

NEWSLETTERS

A REALITY CHECK IN TRADEMARK CASES

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We welcome the decision issued by the Peruvian Trademark Office (INDECOPI) that upheld the opposition against the registration of the trademark BILLALCON SURFERS and logo in Class 25 by Jose Almeida Contreras.

Clearly the registration would damage the interests of our client GSM (Operations) from Australia, owner of the well-known brand BILLABONG, which uses the same type of letter font in some of its logos.

Regrettably, the first administrative instance issued Resolution N ° 1020-2010/OSD dated May 3, 2010, using an unusual definition of the local surfing apparel market, found that products covered by the mark in conflict produced a different pronunciation and intonation, despite of the fact that BILLALCON SURFERS and BILLABONG shared some similar letters and sounds. They also added that the requested trademark included figurative elements, while the registered brand was merely a group of letters that produce a different visual impression.

The second administrative instance, reviewing similar jurisprudence related to applicants who have applied for similar marks to BILLABONG in the past, issued the Decision No. 581-2011/TPI, dated March 16 2011, finding that the presence of BILLA as well as the syllables (I-A-O) in the same phonetic sequence caused a likelihood of confusion among consumers. In consequence it overturned the first administrative instance decision and denied the requested mark. We believe this case sets a very good precedent, which reflects the feelings of those who have impotently watched similar marks being granted simply because they were not copied exactly. In this case, the counterfeiters changed the final elements of the mark BILLABONG, in order to achieve a distinction that supposedly prevented the risk of confusion, but which in practice was totally false.

We hope this trend continues in opposition cases, because it demonstrates the fact that the Peruvian trademark office is taking into account the practical aspects of each case, and not just following old recipes that coldly analyse, allowing clearly-similar brands coexist in the market, favoring confusion and increasing market inefficiency.

We strongly believe that this case is an example of INDECOPI sharpening its process to protect the market against counterfeits, as well as helping all market participants to find sufficient and correct information before taking a decision. This in turn makes the market more efficient and benefits entrepreneurs and consumers.

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