

Noli IP Newsletter

NOLI IP Solutions, PC

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January 2020 Edition

Hello to the New Year 2020!

By Mariana Paula Noli, Esq.

"If you can't fly, then run. If you can't run then walk. If you can't walk, then crawl, but by all means, keep moving." Yesterday I was looking for quotes to honor Martin Luther King Jr. on MLK day and I found this one, always keep moving forward!

quite literally! I not only completed a half marathon (13.1 miles) in Long Beach for the new year and a marathon (26.2 miles) in Carlsbad, but also earlier this month, I flew to Oakland, California to



Sergio, Karim, Mariana, Diane and Sam at our Holiday Party 2019

Yes, we always keep moving forward despite the many challenges.

Personally, I started the new year running, and flying,

attend the Executive Committee of the California Lawyers Association Intellectual Property Section.

Happy 2020!

By Erica V. Durant

I hope that the New Year is off to a great start and that you all enjoyed some time with family and friends.

The staff at Noli IP is super excited to begin this new year with you all. We know that we are already off to a very busy start. 2019 came and went fulfilling many of our goals as well as overcoming many challenges. We keep on going... I can only say that we have come a long way and we are always looking forward to becoming a better partner and advisor to our clients. Always learning, growing, getting better at what we do, professionally and personally.



Ms. Erica V. Durant

We are ready for what this new year has in store for Noli IP Solutions, PC. So here we go again!



Ms. Noli with her colleague crossing the finish line of the 2020 Carlsbad marathon

The year has barely started and I have many reasons to be thankful. I am so honored to have been selected to be part of the 2020 DC Delegation of the California Lawyers Association Intellectual Property Law Section. It has been a dream of mine to have the opportunity to visit the capital city and meet with the United States Patent and Trademark Office (USPTO), the US Copyright Office and the representatives and legislators making the laws and rules, making a difference in our daily work. How exciting is this!

Another fantastic recognition I learned about this month was that my peers voted for me to become IALA President for next year 2021. This organization has been a big part of my professional career, has seen me as a brand-new licensed attorney back in 2006-2007 when I was first sworn in as a California licensed attorney, and now I am honored to get an opportunity to become its President. On January 25, 2020, I will be swearing in as President elect for the IALA

Italian-American Lawyers Association along with my colleague Theresa Macellaro (2020 President), Anthony Costanzo, Angela Zanin, Onik Ovanesian, David Plumley and all the other members of the Board of Governors. I am so fortunate to be of service to this organization and I have no doubt this year will be a memorable one!



Ms. Mariana Noli, IALA President elect

Needless to say, I understand as the saying goes that “with great power, comes great responsibility.” I know that this year will be a challenging one that will require growth and effort on my part, but I am ready and excited for what is coming our way.

Diane, Karim, Sergio and I are planning to attend the MD&D West conference in Anaheim (<https://mdmwest.mddionline.com>) and the Strategies in Light conference (<https://www.strategiesinlight.com/>) here in San Diego this

year, as we have done for the past two years.



Our group at the local events

Diane’s daughter Sam continues to assist us with the digital marketing of the firm and taking on more tasks in our communication and marketing department, as we plan to launch a new website and a new format for our monthly newsletter.

My sister Lucy and I will be touring and visiting clients in South America (Argentina, Uruguay, Chile, and possibly Paraguay) late February, early March. She continues to be the main point of contact for our regional filings.

As we do every year 2014, Noli IP will be represented at the Inter-American Association of Intellectual Property (ASIPI). I will be attending the upcoming meeting in Montevideo and as part of the Law Firm Management Committee of ASIPI, I am working together with my esteemed colleague and friend Elyssa LeFevre on a project for gender equality and equity in our profession. This is a topic I have been

extremely passionate about all my life.



Our group at the INTA in Singapore

Sergio and I will also be flying to Singapore for the INTA

International Trademark Association Annual Meeting.

And there are many more exciting plans ahead for us! I am confident when I say that our group will keep on moving forward, whether it is flying, running, walking, or crawling to reach that finish line! We all as a group and individually have faced many

challenges these past years since we started working together, but we remain committed to our promise to you.

“Crafting sophisticated and innovative solutions for our Clients’ business and legal problems.” I hope you know that you can count on us! Happy New Year!

“Google”: A Failed Genericide Story

By Mariana Paula Noli, Esq.

As you may recall from our prior article on our December 2019 newsletter, once a mark is declared to be a generic name, the designation enters the “linguistic commons” and is free for all to use. It loses all of its trademark power.

The Lanham Act provides that if a registered mark becomes the generic name for the goods or services for which it is registered, a challenger can file a petition in court to have that registration cancelled. Thus, in practical terms, there is a very delicate balance between attempting to promote a brand while not stepping on the Lanham Act’s toes, to avoid triggering a genericness claim.

The somewhat recent ninth circuit’s decision in re. “Elliott vs. Google, Inc.” 860 F.3d 1151 (9th Cir. 2017), cert. denied, 1385 Ct. 362 (2017) upheld a summary judgment finding that Google’s trademark is not generic. By doing so, the court in Elliott lessened the fear of possible loss of the trademark power by finding that indiscriminate use of a mark alone does not support genericide.

As a brief background, Chris Gillespie had registered 763 domain names, which included the word “google” so Google filed a complaint with the National Arbitration Forum arguing that these registrations constituted trademark infringement.

David Elliott, joined by Gillespie, requested to cancel Google’s trademarks claiming that Google’s mark “google” had become the generic term for searching in the internet.

Google claimed that verb use did not automatically trigger genericide and that plaintiffs had failed to bring any triable issue of fact. The district court granted summary judgment in favor of Google relying on a Teflon-type survey that showed 94% of participants identified “google” with a brand, not a “common name.” Such survey evidence is only not required if there is overwhelming evidence outside the surveys to

prove genericness. The courts have approved two main models: (1) the Thermos survey and (2) the Teflon survey. The *Thermos survey* is the less used, it asks respondents how they would ask for the product at issue. The *Teflon survey*, used in this case, consists of three steps: (1) a survey maker explains the basic definitions of terms like “common generic name” and “brand name.” (2) a survey maker conducts a test and everyone who fails is eliminated, (3) the survey maker will ask the participants to classify terms as brands or common names.

In a world where the brand is now the product, consumers have developed such loyalty to companies and brands. Survey evidence help the court reveal what consumers think about different products, marks, and companies.

The ninth Circuit affirmed the district court’s decision. With the Court ruling at the summary judgment stage, the Elliott decision essentially turns on the holding that verb use does not automatically constitute genericness. Verb usage of the term “google,” according to the Ninth Circuit, did not even bring up the question of material

fact. ELLIOTT MADE CLEAR THAT VERBIFICATION OF A BRAND IS ACCEPTABLE WITHIN THE FRAMEWORK OF THE GENERICIDE DOCTRINE.

While the court in Elliott attempted to follow precedent, they failed to discuss the contextual differences between a brand like Google and other companies that are focused on a product rather than a brand.

Google is a failed story of Genericide, what will happen with the genericide doctrine in general still remains to be seen.



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ASIFI SEMINAR



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ASIFI Member since 2012
Committee Member since 2015

We are very pleased to announce that **Ms. Mariana Noli, Esq.** will be representing **Noli IP Solutions, PC** at the 2020 Inter-American Association of Intellectual Property ASIFI Meeting in Montevideo, Uruguay, this upcoming March 8th-10th.