

Non-traditional marks in Latin America: the current landscape

The acceptance of non-traditional trademarks has increased in most Latin American jurisdictions in recent years. We provide an overview of the current state of play

Non-traditional trademarks are becoming increasingly popular in Latin America, which has a population of over 620 million. This uptake is prompting a need for more sophisticated trademark protection, as companies include unconventional marks in their marketing and advertising campaigns for new technologies of the fourth industrial revolution.

This dynamic process is being well received among World Trade Organisation members and thus in countries in the Latin American region. These have tended to follow, in general terms, the legal protection granted to non-traditional trademarks (eg, shape marks, colour marks, sound marks and smell marks) established in Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). This article deals with protectable subject matter: “any sign, or any combination of signs, capable of distinguishing

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the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark... Members may require, as a condition of registration, that signs may be visually perceptible.”

The requirement that the “signs be visually perceptible” is crucial for the protection of non-traditional marks in Latin American countries. Some have gone so far as to allow the registration of animated or motion marks, holograms, position or gesture marks and even texture marks.

We have selected a number of Latin American countries – Argentina, Brazil, Chile, Colombia, Mexico and Peru – to build up a picture of how international brands may obtain protection for such marks in the area. Some of these countries are members of either the Andean Community or Mercosur (the Southern Common Market).

PICTURE: JANAKA
DHARMASENA/
SHUTTERSTOCK.COM



Argentina

Non-traditional trademarks may be registered in Argentina under Article 1 of the Trademark Law (22,362).

This provides an illustrative description of what can be protected as a trademark and leaves the door open to any other distinctive sign – a broad and unique situation in South America and one which can be used by international trademark owners to protect their brands.

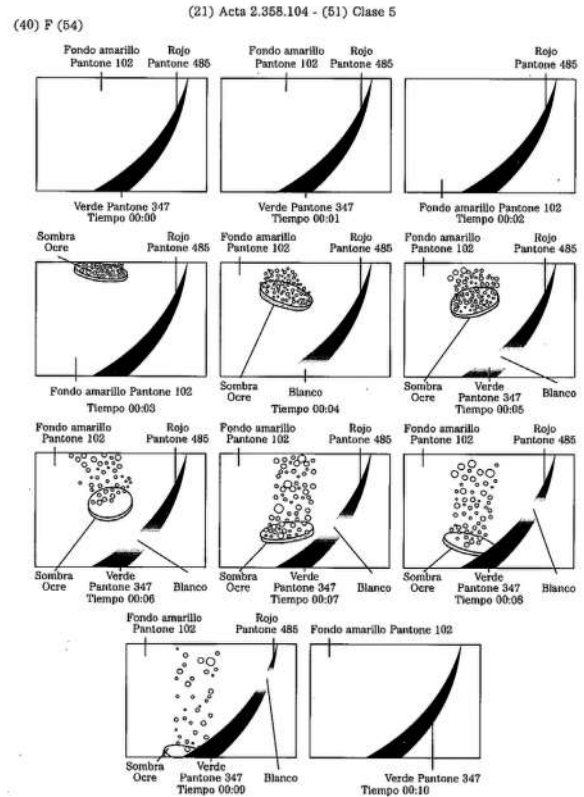
Article 1 states:

1. The following may be registered as trademarks to distinguish goods and services: one or more words, with or without meaning; drawings; emblems; monograms; engravings; stampings; seals; images; bands; combinations of colours applied to a particular place on the goods or their packaging; wrappers; containers; combinations of letters and of numbers; letters and numbers insofar as they concern the special design thereof; advertising phrases; reliefs having distinctive capacity, and all other signs having such capacity.

2. The following shall not be considered trademarks, nor shall they be capable of registration:

- a) names, words and signs that constitute the necessary or usual designation of the product or service to be distinguished thereby, or that are descriptive of its nature, function, qualities or other characteristics;
- b) names, words; advertising signs and phrases that have passed into general use prior to the application for registration thereof;
- c) the shape given to the goods;
- d) the natural or intrinsic colour of the goods, or a single colour applied thereto.

