

Geographical Scope of Protection of FWKM Latin America & the Caribbean

By

**The Famous and Well-Known Marks Latin America &
Caribbean Subcommittee**

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1. Introduction

The Latin America & Caribbean Subcommittee of the Famous & Well Known Trademark Committee undertook a survey of 11 countries to identify in which of these jurisdictions, if any, a trademark owner may have its mark recognized as “famous” or “well-known” even though the mark has never been registered or used in the country.

The survey covered Argentina, Brazil, Chile, Colombia, the Dominican Republic, Ecuador, Guatemala, Mexico, Paraguay, Peru, and Venezuela.

The nomenclature and definition of “famous” and “well-known” marks (“FWKM”) varies from jurisdiction to jurisdiction, although all covered countries do recognized some type of protection for marks with reputation. This survey identifies the exact terminology used in each country in Spanish or Portuguese, as well as the English translations of those terms.

A quick-reference chart at the end of the survey summarizes the situation of FWKM neither registered nor used in these 11 countries.

2. Country Comparison

ARGENTINA

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The aim of this report is to provide insight on the scope of protection of Famous and Well-Known Marks—together referred to as FWKM—in Argentina, particularly focusing on the geographical scope of protection, and on their protection when they have not been previously used or registered in our country.

For the purpose of this study, we will consider “Famous Marks” (hereinafter, “FM”) those that achieve a high degree of recognition even among people who are not consumers of the kind of goods or services identified by the mark. On the other hand, we will refer to “Well-Known Marks” (hereinafter, “WKM”) as those that achieve a high degree of recognition, but only among consumers of the type of goods or services on which the mark is used.

1. Protection of FWKM under Argentine Law

Protection of trademarks in Argentina is governed by Trademark Law No. 22.362—hereinafter “TM Law”—, the Paris Convention for the Protection of Industrial Property (incorporated to Argentine legislation by Law No. 17.011)—hereinafter the “Paris Convention”—, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (incorporated to our national legislation by Law No. 24.425)—hereinafter the “TRIPS Agreement”.

Although the TM Law does not include any provision or definition regarding FWKM, article 6 *bis* of the Paris Convention establishes that member States agree to refuse or cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, translation or an imitation liable to create confusion, of a mark that is considered to be well-known in that country and used for identical or similar goods.

Consistently, TRIPS Agreement protects FWKM by extending the Paris Convention’s scope of protection. Article 16.2 of TRIPS Agreement states that Article 6 *bis* of the Paris Convention shall apply, *mutatis mutandis*, not only to products, but also to services. This article also provides a useful standard to determine the notoriousness of a trademark: one should consider the knowledge of the trademark in the relevant sector of the public, including knowledge in the country obtained as a result of the promotion and advertising of the trademark.

The above-mentioned rule would therefore imply that a mark would be considered notorious if the relevant sector of the public recognizes it. This criterion is also set forth in the Protocol of Harmonization of

Rules Regarding Intellectual Property in Mercosur in the Field of Trademarks, Indications of Source & Appellations of Origin—hereinafter the “Mercosur Protocol”—, which is not operative in Argentina but has been used by certain judges as a guideline (See: “*Louis Vuitton S.A. v. Akerman, Rubén / Nulidad modelos y diseños. Daños y perjuicios*”, *Court of Appeals in Civil and Commercial Matters*¹, Section III, 16/11/2004) as its article 9.5 establishes that “[i]n order to determine the notoriety of the trademark in the sense of the provision mentioned here, the knowledge of the sign shall be taken into account, including said knowledge in the pertinent State in which protection is requested, said knowledge having been acquired from the publicity of the sign”.²

The above-mentioned provisions demonstrate that WKM are closely related to the knowledge and recognition that the relevant sector of the public has of the registered sign, for which promotion and advertising are of vital importance.

The standard of protection set forth in Article 6 *bis* of the Paris Convention is also broadened by Article 16.3 of the TRIPS Agreement “[...] to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use”.³

In the same direction, article 9.6 of the Mercosur Protocol determines that its member States shall assure the protection in their territories of trademarks that have become exceptionally well known and belong to nationals of the member States against their duplication or imitation in any line of activity, provided that there is a possibility of damage towards the trademark or its owner. This guarantees protection for trademarks not only in the class in which they are registered, but also in other classes. However, this protection would apply only to “exceptionally well known” trademarks, to which we refer as FM.

Although useful as guidance, neither the International Treaties ratified by Argentina nor the local regulations mentioned before establish a complete, objective standard for authorities to conclude whether a trademark is notorious or not.

In accordance with the Joint Recommendation concerning provisions on the Protection of Well-Known Marks (which is not operative in Argentina but could be used as a guideline for the interpretation of the Paris Convention)—hereinafter, the “Joint Recommendation”—adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) in 1999, the following factors could be used as guidelines by the competent authorities when deciding on the notoriousness of a trademark:

¹ Hereinafter, “CACCM”.

² *Protocol of Harmonization of Rules Regarding Intellectual Property in Mercosur in the Field of Trademarks, Indications of Source & Appellations of Origin*, available at <http://ipiba.org/1403-2/> (on July 29th 2014).

³ *TRIPS Agreement*, available at http://www.wto.org/english/tratop_e/trips_e/t_agm3_e.htm#2 (on July 29th, 2014).

- a) the degree of knowledge or recognition of the mark in the relevant sector of the public⁴;
- b) the duration, extent and geographical area of any use of the mark;
- c) the duration, extent and geographical area of any promotion of the mark;
- d) the duration and geographical area of any registrations, and/or any applications for registration, of the mark;
- e) the record of successful enforcement of rights in the mark;
- f) the value associated with the mark.

However, the Joint Recommendation states that the above mentioned items are not to be considered as requirement that trademarks need to fulfil in order to gain the status of notoriousness. Moreover, it states that the concurrence of all of the above-mentioned circumstances is not necessary for a trademark to be considered notorious. As a matter of fact, the Joint Recommendation concludes that, in order to decide on the notoriousness of a trademark, it is necessary to weigh, on a case-by-case basis, the particular circumstances of each trademark in each venue.

In the absence of uniform criteria to objectively determine the notoriousness of a trademark, Argentinian judges have developed more or less precise guidelines through case law, as will be analyzed in the following section.

2. How Case Law addresses the protection of FWKM

Over the last two decades, Argentinian Courts have tackled different issues regarding the regime applicable to notorious trademarks, deciding on issues such as different degrees of notoriousness (“well-know” vs. “renowned” trademarks) and the requisites for protection (the necessity of registration or use in Argentina). We will analyze them in the following chapters.

2.1 Indirectly addressing notoriousness: the “miraculous coincidence” doctrine

In 1961, five years before Argentina adopted the Paris Convention, *Fromageries Bel Societe Anonyme*, owner of the broadly renowned cheese trademark “*La vache qui rit*”

⁴*Joint Recommendation concerning provisions on the Protection of Well-Known Marks*, Article 2(2):

- (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:
 - (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
 - (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
 - (iii) business circles dealing with the type of goods and/or services to which the mark applies.
- (b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.
- (c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.
- (d) A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(in English: “the laughing cow”), found that an unrelated third party had successfully registered in Argentina the trademark “*La vaca que ríe*” [Spanish for “*La vache qui rit*”], alongside with their classic laughing cow design. The company immediately sought the nullity of such registration. In February 1961, in the case “*Fromageries Bel Societe Anonyme v. Ivaldi, Enrique / Nulidad de registro de marca*”, the Federal Court of Appeals in Administrative Matters held that, regardless of what the TM Law could say, “[...] plagiarism could not be more evident. The defendant might argue that he came up with the wording ‘La Vaca que Ríe’, but it would be an almost miraculous coincidence that he also came up with the identical laughing cow design, the exact word placement and the same mountain background”.

This decision was confirmed by the Supreme Court in 1962: “[I]t must be admitted that the servile reproduction of a foreign trademark, in order to obtain benefits from the products identified by it, is unlawful” (“*Fromageries Bel Societe Anonyme v. Ivaldi, Enrique / Nulidad registro de marca*”, Supreme Court, 23/06/1962).

This ruling has been considered a leading case, and the “miraculous coincidence” doctrine, which in fact protected FWKM against bad-faith plagiarists, has been applied ever since by Argentine courts⁵.

2.2 Difference between FM and WKM

Later on, as part of an understandable “evolutionary process”, judges only referred to “notorious trademarks”, without distinguishing between FM and WKM. It could be argued, however, that when alluding to “notorious trademarks”, judges referred to what we call “famous marks” rather than to “well-known marks”. By way of illustration, we could refer to the following quotes, which are ordered chronologically:

- 1990: “Notoriety is a higher standard that few trademarks reach. For it to exist, the trademark must be well-known amongst the majority of the general public, whether consumer or not.” (“*Marriott Corporation v. Rila S. A.*”, CACCM, Section III, 27/04/1990, LL 1991-B-16);
- 1991: “When a mark is notorious, it allows its owner to successfully oppose to registration of similar trademarks, even for products different to the ones it covers.”

⁵ See also: “*Rivarola, Gonzalo Braulio v. United Feature Syndicate Inc. / Oposición Indevida reg. marca Snoppy*”, CACCM, Section II, 17/03/1989; “*Puma A.G. Rudolf Dassler Sport and other v. Cueros del Norte S.R.L. / Cese de uso de marca*”, CACCM, Section II, 12/10/00; “*Federal Express Corp. v. International Express S.A. / Ordinario*”, CACCM, Section A, 18/06/09; “*Portillo, Alfredo v. Cencosud S.A. y otro / Cese de uso marcas. Daños y perjuicios*”, CACCM, Section III, 06/07/2010; “*Ferrari Idea S.A v. Mussini, Luis Eduardo y otro / Cese de oposición al registro de marca, CACCM, Section III 11/10/2011*”; “*Oakley Inc. v. Planet Optical S.R.L. y otro / Cese de uso de marcas. Daño y perjuicios*”, CACCM, Section III, 06/11/2012; “*Spirits International NV v. Casa Dellepiane S.A. / Cese de oposición al registro de marca*”, CACCM, Section II, 18/03/2014.

(“*Compagnie Générale D’Electricité S.A. v. Confederación Gral. Económica*”, CACCM, Section II, 13/09/1991);

- 1992: “When the trademark upon which the opposition is based is ‘notorious’, the criterion when analyzing whether both trademarks are similar must be strict, in order to protect the special prestige of the notorious one.” (“*Marante, Carlos A. v. Sporloisir S.A.*”, CACCM, Section III, 26/08/1992, LL 1993-A-332);
- 2002: “[T]he owner of a notorious trademark has a legitimate interest in avoiding that its mark be used for different products, as that would mean the dilution of the trademark; of its distinctive power, which is its most valuable feature [...]” (“*Stanton & Cía. S.A. v. Instituto Nacional de la Propiedad Industrial*”, CACCM, Section III, 21/3/02).

By 2002, however, we can see that a finer distinction started to be made. Several cases began to address the issue of the different degrees of notoriousness that a trademark can achieve, distinguishing them between “famous” (or “renowned”) and “notorious” (“well-known”), and limiting the protection of notorious (or well-known) marks to the boundaries of the type of goods or services on which the mark is known. This, arguably, emerged not so much from the need of protecting owners of trademarks that were not so broadly famous, but from the need of protecting consumers of certain goods or services, which could be misled by unscrupulous third parties⁶.

Therefore, by 2002 we could read that “[...] in the [case of ‘notorious trademarks’], trademark dilution may occur in the universe of a certain type of buyer, but not in another [...]. In this case, protection—which should always be considered exceptional, and therefore of restricted application in notorious trademarks—must occur in the market segment where dilution may occur. On the contrary, in the case of a renowned brand (i.e., still known in those sectors where the product is unlikely to be purchased—Rolex, Ferrari—) dilution may also occur in places where there is no commercial competition.” (“*MD Distribuciones S.A. v. Quick Foods S.A. / Cese de oposición al registro de marca*”, CACCM, Section II, 17/08/2002). By 2006, further to that reasoning, it was stated that “[n]otorious [well-known] trademarks and renowned [famous] Trademarks are different, while the first one is known by consumers of the product or service in question, the famous or renowned trademark is recognized by everyone, whether they are consumers or users of the product or not. The famous trademark, also called renowned, is legally protected beyond the principle of specialty, while the notorious trademark is only protected in its own

⁶ “[W]hile in the case of the notorious mark, the purpose is the protection of the consumer, in the first case [Famous Trademarks] protection is given to the trademark owner, preventing the loss of the trademark’s distinctiveness, sale power and ‘uniqueness’.” “*Grupo Anderson’s S.A. de CV v. Ricco, Leonardo J.*”, CACCM, Section III, 02/03/2006.

field.” (*Grupo Anderson’s S.A. de CV v. Ricco, Leonardo J.*, CACCM, Section III, 02/03/2006).

By way of summary, we can say that while WKM override the principle of priority (under which the first person to file a trademark application shall be its rightful owner), they do not affect the principle of specialty (according to which a mark only protects or distinguishes the goods or services for which it has been registered). FM, on the other hand, override both principles, being enforceable even against unrelated goods and services⁷.

2.3 Protection of unregistered FWKM

In Argentina, ownership of a trademark is acquired through registration, as established by Article 4 of the TM Law. Therefore, in case a conflict between a registered FWKM and a confusingly similar mark arose, the case is not likely to be solved on the basis of notoriousness, but rather by simply alleging the pre-existent registration of the FWKM.

However, the conflicts reaching the Courts are generally more complex. Sometimes, in the context of counterfeiting cases, owners of unregistered FWKM may find that identical or confusingly similar registrations have been granted to counterfeiters by the Trademark Office. In other occasions, rightful owners of FWKM may find difficulty in registering their brands in Argentina due to oppositions filed by third parties who have been granted identical or similar trademarks. It is undeniable that refusing to protect owners of FWKM in cases such as those, just because the FWKM was not registered, could mean legitimating the bad faith of third parties.

Precisely under an analogous reasoning, in *re “De Rigo SpA v. Rodríguez, Jorge / Nulidad de marca”* (CACCM, Section III, 6/11/97), it was established that “[requirement of registration] cannot be applied with an excessively rigorous criterion that deprives owners of unregistered trademarks from the protection which arises from the general principles of Law against unfair practices, or from the protection of the right to a clientele acquired by the practice of a lawful activity.” This case relied upon the fact that “[...] many decisions have ruled for trademarks used in commerce, against others registered afterwards, basing their decisions in article 953 of the Civil Code—which nullifies any immoral juridical acts—. Besides, the trademark law indirectly protects unregistered trademarks in use, by entitling any party with a rightful interest to oppose to the registration of a trademark”.

⁷ See also: *“Iberia Líneas Aéreas de España S.A. v. Arte Gráfico Editorial Argentino S.A.”*, CACCM, Section I, 23/03/2006; *“Herrera, Paloma v. Carolina Herrera S.A. y Otro / Cese de oposición al registro de marca”*, CACCM, Section III, 12/09/2003.

Although the “ethical reasons” of Article 953 were also invoked in other cases (see., e.g.: “*Editorial La Página S.A. v. Elizalde Leal, Alberto Clodomiro / Nulidad de marca*”⁸, CACCM, Section I, 5/5/1998; “*Harrods Limited v. Harrod’s Buenos Aires Limited / Cese de oposición al registro de marca*”⁹, CACCM, Section I, 12/03/2000), not long before, in 1996, it had been considered that heavy investment in advertising, sales volume, and knowledge and prestige abroad and in our country were material reasons for providing protection to unregistered FWKM. This position focuses more clearly on preventing that a third party obtain a benefit from the economic efforts of the trademark’s rightful owner (see: “*Lotto Spa v. Carlos Cimmino e Hijos y otros / Nulidad de marca*”, CACCM, Section III, 27/08/1996). These “economic reasons” were also invoked in “*The Southland Corporation c/ Bianchetti, Emilio René y otro / Nulidad de marca*” (CACCM, Section III, 16/7/98), in which it was considered that “[...] the appellant’s trademark has been registered in more than forty countries and that its volume of business is truly remarkable [...]”. In this case, however, bad faith of the local trademark owners was weighed on the decision, as it was highlighted that they had “conducted numerous market researches and held meetings with equally skilled third parties” before starting their business project.¹⁰

More modern cases, such as “*Federal Express Corp. v. International Express S.A. / Ordinario*”, (National Court of Appeals in Commercial Matters, Section A, 18/06/09), tend to focus on consumer protection and the avoidance of trademark piracy as central reasons for protecting unregistered FWKM. Bad faith also seems to be of paramount importance, mostly in view of Article 24, paragraph ‘b’, of the TM Law, which establishes the nullity of trademarks “[...] registered by anyone who, at the time of applying for registration, knew or should have known that the marks belonged to a third party [...]”. It is worth noticing that, although nullity actions in general prescribe 10 years after registration of the trademark, the prescription term does not apply in cases in which bad faith of the trademark owner can be proved.

