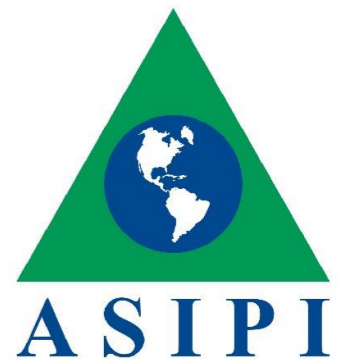


Exclusion of Common Use Expressions Protection in Trademark Registration - The Brazilian and International Practice

-An Overview of Latin America-

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President of ASIPI



DISTINCTIVENESS



**Essential characteristic
of a mark**

SCALES OF DISTINCTIVENESS

Fanciful

Arbitrary

Suggestive

Descriptive

Generic

COMMON USE — GENERIC

Common &
Generic
terms



Descriptive &
Evocative
terms

VENEZUELA



Opposition against ESTILO LIBRE for
perfumes, personal care and beauty
products



Accepted by Industrial Property Office and
ratified in appeal

It is a **COMMON USE TERM**



Decision revoked by the Supreme Court
and granted registration

It is a **SUGGESTIVE MARK**

A sign could
be
composed
by a
common
term

totally

OFERTON: “although it is not expressly included as a voice in commonly used dictionaries, it has a clear and precise meaning: a big offer”

partially

*DOLO ALIVIOI, DOLO ARRISAR,
DOLO MIOTRAL, DOLO MOFF,
DOLO ULTRAFEN, DOLO-RINN,
DOLO-AMERIN, DOLO-ALGIN*

COMMON USE EXPRESSIONS

- ✓ Free to use
- ✓ Lack of distinctiveness- not registrable
- ✓ Depends on the nature of the product or service
- ✓ Depends on the country

Guagua



Chile



Dominican Republic

Refajo



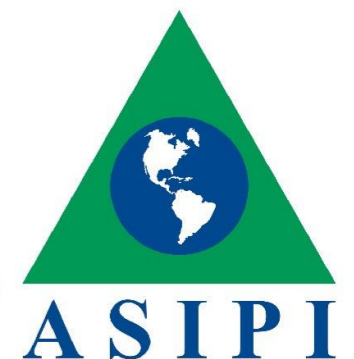
Dominican Republic



Colombia

In Peru, INDECOPI has stated that in order to determine the usual or common term:

- ✓ It should serve **the meaning that the name has in the ordinary language used in the country**, in which foreign, jargon and other invented words that have gained some popularity in its use, are included.
- ✓ Consideration must be given to the specific products or services in question and **not just to any product or service of the same gender**.
(Resolution No. 374- 2015 / CSD).




REGISTRATION GRANTED

Peru 

- ✓ Opposition against EXTREME MAKEOVER HOME EDITION in classes 38 and 41. Rejected because although “HOME EDITION” is a common term in English language that is known by consumers, EXTREME MAKEOVER **is not a phrase of general knowledge by the public.** (Resolution No. 374-2015/CSD).

REGISTRATION REJECTED

Chile 

- ✓ Registration for AUTOSCANNER (cl.37) was rejected because it is a common use expression, as well as RAGU (cl. 29), which had been previously registered (in 1978).. 
- ✓ Registration for KANIKAMA was annulled because it is commonly used to identify an ingredient to prepare a typical Japanese food, that is a known and used term by the public.



