

PROTECTION OF NON-TRADITIONAL MARKS IN PERU

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In our country non-traditional marks are protected: scent, tactile and taste marks, although they are not expressly mentioned. But, since our legislation has a declarative enumeration of the signs that can be marks, they can be registered. Sounds and smells are in fact expressly mentioned to constitute marks. Three-dimensional marks are also protected.



In our legislation, Article 134 of Decision 486 states that "For purposes of this system, any sign that is capable of distinguishing goods and services on the market shall constitute a trademark. Signs that are capable of **graphic representation** shall be eligible for registration as trademarks. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to the registration of the trademark". Signs that shall be capable of constituting a trademark are expressly listed, amongst others the "sounds and smells" (paragraph c)). In the list, "tactile, scent and taste marks" are not mentioned, however their registration is not forbidden.

It is possible to point out that in Article 50 of Legislative Decree 1075 (our domestic law in force from February 1, 2009) the requirements that are needed for filing a trademark application are listed and the following requirement is expressly mentioned: "The reproduction of the mark where it involves a descriptive mark with spelling, form or color, or a figurative mark, mixed with or without color, or a **graphic representation of the mark where it involves a three-dimensional mark or a visually imperceptible mark**" (paragraph b)).

I. REQUIREMENT OF DESCRIPTION FOR REGISTERING NON VISIBLE MARKS

In previous articles, Article 134, paragraph c) of Decision 486 and Article 50, paragraph b) of Legislative Decree 1075, the requirement of graphic representation for non visible marks is set forth.

In Article 16.2 of Acuerdo de Promoción Comercial entre Perú y Estados Unidos (APCPE) (Trade Promotion Agreement between Peru and USA) in Chapter 16, Industrial Property, in first paragraph, the following is set forth:

"No part shall require as registration condition that signs are significantly visible and no part will deny registration of a mark only based on the fact that the sign consists of a sound or smell."

Pursuant to the APCPE a non visible sign cannot be required as a registration condition to be visible since due to its nature said sign is non visible, for example, a sound sign can be perceptible in a hearing mode on a magnetic carrier (CD or USB).

III. CRITERIA OF REGISTRABILITY EXAMINATION FOR A NON VISIBLE MARK

While non visible marks are protected, there is not any smell mark or taste mark registration yet.

There are 24 sound registered marks. In these cases, a graphic representation is demanded together with its corresponding stave when it is a melody, and when it is another sound it should be accompanied by its spectrogram. As examples, the following is quoted:

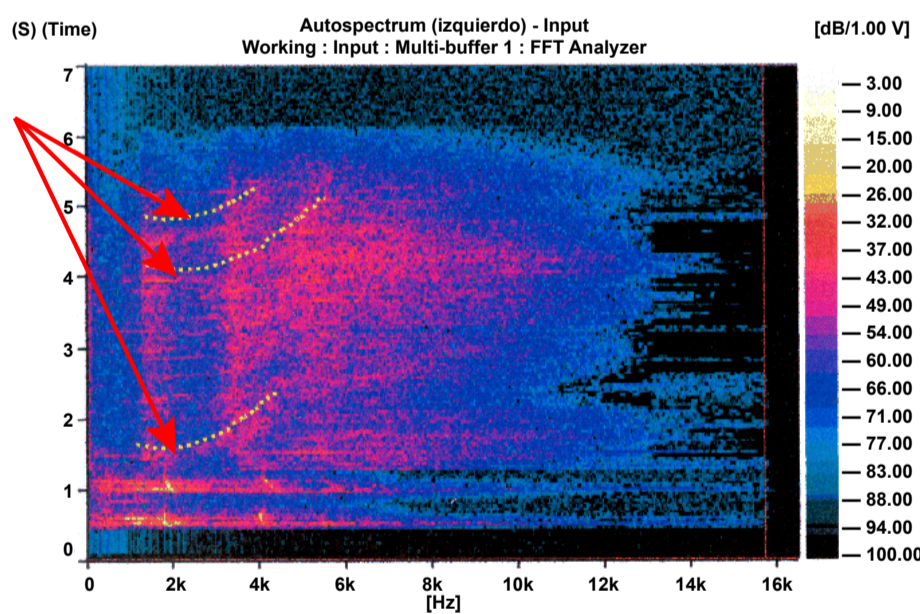
Holder : MASTERCARD INTERNATIONAL INCORPORATED
Certificate No. : 80884
Date : June 12, 2002, renewed on June 12, 2022
Class : 09 – COMPUTER APPARATUS AND EQUIPMENTS, COMPUTER SOFTWARE AND COMPUTER PROGRAMS; COMPUTER SOFTWARE EQUIPMENTS TO FACILITAE PAYMENT TRANSACTIONS BY ELECTRONIC MEANS AND THE LIKE.

Description : AUDIO TONE AS REPRESENTED IN THE FOLLOWING STAVE



Holder : BAYER HEALTHCARE LLC
Certificate No. : 167418
Date : August 20, 2010
Class : 05 - Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Description : THE SOUND AS IN THE SPECTROGRAM



For the stave case, it is also demanded to attach a proof of the corresponding payment for the technical report to the Conservatory of Lima, whereby it is evidenced that the sound sign and the musical graphic match each other, after performing an audition of the CD, in order to check the sound signs included in the CD and the document with the musical graphics thereof (stave).

The steps are the same as for visible marks.

The demanded graphic description should be technic, in accordance with the kind of sign. While we have in mind that the Court of European Community determined, in the case of sound marks in the sense that the graphic representation of a sound mark should be clear, precise, self-contained, easily accessible, unintelligible, durable and objective; in our case, the stave or sonogram is demanded (MEISSNER BOLTE. "Non-traditional trademarks at the German Patent and Trademark Office". In: MB MILESTONES (Vol.6/2013). Page 3.)



For the time being, there are some criteria for sound marks (it is considered that the stave clearly and accurately expresses the sound description); subsequently other criteria will be set forth for other kinds of marks, for example for smell marks, the chemical formula would be another kind of acceptable description, or linguistic description of the smell, with words of the common language understandable for the sector consumer.

IV. ANDEAN PREJUDICIAL INTERPRETATION

The Andean Community gives an opinion on non visible marks, namely on sound marks.

Pursuant to Process No. 27-IP-95 of the Andean Court of the Andean Community, a sound mark is defined as: "the sign perceptible by human ear, fulfilling the function of distinguishing and identifying a product or service through broadcasting by any suitable medium", adding as characteristics of this kind of marks the sonority, originality or novelty, striking character and easy diffusion (Carlos Alberto Parra Satizabel, "La marca sonora" (Sound Mark), Colombian magazine on Industrial Property, No 4, year 1995, Bogota 1995, p. 125). This Court considers that in future the requirements and conditions for registering this kind of marks, that especially in the radio environment have particular connotation, could be specified.

Up to now there have been no cases of opposition to the registration of sound marks so that the criteria for obtaining protection of a non visible mark are still the graphic representation by means of the stave or spectrogram, as appropriate, and the sufficient distinctiveness.

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