2.4 Protection of FWKM unused in Argentina

Reasons for granting protection to FWKM that were not *used* in the territory—different from what happens in the case of absence of *registration*—are not so clearly stated in case law. The motives are in fact obscure, and are mostly diluted among secondary considerations. Cases in which locally unused FWKM have been protected are: “*Ferrari Idea S.A. v. Mussini, Luis Eduardo y otro / Cese de oposición al registro de marca*”

⁸ “[A]lthough trademark law adopts the attributive system, which provides protection for registered signs, it also does recognize certain protection to trademarks which are used without being registered, based on basic principles of our legal system, as Article 953 of the Civil Code.”

⁹ “[C]omplaints requesting trademark invalidity of registered trademarks—which consist of a copy or imitation of a foreign trademark—are not contrary to the territoriality principle, as the general interest of protection against conducts which transgress ‘the ethical rules of loyalty and good faith’ should prevail.”

¹⁰ Nevertheless, if a third party, in good faith, obtained registration of a FWKM, the owner of the FWKM abroad would still be entitled to request its cancellation.

(CACCM, Section III, 11/10/2011), “*Harrods Limited v. Taratuty, Enrique Natalio / Cese de Oposición al Registro de Marca*” (CACCM, Section I, 11/10/2007) and the aforementioned “*Federal Express Corp. v. International Express S.A*” and “*Lotto Spa v. Carlos Cimmino e Hijos y otros*”. The “*Lotto*” case in particular is frankly meagre in arguments, and just states that “[...] the use or not of the trademark in the country does not affect the fate of this trial because it is a known trademark in the international sphere”.

This scarcity of arguments is likely due to the fact that there is no local legislation expressly addressing the requirement of use. However, and although this position is not unanimous in Argentina, it could be argued that use in the country does not, or at least should not, appear as a requirement for a FWKM to be protected. Apart from the already quoted case law, this could be supported by three legal instruments: the TM Law, the TRIPS Agreement and, finally, the Paris Convention’s Revision Conference of Lisbon of 1958.

By thoroughly analyzing the Argentinian TM Law, we can find a wide spectrum of provisions that avoid mentioning the requirement of use. For example, use is not required as a requirement for trademark registration—which is, in turn, in accordance with Article 15.3 of the TRIPS Agreement.¹¹

Accordingly, Article 2.3 of the Joint Recommendation, establishes: “a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark: (i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State”.

In the same direction, during the Paris Convention’s Revision Conference of Lisbon in 1958—hereinafter, the Lisbon Conference—it was proposed that the Convention should include a statement expressly determining that use was not a requisite to grant protection to WKM. Although this proposal was finally not accepted, it did show the need to extend the protection of WKM, notwithstanding their use within a certain territory.

¹¹ It deserves to be noticed, however, that in order to be able to renew a trademark registration, its holder must declare that the trademark has been used within a period of five years prior to its renewal, according to Articles 5 and 20 of the TM Law. Nevertheless, these articles do not specify whether the trademark must have been used in Argentina or abroad. As the TM Law does not specifically require use in the Argentine territory, use of the trademark abroad would be sufficient for its renewal, as long as it occurs at some point during the referenced five-year period. The legal basis for this reasoning relies on Article 19 of the Argentine Constitution, which establishes that “[...] no inhabitant of the Nation shall be obliged to perform what the law does not demand, or deprived of what it does not prohibit”.

By way of contrast, when the TM Law in its Article 26 sets forth the requirements to request the cancellation of a trademark registration, it expressly demands its lack of use *in the country*. Therefore, if legislators had had the intention of including the requirement of use within Argentina in Articles 5 and 20, they would have included it expressly, as they did in Article 26.

In summary, although the arguments are not clear from case law, the aforementioned legal provisions could certainly provide a reasonable basis to provide for the protection of FWKM that were not used in Argentina.

3. How Internet has helped in protecting FWKM

In recent years, increasing access to Internet has affected the way FWKM are conceived. In a globalized world, FWKM are not bound to national borders, as their promotion and, therefore, recognition, travel faster than the products or services that they identify.

As stated in “*Companhia Leco De Produtos Alimenticios v. Kasdorf S.A. / Cese de oposición al registro de marca*” (CACCM, Section I, 23/11/2004) and “*E.I. Du Pont De Nemours & Company v. Topola S.A. / Cese de oposición al registro de marca*” (CACCM, 23/11/2004), “[t]he concept of well-known trademark is boiling, as expected with the expansion of markets in a globalized world [...]”.

Both prospective consumers and the general public may notice the existence of certain trademarks before they are used in their country, or even if they are not used at all. More and more trademarks are becoming FM or, at least, WKM, thanks to immediate and global reach of the Internet, and this is explained by the cheap and fast advertising and promotion that Internet provides to trademark owners. The phenomenon of Facebook and other social media (such as Twitter, Pinterest or Instagram, among others), has given companies a space to share their products, sometimes without incurring in any major costs. The viralization of contents through websites rockets the notoriousness of trademarks, as consumers can obtain information about products and services by just accessing their preferred social media website.

The rapid spread of information through the Internet has had an impact on economic life. By allowing individuals to access data that was previously unreachable, Internet has provided valuable new tools for identifying and pursuing economic opportunities. For some, unfortunately, unfairly taking advantage of a FWKM already registered abroad is one of these “opportunities”.

Using a trademark does not only imply marking a product, but also comprehends the advertising of the trademark for commercial purposes by any means, as stated by the Argentinian Supreme Court in “*Productos CIBA v. Instituto Biológico Argentino*” (2/10/1940). Internet advertising raised the issue of determining which law and jurisdiction are applicable to trademark infringement cases, as it is hard to track down where the infringement is occurring.

All in all, the Internet phenomenon actually serves as a way of reinforcing the position that, when in presence of a FWKM, protection should be granted even when it is not being used or registered in Argentina. It is undeniable that some trademarks are vastly known worldwide, whether they are locally used or not. Blindly enforcing requirements of local registration or use for the protection of a FWKM would imply denying the new reality that trademarks (and their owners) are facing.

4. Factors to be considered to enjoy FWKM protection

As stated throughout this report, protection of FWKM in Argentina depends on a variety of different factors that are not set out clearly. Trademark notoriousness is a matter of fact, “[...] as judges decide on a case by case basis according to their appreciation of the facts [...]” (“*E.I. Du Pont v. Topola*” and “*Companhia Leco v. Kasdorf*”, among others).

Currently, in order to enjoy FWKM protection, the trademark must be known by the majority of the population (in the case of FM) or, at least, by consumers and/or potential consumers of the product to which the mark is applied (in order to be deemed as a WKM), for which promotion and advertising are of vital importance. For instance, in “*Budweiser Budvar National Corporation v. Anheuser Busch Incorporated / Cese de oposición al registro de marca*” (CACCM, Section II, 06/06/2011), judges stated that “[t]he notorious trademark can only qualify as such if it is known by a substantial group of the public, for which I mean, of the whole population”. Similar arguments were used in “*Di Gio S.R.L. v. Ga Modefine S.A. / Cese de oposición al registro de marca*” (CACCM, Section III, 30/09/2008) and in “*Aca Salud Cooperativa de Prestaciones de Servicios Médicos Asistenciales Ltda. v. Arte Gráfico Editorial Argentino S.A. / Cese de oposición al registro de marca*” (CACCM, Section II, 15/08/2008).

Alongside the knowledge of a trademark, one should take into consideration other key factors, such as trademark history, its extended use, and the magnitude of its owner’s advertising efforts. For instance, in “*Club Ken S.R.L. v. Levi Straus & Co. / Cese de oposición al registro de marca*” (CACCM, Section II, 21/11/2000), judges stated that the assessment of the notoriousness of a “[...] clearly distinguishable trademark [...] deserves an extended protection given its ‘undeniable diffusion’, history and ample exploitation”. This criterion was also followed in “*Budweiser v. Anheuser*”.

Trademark notoriousness should be something evident and, therefore, it would not need to be proved, as stated in “*Sáenz Briones y Cía. S.A. v. Agronorte S.A. / Nulidad de marca*” (CACCM, Section II, 22/05/2009). However, as judges are often conditioned by their personal knowledge of the mark, owners of FWKM generally do produce evidence in order to demonstrate the trademark’s notoriousness—something that, in practice, is neither costly nor difficult. While owners of FM would need to prove that the majority of the population of Argentina could recognize the trademark, for owners of WKM it would suffice

to prove that the mark is known within the relevant sector of the public. In case of WKM— and thanks to the widespread use of Internet— if the trademark is recognized as such in a relevant foreign market, it would be reasonable to infer that its fame extended among potential consumers in Argentina.

Judges have also argued that “[...] notorious trademarks—prima facie—enjoy a stronger protection, in order to restrain any potential unlawful use of other’s prestige, and for protecting the interests of consumers. This singular protection is reflected in the application of a stricter comparison criterion.” (*CACCM, Section III, 28/12/2006, “Bayer Ag v. Arte Grafico Editorial Argentino S.A. / Cese de oposición al registro de marca”*). Said statements were shared by judges in *“Ferrum S.A. de Cerámica y Metalúrgica v. Honda Giken Kogyo Kabushiki Kaisha / Cese de oposición al registro de marca”* (*CACCM, Section III, 15/11/2005*) and in *“Budweiser v. Anheuser”*.

5. Conclusion

As stated throughout this report, although protection of FWKM in Argentina is governed by the Paris Convention and the TRIPS Agreement, their treatment has primarily been defined through case law, which has set out more detailed standards.

It can be said that judges have come a long way from the “miraculous coincidence” doctrine. However, even if some of them clearly establish a difference between FM and WKM (the former, renowned worldwide, being able to override both the principle of specialty and the principle of priority; the latter, extending only to the goods and services it identifies), this diversity is not shared, described and applied by all judges.

Regarding the need for registration, judges have granted protection to FWKM even when they are not registered in our country. These decisions are based on general principles of law and commercial and civil regulations, despite the fact that Argentinian Law has traditionally adopted a criterion by which ownership of a trademark is acquired through registration.

However, the requirement of use in Argentina is still a matter of debate, given the sparing arguments of the few decisions we can count with. It is worth considering, nevertheless, that requesting use and/or registration of a FWKM in the country could imply benefitting a third party whose only intention is to profit from the trademark owner’s efforts and the FWKM’s reputation, leading consumers to establish a relationship between a falsely used trademark and its rightful owner—a relationship that does not really exist.

The massive use of Internet has blurred territorial boundaries and has generated the need of a uniform criterion with regard to what is to be considered “use” of a trademark. In our opinion, a trademark should be deemed “used” either if the products or services it

identifies are available for the consumer *in Argentina* through a foreign website. It appears undeniable that some point of connection with Argentina still needs to be required.

In light of the above, the need for clear rules becomes of great importance. Given their differential status, it is undeniable that FWKM deserve an extended protection.

BRAZIL

The Brazilian Industrial Property Law (“IP Law”) recognizes two types of marks with reputation, the “marca de alto renome”, or “highly reputed” mark, and the “marca notoriamente conhecida”, or “well-known” mark. As discussed more thoroughly below, a highly reputed mark must be registered in Brazil and must be found by the Brazilian National Institute of Industrial Property (“INPI”) to be “highly reputed” through a special administrative procedure. Highly reputed trademarks are, on one hand, protected in all classes. A well-known mark, on the other hand, does not have to be registered in Brazil, and only needs to be “well-known in its field of activity” under the terms of Article 6 *bis* (I) of the Paris Convention in order to be entitled to “special protection” in the country. Notwithstanding, it is worth noting that the IP Law requires the owner of a well-known mark to apply to register its mark in Brazil, so as to properly enforce its rights, since otherwise, the INPI will dismiss oppositions or nullity requests arguing that the mark is “well-known”.

A. “Highly reputed” marks

(Ana Lúcia de Sousa Borda - Dannemann Siemsen Bigler & Ipanema-Moreira, Rio de Janeiro)

Introduction

Different from the well-known marks, which enjoy protection in Brazil even if they are not registered in our country, the first requirement to be fulfilled by a mark to be possibly declared as highly reputed is the compliance with the principle of territoriality (“*princípio da territorialidade*”). This means that only those marks which have been registered by the Brazilian Trademark Office (INPI) may be subject to highly reputed status. It is important to add that the so-called “principle of territoriality” has always been adopted as far as famous/highly reputed marks are concerned.

For the sake of clarification it is worth noting that in this study the designations “highly reputed” or “famous marks” will be used the same way, i.e., having the same meaning, thus referring to the same subject.

Famous marks are those which have reached such a degree of recognition and awareness in the market that their use even in another business area may be detrimental, especially

to their distinctiveness. Their mere presence in the market, regardless the nature of the business, is sufficient to attract a higher degree of attention and awareness among consumers, as well as among the public in general. In a nutshell, famous marks enjoy such a high level of recognition that their use even in a completely unrelated business may entail an undeserved and unlawful benefit to the infringer and, in parallel, be harmful not only to the rights and interests of their legitimate owners, but also to the distinctive character and singleness of the marks. It is indeed quite hard to conceive that famous marks like McDonalds or Mercedes-Benz, for example, could be used in other businesses without entailing confusion or at least wrongful association, not to mention their dilution. This is the reason behind the special protection afforded to famous marks.

A famous mark, when recognized as such by the INPI, enjoys the abovementioned special and enlarged protection as a consequence of the fact that the principle of specialty of trademarks (*"princípio da especialidade das marcas"*) does not apply to it, as an exception to the rule that a registered trademark enjoys protection in a certain business area and is subject to extension of said protection only to encompass identical or confusingly similar marks used in connection with products or services which are similar, related or akin.

Statutory and administrative provisions concerning highly reputed marks

Following are the main statutory and administrative provisions regarding famous marks.

- a) **The Industrial Property Law (Law no. 9.279/96) - IPL** - Pursuant to its Section 125, ***"Marks registered in Brazil and deemed to be famous shall be afforded special protection in all fields of activity"***. This legal provision makes it quite clear that only marks registered in Brazil are eligible as highly reputed marks, in line with the abovementioned principle of territoriality. Once the registration in a given class is granted by the INPI, the famous nature of a mark may be requested by its holder at any time. That being said, there is no doubt that the geographical area of concern for famous marks is the Brazilian territory. Nonetheless, this study will investigate whether high reputation abroad and suitable evidence in this respect could influence the examination by said agency, at least to a certain extent.
- b) **INPI Resolution No. 107/2013** - The wording of the abovementioned Section 125 of the IPL of course calls for a set of rules dealing with the requirements and examination in order to determine whether a trademark deserves famous status. It is mandatory to note that this Resolution has changed the examination proceeding for the recognition of famous marks dramatically, since it is no longer necessary to seek special protection only along with an opposition or an administrative nullity proceeding, as it was the case under the previous Resolution. Resolution 107/2013 no longer conditions the highly reputed status to a so called "incidental proceeding" (opposition or administrative nullity) – instead, the interested party may request the INPI to examine whether a mark

is famous at any time. Only a valid registration in Brazil and suitable evidence pointing to the famous status of the mark are now required.