Latin American provisions on Common Use designations and their prohibition of registration



ARGENTINA

“Names, words, signs and advertising slogans that have passed into general use before the application to register them;” (Art. 2, b) Law No. 22.362)



BOLIVIA, COLOMBIA, ECUADOR Y PERU

“consist **exclusively** or have become the **common or usual designation** for the product or service concerned in the everyday language or usage of the country” (Art. 135, g) Andean Decision 486)



BRAZIL

“Signs of generic, necessary, common, ordinary or simply descriptive character, when related to the product or service to be distinguished” (Art. 124, VI Ley No. 9.279)



COSTA RICA

“It is **exclusively** a sign or indication which, in the everyday language or commercial practice of the country, is a common or usual **name** for the good or service to which it applies (Art. 7, c) Law 7978)

Latin American provisions on Common Use designations and their prohibition of registration



CHILE

“Signs or expressions that may be in general use in trade to **designate** certain class of products, services or establishments.” Art. 20, (e) Law 19.039)



DOMINICAN REPUBLIC

“consist **exclusively** of a sign or an indication that in the current language or in the commercial usage of the country, is the generic, common or usual **designation** of the goods or services concerned” (Art. 73, d Law 20-00)



EL SALVADOR

“It consists **exclusively** of a sign or indication which, in everyday, technical or scientific language, or in customary business practices in the country, is a common or customary **designation** of the good or service in question” (Art. 8, c) Decree 868)



GUATEMALA

“it consists **exclusively** of a sign or an indication that in ordinary language the scientific, technical, or commercial uses of the country, is the common or usual **designation** of the product or service in question;” (Art. 20 (d) Law No. 57-2000)

Latin American provisions on Common Use designations and their prohibition of registration



HONDURAS

“Consists **exclusively** of a sign or indication that in the commerce practice, is the common or usual **designation**, the generic name or the technical name of the of product or service concerned” – Art. 83 (4)



NICARAGUA

“Consist **exclusively** in a usual sign or indication that, in everyday or technical language, is used **to designate** the product or service to which it applies” (Art. 7 (e) Law No. 380 – 2001)



MEXICO

“Technical or common use indications of products or services claiming to be based with the Brand, and **words** that in the everyday or commercial language, have become the usual or generic **designation** of said products or services” (Art. 90. II Industrial Property Law modified on April 9, 2012)



PANAMA

“**expressions** that constitute the usual or generic **designation** of the product or service, with the exception of descriptive or generic marks that have become distinctive or special through use” (Art. 91 (2) Law No. 35)

Latin American Provisions on Common Use designations and their prohibition of registration



PARAGUAY

“Marks which consist **solely** of a sign that is the generic name or **designation** of the product or service to which they refer ...”
(Art. 2 (e) Law No. 1294/1998)



URUGUAY

“**words or expressions** which have become customary in the current language and **signs or designs** not being fancy, i.e. that do not comprise novel, special or distinctive features;” “words or combinations of words in foreign languages whose translation into Spanish falls under the prohibitions set out in the above items (9), (10) and (11);” (Art. 4 (11 and 12)) Law 17.011)



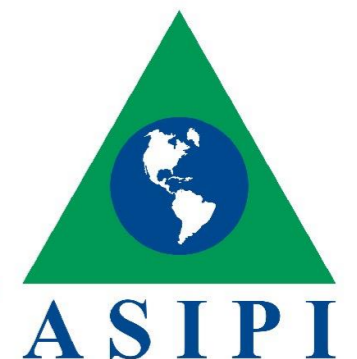
VENEZUELA

“**Terms and expressions** which passed into general use, and **expressions** commonly used to indicate the genus, species, nature, origin, quality or form of products”
(Art. 33, 9) Industrial Property Law - 1956)

Most of the countries limit the prohibition to the case in which a mark consists “**exclusively**” of common or usual **designations or expressions**.

On the contrary, the provision in Argentina is more general, as well as in Brazil that refers to “signs” and Uruguay that includes “signs” and “designs”, not limiting the prohibition to “designations”.

So, are common used signs only words or may be a design?



What about these designs?

Distinctiveness?



Cooperatives



Law Firms



**Internet
Provider**



**Recycling
Services**

ONLY WORDS...

