**Harmonization protocol of norms on intellectual property in the mercosur regarding trademarks,**

**indications of source and denominations of origin.**

**GENERAL PROVISIONS**

**ARTICLE 1**

**Nature and Scope of Obligations**

The Party States shall guarantee the effective protection of intellectual property regarding trademarks,

indications of source and denominations of origin, assuring as a minimum the protection derived from

the principles and norms of this Protocol.

They may, however, grant a more ample protection, provided that [said protection] is not incompatible

with the norms and principles of the treaties mentioned in the present Protocol.

**ARTICLE 2**

**Effectiveness of International Obligations**

(1)The Party States obligate themselves to comply with the norms and principles of the Paris Convention

for the Protection of Industrial Property (Act of Stockholm of 1967) and the Agreement on Aspects of

Intellectual Property Related to Commerce (1994), attached to the agreement for the creation of the

World Commerce Organization (1994).(2) No provision of the present Protocol shall affect the obligations

of the Party States that result from the Paris Convention for the Protection of Industrial property (Act

of Stockholm of 1967) or from the Agreement on Aspects of Intellectual Property Related to Commerce

(1994).

**ARTICLE 3**

**National Treatment**

Each Party State shall grant the nationals of the other Party States a treatment which shall be no less

favorable than [the treatment] it grants its own nationals with respect to the protection and the exercise

of intellectual property rights regarding trademarks, indications of source and denominations of origin.

**ARTICLE 4**

**Exemption of Legalization**

(1)The Party States shall make efforts to exempt from legalization, whenever possible, the documents

and signatures [included] in the procedures related to intellectual property rights regarding trademarks,

indications of source and denominations of origin.(2)The Party States shall make efforts to exempt

from sworn or legalized translation, whenever possible, [the original documents] of the proceedings

related to intellectual property regarding trademarks, indications of source and denominations of origin,

when [said] documents are in the Spanish or Portuguese languages.(3)The Party States may require

a sworn or legalized translation when this is indispensable in the case of litigation in administrative

or judicial matters.

TRADEMARKS

**ARTICLE 5**

**Definition of Trademark**

(1)The Party States shall recognize as a trademark, for registration purposes, any sign that is susceptible

of being distinguished in the trade of products and services.(2)Any Party State may demand, as a

condition of its registration, that a sign be visually perceptible.(3)The Party States shall protect service

trademarks and collective trademarks, and they may, likewise, establish protection for certification

trademarks.(4)The nature of the product or service to which the trademark is to be applied shall, in

no case, constitute an obstacle for the registration of the trademark.

**ARTICLE 6**

**Signs Considered as Trademarks**

(1)Trademarks may consist of, among other [things], fantasy words, names, pseudonyms, commercial

themes, letters, numbers, monograms, figures, portraits, labels, shields, imprints, trimmings, lines and

stripes, combinations and arrangements of colors, and the shape of the products, of their containers

or fittings, or of the means or places of sale of the products or services.(2)Trademarks may consist

of national or foreign geographical indications, provided that they are not indications of source or

denominations of origin, in accordance with the definition given in Articles 19 and 20 of the present

Protocol.

**ARTICLE 7**

**Registration Provisions**

**Registration Provisions**

The registration of a trademark may be requested by physical or juridical persons, of public or private

law, that have a legitimate interest [in doing so].

**ARTICLE 8**

**Priority for the Registration of a Trademark**

Priority for the registration of a trademark shall be granted to the person who first requests it, unless

that right is claimed by a third party who has used [the trademark] in a public, peaceful way and in

good faith, in any of the Party States, during a minimum term of six months, provided that upon

presenting his objection he [also] requests the registration of the trademark.

**ARTICLE 9**

**Registrable Trademarks**

(1)The Party States shall prohibit the registration, among others, of descriptive signs or [signs] that

are generically used to designate products or services or types of products or services that the trademark

distinguishes, or [signs] that constitute indications of source or denominations of origin.(2)[The Party

States] shall also prohibit the registration, among others, of signs that are misleading, contrary to

morality or the public good, offensive to persons living or dead or to religions; [signs] that are formed

with national symbols or [symbols] of any country; [signs] that are susceptible of falsely suggesting a

relation with persons living or dead, or with national symbols of any country, or that offend their value

or respectability.(3)The Party States shall reject applications for registration of trademarks that have

been proven to infringe upon rights of third parties, and [the Party States] shall invalidate the registration

of trademarks applied for in bad faith that have been proven to infringe upon rights of third parties.(4)The

Party States shall specifically prohibit the registration of a sign that imitates or .duplicates, partially

or completely, a trademark that the applicant evidently could not fail to have recognized as belonging

to a owner established or domiciled in any of the Party States, or that is susceptible of causing confusion

or association.