It is of utmost importance to reproduce the contents of Section 1 of the Resolution, as follows:

“For the effects of this Resolution, a mark is considered to be famous when its performance in distinguishing its products or services and its symbolic effectiveness (in terms of distinguishing goods or services) goes beyond its primitive scope, thus exceeding the so called principle of specialty thanks to its distinctive character, its recognition by a significant number of consumers, its quality, reputation and prestige associated to it and its flagrant capacity of attracting consumers by means of its mere presence”.

According to said Resolution, the mark must comply with three essential requirements, namely

I - recognition and awareness by a broad portion of the public in general (and not only by direct consumers);

II - quality, reputation and prestige which are associated by the public between the mark and the products it identifies and

III - degree of distinctiveness and exclusivity of the mark in question.

As for the requirement set forth in item I above, the Resolution recommends that an opinion survey be submitted, without prejudice to further evidence of a different nature. Submitting a survey is, therefore, not mandatory, but strongly recommendable.

Paragraph 4 of Section 4 of the Resolution lists the kind of evidence which may be submitted along with the request of highly reputed nature. For the purpose of this study, it is worth noting that some evidence does reinforce the principle of territoriality (in particular reputation in Brazil), namely

- Length in time of publicity and genuine use of the mark in the Brazilian market;
- Means of commercialization of products under the mark in Brazil;
- Geographical length of effective commercialization of the mark in Brazil, and abroad;

- Publicity means used in the advertising of the mark in the Brazilian media, and abroad;
- Amount invested by the mark holder in publicity in the Brazilian media in the last five years;
- Profile of the public and number of consumers in Brazil which have been exposed to the mark by the Medias used by the mark holder to advertise its mark;

It should be noted that the list of paragraph 4 of Section 4 of the Resolution is to be deemed as a guideline, and not as a mandatory list of documents to be filed by mark holders seeking special protection for their marks.

Assuming that the evidence submitted is deemed as suitable to prove the famous nature of the mark which is the subject of the request, then the INPI will declare that the mark is famous, a declaration which is valid for 10 years, different from the prior Resolution, which afforded special protection for only five years. The recognition is followed by an official designation of the trademark registration, meaning that the recognition of the highly reputed status will be published in the Official Gazette and a notation will be added to the excerpt of the mark, so that the recognition will be properly publicized. The abovementioned 10-year term will start upon publication of the decision to grant famous status in the Official Gazette. Consequently, third parties will become aware of the special status granted by the INPI, as per information to be provided in the INPI's website as well. This is in line with the so called principle of publicity which must be complied with by public entities, meaning that all decisions issued by the INPI must be made available to the public.

Upon expiration of said term, the trademark owner may submit a further request, along with updated evidence that its mark still deserves the special protection granted to famous marks.

- c) INPI Resolution No. 142-2014 (Manual on Trademarks)** - Section 2.4.2 of this Resolution provides for an exception, to the extent that only famous marks do not require the application of the principle of specialty of marks, not only as an exception to said principle, but also keeping in mind the fact that pursuant to Brazilian Law the applicant can only claim products or services which are encompassed by its specific business area.

Administrative decisions concerning highly reputed marks

We will go through some decisions rendered by the INPI and study the elements, especially the geographical ones, which led to the granting of the special protection.

Before that, however, it is of utmost importance to make some preliminary comments in connection with the decisions which afforded special protection to FIFA's marks.

It should be noted that extended protection pursuant to Section 125 of the IPL granted in favor of FIFA, more specifically to the marks which have been adopted for the last Football World Cup which took place in Brazil in July 2014, have not taken into consideration the provisions of Ordinance 107/2013.

In this respect special attention has to be drawn to the fact that Brazil as a hosting country of the FIFA World Cup has undertaken to comply with a number of obligations in line with Law no. 12.663 of June 5th, 2012 (the so called "**Lei Geral da Copa**"), available at www.planalto.gov.br/ccivil_03/-ato2011-2014/2012/Lei/L12663.htm. Pursuant to said Law no. 12.663 Chapter II (PROTECTION AND EXPLOITATION OF COMMERCIAL RIGHTS) Section I (Special Protection of the Industrial Property Rights Related to the Events) the INPI must afford famous status to those marks encompassing official signs, such as the FIFA emblem, the official mascots and other official symbols pointed out by FIFA. It should be added that even though the famous status has been granted in line with Section 125 of IPL, the FIFA marks, in compliance with the so called "**Lei Geral da Copa**", have undergone special proceedings, meaning that (a) FIFA has been exempt from submitting evidence of high repute status to the INPI, (b) the INPI had to comply with a kind of fast track, so as to ensure a very quick examination process and c) the famous declaration of FIFA's marks lasted until December 31, 2014 and not 10 years as set forth in Resolution no. 107/2013. In a nutshell, the decisions to afford famous status in favor of FIFA's marks, even though worth mentioning, should not be deemed as equivalent to those decisions rendered in connection with registered trademarks in Brazil.

That being said, the BTO has so far issued 39 decisions, whereby only five of them acknowledge special status to trademarks "**FUSCA**", "**BARBIE**", "**HONDA**", "**FABER-CASTELL**" and "**PLAYSTATION**".

Pursuant to the reasons behind the decisions to grant special status to trademarks "**FUSCA**", "**BARBIE**", "**HONDA**", "**FABER-CASTELL**", and "**PLAYSTATION**", all evidence submitted has been taken into consideration and commented on by the examiners, however, it is clear from their reasoning that opinion surveys having a broad coverage of the Brazilian population (divided in ages, gender, social class and education) living in different regions of the country are of paramount importance. The holders of the marks now enjoying famous status did submit, among further evidence and information, opinion surveys carried out among individuals of different ages, social classes, gender and education.

In spite of the fact that information on the geographical length of trade of products or services under the mark and publicity abroad is listed in the Resolution as one possible means of evidence to obtain the special status, the fact is that this kind of evidence, even though suitable, will not have a decisive impact as far as the granting of famous status is concerned.

Conclusion

A. “Famous” marks

Upon a review of the legal texts dealing with famous marks and the administrative case law now available, it is clear that the geographical area of concern with respect to this category of marks is the Brazilian territory in a broad sense, meaning that the number of regions covered by the surveys should be as high as possible.

Even though some evidence obtained abroad may be submitted to the INPI along with the request for the recognition of famous status, the fact is that this kind of evidence will have a mere subsidiary character. Key evidence is consistent and long term publicity, trade and promotion carried out in the Brazilian territory.

In addition, it must be highlighted that even though Resolution no. 107/2013 in Section 4, paragraph 1 only recommends the submission of an opinion survey as suitable evidence to comply with the third requirement, namely

1 - recognition and awareness by a broad portion of the public in general (and not only by direct consumers),

The fact is that not only this requirement but the remaining ones in most cases do call for the submission of such an opinion survey so as to comply with the BTO’s understanding of suitable evidence needed in this context, as it was possible to confirm by analyzing the decisions so far issued by INPI to grant famous status.

B. “Well-known” marks

(Walter W. Palmer - Pinheiro Palmer Advogados, Rio de Janeiro)

Introduction

Unlike “highly renowned” marks, “well-known” marks do not have to be registered in Brazil, and only need to be “well-known in their field of activity” under the terms of Article 6 *bis* (1) of the Paris Convention in order to be entitled to “special protection” in the country.

A trademark owner can claim that its mark is well-known either in administrative proceedings before the INPI or in judicial proceedings before Brazilian courts. If a trademark owner alleges in an administrative or judicial proceeding that its mark is well-known and has not already applied to register the mark in Brazil at the time the claim is asserted, the trademark owner must file an application for the mark with the INPI within 60 days of initiating the proceeding or the claim of well-known status will be rejected. The IP Law authorizes the INPI to recognize a trademark as well-known *sua sponte* and cite the mark as grounds for rejecting a third party's application for an identical or similar mark.

Statutory provisions concerning well-known marks

Art. 126 of the IP Law is the statutory basis for well-known marks in Brazil, and provides as follows:

Article 126 – *A trademark that is well-known in its field of activity pursuant to the provisions of Article 6bis (I) of the Paris Convention for the Protection of Industrial Property shall enjoy special protection, irrespective of whether it has been previously applied for or registered in Brazil.*

Paragraph 1 – *The protection provided this article shall apply equally to service marks.*

Paragraph 2 – *The INPI may reject ex-officio an application to register a mark that reproduces or imitates, either wholly or in part, a well-known trademark.*

Administrative regulations concerning well-known marks

Section 2.4.1 of the Trademark Department's Trademarks Manual (instituted by Resolution No. 142/2014) clarifies that the protection of well-known marks which are neither registered nor applied for in Brazil is an exception to the IP Law's general rule that "property of a trademark is acquired through the issuance of a valid registration" required by the country's accession to the Paris Convention.

The Manual provides that the INPI will "refuse to register or invalidate the registration of a sign which constitutes a usurpation of a trademark duly protected, through application or registration, in another country which is also a member of the Paris Convention, when the mark is well-known in the country." Significantly, in Section 5.12.4, concerning oppositions based on well-known marks, the Manual states:

Given that the Paris Convention does not give any definition of notoriety, nor even establish criteria for considering it, the INPI, as the authority competent for considering material of this nature, considers the issue looking to see if the mark

*has achieved a certain reputation **in Brazil**, in an **identical or similar** market segment.*

Thus, to receive the protection of Art. 126, the mark owner must establish that its mark is well-known **in Brazil**.

Section 2.4.1 clarifies that the INPI can recognize a trademark as well-known *sua sponte* when a Trademark Examiner concludes that the mark is sufficiently well-known that there is no need for the production of proof on the issue.

Per Section 5.12.4, where the trademark owner has claimed that its mark is well-known in an administrative proceeding, Trademark Examiners must analyze (a) whether the trademark owner is a national resident or domiciled in a country which is a member of the Paris Convention; (b) whether the trademark owner has standing for the underlying administrative proceeding; and (c) whether the trademark owner has sufficiently argued, and established with accompanying proof, that its mark is known in its market segment or a similar market segment in Brazil.

While the Manual does not include a list or discussion of the types of evidence which a trademark owner can present to establish that its mark is well-known, INPI Resolution 107/2013 concerning highly-renowned marks does, and permits, both expressly and implicitly, evidence which originates outside Brazil:

Expressly permitted:

- The amount of time of advertising and use of the mark outside Brazil
- The geographic scope of use of the mark outside Brazil
- Means of advertising the mark outside Brazil

Implicitly permitted:

- Total sales of goods/services carrying the mark worldwide
- The value attributed to the mark on the owner's balance sheet

Resolution 107/2013 makes clear, though, that the trademark owner must use these types of evidence to establish that the trademark is highly-renowned **in Brazil**.

Presumably, therefore, evidence originating outside Brazil, including the specific types of evidence listed above, can be presented to the Trademarks Department to establish that a trademark is well-known, although the evidence must lead to the conclusion that the trademark is well-known in Brazil.

Administrative decisions concerning well-known marks

The Trademarks Department has cited the following types of evidence originating in Brazil in finding that a trademark was “well-known” in the country for the purposes of Art. 126, even though the mark had not been used in the country:

- News articles in Brazilian publications regarding the mark (**DUBAI Composite**, App 900565179, Official Gazette 2179, 2012)
- Websites in Portuguese featuring announcements offering to buy or sell products carrying the mark (**RICKENBACKER BRASIL WOOD Composite**, App 829991506, Official Gazette 2085, 2010)

The Trademarks Department has cited the following types of evidence originating outside Brazil in finding that a trademark was “well-known” in Brazil for the purposes of Art. 126:

- Trademark owner’s registration of its mark in its home country for over 40 years and in other Paris Convention countries (**TINACTIN**, App 820734772, Official Gazette 1816, 2005)
- Trademark owner’s registration of its mark in various countries other than Brazil (**CABANA Composite**, App 818935790, Official Gazette 1546, 2000; **SUGAR IN THE RAW AÇUCAR MASCADO Composite**, App 820712043, Official Gazette 1834, 2006; **MOULIN ROUGE PRAIA DA COSTA Composite**, App 825075645, Official Gazette 1979, 2008; **COBALT Composite**, App 827749333, Official Gazette 2085, 2010; **RUEHL Composite**, App 829624376, Official Gazette 2127, 2011; **KENDALL Composite**, App 900484845, Official Gazette 2143, 2012; **ALPINESTARS**, App 820557773, Official Gazette 2265, 2014)
- Foreign player’s fame in a particular sport (**BECKHAN**, App 825770769, Official Gazette 1994, 2009)
- Status of a sporting event as “traditional” in the foreign country where it is held (**ECO DAYTONA**, App 825672570, Official Gazette 1979, 2008)
- Appearance of the mark at international competitions for the specific sport with which the mark is associated (**ALPINESTARS**, App 820557773, Official Gazette 2265, 2014)
- Advertising campaigns and music videos originating outside Brazil in which products carrying the mark were shown being used by famous athletes and musicians (**Arrow Design**, App 901870579, Official Gazette 2248, 2014)

- Photographs from international sports competitions shown in news articles on Brazilian websites in which the trademark appeared on the athlete's clothing (**ALPINESTARS**, App 820557773, Official Gazette 2265, 2014)
- Publication of the trademark in magazines outside Brazil (**CAFÉ FLORIAN**, App 818681420, Official Gazette 1786, 2005)
- Regular publication of the trademark in foreign magazines dedicated to the specific sport with which the mark is associated (**ALPINESTARS**, App 820557773, Official Gazette 2265, 2014)
- Proof that the consumers of products carrying the mark are highly specialized and likely to know of the mark (**RICKENBACKER BRASIL WOOD Composite**, App 829991506, Official Gazette 2085, 2010)
- Proof of commercial activity outside Brazil (**BYBLOS**, App 815938837, Official Gazette 1780, 2005)
- Proof of widespread commercial activity outside Brazil (**CABANA Composite**, App 818935790, Official Gazette 1546, 2000)

Judicial decisions concerning well-known marks

Courts in Brazil have the power to decide whether trademarks are well-known under Art. 126 of the IP Law, and they are not bound by previous determinations on the issue by the INPI.

Whether a trademark is well-known is a question of fact determined through a careful examination of the relevant evidence. It is not necessary to prove that the mark was well-known to all consumers, but only to the consumers of the specific market segment at issue. Significantly, the mark must be well-known in Brazil.

While evidence of registration, use, and notoriety of a mark outside Brazil is certainly relevant to establishing that the mark is well-known in Brazil, it may not be enough, absent some evidence suggesting that Brazilian consumers know of the mark, to establish that the mark is well-known under Article 126.

For example, in *Chico Cheese's Pizza e Participação Ltda v. Showbiz Pizza Time Inc. and INPI* (Civil Appeal, Case 1997.51.01.016152-9, TRF-2, 2009), Chico Cheese's Pizza e Participação Ltda sought to overturn the INPI's nullification of its registration for **CHICO CHEESE'S PIZZA** on grounds of Showbiz Pizza Time Inc.'s **CHUCK E CHEESE'S PIZZA** trademark, which the INPI found well-known under Article 6 *bis* of the Paris Convention

even though the mark was not registered in Brazil. The trial court upheld the INPI's nullification of **CHICO CHEESE'S PIZZA** on grounds that Showbiz proved it had used **CHUCK E CHEESE'S PIZZA** in the United States since the late 1970s and had registered the mark in various countries around the world, which the trial judge understood to establish that the mark was well-known. On appeal the Federal Tribunal for the Second Region reversed the decision, holding that Showbiz's overseas registrations alone were not sufficient to establish that the **CHUCK E CHEESE'S PIZZA** mark was well-known in Brazil:

*In the case at bar ... SHOWBIZ PIZZA TIME, INC. has not proved the notoriety of the marks **CHUCK E CHEESE'S PIZZA** and **CHUCK E CHEESE** here in Brazil. The documents [in the record] do not even show that the marks had been disclosed here in Brazil such that they would be known in the market segment where the products they identify are found.*

The fact that the marks of SHOWTIME PIZZA TIME, INC., were registered in other countries such as Australia, China, Bolivia, Japan, and Canada does not confer to these marks the quality of being well-known, so as to bar the registration of the national mark of CHICO CHEESE'S PIZZA E PARTICIPAÇÃO LTDA, notably in the absence of proof of notoriety here in Brazil, in the same market segment, in the same area of activity.

