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Trademark notoriety and evidentiary enforceability: the five-year criterion

Guillermo Melgarejo Zorrilla and Manuel Fernández-Stoll Zar of Estudio Colmenares & Asociados examine a significant new binding precedent in Peru that reshapes how trademark notoriety is assessed over time. By introducing a five-year evidentiary threshold, the decision clarifies when rights holders can rely on prior recognition and when fresh proof is required, offering important guidance for brand owners navigating enforcement and strategy in the Andean jurisdiction.



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“Notoriety is not a permanent condition but depends on evolving market factors such as use, dissemination, and recognition.”

This article analyzes a binding precedent in the field of distinctive signs that establishes a time criterion for the evidentiary enforceability of previously recognized trademark notoriety. This criterion delimits the scope of the presumption of continued notoriety and establishes the threshold above which the owner must re-establish the validity of said condition, with a direct impact on the exercise of the rights inherent to the well-known trademark.

In Peru, a member country of the Andean Community, a binding precedent has been

in force since March 2024 regarding the recognition and validity of the notoriety of distinctive signs, established by Resolution No. 0330-2024/TPI-INDECOPI. This precedent sets a maximum period of five years within which the previously recognized notoriety of a distinctive sign may be invoked, without the filing of new evidence being required, the resolution declaring said condition being sufficient. Once this period has elapsed, the owner who wishes to exercise the rights inherent in notoriety must prove, by means of new evidence, that the distinctive sign



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continues to have this attribute.

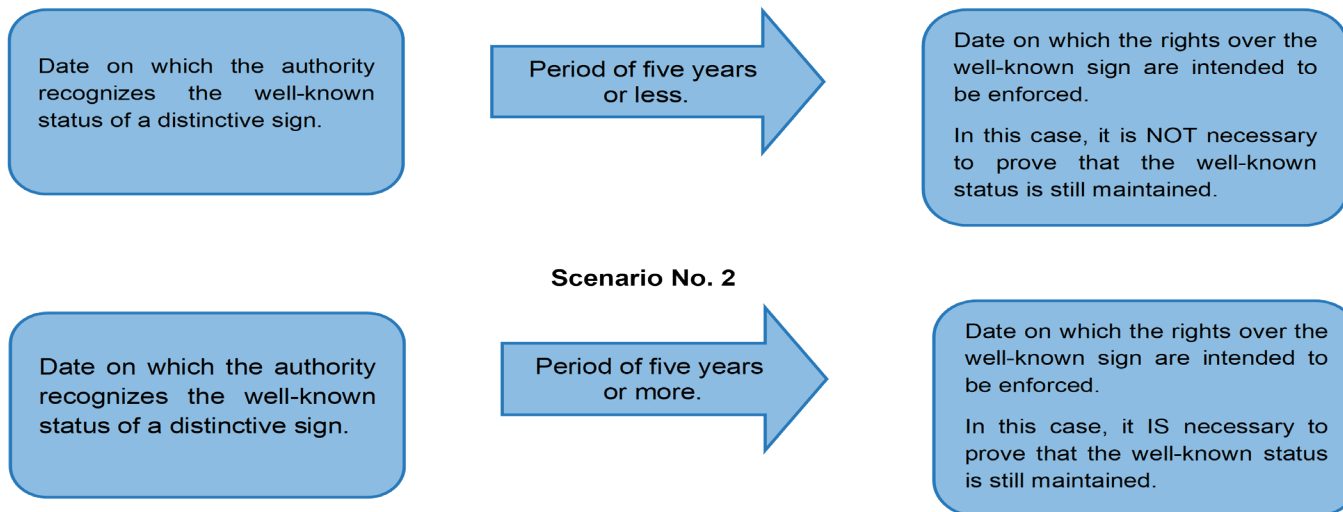
In this regard, the referenced decision states that:

“This decision constitutes a binding precedent in relation to the maximum period that may elapse between the date on which the authority recognizes the notoriety of a distinctive sign and the date on which the owner invokes the rights arising from such notoriety, which is five (5) years. Once this period has elapsed, the owner must submit the necessary evidence to demonstrate that their sign continues to enjoy such status.”

In order to illustrate the scope of the precedent, particularly with regard to the established time limit, the following table outlines the criteria adopted by the Administrative Court:



Scenario No. 1



Note. Adapted from Resolution No. 0330-2024/TPI-INDECOPI, issued by the National Institute for the Defense of Competition and Protection of Intellectual Property, 2024, p. 20.