FIGURE 1: First motion mark granted in Argentina




(22) 05/11/2001 - (73) F. Hoffmann - La Roche AG - CH.
 (57) Solamente preparaciones farmacéuticas y sanitarias dietéticas adaptadas para uso médico. Se reivindican las propiedades distintivas de la forma y del movimiento descendente y ascendente de los colores, resultante de visualizar en forma secuencial 11 imágenes con una frecuencia de 1 segundo.
 (74) Ag 196 - (44) 26/12/2001.

TABLE 1: Colour marks registered in Brazil

Number	Granted	Submitted by	Mark	Position	Title	Class
2697769	18/08/1937	Nominativa	BLACK & WHITE	Registro	DIAGEO BRANDS BV	NCL (8) 33
7503725	20/03/1981	Nominativa	BIANCO	Registro	OTTO BAUMGART INDÚSTRIA E COMÉRCIO SA	NCL (7) 02
730156702	31/07/1984	Nominativa	PINK	Registro	ÔMEGA PARTICIPAÇÕES LTDA	32/10
823922472	09/08/2011	Nominativa	ORANGE	Registro	ORANGE BRAND SERVICES LIMITED	NCL (7) 41
826310460	11/09/2007	Nominativa	YELLOW GREEN	Registro	EMBRYO WEB SOLUTIONS LTDA ME	NCL (8) 09
826929931	06/11/2007	Nominativa	BIANCO	Registro	DANIELLA FERREIRA DA ROCHA	NCL (8) 40
900649194	18/05/2010	Nominativa	AZURE	Registro	SHOESTOCK COMERCIO DE CALCADOS E ACESSORIOS LTDA	NCL (9) 25
823173020	04/12/2007	Nominativa	CORAL	Registro	AKZO NOBEL LTDA	NCL (7) 35
823938271	29/05/2007	Nominativa	CORAL	Registro	AKZO NOBEL LTDA	NCL (7) 02
902460579	18/12/2012	Nominativa	AZUL VIAGENS	Registro	AZUL SA	NCL (9) 39

TABLE 2: Position and movement marks registered in Brazil

Registration number	Trademark
Registration 007178085	
Registration 840117930	
Registration 815547480	
Registration 817935487	
Registration 820171921	
Registration 826006248	
N/A	

Most applications for non-traditional marks are filed for 3D marks. In several key cases, the courts have decided that the shape of a product can be registrable provided that it is original or distinctive. As a result, several registrations have now been granted, including for a soap in the shape of an egg, the distinctive shape of Toblerone chocolate bars and even the shape of a salty cookie.

With regard to 3D marks, the courts have decided that these can be registered as trademarks, even when they also qualify for protection as industrial designs.

In connection with scent trademarks, the applicant must accurately describe the scent. This can be achieved either by describing the object of the smell or by providing its chemical composition.

L'Oréal was the pioneer in this field in 2004 when it filed an application for a scent mark in international Class 3, providing the chemical composition of the smell in order to obtain the registration.

With regard to sound trademarks, there are approximately 40 such marks registered in Argentina. The first sound mark (Registration 1,796,514) was granted in 2000 to Intel Corp.

The first motion trademark was granted in Argentina in 2002, consisting of the movement and colour change of the famous Supradyn vitamins, where the colour changes in a descending fashion and then returns back to the original colour in an ascending fashion – a pioneering case for motion marks in South America (see Figure 1).

Brazil

According to Article 122 of the Industrial Property Law (9279/96) only perceptible and distinctive visual signs may be registered as trademarks. Thus, it is possible to obtain registrations for 2D and 3D marks.

In principle, the Brazilian Institute of Industrial Property does not allow the registration of signs which are not visually distinctive (eg, sound, smell and texture marks). Additionally, and with regard to colour marks, Article 124 of the Industrial Property Law establishes that “colours are non-registrable, unless they are combined in a distinctive manner”.

Case law in this area has established that in order to be registrable, a mark must be stable, so that it does not suffer changes over time. It must also be distinctive and licit.

With respect to holograms, motion and position trademarks, the situation is less clear-cut; however, such signs may be granted registration as design marks.