It must be observed that the record contains not one document which proves that the marks were disclosed inside the nation's territory. It is worth mentioning that in the case at bar, proof of prior use of the mark in Brazil is not being analyzed, since this position has been rejected by the jurisprudence as a requirement for a mark to be well-known. It is being verified whether the marks [of SHOWTIME] really have notoriety in their sector in the country, and in this aspect, [Showtime] has not discharged its burden [of proof].

By way of comparison, in *Porto Marino SA v. Prada SA and INPI* (Civil Appeal, Case No. 2008.51.01.806225-5, TRF-2, 2011), a different panel of the same appellate court considered the date of first use of a mark overseas and overseas registration of the mark relevant, although the record also contained proof of registration and advertising of the mark in Brazil. Porto Marino SA sought to overturn the rejection of its application for **PRADA** based on Prada SA's registrations for **PRADA** in Brazil and the status of the **PRADA** mark as well-known under Art. 6 *bis* of the Paris Convention. Losing at the trial court level, Porto Marino appealed, including on the trial court's finding that **PRADA** was well-known under Article 126 of the IP Law. The Tribunal Federal for the Second Region rejected the appeal, holding that Prada SA had proved that its mark was well-known by showing that it had used the mark for clothing since 1914, that it had registered its commercial name in Italy in 1988, and that it had registered its mark around the world.

However, the court also based its conclusion on the fact that Prada SA had registered its mark in Brazil in 1957, that the mark was regularly advertised in major national magazines, and that the mark figured prominently in the popular movie “The Devil Wears Prada”.

At the other end of the spectrum is *D-Link Systems Inc. v. D Link Com e Ind de Equipamentos de Informática Ltda and INPI* (Civil Appeal, 0312232-52.1995.4.03.6102, TRF-3, 2012), in which the appellate court found **D-LINK** to be well-known based on proof of registration of the mark overseas and notoriety of the mark in markets outside Brazil. D-Link Systems Inc. filed the action to nullify D Link Com e Ind de Equipamentos de Informatica Ltda’s registration for **D’LINK Composite**, which the trial court granted. D Link Com e Ind de Equipamentos de Informatica Ltda appealed, challenging the finding that **D-LINK** was well-known under Article 6 *bis* of the Paris Convention and arguing that it owned the mark because it filed first in Brazil. The appellate court noted that “the ... documents demonstrate abundantly that **D-LINK** is a prestigious mark not only in the United States of America [D-Link Systems Inc.’s home country], but also in other countries such as India, Italy, Poland, Canada, China, Denmark, France, Germany, Japan, and others,” and also found relevant that D-Link Systems Inc. had “registered [its mark] in various countries on dates prior to the Defendant’s application” in Brazil.

Two recent trial court decisions on preliminary injunction requests suggest, as well, that courts will give substantial weight to use, registration, and notoriety of the mark outside Brazil.

In *Depo Auto Parts Ind. Co. Ltd. v. Zuquim Comercial and INPI* (0019529-88.2013.4.02.5101, 9th Federal District Court, Rio de Janeiro, 2013), the trial court granted a preliminary injunction suspending the legal effects of registrations for **DEPO AUTOLAMPS** based on a finding that Depo Auto Parts Ind. Co. Ltd.’s **DEPO** mark was well-known in Brazil under Article 126 of the IP Law due to its “highly accentuated activities in various countries”, where the plaintiff had submitted evidence that it had used **DEPO** since 1977, had registered the word and composite forms of its mark in a total of 22 jurisdictions, and was selling its goods in more than 190 countries. However, the record also included evidence that Zuquim Comercial had contact with representatives of Depo Auto Parts Ind. Co. Ltd. at a trade fair and had e-mailed Depo Auto Parts Ind. Co. Ltd about importing its products into Brazil before filing its applications in Brazil, which may have affected the judge’s decision.

In *Johnny Rockets Licensing, LLC v. Rockets Comercio de Alimentos Ltda and INPI* (0808458-18.2011.4.02.5101, 13th Federal District Court, Rio de Janeiro, 2011), the trial court granted a preliminary injunction suspending the legal effects of a registration for **ROCKETS Composite** on grounds that the plaintiff had proved that its **JOHNNY ROCKETS THE ORIGINAL HAMBURGER Composite** mark had a “high degree of notoriety ... in the field of restaurants, around the world.”

Obviously, neither the INPI's Trademark Department nor Brazilian courts can ignore the impact of the Internet on spreading knowledge of trademarks not used in Brazil amongst Brazilian consumers. As one respected legal commentator observed:

*The Internet and foreign magazines of broad circulation in the main cities of the country can be highlighted as powerful vehicles for the divulgation and propagation of a mark, and for this reason, **cannot be ignored in the analysis of notoriety inside Brazilian territory.** The rule is that notoriety must be analyzed in the country where the protection is sought, but there do not exist limitations or restrictions regarding the means by which that notoriety is won.*

[Emphasis added.] “Marca Notoriamente Conhecida: Espectro da Proteção Legal”, Maria de Lourdes Coutinho Tavares, Brazilian Intellectual Property Association Magazine, Edition 81 (March/April 2006), page 22.

Conclusion

A trademark can be recognized as a well-known mark in Brazil even if it has not been used or registered in the country. To do so, the trademark owner must present proof that its mark is well-known inside Brazil. While the evidence can originate from outside Brazil, it must lead to the conclusion that the mark is well-known inside Brazil.

CHILE

(Hernán Ríos - Marks & Clerk LLP, London, UK)

(Paulina Bardón – Claro & Cia, Santiago de Chile, Chile)

The Chilean Industrial Property Law (Law 19.039), in its **Article 20. g)**, deals with well-known (*notoria*) and famous (*famosa*) trademarks and distinguishes between well-known and famous trademarks registered abroad and registered in Chile:

The following may not be registered as trademarks:

- Registered abroad

g) Trademarks that are identical or graphically or phonetically similar to others registered abroad to distinguish the same goods, services or commercial or industrial establishments liable to create confusion and provided they enjoy fame and notoriety in the sector of the public that usually consumes those goods, demands those services or has access to those commercial or industrial establishments in the country of origin.

If a registration is rejected or cancelled for this cause, the holder of the well-known trademark registered abroad must apply for the registration of the trademark within 90 days. If not, the trademark may be applied for by anyone and the person whose application was rejected or registration cancelled shall have priority within the following 90 days from the date of expiration of the right of the holder of the well-known trademark.

- Registered in Chile

*Trademarks registered in Chile that enjoy fame and notoriety, may prevent the registration of other **identical** or **similar** trademarks that distinguish **different** and unrelated products, services or commercial or industrial establishment, provided that the latter has some **connection** with the products, services or commercial or industrial establishment that distinguishes the well-known mark and, on the other hand, that such protection would be likely to **harm the interests** of the owner of the notorious registered trademark.*

In this case, fame and notoriety will be determined in the relevant sector of the public who regularly consume these products, demand for those services or have access to such commercial or industrial establishments in Chile.

The above Article allows the filing of opposition and/or annulment actions based on foreign famous and notorious trademarks, provided that these trademarks are used for the **same** products or services as the ones that are requested in the application to be opposed or annulled.

In the case of opposition or annulment actions based on famous and notorious trademarks registered or in use in Chile, the criterion is less restrictive and the actions can be based on trademarks that are used for **different** and non-related products or services, provided that its use may affect the interests of the owner of the famous mark.

The Chilean Industrial Property Law (Law 19.039), in its **Article 27**, provides that the right to file an annulment action against a trademark registration **expires in 5 years, unless** the trademark application was filed in **bad faith**. According to case law and legal authors, bad faith is presumed in cases involving famous and well-known marks. This provision reflects the criterion of Article 6 *bis* of the Paris Convention in its entirety and has been recognized by the Chilean Supreme Court.

The Chilean Supreme Court has ruled regarding well-known trademarks, recognizing that bad faith keeps the annulment action alive. (Recurso de Casación 2182/2009 – Decisión 3317), from 20 January 2011, recognizes the fact that an invalidity action against a

registered trademark based on a well-known trademark not registered in Chile, when the application was made in bad faith, does not expire in five years. This particular invalidity action was filed by O'Neill Inc. against a trademark registration for O'Kid by O'Neill for goods in Class 25 in the name of Sisco Textiles, Inc.

Decisions from the National Institute of Industrial Property (INAPI) where the well-known status of a trademark abroad were considered valid grounds to refuse a national trademark application include TWITTER and TWEET (opponent Twitter Inc.) vs. TWEETCAFE & Device and STUDIO 54 (opponent MGM GRAND HOTEL LLC) vs. STUDIO 64.

The Procedural Guidelines of Trademarks (“Directrices de Procedimiento de Marcas Comerciales”) of INAPI, dated 2010, hereinafter referred to as the “Guidelines”, discuss the relative grounds of refusal of well-known and famous trademarks not registered in Chile. The following are the main topics included in the Guidelines:

- The degree of recognition is one important issue when evaluating the risk of error or confusion. The more notorious a trademark is, the broader its scope of protection will be.
- The principle of specialty of trademarks, which means that the protection of a trademark extends only to products/services included in its scope of protection, has an exception in the case of brands that are well known, famous or renowned. The more notorious a trademark is, the less relevant the specialty of its scope of protection will be.

Criteria to determine the degree of notoriety or fame of a trademark:

- Well-known trademarks are those that are known to a large percentage of consumers in a specific field of products or services.
- Famous or renowned brands are those that are known internationally or globally.
- Chilean law makes no distinction between well-known and famous or renowned marks, so they are treated in the same way.
- Knowledge of famous and well-known trademarks must be within national borders regardless of whether the trademark is registered or not.
- The provisions of the Paris Convention are totally applicable to famous and well-known trademarks.

- Famous and well-known trademarks are an exception to the principle of specialty, which means that confusion is possible even in cases where products or services are different.

Issues that should always be considered (following Article 2 (1) (b) of the “Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO, September 20 to 29, 1999) are as follows:

- The degree of knowledge or recognition of the mark in the relevant sector of the public.
- The duration, extent and geographical area of the use of the mark.
- The duration, extent and geographical area of any promotion of the mark, including advertising or publicity and presence at fairs or exhibitions, of products or services to which the mark is applied.
- The duration and geographical area of any registration or any application for registration of the mark, to the extent that they reflect use or recognition of the mark.
- The record of successful enforcement of rights on the mark, in particular, the extent to which the mark was recognized as well known by competent authorities.
- The value associated with the mark.
- The fame and notoriety will be determined in the relevant sector of the public that regularly consume these products, demand those services or have access to such commercial or industrial establishments in Chile. The concept of relevant public is reduced to the circle of consumers of those products or services. In this sense, it has a similar meaning to the consuming public: the sector of the population that consumes and has access to certain products and services.
- Relevant and accepted evidence to attest fame and notoriety and to prove the level of knowledge in the relevant sector of the public are: Foreign trademark registrations in similar or related classes, publications in specialized journals, advertising, brochures, invoices, waybills and annual sales reports.

- Foreign registrations are generally used to attest the duration, extent and geographical area of any use of the mark. Publications and brochures are usually used to attest the degree of knowledge or recognition of the mark in the relevant sector of the public. Invoices, waybills and annual balances are generally used to attest the value associated with the mark.

Finally, the Guidelines mention the case of the **FERRARI** trademark (Application No. 770.799 – decision DNI No. 144.965), which fulfilled all the requirements established in Article 20 (g), where the opponent filed copies of foreign trademark registrations for the trademark **FERRARI** in Class 9 and various extracts from the Internet which made reference to the trademark.

COLOMBIA

(Ximena Castellanos – Castellanos & Co., Bogotá)

Legislation and draft Trademark Examination Manual

All of the Andean Community provisions regarding the protection of “notoriously known” trademarks (“signos notoriamente conocidos”) are included in Articles 224 to 236 of Title XIII of the Andean Decision 486, some of which are reproduced below:

ON WELL-KNOWN DISTINCTIVE SIGNS

Article 224. - *A well-known distinctive sign is understood to mean a sign that is recognized as such in any Member Country by the pertinent sector, independently of the way or means by which it was made known.*

Article 225. - *A well-known distinctive sign shall be protected from use or registration that is not authorized pursuant to the stipulations of this Title, without prejudice to such other provisions of this Decision as may be applicable and to the provisions of the Member Country in respect of protection against unfair competition.*

Article 226. - *Use of all or a part of a well-known distinctive sign or the reproduction, imitation, translation, or transliteration thereof, that may create confusion in respect of identical or similar businesses, activities, products or services to those to which it is applied, shall constitute unauthorized use of that distinctive sign.*

Also constituting unauthorized use of a well-known distinctive sign is the use of all or of an essential part of that sign, or the reproduction, imitation, translation, or transliteration thereof, even if in respect of businesses, activities, goods, or services other than those to which that well-known distinctive sign is applied, or its use for non-commercial purposes, where such use could be liable to produce any of the following effects:

- a) the risk of confusion or of association with the owner of the sign, or with the businesses, activities, goods, or services belonging to that owner;
- b) unjust economic or commercial injury to the owner of the sign by reason of the weakening of the distinctive force or commercial or advertising value of that sign; or,
- c) unfair exploitation of the sign's prestige or fame.

Use of a distinctive sign may be verified by any means of communication, including electronic media.

Other provisions related to the protection of famous and well-known trademarks are Article 136 h) and Article 155 e) and f), as follows:

Article 136. - *Those signs the use of which in commerce may constitute an impediment to the rights of third parties, may likewise not be registered as trademarks, in particular where:*

h) *consist of a total or partial reproduction, imitation, translation, transliteration, or transcription of a well-known sign belonging to a third party without regard to the type of product or service to which it shall be applied, the use of which would lead to a likelihood of confusion or mistaken association with that party; taking unfair advantage of the prestige of the sign; or weakening its distinctive force or its use for commercial or advertising purposes.*

Article 155. - *The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from engaging in the following acts*

e) *using in the course of trade identical or similar signs to a well-known trademark with respect to any goods or services, where such use, by weakening the distinctive force or the value of that trademark for commercial or advertising purposes or by taking unfair advantage of the prestige of the trademark or of its owner, could unjustly damage the economic or commercial interests of the owner of the registration;*

f) *making public use of identical or similar signs to a well-known trademark, even for purposes that are non-commercial, where such use could weaken the distinctive force or value of that trademark for commercial or advertising purposes or take unfair advantage of its prestige.*

From these provisions it is clear that, according to the law, there is no difference between “famous” and “well-known” trademarks. The Andean legislation simply refers to “notoriously known” trademarks, which are trademarks that are recognized as such by the pertinent sector, rather than by the general public.

Nevertheless, the Superintendency of Industry and Commerce (SIC) is currently preparing a draft Trademark Examination Manual, in which examiners will be asked to differentiate between different types of “notorious” trademarks. In the Manual, “well-known” trademarks are defined as those which are known as such by the general public, rather than by only the pertinent sector, while “simply notorious” trademarks are those that are recognized as such by the pertinent sector only.

The degree of protection granted to each of these types of trademarks is different in that “well-known” trademarks will be granted protection regardless of the products or services at issue, while “simply notorious”

trademarks will be awarded protection only if there is a risk of association with the trademark owner or with its products and services.

Therefore, under the Manual, to achieve protection of a notoriously known trademark without showing a risk of association, but only a risk of dilution, the mark must be known not only to the pertinent sector, but to the public in general. As established in the Manual, the more important the evidence of notoriousness, the more protection which shall be awarded with regard to unrelated products or services.

