

## **REGISTRATION OF WEAK AND EVOCATIVE TRADEMARKS**

In Peru, weak and evocative trademarks are protected, in spite of the fact that they are not expressly set forth in our legislation, wherein it is mentioned that "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" (Article 134 of Decision 486). Registration of these trademarks demands that they enjoy sufficient distinctiveness.

### **Sufficient distinctiveness**

Capable of distinguishing means that the distinctive ability required in the relation trademark-product relates to the individualizing and differentiating ability of the sign with regard to the category it covers. That is to say, the weak or evocative trademark should not be fully identified with the good or service or some information related thereto, but to simultaneously identify a kind of good, but being differentiated and indicating a business origin. The requirement of distinctiveness with regard to the goods or services in the market seeks to safeguard the general interest of the consumers or users, as well as of the businessmen interests and to preserve the terms of common use, that inform consumers on characteristics of the goods or services sought to be identified.

### **Descriptive, generic and common signs**

Local and Andean regulations prohibit the registration as a trademark of descriptive, generic and common signs, when they consist exclusively of a descriptive expression, a generic or technical name, or a common or usual designation of the good or service in question (paragraphs e), f) and g) of Article 135 of Decision 486), since they are common expressions, nouns and adjectives that are necessary to inform the consumers on the good or service, that belong to the language, so that they are of public domain and cannot be object of exclusive appropriation by only one owner. These signs cannot be registered as a trademark in isolated individual form because they lack distinctiveness, that is to say, the denomination could only be exclusively registered if it has acquired due to its use in the market a secondary meaning, or if it is accompanied of another elements providing it sufficient distinctiveness, however the owner of this trademark unit having sufficient distinctiveness could not prevent third parties from using the descriptive, generic or common elements. This means that the generic or descriptive dimension of a sign can be neutralized with the addition of new distinctive elements, thus acquiring an own meaning and sufficient distinctiveness so as to be registered as trademarks and having differentiation as a whole, with regard to the good or services it distinguishes (Process 17-IP-2003), (pages 8-9 Process 39-IP-2010 dated May 19, 2010).

Descriptive, generic or common or usual signs of the goods or services, if combined with other words or particles, can engender sufficiently distinctive trademark groups that have the possibility of being registered, but the owner of the trademark group cannot prevent the use of the descriptive, generic or common term by other businessmen and, therefore, its trademark is weak.

## **Evocative trademark**

Evocative signs have sufficient distinctiveness, since they do not design the good or any characteristic thereof, but suggest the consumer or user certain characteristics, qualities or effects of the good or service, by demanding said consumer the use of the imagination or understanding to link that sign with this object. In order to understand the provided information of the good or service, the consumer should carry out a deductive process, unlike the generic or descriptive sign. The evocative trademark plays the distinctive role of the trademark and, therefore, it can be registered. (Processes 92-IP-2004, 16-IP-2012, 39-IP-2010, 19-IP-2014, 30-IP-2013, Process 16-IP-2012).

## **Weak trademarks**

The Andean case law has set forth that: *"Evocative trademarks are considered as weak trademarks, since any person has the right to evoke in its trademarks the properties or characteristics of the goods or services that will be distinguished by such trademarks, which implies that its owner should accept or cannot prevent other distinctive trademarks from equally evocating the same properties or characteristics of its trademark"*. (Process 30-IP-2010)

It can be noted that the weakness of evocative trademarks constitutes a certain limitation of the *ius prohibendi* on being impossible to prevent other distinctive trademarks from evoking their characteristics.

A weak trademark is the one that does not have the sufficient distinctiveness to prevent the registration of trademarks with certain degree of similarity, unlike arbitrary or fancy trademarks (Process 30-IP-2013).

A registered trademark can weaken when any of the elements forming the generic sign is of common use or evokes a quality of the good or service. The sign will become weak against other ones also including some of such elements or qualities that cannot be exclusively appropriated. The presence of these generic or descriptive elements, that cannot be exclusively appropriated, diminishes the strength to the trademark group so that the owner of the registered weak trademark should tolerate that other trademarks include such elements, although they could demand that the suffixes or other distinctive elements of the trademark group serve to clearly differentiate them from the other ones. The owner of the weak trademark containing a word of common use, cannot prevent the inclusion thereof in third's trademarks and only base the existence of confusion on this inclusion.