



International Trademark Association  
*Representing the Trademark Community since 1878*

July 2nd, 2009  
Dr. Margarita Vilatimo  
Independent Bureau of Intellectual Property  
Intellectual Property Registrar

Re: SAPI's Trademark Practices – Searching requirement and Classification System

Dear Dr. Vilatimo:

The International Trademark Association (INTA) is a 131-year-old membership organization, representing the interest of trademark owners throughout the world, currently with 5,500 member corporations and professional firms in 190 countries. Currently the Association has 31 member firms in Venezuela. One of the purposes of INTA is the development of clear and consistent principles, worldwide, regarding trademark issues and unfair trade practices. As an accredited, non-governmental observer to the World Intellectual Property Organization (WIPO), INTA has contributed to the work of WIPO and advised national trademark offices around the world on issues relating to harmonization of trademark law and practices and, in particular, on the harmonization of formalities of national trade mark offices.

INTA takes this opportunity to put forward comments on newly established practices by Venezuela's Independent Office for Intellectual Property, known under Spanish acronym, SAPI, with respect to the searching requirement and the trademark classification system for the registration of trademarks.

### **Searching Requirement**

INTA would like to express its concern relative to SAPI's Official Notice dated May 4, 2009, which sets in place new searching requirement in order to initiate the registration process of a trademark. According to the notice, the application must be accompanied by an official searching result issued by SAPI. This new requirement erroneously draws its legal basis from Article 71 of the Law on Industrial Property.

We call to SAPI's attention that Article 71 refers to a single document, the application, which in itself bears indication that the trademark is not similar to or the same as a trademark already registered in the same class or a similar class which may lead to confusion or mislead the consumer or public at large. INTA contends, therefore, that resolution No. 020 seeks to establish a new searching requirement that has no basis in the controlling statute.

Moreover, a searching result does not guarantee trademark clearance with respect to other trademarks that may already be registered. Furthermore, the trademark applicant will encounter a number of administrative limitations specifically when dealing with searching services which are often unreliable and which create considerable delays in issuing searching results. The uncertainty as to the date in which the searching results will be issued constitutes an additional obstacle for the effective and prompt processing of trademark registrations.

Given the issues noted above, INTA urges SAPI to rescind Resolution No. 020 on the new searching requirement.

### **Classification System**

Now that Venezuela has reverted to the 1955 Industrial Property Law, INTA would like to express its concern about SAPI's requirement that all applications be filed in accordance with the classification system as contained in this law.

INTA encourages countries to continually advance their trademark laws in order to increase legal certainty in rights protection. This process should avoid changes in legislation and regulations that would adversely affect the existing scope of protection of trademark rights.

It is our understanding that the classification provided in Article 106 of the 1955 Industrial Property Law is limited solely to products. As a result, uncertainty as to the protection of valid registrations for services would be greatly increased and applications for service mark registrations would no longer be accepted. The Article 106 classification also does not cover the products that are included in the International ("Nice") Classification that is administered by WIPO. Therefore, reverting to the 1955 local classification would deny effective protection to trademarks.

The requirement that trademark applicants abide by the 1955 local classification also raises many technical inconveniences. It is of our understanding that the SAPI's Industrial Property Registry database is in fact based upon and updated with the International Nice Classification. Therefore, when carrying out an availability search or simply researching the database, the classes provided in the search results for the trademark of interest are those of the international class. However, when filing an application under the 1955 law's local classification that corresponds to different international classes, separate applications must be filed. For example, if a party is interested in protecting services in class 38 and 42 under the international class, rather than filing a single local class application, two separate applications must be filed.

In sum, this reversion to the classification as contained in the 1955 law will result in uncertainty for applicants as to the correct classification of products and services. It also will increase the existing backlog of work at the Industrial Property Registry given the office actions that would be issued due to lack of fulfillment of formal requirements.


Finally, the expedited registration process of trademarks which has been in force until recently will be impeded.

INTA therefore urges that SAPI correct these inconsistencies in order to reduce uncertainty with respect to how products and services are to be classified.

### **Conclusion**

INTA requests that SAPI consider the highly negative effects that the new requirements for searching and classification will have on trademark rights and trademark owners and respectfully urges that they either not be implemented or be corrected. The Association stands ready and willing to work closely with SAPI on these issues. Should you require further information, please contact Ms. Laura Cruz at [lcruz@inta.org](mailto:lcruz@inta.org).

Sincerely,

A handwritten signature in dark ink, appearing to read "Richard Heath". The signature is somewhat stylized and is positioned above the typed name.

Richard Heath  
President