Factors to be considered to enjoy FWKM protection

In order for a trademark to be declared notorious by SIC, its owner must file enough evidence to show the following criteria:

Article 228. - *In order to determine whether a distinctive sign is well-known, due account shall be taken of the following criteria among other things:*

a) *the extent to which it is known in the relevant sector of the public in any Member Country;*

b) *the age of the distinctive sign and the size of the geographical area where it is used in and outside any Member Country;*

c) *the age and the size of the geographical area where the distinctive sign is promoted, in or outside any Member Country, including its advertising and presentation at fairs, exhibitions, or other events in connection with the goods or services, the establishment, or the activity to which it is applied;*

d) *the value of all investments made in promoting the distinctive sign or the establishment, activity, goods or services to which it is applied;*

e) *figures for the sales and income of the owner, both at the international level and in the Member Country where protection is being sought, in respect of the distinctive sign whose well-known character is alleged;*

f) *the extent of the inherent or acquired distinctiveness of the sign;*

g) *the book value of the sign as a corporate asset;*

h) *the volume of orders from persons interested in obtaining a franchise or license to the sign in a specific territory; or,*

i) *the existence of significant manufacturing, purchasing, or storage activities by the owner of the sign in the Member Country where protection is being sought;*

j) *the international trade-related aspects; or,*

k) *the existence or age of any registration or application for registration of the distinctive sign in the Member Country concerned or in any other country.*

Article 230. - *The following, among others, shall be considered pertinent sectors of reference for purposes of determining whether a sign is well-known:*

a) *the real or potential consumers of the type of goods and services to which the sign shall be applied;*

b) *the persons involved in the channels of distribution or marketing of the kinds of goods or services to which the sign shall be applied; or,*

c) *the commercial circles operating in lines of business connected with the kind of establishment, activity, goods, or services to which the sign is applied.*

It shall be sufficient, for the purpose of recognizing the well-known character of a sign, for it to be known within any of the sectors referred to in the previous paragraphs.

Once the notoriousness has been proven through the criteria above, the trademark owner shall be granted protection after demonstrating:

1. That the sign in conflict is a reproduction, imitation, translation, transliteration or transcription, total or partial, of the notoriously-known trademark **and**
2. That the use of the sign is likely to cause a risk of confusion or a risk of association with the owner or with its products and services; **or**
3. The unfair profit obtained from the prestige of the sign; **or**
4. The dilution of the sign's distinctive force or of its commercial or advertising value.

With regard to these factors, SIC interprets that when the mark to be protected is "simply notorious" (only known in the pertinent sector), the risk of confusion or association with the trademark in conflict has to be proven to achieve protection. When the mark is not just notorious but "well-known" (known to the general public), then protection will be awarded, regardless of the products and services to which the infringing mark is directed.

Use in Colombia as a requirement to have mark recognized as notoriously known

Article 229 of Andean Decision 486 provides as follows:

Article 229. - *The well-known nature of a sign shall not be denied solely because:*

- a) *it is not registered or in the process of being registered in the Member Country concerned or in any other country;*
- b) *it has not been nor is it being used to distinguish goods or services or to identify activities or businesses in the Member Country concerned; or,***
- c) *it is not well-known abroad.*

According to the above mentioned provision, there is recognition of the notorious character of a trademark even in the absence of use of the trademark in the Member country concerned. **Therefore, use in Colombia is not a requirement for a trademark to enjoy protection as “notorious”.**

There is a very interesting decision in connection with the registration of trademark WAL-MART in Colombia for services in Class 42 by WAL-MART STORES INC. The trademark WAL-MART was subject of a cancellation action due to non-use by a Colombian citizen, who wished to obtain registration of the trademark for himself. In contradiction to the Andean legislation, which establishes that for a trademark not to be cancelled for non-use, the owner must prove use in commerce, and that the covered products or services were placed in the market in a way as it corresponds to their nature, SIC decided that when the mark to be cancelled is one that is notoriously known, no actual use of the trademark has to be proven. SIC concluded that the purpose of the cancellation action due to non-use is to remove from the register trademarks that are not in use, but not to remove from the register non-used notoriously known trademarks, and that notoriously known trademarks do not need to be in use in Colombia to achieve protection as such. Therefore, SIC concluded in this case that, since notorious trademarks do not need to be in use in an Andean member country to achieve protection over similar trademarks, they also may not be cancelled for non-use. Nevertheless, SIC established in the decision that the products or services from which the notorious character is achieved shall correspond to the products or services in the Colombian trademark registration. The following are the pertinent quotations from the decision:

In fact, a trademark that awards the quality of notorious in a certain place, which products or services are not commercialized within this market will comply with its functions as trademark, because if it is broadly known in the pertinent sector it signifies that the consumers will recognize that it identifies certain products or services to which it is notorious, fully complying with its distinctive function, as well as its advertising function and its function as means of identification of goodwill”.

Therefore, even if in strict sense the mark is not in use, when its notoriousness is recognized, it is implicit the fact that it accomplishes its functions as a distinctive sign, and so its cancellation due to non-use cannot proceed.

(...)

In fact, if a notorious trademark is cancelled when it has a high degree of distinctiveness, this will be violating its owner's right, in detriment of consumers, who already recognize the trademark and associate it with certain qualities and a certain commercial origin.

(...)

The non-application of the cancellation over notoriously-known trademarks shall be regarded in accordance to the following provision of Decision 486:

Article 229. - *The well-known nature of a sign shall not be denied solely because:*

b) it has not been nor is it being used to distinguish goods or services or to identify activities or businesses in the Member Country concerned; or,

There is no case law dealing with Internet use in order to establish that a mark is notoriously known. Nevertheless, a reasonable interpretation is that the legislation does not limit the use of different means of proof in order for a trademark to be recognized as notorious by the trademark authorities, and that the trademark owner can demonstrate knowledge by consumers in the Andean Region of the notorious trademark by demonstrating use of the mark on the Internet, even if that use on the Internet does not correspond to use in commerce in the corresponding Andean market. In other words, since no actual use in Colombia is needed to demonstrate that a trademark is notoriously known there, proof that a mark is used on the internet in a manner in which the mark reaches Andean consumers of the pertinent sector can be a way to prove notoriousness.

DOMINICAN REPUBLIC

(Wallis Pons – Biaggi & Messina, Santo Domingo)

Overview

Dominican Republic Law No. 20-00 on Industrial Property, dated May 8, 2000, as modified by Law No. 424-06 on Implementation of DR-CAFTA, expressly protects only “famous” trademarks (“*signos distintivos notoriamente conocidos*”) which are known in the territory of the Dominican Republic.

Notwithstanding this, “well-known” trademarks (“*marcas notoriamente conocidas*”) are

also protected in the Dominican Republic as a result of treaties to which the country is signatory, such as the Paris Convention and the TRIPS Agreement.

Internationally it is understood that famous trademarks often need to be registered in at least their home countries for protection abroad, whereas well-known trademarks are protected without being registered in their home countries.

It is also understood that famous marks are protected from unauthorized use on non-competing goods and services, whereas well-known trademarks are protected only for goods and services related to those with which the marks are associated.

The theory of dilution is only available for famous trademarks, since well-known trademarks are only protected if the third party's goods and services are similar or if they can be associated with the ones to which the well-known trademark is related.

In view of the facts stated above and of the considerations set forth below, it can be inferred that both "famous" and "well-known" trademarks are protected in the Dominican Republic; however, the guidance and resolutions issued to date reflect that, in practice, only "well-known" trademarks have been protected.

Scope of protection under treaties, applicable law and regulations

Article 6 *bis* of Paris Convention states:

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

The TRIPS Agreement states in Article 16, related to the Rights Conferred, the following:

1. *The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.*

2. *Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.*

3. *Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use*

Thus, both treaties protect well-known trademarks.

Despite this, Dominican Republic Law No. 20-00 on Industrial Property dated May 8, 2000, as amended, states the following:

Article 70. - Repealed and substituted by Article 10 of Law 424-06:

Article 10. Definition of terms:

j) Famous distinctive sign: a distinctive sign known to the relevant sector of the public or business circles in the country, or in international trade, regardless of the manner or means by which it has become known. (Underlining added)

Article 74. Trademarks inadmissible because of Rights of Third Parties.

A symbol cannot be registered as a trademark when it would affect some right of a third party. The following cases, among others, will be considered in which the symbol intended for registration: (Underlining added)

d) Constitutes the complete or partial reproduction, imitation, translation or transcription of a distinctive symbol which is widely known in the country by the relevant sector of the public, whatever may be the products or services to which the symbol is applied, when its use might cause confusion, a risk of association with that third party, taking unfair advantage of the notoriety of the symbol, or the dilution of the distinctive power of its commercial or publicity value. (Emphasis added)

It can be inferred that the protection given by Law No. 20-00 is for “famous” trademarks, when it states that “a symbol cannot be registered as a trademark when ... [the symbol intended for registration] constitutes ... the transcription of a distinctive symbol ... whatever may be the products or services to which the symbol intended is applied....”

As a result, the scope of protection in the Dominican Republic is both, for “famous” trademarks based on Law 20-00, and for “well-known” trademarks based on international treaties.

On this issue, it is important to note that in the Dominican Republic legal system, treaties have constitutional rank and are therefore above internal laws.

Requirements related to use

In order to obtain protection of a famous trademark in the Dominican Republic, the law requires that the trademark be widely known in the country by a relevant sector of the public.

Indeed, in different resolutions issued by the Distinctive Signs Department of the National Industrial Property Office (ONAPI), it has been established:

Though the plaintiff has proof to hold notoriousness of the trademark ESTRELLA GALICIA internationally, the declaration of notoriousness is confined to a determine territory, therefore the elements submitted do not supply to a notoriousness in the national territory. ¹²

Factors to be considered to enjoy FWKM protection

The criteria applied by the Distinctive Sign Department of ONAPI to determine if a Trademark is considered well known are those provided by the Joint Recommendation Concerning Provisions related to the Protection of Well-Known trademarks issued by the World Intellectual Property Organization, which are:

¹² Resolution No. 290 dated August 29, 2013, in connection with the opposition action filed by Hijos de Rivera, S. A. owner of the trademark ESTRELLA GALICIA in Class 32, against the trademark application ESTRELLA DAMM in Class 32 filed in the name of Sociedad Anonima Damm.

- (a) *In determining whether a mark is well-known, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.*
- (b) *In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well-known, including, but not limited to, information concerning the following:*
1. *The degree of knowledge or recognition of the mark in the relevant sector of the public;*
 2. *The duration, extent and geographical area of any use of the mark;*
 3. *The duration, extent and geographical area of any promotion of the mark;*
 4. *The duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;*
 5. *The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;*
 6. *The value associated with the mark.*

Among the possible proof to be filed in order to demonstrate the notoriousness of a trademark, which are not limited to, and at least a minimum of 3 needs to be submitted, all at the Trademark Examiner criterion, are:

- *Invoices*
- *Surveys (conducted by certified companies)*
- *Marketing surveys*
- *Advertisement or propaganda, being written, televised or radio*
- *Awards*
- *Recognitions*
- *Trade fair presentations or exhibit*
- *Statement of sales*
- *Statement of production*
- *Different commercial establishments or branches that the company has*
- *Previous registrations or uses of the trademark, for determining the time frame in which the trademark has been in use*
- *Investments conducted to promote the establishment, commercial activity, product or service.*
- *The book value of the trademark as a business asset.*
- *Volume of orders received from people interested in obtaining a franchise or license of the trademark*
- *Certification of the Associations related to the type of product or service*

(Chamber of Commerce, Golf federation, Sport Federation, National Health Workers Federation, United Business Federation, Industrial Federation Association, among others).

- *Distribution agreements*
- *Employment payroll.*

While the evidence that can be filed is not limited to that mentioned above, a minimum of 3 of those listed needs to be submitted. The evidence required is exempted from notarization.

Case Law

The following trademarks have been declared “well-known” trademarks by the Trademark Office since 2010:

Trademark CRISOL registered in the name of MERCASID, S.A.¹³ The Resolution stated:

The Dominican Republic is a country member of the Paris Convention for the Protection of Industrial Property. That the notoriousness that a trademark acquires comes from facts or circumstances resulting from the effort of the owner to promote its trademark and its products between consumers or consumer circle, or among the generality of consumers, respectively. Who claims notoriousness assumes the burden of the proof and needs to prove it by the pertinent procedural means.

That MERCASID, S.A., filed marketing surveys in which it is indicated, through statistics, the use of the trademark CRISOL in the country, health indicators and the benefits of the cited trademark, demography study of the trademark CRISOL, in comparison with other oil trademarks used in the Dominican Republic territory, studies related to aspects of identity, advertisement material in connection to the trademark CRISOL, consequently is decisive that the trademark CRISOL enjoys notoriousness in the Dominican Republic. (Underlining added)

Trademark CHANEL registered in the name of CHANEL SARL. The resolution stated¹⁴:

The Distinctive Signs Department established that CHANEL trademark is notorious in our country, therefore enjoys a special protection conferred by the Paris Convention for the protection of Industrial Property.

Territoriality issues regarding use in the Internet

¹³ Luis Daniel Perez Reyes vs MERCASID, S. A. Resolution No. ____ dated August 29, 2013.

¹⁴ CHANEL SARL vs CHANEL CAROLINA UREÑA RODRIGUEZ, Resolution No. 0000036 dated February 2, 2011

Please note that even though use in the Dominican Republic is required in order to be able to claim notoriousness, a trademark could be declared notorious if it is known to a pertinent sector of the public or business sectors and it is proven that the mark is not, *per se*, in the market, but has been acquired by Dominicans through the Internet, considering the Joint Recommendation Concerning Provisions related to the Protection of the Trademarks and other Intellectual Property rights of symbols in the Internet issued by WIPO. For example, ONAPI stated, in Resolution No. 0045-2014 dated July 19, 2014, in connection to the Cancellation Action brought against the trademark RON ABUELO:

In connection to the above mentioned, it is important to indicate that Resolution No. 845 previously cited establishes factors to be considered for determining if a use of a symbol through the Internet has a commercial effect in a member State...¹⁵

In sum, there is no requirement that a trademark be used in the Dominican Republic in order to be considered “famous” or “well-known”. Proof that a mark is notorious outside of the Dominican Republic can be presented, but is not sufficient by itself to establish that a mark is “famous” or “well-known”. Instead, the mark owner must present evidence establishing that the mark is “famous” or “well-known” in a pertinent sector of the public or business sectors.

ECUADOR

(Rodrigo V. Bermeo-Andrade – Bermeo & Bermeo Law Firm, Quito)

Ecuador is a signatory of both the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights, and thus the country abides by Article 6*bis* of the Paris Convention and Article 16 of the TRIPS agreement. Famous (“*marcas de alto renombre*”) and well-known (“*sinos distintivos notoriamente conocidos*”) marks are further regulated by Andean Community Decision #486 and the national Intellectual Property Law and its regulations.

Famous vs Well-Known Marks

Andean Community Decision #486 provides no distinction between famous and well-known marks.

However, Article 198 of Ecuador’s Intellectual Property Law provides that marks can acquire “famous” status if they are generally known to the public (rather than to the relevant sector of the industry) in the country, or internationally. The protection of these marks

exceeds the specialty principle of marks and is valid against third parties' use or registration of similar marks regardless of the products or services.

Requirement of use

There is no legal requirement that a mark be used in order to obtain well-known status. In fact, Article 229(b) of Andean Decision 486 clearly states that *"the well-known nature of a mark shall not be denied solely because ... (b) it has not been nor is it being used to distinguish goods or services or to identify activities or businesses in the Member Country concerned."*

However, the Ecuadorian Institute of Intellectual Property (IEPI) does not have a clear position on this issue as in some cases it has requested that the mark be used in the country, while on other occasions it has requested that the mark be known in Ecuador.