(5)Article 6 bis of the Paris Convention for the Protection of Industrial Property shall be applied mutatis

mutandi to the services. In order to determine the notoriety of the trademark in the sense of the provision

mentioned here, the knowledge of the sign shall be taken into account, including said knowledge in

the pertinent State in which protection is requested, [said knowledge] having been acquired from the

publicity of the sign.(6)The Party States shall assure in their [respective] territories the protection of

the trademarks that have become exceptionally well known and belong to nationals of the Party States;

[said protection] shall be against the duplication or imitation of [said trademarks], in any line of activity,

provided that there is a chance that damage will be caused.

**ARTICLE 10**

**Term for Registration and Renewal**

(1)The validity of the registration of a trademark shall expire ten years after the date of its granting in

the respective Party State.(2)The term of validity of the registration may be postponed for equal and

successive ten-year terms, to begin on the date of the preceding expiry date [of the registration].(3)The

Party States obligate themselves to comply, as a minimum, with the provisions established in Article

5 bis of the Paris Convention for the Protection of Industrial Property (Act of Stockholm of 1967).(4)When

the term is extended no modification shall be introduced in the trademark, nor may the list of products

of services covered by the registration be expanded.(5)With respect to the extension of the registration

of a trademark, a Party State may not:

a. perform a thorough examination of the registration;

b. call for opposition or admit same;

c. require that the trademark be in use; nor

d. require the trademark to have been registered or [its registration] to have been extended in another

country or regional office.

**ARTICLE 11**

**Rights Granted by Registration**

The registration of a trademark shall grant the owner an exclusive right of use, and [the right] to prevent

any person from performing, without [the patentee's] consent, the following acts, among others: the

use, in commerce, of a sign identical or similar to the trademark, for any products or services, when

said use may cause confusion or a risk of association with the holder of the registration, or unjust

economic or commercial damage, caused by a dilution of the distinctive force or the commercial value

of the trademark, or [a risk of] an improper use of the prestige of the trademark or of its owner.

**ARTICLE 12**

**Use of Certain Indications by Third Parties**

The registration of a trademark shall not grant [the owner] the right to prohibit a third party to use,

among others, the following indications, provided that such use is made in good faith and cannot cause

confusion regarding the company origin of the products or services:

(a)his name or address, or those of his commercial establishments; and

(b)indications or information on the availability, use, application or compatibility of his products or

services, in particular in relation to repair parts or accessories.

**ARTICLE 13**

**Exhaustion of a Right**

The registration of a trademark shall not prevent the free circulation of the trademarked products,

legally introduced into commerce by the owner or with his authorization. The Party States obligate

themselves to include in their respective legislations measures that provide for the exhaustion of the

right granted by the registration.

**ARTICLE 14**

**Nullity of Registration and Prohibition of Use**

(1)Upon request by an interested person, and after the owner of the registration of the trademark has

been granted a hearing, the national competent authority of a Party State shall declare the nullity of

the registration if it was made in violation of any of the provisions established in Articles 8 and 9.(2)When

the causes of nullity affect only one or some of the products or services with regard to which the

trademark was registered, nullity shall be declared only with respect to these products or services, and

they shall be eliminated from the respective list in the registration of the trademark.(3)The Party States

may establish a time period regarding prescription of the action [requesting] nullity.(4)The action

[requesting] nullity shall not prescribe when the registration was obtained in bad faith.

