

## WHAT CONSTITUTES "USE"?

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This article considers the criteria used by the Peruvian trademark office to resolve cancellation for non-use of trademarks.

Within the scope of Decision 486 of the Andean Community, in Peru, a trademark might be cancelled when it has not been used for three years after receiving a certificate of approval (including the notice of resolution which grants the registration of the brand).

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But there are problems with the administration's interpretation of the time when such notice is received. It considers it necessary that the certificate is physically collected at the registration division of the Peruvian trademark office in order for the notification which grants the mark to be considered 'carried out'.

This interpretation means that an applicant might pick up the certificate many months or even years after the issue of the notice, or even never take the notification. This makes it impossible to start counting the three years of non-use of the mark in order to request its cancellation, and therefore the trademark is effectively removed from the market, avoiding its commercialization by interested third parties.

We hope that this approach will change so that the arrival date of the certificate at its box at the registration division becomes the beginning of the period of three years.

Regarding the administration's interpretation of Article 166 of the Decision 486 on the proper use of a brand, experience derived from the resolutions show that the Peruvian administration is too strict about mixed or figurative brands, requiring evidence which proves the use of the trademark in exactly the way that it was granted.

Word marks do not cause as much trouble as figurative marks because it is necessary only to demonstrate the use of the word. However, the use of the word mark cannot merely be asserted. It must appear in documents that prove the commercial use of the mark in the territory of Peru or another country of the Andean Community. The jurisprudence mentions the most important proof is sales invoices, which can be supported with publicity, revenue and expense reports and so on, all of which must refer to the brand.

In addition, invoices must contain specific reference to the product to which the mark is applied, so that it can be established that it is used for the products listed on the certificate concerned. Likewise, they should be in such numbers that prove the product is on the market in reasonable quantities.

In the case of figurative and mixed marks, it is necessary for the documentation to contain them. Since it is highly impractical for invoices to contain figurative marks, normally just the word appears; the jurisprudence shows that the mixed mark is commonly used as a watermark on the invoice. Regrettably, the big problem with this is in cases of sales of products with different brands—it would not make any sense to have just one single mark in the background. In these cases it is recommended to mention the product code in the description, and attach documentation where these codes appear. Generally these are catalogues in which the mark appears as it was registered.

Only minor variations of the mixed trademark are allowed, to ensure the brand will be used in a way closest to how it has been granted. For some it may be that these criteria would prevent traders comfortably using their marks, but we believe it helps to respect trademark rights, punishing those

who are not diligent and do not use the sign in the way it has been granted. We believe that this is a proper curb on rights owners and benefits market players.