the **Italian-American Lawyers Association (IALA)** hosted its yearly California Supreme Court Night at Casa Italiana in downtown Los Angeles. It was quite amazing to hear the speech from the 28th Chief Justice of the California Supreme Court, Ms. Tani Gorre Cantil-Sakauye, and quite an honor to be present in an event that gathered some of the most prestigious legal minds in our community.