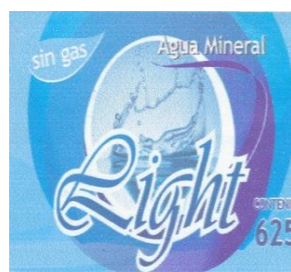
- ✓ Andean Community: a sign of common use is “one that is composed **exclusively of one or more words or indications** used in the common language or in the commercial use of the country where the registration of the sign as a trademark has been requested, to identify the goods or services in question.” (Process 108-IP-2004)
- ✓ INDECOPI (Peru): the prohibition for registration comprises only signs **consisting exclusively of common or usual names**, so signs containing other distinctive elements, may be subject of registration. (Resolution No. 374- 2015 / CSD)

CASES

Peru



Costa Rica



Resolution No. 0302-2015/CSD



Resolution No. 0129-2014/CSD



Voto No. 0744-2015



Voto No. 1106-2013



ANDEAN COMMUNITY, MEXICO AND CHILE

ANDEAN COMMUNITY

- ✓ Signs may be formed by usual or common use words. In this case, **distinctiveness is found in the different element that integrates the sign and in the condition of fanciful sign of the trademark as a whole.** (Court of Justice of the Andean Community. Prejudicial Interpretation No. 70-IP-1013)

MEXICO

- ✓ The Specialized Room in Intellectual Property Matters of the Federal Tax and Administrative Court of Justice has ruled that common or usual terms can be registered **if an element that adds distinctiveness is included.** (Case 192/08-PI-01-6)

CHILE

- ✓ The Supreme Court of Justice in Chile ruled that in order to determine the distinctiveness of a mark, it must be analyzed as a whole and consequently, **although the name may be composed of some non-distinctive elements as a whole it can be perfectly registered.**
- ✓ Mandatory disclaimer in the registration on common use, generic and descriptive elements.

CASES: COLOMBIA AND CHILE

COLOMBIA

The Superintendence of Industry and Commerce accepted the coexistence of DATACREDITO and DATARIESGO because the expression “DATA” is of common use and must be excluded from the comparative analysis of the marks.

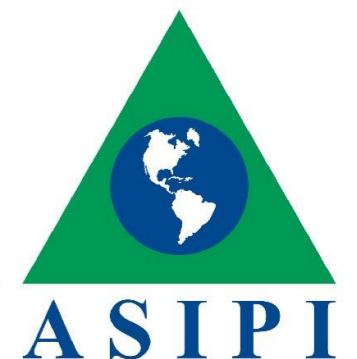
CHILE

Trademarks KID CONNECTION (cl. 3, 18, 25 and 26), MEDIABRANDS (cl. 41), which had been rejected by the Director of the National Institute of Industrial Property (INAPI), were accepted for registration.

HARMONIZED MANUAL ON TRADEMARK CRITERIA

The examiner shall prevent from granting an exclusive right on a term that is part of the common vocabulary and must:

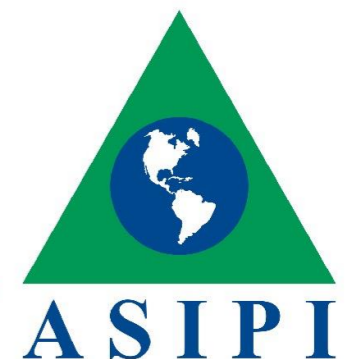
- ✓ Consider the words or expressions that any competitor may be used. MOJITO class 33 was not allowed to registration since it is the common term for the product that it intends to identify.
- ✓ Not allow the registration of common use signs with added elements that do not provide the necessary distinctiveness. The registration for WORLD SERIES OF POKER was rejected in Costa Rica.
- ✓ Examine the sign with respect to the specific market in which the mark will be used.
- ✓ Not allow terms in foreign languages if the consumer recognizes them. HOT DOG, SOFTWARE, PENALTY, FASHION and JACUZZI are some of the examples contained in the Manual.
- ✓ Not allow usual or common abbreviations. BCO. for banking services, ARQ. for architectural services, W.C. for rental portable toilets.
- ✓ If the term has acquired secondary meaning, it would be not included in the prohibition.