For example, when deciding the well-known status of the RITZ hotel in Paris or the RITZ-CARLTON Hotels, the IP Committee stated that *"there is not enough evidence of the existence of the mark in the Ecuadorian market as a well-known mark."*¹⁶

In the decision regarding the well-known status of the mark BRILLO, the IP Committee stated that *"the defendant has not filed enough evidence to prove the well-known status of BRILLO & DESIGN in Ecuador (...) none of the documents makes reference to use in commerce of the mark in Ecuador."*¹⁷ Likewise, in the decision regarding the mark NIKE, the IP Committee stated that *"the notoriety of the mark NIKE in class 03 in the country has not been proven."*¹⁸

Finally, when the IP Committee faced the issue of whether GOOGLE would be awarded well-known status in Ecuador, they held that *"there is not enough evidence to warrant the well-known status requested by the owner in our country."* Later, they stated that the mark needs to be well-known in the country, per article 6bis of the Paris Convention, therefore *"registrations of the mark in other countries, world sales figures, without a detail of the sales in Ecuador, do not meet the burden of proof for a mark to be declared well-known."*¹⁹

Thus, although the governing law does not require use of the mark in the country to be recognized as well-known, the IEPI requires a degree of knowledge or recognition of the

¹⁶ Fideicomiso Parque Real vs. The Ritz Carlton Hotel Company & The Ritz Hotel Limited, IP Committee Decision No. 042-2012-CPI, June 22, 2012. Trademark RITZ PLAZA.

¹⁷ Galender Assets v. Armaly Sponge Company., IP Committee Decision No. 617-2013-CPI-1S, August 21, 2013. Trademark BRILLO & DESIGN

¹⁸ Nike International Ltd vs. Campomar S.L., IP Committee Decision No. 217-2012-CPI-1S, October 26, 2012. Trademark NIKE cl.03

¹⁹ Procatex Ltda vs. Google, Inc. IP Committee Decision No 939-2013-CPI-1S, November 22, 2013. Trademark GOOGLE.

mark in the relevant sector of the public. It seems that the IP Committee confuses use of the mark with knowledge of the mark, and may sometimes request documentation that is not legally necessary. However, it is clear that their policy is that the mark has to be known in the country, and that they are strict in admitting evidence. Owners of famous marks have failed to meet the burden of proof by relying solely on international evidence and not providing evidence that the relevant sector of the Ecuadorian public knows or recognizes the marks.

Territoriality issues regarding use on the Internet

Article 224 of the Andean Decision states that a well-known mark is protected “*regardless of the way or means by which it became well-known.*” This means that use on the Internet or in any other modern technology is valid.

However, as with the decisions mentioned above, it is necessary to prove that, even if the marks are not used in Ecuador, they are known in the country. In practice, general information about the international notoriety of the mark will not be sufficient – instead, a connection has to be made to the relevant public in the country.

Factors to be considered to enjoy FWKM protection

WIPO’s Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks is substantially recognized in the Andean Decision #486, which regulates Intellectual Property.

It is important to note that these factors need to be connected to the relevant sector of the Ecuadorian public in order to meet the burden of proof required by past decisions.

However, there are some other factors established in the law which only raise more questions, in light of the IEPI’s abovementioned policy regarding the geographical scope of protection.

Article 228 of the Decision states that factors to prove well-known status of a mark are, among others, “the extent to which the mark is known in the relevant sector of the public in any Member Country”; the duration, amplitude and geographical area where the mark is used or promoted, in and outside any Member Country; or the existence or age of any registration or application for registration of the mark in the Member Country concerned or in any other country. These requirements suggest that a well-known mark in any Andean Community country would be protected in the other members, and also suggest that well-

known marks with broad use or promotion in a large geographical area outside a Member Country may also qualify for protection.

In conclusion, while Andean Pact law and Ecuador's IP Law suggest that a trademark can be found famous or well-known based on its use outside the country, the IEPI has sometimes required proof of use of the trademark in the country. Further, while Andean Pact law suggests that a trademark can be considered well-known in Ecuador based on the fact that it is well-known in another Andean Pact country, the IEPI requires proof that the trademark is well-known in Ecuador. Thus, it is important to have a case-by-case analysis, as decisions may provide different and contradictory interpretations of the law.

EL SALVADOR

(Javier Mejía – Mejía, Escobar & Asociados, San Salvador, El Salvador)

In El Salvador, before 1994, which was the year when the Paris Convention became effective, there was not a statute directly dealing with well-known and famous trademarks. When TRIPS was ratified by El Salvador the protection of well-known trademarks was adjusted to also cover service marks.

One of the first rulings [**Case Law**] dealing with well-known trademarks in El Salvador dates back into the year 2000²⁰. The case addressed a bad faith registration by a Salvadoran legal entity named Calvin Klein Company, S.A. de C.V. of the mark "**CALVIN KLEIN**", which back then was a trademark owned by the US Company Calvin Klein Trademark Trust. The court in said case cancelled the unlawful "**CALVIN KLEIN**" registration in favor of its lawful owner, basing the ruling in the "*quantitative and qualitative*" criteria.

The first criteria [*quantitative*] considered the number of individuals familiar with the trademark, and the other criteria [*qualitative*] considered the commercial value of the trademark as a tool for promotion and sale of the products identified by a specific trademark in a particular market. Both factors combined, the court concluded that protection should be granted when the pertinent sector of the public in the territory recognized the mark from its original source.

A ruling issued in 2004 invoking the Paris Convention and TRIPS as binding authority, was the case PAYLESS SHOESOURCE WORLDWIDE INC v. PIEL Y CALZADO, S.A. DE C.V.²¹. In this case, Payless Shoesource Worldwide Inc., filed a claim to obtain the cancellation of the registration COASTER which was registered by the local company Piel y Calzado, S.A. de C.V., basing the claim on the fact that "COASTER" was a well-known

²⁰ Supreme Court-Civil Chamber Ref 1240-2000

²¹ Supreme Court- Civil Chamber Ref 1682-2004

trademark and property of Payless Shoesource Worldwide Inc. The court denied the cancellation action because for a trademark to become well-known, it must achieve widespread recognition in the different markets, but in the end distributors and consumers will be the ones that will confirm if a trademark has reached said status. The recognition as a “well-known” trademark will rest on the efforts made by the lawful owner to promote its use, marketing and widespread recognition in a particular market.

It is important to comment that even with TRIPS, the factors that determine if a trademark should be considered as well-known are not precisely established, leaving the trademark examiner and courts the authority to evaluate on a case-by-case basis which trademarks could be considered well-known in the territory²².

It was not until the Trademark Act of 2002 that famous and well-known marks were addressed by a local statute.

Section 2 of the Trademark Act rules on famous and well known marks as follows:

Well-known distinctive sign: *A distinctive sign well-known by the pertinent sector of the public, or in business circles common to same, as belonging to a third party, which has acquired that quality due to its use in the country or as a consequence of its promotion.*

Famous distinctive sign: *A distinctive sign that is known by the general public, within or without the country.*

In accordance with the case, “well-known”, as a quality, is a higher degree reached by very few marks. It is an aspiration that their owners always have. Achieving this condition implies a level of acceptance by the public that is only a consequence of the success of their branded product or service. In this sense, it cannot be concluded that a trademark or sign is introduced under such a condition.

Moreover, Section 2 of the Trademark Act develops a limited parameter initially introduced by TRIPS, which requires that, in order for a trademark to be considered as “well-known”, it should be known by a large sector of the public, or in the business channels where the products and services using the mark are traded.

In addition, the Trademark Act recognizes in its Section § 9 (d) the prohibition of the use or registration of a reproduction, imitation, translation or transcription, total or partial, of a well-known trademark, when its use is likely to cause confusion or the risk of association.

²² The ruling issued by the Civil Chamber of the SUPREME COURT for the COASTER Case provided that Payless Shoesource Worldwide Inc, failed to prove that the trademark COASTER was “well-known”. In reaching said ruling, the Court considered relevant the testimonial evidence against the documental evidence filed by Payless Shoesource Worldwide Inc.

The aforementioned prohibition strengthens protection against unfair practices, particularly the registration of trademarks which are similar to well-known ones. Consequently, trademark examiners have the authority to reject an application if it is clear that it will likely cause confusion with a well-known or famous trademark.

The Central America-Dominican Republic Free Trade Agreement with the United States (CAFTA-DR) could be considered as an additional tool to protect well-known and famous marks, because Section 15.2.5 sets an obligation to protect and recognize a well-known trademark, even if it is not registered.

Unfortunately, the Salvadoran Trademark Act has a limitation with respect to well-known or famous trademarks, because it does not set in a clear manner the parameters into how it should be determined if a trademark is well-known or famous. In order to overcome this limitation, owners of well-known or famous trademarks have faced the need in all types of cases to file abundant evidence to persuade the trademark examiner or the court that the trademark has reached said status.

In this regard, for a trademark to be considered well-known, the Supreme Court requires two basic factors: “(i) that the trademark had been used intensely within a determined country; and, (ii) that it has a wide recognition in the market where it is used”.²³

Likewise, the Supreme Court has repeatedly indicated that: “it is not the simple registration what raises the well-known category of a trademark, but its dissemination in the different markets. It is the distributor or consumer who will recognize the characteristic of being well-known, thanks to the effort of the owner or user of the trademark to raise it from the category of a common or ordinary mark to that of well-known; characteristic that it is acquired, among other reasons, by the intensity of its use, by its prestige in the market and by how wide-spread its recognition is”.

According to the decision issued by the Supreme Court in case *M FERNANDEZ y COMPAÑÍA S.A. v. IMPRENTA WILBOT S.A. de C.V.*²⁴ in order to establish whether a trademark is well-known, the following should be taken into account: (a) The extent to which it is known to the public as the distinguishing trademark of the goods or services for which it was granted registration; (b) The scale and scope of the dissemination and advertising or promotion of the mark; (c) The period of time for which the trademark has been in use; (d) Analysis of the manufacturing and marketing of goods identified by the trademark.

With regard to “**famous trademarks**” we have found a limited number of cases where the Court dealt with famous trademarks. We have reviewed a case [230-2010] ruled by the

²³ Supreme Court of Justice -number: 230-2010

²⁴ Civil Chamber-Supreme Court 193-CAM-2009

Supreme Court and in said case, which involved the *British American Tobacco Central America, S.A v. The Coca Cola Company*, the court provided that *famous marks are those that have wide-spread recognition that covers different groups of consumers of diverse markets*. In addition, it found that *its knowledge as an indicating sign of an entrepreneurial source extends to all the public in general*.

As mentioned before, the absence of guidelines in the relevant statutes as to how to determine if a trademark is well-known or famous, is a difficult factor for some owners, especially if the trademark is not registered in the territory. Therefore, there is expectation that as more “Case Law” develops, the standards regarding when a trademark could be considered well-known or famous, and the evidence to prove it, will be clearer for practitioners.

GUATEMALA

(Karina Calderón – Comte & Font Legalsa, Guatemala City)

Guatemalan law recognizes well-known marks (“*marcas notorias*”) in connection with Art 6 *bis* of the Paris Convention and Art 16 of the TRIPS Agreement.

Article 4 of the Industrial Property Law defines a well-known mark as any sign known or recognized in the relevant sector of the public, or in business circles, as a consequence of its use in the country or the promotion of the mark, including through advertising or publicity of the goods or services to which the mark applies.

Article 21 c) of the Law provides protection for well-known marks even if they are not registered in the country. This article prohibits the registration of a mark if it constitutes a reproduction, an imitation, a translation, or a transliteration of an unregistered, well-known mark, in respect of any goods or services to which the well-known mark applies, if the use or registration is liable to create confusion or risk of association with a well-known mark, or if use of that mark would take unfair advantage of the distinctive character of a well-known mark, or impair in an unfair manner the distinctive character of a well-known mark.

Article 35 a) of the Law allows the owner of a well-known mark to oppose the registration of a mark which is in conflict with its well-known mark, takes unfair advantage of the well-known mark, or impairs in an unfair manner the distinctive character of the well-known mark. Also, the owner of a well-known mark is entitled to request the nullity, by decision of competent authority, of the registration of a mark which is in conflict with the well-known mark.

According to the Law, in determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well-known, which include, in particular, the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of diffusion, advertising or publicity of the mark; the duration, extent and geographical area

of any use of the mark; and the analysis of production and marketing of the type of goods and/or services to which the mark applies.

The relevant sector of the public includes the actual and/or potential consumers of the type of goods and/or services to which the mark is applied; persons involved in channels of distribution of the type of goods and/or services to which the mark is applied; and business circles dealing with the type of goods and/or services to which the mark is applied.

In sum, use of a mark in Guatemala is not required for a mark to be found well-known, although use in the country is helpful. Proof that a mark is well-known outside Guatemala is relevant, if it helps to establish that the mark is known and recognized within Guatemala as well. While the outcome of each specific case will depend on the type of evidence filed and the criteria adopted by the court, it is unlikely that a mark will be found to be well-known in Guatemala based solely on proof that the mark is well-known outside the country.

MEXICO

(Luis Pavel Garcia Costinica – Costinica & Asociados Abogados, Mexico City)

The difference between famous and well-known trademarks

The Mexican Intellectual Property regulations concerning famous and well known trademarks are consistent with Article 6*bis* of the Paris Convention, Article 1708 of North American Free Trade Agreement (**NAFTA**), Article 16 of Trade-Related Aspects of Intellectual Property Rights (**TRIPS**), and with the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (**WIPO**) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO from September 20 to 29, 1999.

Famous and well-known trademarks are regulated by Chapter II *bis* of the Mexican Intellectual Property Law (**MIPL**), and the Mexican Institute of Industrial Property (**IMPI**) is the administrative authority empowered to apply such regulations²⁵.

²⁵**IP LAW. ARTICLE 6.** “The Mexican Institute of Industrial Property, the administrative authority in industrial property matters, is a decentralized body with legal personality and its own assets, which shall be empowered to:

...

III. Process applications for and, where appropriate, grant invention patents and utility model registrations industrial designs, trademarks and advertisements, issue declarations to the effect that trademarks are well known or famous, issue declarations of protection for appellations of origin, authorize the use thereof, publish commercial names and also record renewals thereof and the transfer or licensing of their use and exploitation, and such other powers as are conferred on it by this Law and the regulations thereunder, for the recognition and preservation of industrial Property rights;

...

The principle of territoriality also applies in México, so the fact that a trademark enjoys protection in a foreign jurisdiction has no bearing on its enforceability in México. Nonetheless, foreign registrations and declarations of notoriety or fame could be considered strong evidence, not only to obtain a trademark registration in Mexico, but also a declaration of notoriety or fame.²⁶

Mexico recognizes both categories, “famous trademarks” (“*marcas famosas*”) and “well known trademarks” (“*marcas notoriamente conocidas*”), differentiating between them by the amount of people who are aware of the trademarks. Accordingly, a trademark shall be considered:

- **“Well known”**: when a given sector of the public or of the Mexican business circles is aware of the trademark as a result of business activities conducted in Mexico, or abroad by a person who uses the trademark in connection with his goods or services, or as a result of the promotion or advertising thereof; or
- **“Famous”**: when most of Mexican consumers are aware of the trademark.

How to obtain recognition

The recognition of famous or well-known status of a trademark can be reached by estimation or declaration of the IMPI. Article 98 *bis* and subsections XV and XV *bis* of the Mexican Intellectual Property Law entitle the IMPI to:

- a. Issue a declaration of notoriety or fame for a trademark registration; or
- b. Issue an administrative decision considering a trademark famous or well-known.

Declaration of Notoriety or Fame

A specific procedure to obtain a declaration of notoriety or fame for a trademark has already been defined in the MIPL. Owners of a Mexican trademark registration can file an application before the IMPI to achieve this recognition.

Following the procedure laid down by the Law, a declaration of well-known status or fame will be issued by the IMPI based on the evidence provided by the applicant. Such evidence

X. Carry out the legal publication, through the Gazette, and disseminate information derived from patents, registrations, declarations of notoriety or fame of brands, authorizations and publications granted and any other information relating to industrial property rights conferred by this Law ...”

²⁶ Thesis: I.4o.A.60 A Page: 972, Ninth Epoch, Register: 203005. Circuit Collegiate Courts. Semanario Judicial de la Federación y su Gaceta Tomo III, March 2006.

must show that the conditions of notoriety or fame are in effect at the time the declaration is issued.

