

TRADEMARKS

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Trademarks

Overview of U.S. trademark system

Basic considerations for trademark use and registration in Latin American countries

“Common law” rights from using a “protectable” mark in commerce

1. Marks exist on spectrum of strength

Generic  Descriptive  Suggestive  Arbitrary  Fanciful

2. Scope of rights is specific to goods or services to which the marks are applied

3. Common law rights are specific to the geographic area of “market penetration” – where consumers are acquainted with the mark

Federal registration enhances and strengthens common law rights

In litigating common law rights, mark owner bears the burden of proving ownership, protectability and geographic scope of rights

With federal registration, presumption of ownership, protectability and nation-wide use

Presumption becomes conclusive and can't be rebutted after five years of registration and the filing of appropriate paperwork and fee – “incontestability”

Registration in Latin American Countries

U.S. trademark rights key off of use

Most Latin American countries award trademark rights to the first to file rather than first to use

- Generally require use within a reasonable time

- Most allow protection for unregistered well-known brands

Very important to file before commercializing in a given country

- Distributors or opportunists may file if you don't

- Complicated, costly and uncertain to regain control of mark if a third party files

Registration in Latin American Countries (Cont.)

Search first to minimize possibility of being accused of trademark infringement and litigating in foreign jurisdiction

Most common practice is to hire local practitioner in foreign jurisdiction coordinated through U.S. Attorney

Paris convention 6 month “priority” date

Monitor trademark filings for opposition

Register mark with U.S. customs in effort to block any counterfeit products from entering U.S. from abroad