VULGARIZATION

A trademark could also be converted in a term of common use when the mark **becomes the identification** of a product or a service itself and competitors use the same to commercialize and advertise their products or services.

The trademark does not identify the product or service of a specific party, and therefore loses its distinctive character, not being a trademark anymore. This phenomenon is usually called “vulgarization”.



VULGARIZATION IN COUNTRIES

YES	NO
<p>Bolivia Colombia Costa Rica Ecuador Guatemala Nicaragua Peru</p>	<p>Argentina Brazil Chile Dominican Republic El Salvador Honduras Panama Paraguay Uruguay Venezuela</p>

REQUIREMENTS FOR VULGARIZATION

ANDEAN COMMUNITY DECISION 486

- ✓ The **need for competitors** to use the sign to conduct their activities, due to the non-existence of another appropriate name or sign to designate or identify the product or service concerned in the market;
- ✓ The **widespread use** of the mark by the **public** and in the **commercial circles** as a common or generic sign for the product or service concerned; and
- ✓ The **public's ignorance** or **limited perception** of the fact that the mark denotes a particular **corporate origin**.

CONDITIONS TO DECLARE VULGARIZATION

(Decision No. 05-745-AC of IEPI)

Objective

- The trademark indeed has become a sign of common use or generic to identify one or more of the products or services for which it has been registered.

- The conversion must occur in both the commercial circles and the public.

Subjective

The action or inaction of the trademark holder has caused or allowed the conversion.

CASES OF CANCELLATION ON THE GROUNDS OF VULGARIZATION



Colombia



Panettone

(Resolution No. 14180, May 2006)



Nachos

(Resolution No. 36706 of 2015)

CASES OF NON-VULGARIZATION

Ecuador

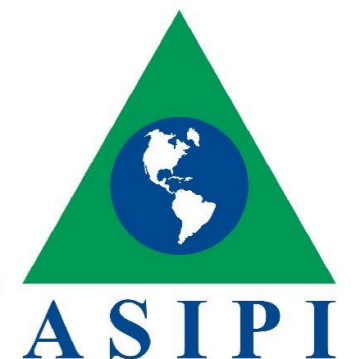
In a cancellation action against ASPIRINA, the IEPI considered:

- ✓ Bayer had not tolerated the use of ASPIRINA as a common or generic sign.
- ✓ There is no need that competitors use ASPIRINA because they use “acetylsalicylic acid”.
- ✓ That there is no lack or low knowledge of the public that ASPIRINA has a particular corporate origin.

Dominican Republic

“Nullity” actions filed by local pharmaceutical companies against ASPIRINA, rejected based on:

- ✓ Invalidation should be analyzed at the time of the granting of the mark, not as a subsequent event, which is the case of vulgarization where a cancellation would correspond, but it is not provided by the law.
- ✓ “It is a brand whose notoriety and seniority are unquestionable”, and that Bayer’s rights on ASPIRINA have been recognized in other cases.



CASES OF NON-VULGARIZATION

Venezuela



- ✓ Nullity action against the registration for CORN FLAKES.
- ✓ SAPI (Venezuelan Intellectual Property Office) stated: "...there is no evidence showing that the word CORN FLAKES to distinguish "Food and food ingredients" was a generic term in 1988, the date on which it was granted. (Resolution No. 905, November 6, 2001).

CONCLUSIONS

- ✓ Common use terms are not registrable throughout the Latin American countries except when they have acquired secondary meaning in jurisdictions that recognize this figure.
- ✓ Administrative and judicial authorities have issued decisions that implement legal provisions regarding common use terms, ruling the cases when trademarks containing such term can be registered. Such criteria is not yet uniform in the region.
- ✓ Cancellation based on vulgarization is not available in all jurisdictions.

**OBRIGADA!
THANK YOU!
¡GRACIAS!**