In this case, the trademark must be registered in Mexico to protect the products or services in which the notoriety or fame of the trademark originated. In general, use of a mark is not required for registration, but in order to achieve a declaration of notoriety or fame, use of the mark must be shown in México or abroad.

In accordance with Article 98 *bis*-2 (MIPL), some of the evidence an applicant must submit with the application to obtain a declaration of notoriety or fame are:

- (i) The sector of the public comprising real or potential consumers who identify the trademark with the products or services which it protects, based on a market survey or study or any other method permitted by law;
- (ii) Other sectors of the public, excluding real or potential consumers, that identify the trademark with the products or services which it protects, based on a market survey or study or any other method permitted by law;
- (iii) The commercial circles comprising traders, industrialists or service providers connected with the type of products or services, who identify the trademark with the products or services protected by the trademark, based on a market survey or study or any other method permitted by law;
- (iv) The date of first use of the trademark in Mexico and, where applicable, abroad;
- (v) **The period of continued use of the trademark in Mexico and, where applicable, abroad;**
- (vi) The marketing channels in Mexico and, where applicable, abroad;
- (vii) The methods of disseminating the trademark in Mexico and, where applicable, abroad;
- (viii) The period of actual advertising of the trademark in Mexico and, where applicable, abroad;
- (ix) The investment made during the previous three years in advertising and promoting the trademark in Mexico and, where applicable, abroad;
- (x) The actual geographical area of influence of the trademark;

- (xi) The sales volume of the products or the revenue received from the provision of the services protected by the trademark, during the previous three years;
- (xii) The economic value represented by the mark in the shareholders' equity of the company owning the trademark, or in accordance with a valuation of the company;
- (xiii) The registrations of the trademark in Mexico and, where applicable, abroad;
- (xiv) The franchises and licenses that have been granted with respect to the trademark; and
- (xv) The percentage of the share of the trademark in the relevant market sector or segment.

A well-known or famous declaration will be in force for five years from the date of its issuance, unless evidence is submitted to prove that the condition of fame or notoriety has ended.²⁷

Administrative decision considering a trademark famous or well-known

Before the procedure to obtain a declaration of notoriety or fame described above was established (June 16, 2005), IMPI was entitled to consider a mark famous or well-known without a specific procedure, and its power to do so remains in force.

Regardless of whether a mark is registered or not, whether it has been declared famous/well-known or not²⁸, and/or whether it has been used or not in Mexico, IMPI is entitled to consider it famous or well-known based only on the examiner's own criteria and prior knowledge, in order to prevent a famous or well-known mark from being harmed:

ARTICLE 90. *The following may not be registered as trademarks:*

²⁷ **ARTICLE 98 bis .3.** "The Institute shall assume, except where there is evidence to the contrary, that the conditions which gave rise to the declaration or its updates shall persist for a period of five years from the date of issuance; consequently, during that period, the impediment provided for in Article 90, subparagraph XV, or the provisions of subparagraph XV *bis*, shall apply, as applicable, expeditiously.

The declaration may be updated at any time, at the request of the person with a legal interest in such, provided that the person proves that the conditions which gave rise to said declaration persist on the date of the relevant application."

²⁸ **IP LAW. ARTICLE 98 bis.1.** "The declaration or any updates issued shall constitute an administrative act by means of which the Institute declares, based on the evidence provided, that the conditions by virtue of which a trademark is well known or famous persist at the time that the act is issued.

The impediments provided for in ARTICLE 90, subparagraphs XV and XV *bis*, for the protection of well-known or famous trademarks, shall apply independently of whether those trademarks are registered or declared."

*Names, figures or three-dimensional shapes identical or similar to a trademark that **the Institute considers or has declared** well known in Mexico, to be applied to any product or service.*

XV bis. *Names, figures or three-dimensional shapes, identical or confusingly similar to a trademark **the Institute considers or has declared** famous under the terms of Chapter II bis, to be applied to any product or service.*

Due to the aforementioned provisions, it may be thought that IMPI may consider a mark as famous or well-known without any evidence, simply by considering the condition of notoriety or fame as a known fact. *(Relying on procedural theory, known facts are considered to be true and consequently are excluded from this burden of proof.)*²⁹ Nevertheless, in order to keep decisions objective and duly supported, IMPI must provide legal grounds and arguments backing up such decisions. In fact, this is an essential formality to comply with the principles of legal certainty and rule of law enshrined in the Mexican Constitution.

IMPI may consider a mark famous or well-known in response to an argument asserted by the party which has legal interest in the mark in any litigation related thereto.

Administrative procedures followed by IMPI in the form of a trial give the involved parties the opportunity to show evidence supporting their respective positions; therefore the relevant party may claim the fame or notoriety of its trademark in order for its mark to prevail over the counterpart's interest. It is important to note that the evidence which must be shown to establish the condition of fame or notoriety of a trademark could be substantially the same listed in article 98 bis-2 of the MIPL.

IMPI is required to analyze the evidence offered by the parties and must issue a final decision answering all arguments raised, including the recognition of the condition of fame or notoriety of a trademark which has been alleged by either party. The estimation of fame issued through this procedure in essence will provide the same scope of protection as a declaration of notoriety or fame; nevertheless, the estimation will not be published in the Official Gazette as it will be in the case of a declaration of notoriety or fame.

The declaration of estimation via an administrative resolution for a trial can be used as strong evidence in the procedure to obtain a declaration of notoriety or fame. Keeping in mind that the condition of fame or notoriety of a trademark is based on circumstances

²⁹ Thesis: Isolated Page: 2643, Fifth Epoch, Register: 356378. Supreme Court of Justice Third Chamber. Semanario Judicial de la Federación y su Gaceta Tomo LVIII.

which exist in a specific gap of time and place, the declaration cannot be considered permanent or indefinite.

Final resolutions issued by the IMPI in the trial form of administrative procedures can be appealed before the Federal Tax and Administrative Court, which is also compelled to issue a sentence resolving all the issues in controversy claimed by the parties, including the recognition of the fame or notoriety of a trademark when it was asserted.

Scope of Protection

Mexican trademarks are governed by the “Principle of Specialty”. Consequently, a trademark can be registered to distinguish only certain products or services of a specific class of the Nice classification, and no multiclass applications are allowed.

A declaration or estimation of notoriety or fame is an exception to such principle and allows the owner to increase the scope of protection of the relevant trademark. This new scope of protection prevents third parties from obtaining registrations for marks identical or confusingly similar to the one considered famous or well-known by IMPI, regardless of the class in which the new trade mark applications are filed.

Subsections XV and XV *bis* of Article 90 of the MIPL establish the scope of protection for a well-known trademark and a famous trademark, respectively, in relation to later applications for the registration of identical or similar signs.

It is very important to note that sections XV and XV *bis* of article 90 of the MIPL are applicable regardless of whether the trademarks considered famous or well-known are registered or declared in Mexico.

Well-known trademarks can be considered as grounds to refuse registration of marks identical or similar to the marks considered or declared well-known to be applied to any product or service, **when the use of the mark applied for registration could:**

- (i) cause confusion or risk of association with the owner of the well-known trademark; or
- (ii) constitute an unauthorized appropriation of the well-known trademark; or
- (iii) cause the discredit of the well-known trademark; or
- (iv) dilute the distinctive character of the well-known trademark.

By way of comparison, a famous trademark can be considered as grounds to refuse registration of a mark identical or similar to the mark considered or declared famous to be applied to any product or service.

In sum, there is no requirement that a trademark be used in Mexico in order to be considered a famous or well-known mark, and evidence that a mark is notorious outside Mexico is considered relevant. However, in order to be declared famous or well-known, there must be proof that the mark is famous or well-known in Mexico itself.

PANAMA

(Edwin Molino – Jiménez, Molino & Molino, Panama City, Panama)

This report focuses on the following issues:

(i) Specific legislation on geographical scope of protection

The Panamanian legislation on Intellectual Property is comprised of the following statutes:

- Law No. 35 of 1996 modified by Law No. 61 of 2012 (hereinafter, “the Law”).
- Paris Convention for the Protection of Industrial Property (Law No. 41 of 1995)
- Agreement on Trade-Related Aspects of Intellectual Property Rights (Law No. 23 Of 1997).

The scope of protection covers famous and well-known marks.

The Law defines both famous and notorious marks as follows:

Article 95. A famous or renowned mark shall be the one that, as a result of its intensive use in the market and in advertising, has spread widely without losing its distinctiveness, and is known by the general public. A well-known trademark shall be the one that has the same characteristics, and is known by the consumer group to which it is intended.

The Trademark Office can reject an application, which covers different or unrelated goods/services, if it is similar to a well-known or famous mark.

Article 91: The following cannot be registered as trademarks, or as elements thereof:

10. Those that are identical or similar to a famous or renowned brand, to be applied to any product or service; or those notorious or well-known, to be applied to specific products or services according to the consumer group to which they are intended;

Article 147 of the Law also limits the publication of company names that violate any of the restrictions of Article 91, therefore involving well-known and famous marks.

(ii) Trademark Office regulations regarding geographical scope of protection

The Trademark Office is not in charge of issuing regulations or formally recognizing famous and well-known marks in Panama. Any type of recognition or declaration of famous and well-known status of a mark is under the jurisdiction of the commercial courts.

(iii) Case law / Trademark Office decisions recognizing/dealing with geographical scope of protection.

In the case between AGENCIAS MOTTA v. COPAMEX INDUSTRIA S.A. DE C.V., Case Law N°2000S.A.35 of August 1st, 2000; the Commercial Superior Court confirmed the difference between a famous and a well-known mark in Panama, since the first is applicable to all goods and services, and the later just to the same type of products/services.

In this case, the Circuit Court recognized the mark “Love Lee” as a well-known mark in class 3 and on such basis rejected the application for trademark “Lovely” for products in class 16. However, the Superior Court considered that the plaintiff only proved that the mark “Love Lee” was well-known in connection with goods covered in class 3, and allowed registration of “Lovely” in class 16.

“The rule of specialty breaks:

1. When the mark is famous or; 2. When a notorious mark is reproduced or imitated or; 3. When the use of the well-known trademark is related to goods of the same class, or in connection with other goods aimed at the same consumer group classes. In the present case, the comparison of the goods covered by the marks at issue reveals that they are not identical, or similar, or belonging to the same class, or related classes.

Within class 3 there are products that have an affinity with others, for example, soaps and perfumes; but there are also others that are unrelated. It would therefore be a forced interpretation to extend protection of a mark that distinguishes cosmetics, even if it is well-known, to paper products located in class 16 under the excuse that use of cosmetic products in the majority of cases also involve the use of products covered by class 16. This statement is without prejudice to what we said earlier on cases of imitation, or pure and simple reproduction of a well-known trademark.

To summarize, we can accept that the brand "LOVE LEE" is notorious or well-known, but not famous or renowned; cosmetics for hair and paper products bear no identity, similarity or connection, and are aimed at different consumer groups. It does not appear that the contested mark imitates or reproduces the mark of the applicant; therefore, the conflicting marks can coexist. However, the Court recognizes that the debated issue is complex and that the applicant brought its action in good faith and proved notoriety, so it will not be sanctioned to pay the litigation expenses of the other party."

(iv) Admissibility of evidence of famous or well-known status in foreign countries

Panamanian Legislation allows evidence of foreign use or registration to establish a better right over a trademark. Any evidence (local or foreign) showing that a mark is famous or well-known is admissible. However, it is also important to show that the mark is famous or well-known in Panama.

(v) Geographical scope of protection necessarily requiring use in country at issue

In Panama, use is not required to achieve protection of a famous or well-known mark. Yet, it is important to provide evidence that the famous mark is known to the Panamanian public in general, or to specific consumers in the case of a well-known mark.

(vi) Final comments

The Panamanian legislation does not establish the requirements to obtain a declaration of famous or well-known status, and the Courts have only recognized these type of marks on a case-by-case basis, so improvements and changes are needed.

PARAGUAY

(Laura Lezcano – Zacarías & Fernández, Asuncion)

In Paraguay's legislation, there is no definition of famous or well-known trademarks. Nonetheless, among the prohibitions regarding non-registrable signs, the TM Law includes ***"signs which constitute a reproduction, imitation, translation, transliteration or transcription in full or in part of an identical or similar distinctive sign, well known to the public in the corresponding sector and belonging to a third party, or take***

advantage of the notoriety of the sign or dilute its distinctive character, irrespective of the manner or way in which the sign was made known” (art. 2 g). Hence, making an interpretation of this article, there are at least two consequences: (i) we can be sure that in Paraguay, in order to evaluate if a trademark is well-known (“notoria”), we have to consider only the sector involved and not the whole market; (ii) legally speaking, the PTO should refuse applications based not only on the fact that it is a reproduction of a well-known trademark, but also if the application is an imitation or translation or transliteration of a well-known trademark.

It is important to bear in mind that in Paraguay, the owner of a trademark does not need to prove use at the administrative level in order to obtain, maintain or renew a registration, regardless of whether the trademark is well-known.

However, Trademark Law provides for the mandatory use of trademarks. Furthermore, a registration can be cancelled if the trademark has not been used for a period of five consecutive years. Cancellation can only be requested by an interested party through the courts. It cannot be done automatically by the National Directorate of Intellectual Property or in proceedings heard before it.

Moreover, **inter-class use** is admitted in our legislation and there are no partial cancellations. In other words, the use of a trademark in relation to even one of the goods or services of a class will suffice to prevent the cancellation of the trademark in the whole class, as well as in other classes in which the trademark is registered.

While the Paraguayan TM Law is silent about whether use should be national or international, the TM Decree establishes the **international use** rule. There have always been questions about whether this provision of the TM Decree is legal, as it merely clarifies the text of the TM Law, or whether it is unconstitutional for having gone beyond the text of the TM Law and the understanding that the lack of any reference in the Law to “international” should be deemed as “national”, since this is the regular scope of any domestic law. Nonetheless, there has not been any case law on this issue up to now. Hence, so far, the rule in Paraguay is international use.

Considering this broad approach to use, in Paraguay, internet use of a trademark is not very controversial. Paraguayan TM Law specially sets forth that advertising shall also be deemed use of the mark, provided that such use actually occurs within four months following the start of the advertising campaign. Indeed, in all cases nowadays (and not only for well-known trademarks), international use of the mark suffices to defend against cancellation for non-use.

The judiciary has clearly and consistently stated that the notoriety of a trademark has to be proved. Nonetheless, if a trademark is famous, no proof is necessary³⁰. Furthermore, the judiciary has also found that the scope of protection of well-known trademarks exceeds the specialty principle. In other words, there is inter-class protection. Hence, dilution is also avoided, particularly in well-known trademarks³¹.

Finally, it is important to note that well-known trademarks are registered in Paraguay and many of them are not being used in the country (e.g., STARBUCKS and WENDY'S). One relatively recent example of this is PEPSI, which has been registered in Paraguay since 1980. This trademark was used in Paraguay for several years but then the company decided to stop doing business in Paraguay. In 2011, after approximately 10 years, Pepsi returned to Paraguay, and, at least publicly, the registration of the trademark was never challenged. This is an example of a trademark being famous in Paraguay without being used during a period of time.

Summing up, it is not necessary that a trademark be used in Paraguay to be considered well-known in the country, and proof of notoriety of the trademark outside the country can be used to establish that the mark is well-known in the country. However, the evidence submitted must show that the trademark is well-known in Paraguay.

PERU

(Francisco Espinosa Reboa – Estudio Francisco Espinosa Bellido Abogados, Lima)

A.- National provisions regarding protection of FWKM including comments on whether these make a difference between Famous and Well-Known character and whether they set use as a requirement to enjoy protection

Famous and well-known trademarks are regulated in Peru by articles 224 to 236 of Decision 486 of the Andean Community, Common Industrial Property Regime for all the Andean Community countries (Bolivia, Colombia, Ecuador and Peru).