According to the chart, the criteria adopted by the Administrative Court are based on two scenarios, defined in terms of the time elapsed since the recognition of notoriety. In scenario 1, when the owner invokes the rights inherent to notoriety within five years from the date on which the administrative authority recognized said status, it is not necessary to prove its continued existence, as the resolution granting said recognition is sufficient. In scenario 2, when such rights are invoked after that period has elapsed, the owner has the burden of providing new evidence to demonstrate that the distinctive sign continues to enjoy notoriety.

Having clarified the scope of the time limit established in the precedent and the

“Rights holders must treat time as a critical factor, as recognition of notoriety is not indefinite.”

configuration of scenarios 1 and 2 that determine the requirement to prove notoriety in the context of administrative proceedings, it is appropriate to examine the application of this criterion in the trademark infringement complaint proceedings that gave rise to it.

In the trademark infringement complaint proceedings analyzed by the Chamber, the plaintiff invoked the notoriety of trademarks whose initial recognition had been made through resolutions issued between 2012 and 2016. Likewise, the Authority specified that the latest evidence provided by the plaintiff to prove notoriety dated from 2015. In this context, at the date of filing of the complaint, i.e., July 5, 2022, more than five years had elapsed, which is why the Chamber required the plaintiff to prove that the trademarks on which the complaint was based continued to enjoy the attribute of notoriety.

The plaintiff complied with the request

by submitting Resolution 3867-2022/CSD-INDECOPI of June 23, 2022, in which the notoriety of the registered trademarks “had been” recognized. However, the Authority specified that no evidence was evaluated or analyzed in the aforementioned resolution, since the decision to maintain the distinctiveness of the sign in said resolution was based exclusively on previous rulings, i.e., those issued between 2012 and 2016.

Based on these considerations, the Chamber specified that, although new rulings were issued after the original Resolution No. 1169-2012/TPI-INDECOPI, in which the Distinctive Signs Commission indicated that the trademarks at the basis of the complaint maintained their status as well-known, such resolutions were not based on the assessment of new evidence. On the contrary, these rulings merely reiterated the recognition of notoriety based on the resolutions issued between 2012 and 2016, without conducting a new evidentiary analysis to verify the validity of this status at the time the complaint was filed.

Based on the two scenarios represented in the preceding graph, it can be inferred that the plaintiff was in scenario 2, in which, since more than five years had elapsed since the trademark was recognized as well-known, the burden was on the plaintiff to prove that such notoriety remained valid at the time the complaint was filed. In this regard, both the wording of the binding precedent and the chart that complements it are relevant for the correct definition of the dynamics of notoriety in Peruvian jurisdiction.

Another point of analysis is why INDECOPI’s Specialized Intellectual Property Chamber set the period for invoking previously recognized notoriety without the need for new accreditation at five years, rather than, for example, three or 10. Although Resolution No. 0330-2024/TPI-INDECOPI does not explain the arithmetic or regulatory reason for this period, this does not weaken the precedent but rather reveals a criterion of prudence aimed at balancing the dynamic nature of trademark notoriety, the absence of an express legal term in Decision 486, and the need for legal certainty and predictability. Notoriety is not a permanent condition but rather depends on factors that vary over time, such as use, dissemination, and recognition in the market. Too short a period would have imposed an excessive burden of proof on the owner, while too long a period would have allowed outdated recognition to be invoked. In this context, the five-year period appears to be a reasonable parameter that presumes the continued existence of the well-known

trademark for a prudent period of time, without excluding the requirement to prove its validity once that threshold has been exceeded.

It follows from the precedent analyzed that owners of well-known trademarks must consider the time factor as a key element in the management of their rights, assuming that the recognition of notoriety is not indefinite. In this regard, it is advisable to maintain, in a constant and organized manner, the evidence proving the validity of this status. This precaution allows for adequately addressing any evidentiary requirements once the five-year period set by the authority has elapsed. In this way, effective invocation of notoriety in administrative proceedings is ensured.

This does not weaken the precedent but rather reveals a criterion of prudence aimed at balancing the dynamic nature of trademark notoriety, the absence of an express legal term in Decision 486, and the need for legal certainty and predictability.

RÉSUMÉS

Guillermo Melgarejo Zorrilla and **Manuel Fernández-Stoll Zar**, attorneys at Estudio Colmenares & Asociados, have a solid and recognized track record in intellectual property, strategically advising national and international clients on the protection and defense of their rights.

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