Although 3D marks may be registered, the necessary or common form may not be.

Article 124 of the Industrial Property Law does not permit trademark registrations to be granted for industrial designs obtained by third parties.

Colour marks may be registered where the mark in question consists of a combination of colours. As such, a number of colour marks have been granted (see Table 1).

Various position and movement marks have also been granted (see Table 2).

Chile

In 2005 an amendment to the Chilean Industrial Property Law made it possible to register sound trademarks. This was a great advance, as until then this kind of protection

was possible only through copyright. Chile does not recognise 3D marks nor protection for trade dress.

However, this situation is set to change now that the presidency has published the Bill for the Approval of a New Industrial Property Law, which includes a specific chapter dealing with non-traditional marks. This sets out provisions for the protection of motion and 3D marks, as well as holograms.

Colombia

Decision 486 of the Andean Community Industrial Property Regulation sets out the following description of what constitutes a registerable trademark: “Signs susceptible to graphic representation shall be registered as a trademark.”

Therefore, in order to be registerable, non-traditional marks must be capable of being represented graphically. According to Article 134 of Decision 486, registerable non-traditional marks include:

- sounds and smells;
- a colour delimited by a shape;
- 3D marks; and
- any combination of permitted marks.

Registerable non-traditional marks are not restricted to this list, as the relevant legislation allows registration to be granted to other signs, provided that they are capable of being represented graphically.

Other non-traditional marks that have achieved protection in Colombia and that are derived from possible registrable trademarks include:

- movement and animation marks;
- position marks;
- tactile or texture marks; and
- gesture marks.

The following are further established requirements that must be included in the application in order for it to be considered (Resolution 3718/2016).

Sound marks

The application for a sound mark must include a graphical representation consisting of:

- a description of the sign by means of a pentagram, phonogram or any other means permitting its identification; and
- a sound file that supports the digital recording in MP3 format.

Colour marks

The application must comprise the graphic representation of the colour delimited by a shape.

When describing the colour, the applicant may include an internationally recognised identification code such as pantone, focoltone, RGB or any other reference system permitting a further verification of its correspondence with the applied-for sign.

Tactile or texture trademarks

The applicant must include the following in order to accomplish the requisite graphical representation:

- a clear, precise and complete description of the texture;
- a bi-dimensional design or photograph; and
- a physical sample of the texture.

3D trademarks

The application must comprise a bi-dimensional graphic or photographic reproduction. If this is insufficient to show the details of a trademark, the applicant must provide up to six different views of the mark. If these views are still not enough for it to be identified, the trademark office can request a physical sample of the trademark.

Table 3 provides examples of non-traditional trademarks registered in Colombia.

Texture or tactile marks

The applicant must file:

- a clear, precise and complete description of the sign’s texture;
- a 3D drawing or photograph; or
- a sample of the object with the texture.

For example, Application 15045738, in Class 33 owned by Diageo Brands BV for Old Parr whisky (see Figure 2). The colour mark is described as pink pantone (183C) delimited by the bi-dimensional shape of a bottle. There is no claim of protection over the shape of the bottle.

Mexico

The Mexican Industrial Property Law was amended in 2018. The updated act defines ‘distinctive signs’ as all

