



European Commission

TRADE MARK PROTECTION STRATEGY IN LATIN AMERICA

LATIN AMERICA IP SME HELPDESK

An SME that has recently registered at least one trade mark is 13% more likely to experience high growth in the future.



1

Seek professional assistance

You should not do it all by yourself. IP experts can help you design your IP protection strategy based on your interests and resources.

In addition, if you do not have a local residence in the relevant Latin American country, you will need a local representative to register your IP rights.

2

Design your brand identity carefully and protect all its elements

Your company/product name, a slogan, the logo or even the colours can be protected as Trade marks; while the mascot, pictures, jingles, videos and other multimedia contents may benefit from copyright protection.

Your digital presence is also vital. Protect your website and apps via designs and copyright, and do not forget to register every domain name you need (i.e. containing the names of the company, a collection or products).



3

Make sure that you own these elements before registering them

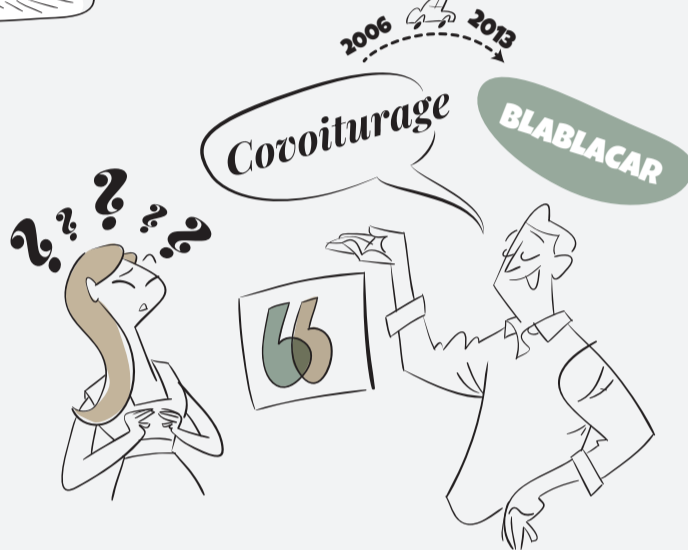
By default, subject to certain exceptions, local regulations may consider the creator of the name, design, drawing, etc. as the initial owner of the rights. Agree on the license or transfer of these rights with the creator before using or registering them.

4

Think globally

Use a name or sign that can be easily reproduced and is distinctive in any of your destination markets (in the short and medium term, at least).

Make sure that it is not seen as offensive, contrary to morality or ridicule in the local language.



An alternative and interesting strategy, used by Unilever to enter certain Latin American countries, was to acquire local brands, such as Frigo, Algida, Miko, Kibon Langnese, Ola and Holanda, and combine them with its heart-shaped logo into a joint trade mark.

This allows Unilever to maintain all the positive associations with the pre-existing trade mark while including all of them under its well-known trade mark umbrella.

5

Search for prior trade marks thoroughly

This will help you know whether your brand is available or if it can be confused with similar registered trade marks. At least ten Latin American NIPOs participate in the EUIPO-managed tool, TMView, an online consultation tool allowing free-of-charge trade mark searches in the official trademark database of those participating offices.

However, free, accessible, multilingual, comprehensive, reliable and online databases are not available in every Latin American country. Feel free to ask our experts if you want to know more!

As a rule of thumb, the NIPO will take into account every registered trade mark (not only the opposing ones).

Coexistence agreements are different to Europe: they are subject to the NIPO's approval (consumers' interest rule).



6

Benefit from international protection mechanisms (where available)

Depending on the country, the Madrid System (for trade marks), the Hague Agreement (for designs) or the Berne Convention (for copyright) can be very useful for multi-country protection.

You can also benefit from the Paris Convention (that provides a priority right of 6 months) or the 486 Decision (through which a single local registration provides you with trade mark use and opposition rights in all Andean Community member states).



7

Take into account registration time differences

Trade marks are granted for 10 years in every Latin American country. However, registration proceedings last on average longer than in Europe.

Protection is provided either from the application date or the granting date (depending on the country).

8

Define the types and products you aim to commercialise

Bear in mind that the Nice Classification coexists with local classifications that vary from one country to another.

However, at least twelve Latin America NIPO participate in the EUIPO-to-search for classification tool TMClass, which helps you to search for, classify and translate the goods and services needed to apply for trade mark protection. You may also verify if those terms appear in the classification databases of the participating offices.

You should only apply for those goods and/or services for which you really intend to use your mark. Otherwise, your trade mark could be cancelled.



9

Protect before you go

Remember that trade mark rights are territorial. If you do not register locally, you have no exclusive rights, so anyone could use similar or identical signs to yours. At the same time, if someone else registered them first in another country, you could be regarded as an infringer in that country.

HELPLINE

free, fast & confidential

3 days working

helpline@latinamerica-ipr-helpdesk.eu

LATIN AMERICA IPR SME HELPDESK

www.latinamerica-ipr-helpdesk.eu @latinamericaipr

© European Union, 2020. Reuse is authorised provided the source is acknowledged. The reuse policy of European Commission documents is regulated by Decision 2011/833/EU (OJ L 330, 14.12.2011, p.39).

Disclaimer: The Latin America IPR SME Helpdesk – An initiative of the European Commission – is a free service for SMEs which provides practical, objective and factual information about Intellectual Property Rights in Latin America. The services are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. The content and opinions expressed are those of the authors and do not necessarily represent the views of the European Commission and/or the Executive Agency for Small and Medium-sized Enterprises or any other body of the European Union. Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice. Neither the European Commission nor the Agency may be held responsible for the use which may be made of the information contained herein.

Luxembourg: Publications Office of the European Union, 2020. Print ISBN 978-92-9202-932-6 doi:10.2826/718887 EA-02-20-335-EN-C PDF ISBN 978-92-9202-931-9 doi:10.2826/03647 EA-02-20-335-EN-N