**ARTICLE 15**

**Cancellation of a Registration Due to Lack of Use of the Trademark**

(1)In those Party States in which there exists an obligation to use the trademark, upon request by any

interested person and after the patentee has been granted a hearing, a competent authority may

cancel the registration of a trademark when it has not been used in any of the Party States during the

five years preceding the date on which the cancellation action was filed. The request for cancellation

shall not be admitted before five years have passed after the date of registration of the trademark. The

registration [of a trademark] shall not be canceled when the [respective] competent authority believes

there are reasons that justify the lack of use [of the trademark].(2)Where there is an obligation to use

the trademark the Party States may provide for the partial lapse of the registration when the lack of

use affects only one or several of the products or services distinguished by the trademark.

**ARTICLE 16**

**Use of a Trademark**

(1)The Party States in which there exists an obligation to use the trademark [hereby] declare that the

criteria regarding the obligation to use the trademark shall be established by common agreement of

the [respective] competent national authorities.(2)The use of the trademark in any of the Party States

shall constitute sufficient [grounds] to prevent cancellation of the registration requested in any of [the

Party States].(3)The burden of proof regarding the use of the trademark shall be borne by the owner

of the trademark.

**ARTICLE 17**

**Opposition to a Registration or to a Registration Request**

The Party States obligate themselves to establish an administrative procedure by which the registration

of a trademark may be opposed. They also obligate themselves to establish an administrative procedure

regarding the nullity of a registration.

**ARTICLE 18**

**Classification of Products and Services**

The Party States that do not use the International Classification of Products and Services for the

Registration of Trademarks, established by the Nice Accord of 1957, nor its revised and updated

versions, obligate themselves to adopt the necessary measures to do so.

**INDICATIONS OF SOURCE AND DENOMINATIONS OF ORIGIN**

**ARTICLE 19**

**Obligation to [Grant] Protection and Definitions**

(1)The Party States obligate themselves to reciprocally protect their indications of source and

denominations of origin.(2)An indication of source is the geographical name of the country, city, region

or locality within a [Party State's] territory, which is known as a center [place] for the extraction,

production or manufacture of a certain product or for the performance of a certain service.(3)A

denomination of origin is the geographical name of a country, city, region o locality within a [Party

State's] territory, which designates products or services whose qualities or characteristics are exclusively

or essentially caused by the geographical environment, including natural and human factors.

**ARTICLE 20**

**Prohibition to Register as a Trademark**

The indications of source and denominations of origin described in paragraphs (2) and (3) above shall

not be registered as trademarks.

FINAL PROVISIONS

**ARTICLE 21**

The Party States shall grant protection to the variety of plants and other vegetable products by means

of patents or a special system or any other system resulting from the combination of both [patents and

a special system].

**ARTICLE 22**

The Party States shall implement effective measures to repress the commercial manufacture of "pirate"

or falsified products.

**ARTICLE 23**

The Party States shall cooperate in the examination and resolution of difficulties inherent in the

circulation of goods and services in the MERCOSUR, resulting from questions related to intellectual

property.

**ARTICLE 24**

The Party States obligate themselves to make efforts to sign, as soon as possible, additional agreements

regarding invention patents, models of utility, industrial designs, author's rights and related [rights],

and other matters associated with intellectual property.

**ARTICLE 25**

The controversies that should arise among the Party States with respect to the application, interpretation

or noncompliance of the provisions contained in the Present Protocol shall be resolved by means of

direct diplomatic negotiations.

If through said negotiations an agreement cannot be reached or if the controversy should be resolved

only in part, the procedures established in the controversy resolution system in force in the MERCOSUR

shall apply.

**ARTICLE 26**

The present Protocol, which is an integral part of the Treaty of Asunción, shall become effective, for

the first States that ratify it, thirty days after the second ratification instrument has been filed.

For the rest of the signatories, [the Protocol] shall become effective thirty days after the filing of the

respective ratification instruments, in the order in which they are filed.

**ARTICLE 27**

The adherence of one State to the Treaty of Asunción, shall imply ipso jure the adherence to the

present Protocol.

**ARTICLE 28**

The Government of the Republic of Paraguay shall be the depositary of the present Protocol and of

the ratification instruments and shall send duly authenticated copies of same to the Governments of

the rest of the States. The Government of the Republic of Paraguay shall notify the Governments of

the rest of the States the date that this Protocol becomes effective and the date of filing of the

instruments. IN FAITH WHEREOF, the undersigned plenipotentiaries, duly authorized thereto, have

signed this Treaty.