TABLE 3: Non-traditional trademarks registered in Colombia


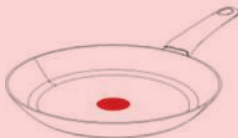


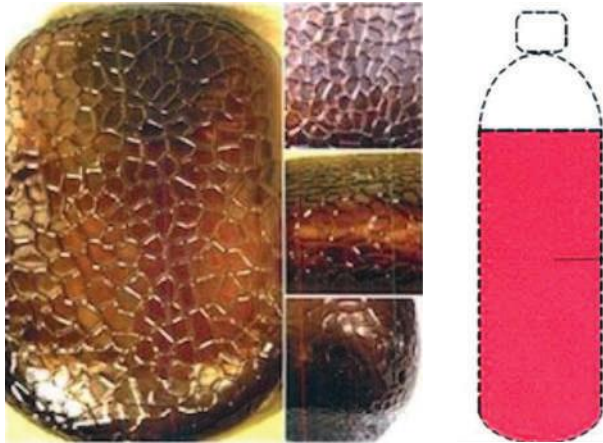
Trademark	Trademark description
	The mark consists of the position of a ring that simulates a lifesaver marked with the logo of the trademark in a silver colour. It is located 1cm from the top edge, in the centre of the back of a pair of women’s underpants.
	The mark consists of a red point (circle) (Pantone 180C) fixed to the centre of a kitchen utensil (eg, a pan, saucepan or frying pan). The contour of the utensil does not form part of the trademark and is meant to show the position of the mark.
	The mark consists of the manual gesture of introducing the index finger in the creamy centre of a cookie with the shape of a ring.
	The character is in a resting position and greets with his hand up; with the hand still up, the character begins to turn 360°, when finished, the hand goes down and the character starts walking, and so on.

FIGURE 2: Diageo Brands' Old Parr whisky mark

signs perceptible by the senses and capable of being represented, used in the industry, commerce or in the services provided by them, to distinguish goods or services from others of the same kind or class in the market.

By virtue of this new definition, since 10 August 2018 (when the amendments came into effect) it has been possible to file trademark registration applications for non-traditional marks. Presently, there are more than 400 applications for non-traditional marks in Mexico.

With respect to scent marks, the first trademark registration of this type related to a paint with a bamboo scent; in the case of sound marks, it was the sound of a metal spoon tapping a glass, granted to the Gran Café de la Parroquia de Veracruz; in the case of commercial images, the first such registration was granted for an ornamental pot.

The amendments modified Article 88 of the law in order to expand the definition of 'trademark' to include "any sign perceptible by the senses and susceptible of being represented in a way that allows to determine the clear and precise object of protection, which distinguishes products or services from others of the same species or class".

In view of this, the Mexican Institute of Industrial Property now allows the registration of the following non-traditional marks:

- Sound – any sound that allows the consumer to associate it with a specific trademark and/or company; such marks can be represented through pentagrams, phonograms or onomatopoeia.
- Holograms – these must be represented by an example that contains a single view of the image and by an explanation of the holographic effect.
- Smell – any smell that allows the consumer to associate it with a specific trademark and/or company; such marks may be represented by a written description of the odour.
- Trade dress – visual elements that allow a consumer to identify a product or an establishment; these can be represented by a detailed description of the product or its visual presentation, including forms, presentation, colours and textures.

So far, the following non-traditional marks have been successfully registered:

- a smell mark for a paint with a bamboo smell in the name of Southeast Sustentable SA of CV;
- a smell mark for modelling dough with a sweet smell formed of a combination of vanilla, cherry and the natural smell of dough based on wheat-flour fragrances, in the name of Hasbro Inc;
- a trade dress mark for a three-piece decorative flowerpot in the shape of a figurine in the name of Germán Flores; and
- a sound mark, the sound of a spoon striking the coffee glass three times in the name of Grupo Gran Café de la Parroquia de Veracruz SAPI de CV.

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Peru

Non-traditional trademarks are expressly regulated by Decision 486 of the Andean Community Industrial Property Regulation. Despite this, the Peruvian trademark authorities do not generally enforce those rights, even when registration has been granted.

Rather, the Peruvian trademark authorities address and analyse non-traditional marks using traditional concepts and methods of trademark analysis. Unfortunately, in many cases this leads to a misunderstanding of the very nature and functioning of non-traditional marks.

A good example of this situation is the fact that the trademark application form in Peru has no category for non-traditional marks; instead, applications for such marks must be filed simply under 'other'.

Despite this, applications for 3D marks are commonly accepted for registration and the Peruvian authorities are working with the National Institute for the Defence of Competition and Intellectual Property to modify the application form to bring it more into line with international standards.

Generally, in Peru, there have been only few applications for non-traditional marks. As of 16 October 2018, Peru had 43 registered non-traditional marks, 42 of which were sound marks, with the remaining one being a motion mark.

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