Decision 486 only makes reference to “marcas notoriamente conocidas” (well-known trademarks), and define them in the following way.

³⁰ Administrative Court decision in the case ARGENCARD S.A. vs. Res. N° 19 dated 05/Feb/02, issued by the Litigious Affair Secretariat and Rr. Nr. N° 230 dated 06/Dec/02, issued by The Head of the Intellectual Property Office (Ac. y Sent. N° 59) , Published in: LLP 01/Jan/1900, 890;
Administrative Court decision in the case PFIZER INC. vs. Res. N° 141 dated 08/Mrch/2002, issued by the Litigious Affair Secretariat and N° 440 dated 31/Oct/2003, issued by the Head of the Intellectual Property Office (Ac. y Sent. N° 116). Published in: LLP 2009 (March), 242.

³¹ Supreme Court in the case Yahoo Inc. vs. Res. 449/04 issued by the Head of the Industrial Property Office (Ac. y Sent. N° 744) Published in: LLP 01/Jan/1900, 1171.

DECISION 486

Article 224. - A well-known distinctive sign is understood to mean a sign that is recognized as such **in any Member Country** by the pertinent sector, independently of the way or means by which it was made known.

There is no reference to other categories of highly recognized trademarks, such as “famous” trademarks.

Regarding use of the trademark as a requirement in order to obtain recognition for well-known trademarks, Decision 486 provides the following:

Article 228. - In order to determine whether a distinctive sign is well-known, due account shall be taken of the following criteria among other things:

a) The extent to which it is known **in the relevant sector of the public in any Member Country**;

b) The age of the distinctive sign and the size of **the geographical area where it is used in and outside any Member Country**;

c) The age and the size of **the geographical area where the distinctive sign is promoted, in or outside any Member Country**, including its advertising and presentation at fairs, exhibitions, or other events in connection with the goods or services, the establishment, or the activity to which it is applied;

d) The value of all investments made in promoting the distinctive sign or the establishment, activity, goods or services to which it is applied;

e) Figures for the **sales and income** of the owner, **both at the international level and in the Member Country where protection is being sought**, in respect of the distinctive sign whose well-known character is alleged;

f) The extent of the inherent or acquired distinctiveness of the sign;

g) The book value of the sign as a corporate asset;

h) The volume of orders from persons interested in obtaining a franchise or license to the sign in a specific territory; or,

- i) *The existence of significant manufacturing, purchasing, or storage activities by the owner of the sign in the Member Country where protection is being sought;*
- j) *The international trade-related aspects; or,*

Article 229. - *The well-known nature of a sign shall not be denied solely because:*

- a) **it is not registered or in the process of being registered in the Member Country concerned or in any other country;**
- b) **it has not been nor is it being used** *to distinguish goods or services or to identify activities or businesses in the Member Country concerned;* or,
- d) **it is not well-known abroad.**

Article 230. - *The following, among others, shall be considered pertinent sectors of reference for purposes of determining whether a sign is well-known:*

- a) *The real or potential consumers of the type of goods and services to which the sign shall be applied;*
- b) *The persons involved in the channels of distribution or marketing of the kinds of goods or services to which the sign shall be applied; or,*
- c) *The commercial circles operating in lines of business connected with the kind of establishment, activity, goods, or services to which the sign applies.*

It shall be sufficient, for the purpose of recognizing the well-known character of a sign, for it to be known within any of the sectors referred in the previous paragraphs.

The legal requirement in Article 229 b) expressly provides that use of the mark in the corresponding Member Country where the analysis is being made **is NOT a necessary requirement** to recognize the well-known status of a mark.

Moreover, the provisions included in paragraphs b), c), e) and k) allow the consideration of the circumstances of use and promotion of a trademark at the international level in order to determine if the trademark is well-known in the Member country.

Also, paragraph a) of Article 228 makes reference only to “the relevant sector of the public in any Member Country” and just refers to “the extent to which (*such trademark*) is known”

by that public, allowing that knowledge to be a product of the international use, fame and advertising, and not necessarily of actual use of the trademark in the Member Country.

B. - National case law regarding protection of non-used FWKM and/or dealing with geographical issues as a factor to enjoy such protection

The following resolutions show the treatment of geographical factors when analyzing a well-known trademark:

Peruvian case law:

- a) Resolution No. 0526-2014/TPI-INDECOPI dated 21 April, 2014 and issued in the application file No. 491970-2012, in which the Intellectual Property Specialized Chamber for the Board of Appeals of the Peruvian Trademark Commission (INDECOPI) provides a complete analysis and thorough example not only of the criteria to determine if a trademark is well-known, but also regarding the interpretation of the territoriality issues with regard to the recognition of the well-known status of a trademark under the provisions of Decision 486.

Some of the most relevant citations from that analysis are the following:

“Regarding the territoriality principle, it is concluded from article 224 of Decision 486 that it will not be negated the well-known status of the sign that is not such on the Member Country where protection is requested; it is enough that it is well known in any of the Member Countries.

Also, with respect to the question if in order to recognize the well-known status of a mark it is necessary that it is registered or in use, the Court of Justice of the Andean Community, in its prejudicial interpretation of the Process 029-IP-2008 has mentioned that “the communitarian law does not require the registration of the well-known sign as an indispensable requirement for its recognition as well known.

Moreover, in the Process 24-IP-2009 it is indicated that:

‘In accordance with article 229, literal a), the well-known status and protection will not be denied only because it is not registered or in the process of registration in the Member Country or abroad. Therefore, a sign can be protected as well-known even if it is not registered in the respective Member Country, and consequently protection is granted to those signs that reach the well-known level, even if they are not registered in the corresponding territory.

Likewise, the protection granted by Decision 486 to the well-known trademark goes beyond the requirement of effective and real use of the mark, which supports figures such as the cancellation of registration for non-use. Indeed, article 229, literal b) provides that well-known status of a sign will not be denied just because it has not been used or it is not being used to identify goods and services, or to identify activities or establishments in the Member Country’.

Andean case law:

- b) Resolution No. 170-IP-2013 dated October 08, 2013 issued in the internal file No. 2007-0305, PHILIP MORRIS PRODUCTS S.A. v. PRODUCTORA TABACALERA DE COLOMBIA S.A. PROTABACO S.A. (“PROTABACO”), in a Prejudicial Interpretation requested by Civil Circuit Court 19 from the Republic of Colombia.

The above resolution makes express reference to the territoriality issues with regard to the recognition of the well-known status of a trademark under the provisions of Decision 486. The pertinent citations from that analysis are the following:

*“Regarding the territoriality principle, it is concluded from article 224 of Decision 486 that **it will not be negated the well-known status of the sign that is not such on the Member Country where protection is requested; it is enough that it is well known in any of the Member Countries.***

The purpose of that provision is avoid that competitors take advantage of the competitor’s effort and, in a parasitic manner, usufruct the prestige acquired by a well-known mark which although not used in the respective Member Country, is still well-known in other countries. It should be noted, however, that the proof of notoriety of the sign should meet the other criteria of use of the sign in the marketplace, since it shall comply with the contents of article 228 of Decision 486 from the Andean Community.

As mentioned with regard to the legal provisions concerning territoriality, both the Peruvian trademark authorities as well as the Andean IP court recognize that:

- (i) Use of the mark in the corresponding member Country where the analysis is being made is not a necessary requirement to recognize a well-known mark.
- (ii) In order to recognize the well-known status of a trademark in Peru or any of the Andean Community countries, it must be well-known in the relevant sector of the public in any Member Country, regardless of the way or means by which it was made known.

- (iii) Several criteria is taken into account in order to analyze if a trademark is well-known in Peru or the Andean Community countries, and most of it can be demonstrated with respect to a Member Country or internationally, such as the amount of time and the size of the geographical area where the distinctive sign is used, the amount of sales and the extent of trademark protection for that trademark.

Although use of the trademark in a Member Country is not a legal requirement, in reality it may be difficult to recognize, and specially demonstrate the well-known status of a trademark within any of the Member Countries only because of its international use and recognition, and without actual use in the region.

Territoriality issues regarding use on the Internet

Since actual use in the Member Country or Member Countries is not a legal requirement to recognize the well-known status of a trademark under the provisions of Decision 486, there should be no relevant issues in connection with determining the territoriality of trademark use on the internet.

In the above cited Resolution No. 0526-2014/TPI-INDECOPI the Intellectual Property Specialized Chamber for the Board of Appeals of the Peruvian Trademark Commission (INDECOPI) recognizes that any evidence may be admitted to demonstrate the well-known status of a mark, and expressly mentions some new types of evidence resulting from the development of international commerce, and the modern means of communication, transport and promotion in the global marketplace.

Therefore, use and promotion of a trademark on the Internet should not create any uncertainty in assessing the well-known status of a trademark within the Andean Community countries, although such evidence may become more relevant in cases where the website is specifically directed to or has a portion that is specifically directed to Latin American countries, or any of the Andean Community countries, with particular and customized content.

Likewise, it should also be taken into account whether it is possible to buy or request the goods or services online, directly from the corresponding Andean Community country.

“For that purpose the parties may submit any evidence admitted in the administrative procedure, such as: invoices, diverse advertisement, polls from consumers or industrial circles, registration certificates of the mark in foreign countries, product inventory, market research, documents that demonstrate the amounts invested in publicity and promotion of the brand. Aside from these traditional elements of evidence, other elements of possible evidence originated in the development of foreign commerce and the modern media of transportation,

communication and promotion in the global marketplace are starting to become recognized, such as advertising related to touristic exchange (magazines distributed in flights by airline companies), volume of requests by people interested in obtaining a franchise or trademark license in a given territory, manufacturing, sale or storage activities by the owner of the mark in the territory where protection is sought, effects of residual advertising (understood as the one that remains in the mind of the consumer after having received an advertising message) projected from one territory to another, international broadcast of sporting events and entertainment events in which advertising content exists, etc.”

URUGUAY

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(i) Specific legislation on geographical scope of protection

In Uruguay, the protection of trademarks is ruled by Trademark Act No. 17.011, the Paris Convention and TRIPS Agreement, both treaties to which Uruguay is a signatory.

The Uruguayan Trademark Act does not have a specific definition or provision regarding famous/well-known marks as in other jurisdictions. Besides that, there is no actual differentiation between famous and well-known marks. Even so, well-known marks are recognized and considered in the Trademark Act in relation to nullity actions. Article 5 establishes that *“Under the present Act the following may not be registered as marks and shall incur relative nullity: Subsection 6: Signs or words which are a reproduction, imitation or a full or partial translation of a **well-known mark** or trade name”*.

Paris Convention and TRIPS provisions, which are recognized by the Law, both mention the protection of well-known marks, and refer to the geographical scope of protection.

Uruguayan Law adopted Art. 6 *bis* of the Paris Convention in its entirety in relation to well-known marks:

1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known **in that country** as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

3) No time limit shall be fixed for requesting the cancellation or the prohibition of use of marks registered or used in bad faith.

TRIPS Agreement in its Article 16, also refers to famous and well-known marks and adds elements to the Paris Convention protection scope.

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

2. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge **in the Member concerned** which has been obtained as a result of the promotion of the trademark.

3. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

In relation to famous trademarks, the Mercosur Protocol of Harmonization, in article 9.6 states that “Party States shall assure in their respective territories the protection of the trademarks that have become **exceptionally well-known** and belong to nationals of the Party States; said protection shall be against the duplication or imitation of said trademarks, in any line of activity, provided that there is a chance that damage will be caused”.

(ii) Trademark Office's regulations regarding geographical scope of protection

There are no specific Trademark Office regulations regarding the geographical scope of protection of famous and well-known marks. Resolutions are based on the legislation and treaties mentioned on point 1.

Based on this, we can affirm that the Trademark Office requires that on a case-by-case basis the interested party prove that the mark is well-known for an important range of consumers in the Uruguayan territory.

Actually, in this globalized era in which borders are blurred, if the evidence filed in a case is vast and covers the usual aspects required by our Trademark Office i.e. history of the mark, foreign registrations, advertisement, publications, brochures, balance sheets, and awards, and the evidence is filed with the proper formal aspects, the Trademark Office will recognize the notoriety of a mark, even if there is no specific evidence regarding Uruguay.

(iii) Case law / Trademark Office's decisions recognizing/dealing with geographical scope of protection

Cancelation action before the Contentious Administrative Court, filed by ESPRIT INTERNATIONAL v. the Trademark Office's resolution that granted trademark AMERICAN ESPIRIT "...the notoriety evidence in relation to the trademark requires said notoriety to take place in national territory. In addition –as interpreted previously- the "well-known" provision requires recognition of the mark in the country through advertisement or promotion, with no need of commercialization in Uruguay".

(iv) Admissibility of evidence of famous or well-known status in foreign countries

As stated previously, our practice requires that we prove the notoriety in Uruguay. Even so, in the actual practice, evidence showing that the mark has been considered as famous or well-known in other jurisdictions is of course admissible and useful in most cases, more so if it refers to countries in our region.

However, it is important to point out that evidence of notoriety status decreed in other countries is not decisive or mandatory for our administration or courts.

(v) Geographical scope of protection necessarily requiring use in country at issue

The lack of actual legislation forces us to evaluate these matters based on case law. We can confirm that in Uruguay there is recognition of well-known marks, **even if they are not being used in our country**. Use is not a requirement for a trademark to obtain protection based on notoriety.

VENEZUELA

(Dana Bentata – Bentata Abogados, Caracas)

Well-known marks (“*marcas notoriamente conocidas*”) have not been expressly regulated in Venezuela since September 12, 2008. Despite the country having formally withdrawn from the Andean Community on April 22, 2006, on September 12, 2008, the Autonomous Service of Intellectual Property (SAPI) published an official notice indicating that, in view of the withdrawal from the Andean community, it would ENTIRELY apply the 1955 Intellectual Property Law going forward. This has been SAPI’s position since that date.

However, it may still be possible for trademark owners to argue that their trademarks are well-known in Venezuela due to the following reasons:

First, Venezuela is a member of the Paris Convention.

Second, the 1955 Law provides, in Article 33 (12), as a basis for opposition, that a mark which is “confusingly similar to a registered mark that could lead to error as to the source or quality of the product” cannot be registered. The Venezuelan Supreme Tribunal of Justice, back before the country became a member of the Andean Pact, interpreted that “notorious” trademarks could be embraced by the Article (the NINTENDO case is an example).

Due to the fact that Venezuela has a huge backlog of opposition proceedings, the following information is also important:

On July 4, 2012, the Supreme Tribunal of Justice interpreted Art. 153 of the Venezuelan Constitution, holding that, upon the coming into effect of a new law, the substantive arguments must be decided based on the law at the time of a trademark opposition, and that only from a procedural standpoint should the local law (the Law of 1955) be applied. This means that oppositions which were filed based on the argument that a trademark was well-known under Andean Decisions 313, 344 and, subsequently, 486, should be decided based on Andean Pact law and not the current Venezuelan Industrial Property Law of 1955.

SAPI has respected this decision: on January 26, 2015, a Resolution regarding the registration eligibility of trademark SPIZZICO (DESIGN) was published in the Official Bulletin, and despite the fact that SAPI cites the wrong Andean Law (Decision 486), it does apply Andean Community law, respecting Article 153 of the Venezuelan Constitution.

However, SAPI has not been favoring oppositions based on well-known marks. Between August 2012 and January 2015 (the most recent published decisions on oppositions, dating from between May 1996 and September 2001), SAPI has never issued a declaration of notoriousness. It nevertheless seems to have considered the argument:

even oppositions based on marks previously declared notorious by SAPI, which were not recognized, were rejected on the reasoning by SAPI that “notoriousness is a variable fact in time”.

In conclusion, while under the governing law, the Industrial Property Law of 1955, well-known marks are not expressly regulated, notorious marks may be protectable under Article 33(12) of the Law, and, at least in theory, SAPI is able to find a trademark well-known in oppositions which were filed while Venezuela was a member of the Andean Community. Finally, Venezuela is a member of the Paris Convention.