

Peru: Comments to the Regulation of Legislative Decree 1075

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Does 'The Regulation of Legislative Decree 1075' really bring a significant change in the paperwork and procedures for distinctive signs?

On May 29th of 2017, the Supreme Decree No. 059-2017 was published in the Official Gazette "El Peruano" whose purpose is to complement what was established in Legislative Decree 1075. Among other modifications, this rule contains changes regarding the processing of applications, as well as the procedure in the precautionary measures in case of infringements of marks.

PROCEDURE FOR FULFILLING THE REQUIREMENTS FOR DISTINCTIVE SIGN REGISTRATION APPLICATIONS

When a trademark is applied for registration, it is necessary to first fill out an application form offered by the Peruvian Trademark Office (INDECOPI). Likewise the following requirements should be met:

- A) The indication that a trademark is applied for;
- B) Identification data of the applicant or the person submitting the application, or certain information allowing the competent Department to communicate with the interested party;
- C) The mark the registration of which is applied for, or a reproduction of the mark.
- D) The express description of the goods and / or services for which the registration of the mark is applied for; and
- E) Vouchers of official fees.

But, what happens if certain requirements are missing? Suppose that someone requests a mark and the voucher of fees is missing or a reproduction of the mark either denominative or graphic is missing. The article 52 of the Legislative Decree 1075 establishes the possibility of fulfilling such requirements within a period of sixty working days following the date of notification, without allotting a file number or filing date.

If adhering to the provisions of the General Administrative Procedure Act 27444, the Documentary Processing Unit or Submission Desk already imposed the obligation to request all documents before receiving and allotting the file number. In spite of this, as a matter of fact the referred unit was able to receive incomplete applications, allotting them a file number without any inconvenience.

The regulation incorporates the obligation of compliance to the Documentary Processing Unit because it must keep in custody the application for registration of the mark until the applicant complies to remedy such requirements. Likewise, it should not be allotted a file number and it must be in custody, which implies that the file will be withheld and should not be derived to the Direction of Distinctive Signs until the applicant complies with the requirements.

If the period indicated in the previous paragraph elapses without the applicant having complied with all the requirements listed in art. 52 of the regulation, the Documentary Processing Unit will return to the applicant the documents that had been submitted.

Returning to the previous example, if the applicant wants to register a mixed mark and did not submit the graphic reproduction of the mark and is asked to attach it, it will have sixty (60) days to submit the graphic reproduction of the mark and thus remedy the omission. Similarly, if the fee for the application has not been paid, there is a term of sixty (60) days to pay and attach the mentioned voucher of fee.

The novelty of the abovementioned Regulation is that if the deadline has been elapsed and the applicant has not complied with submitting the requested documents, the Documentary Processing Unit will return the documents submitted. In this case, any applicant that neglected or forgot to submit the requested documents and breached the deadline, the applicant will not lose the documents that were attached into the application form, as was previously the case.

It may also be the case that the omission has not been detected by the Documentary Processing Unit and the file has reached the Direction of Distinctive Signs. In these cases, it will be this Direction who will require the applicant to comply with the missing requirements, for which there will be a period of sixty days (60), without allotting a file number. In case of non-fulfilment, the application is taken as not submitted.

In practice the latter has always been allowed, since many of the incomplete applications have gone directly to the Direction of Distinctive Signs, without any objection and they have been the ones in charge of requesting the fulfilment of the documents through notifications.

Notification of precautionary measure to temporary deposits by e-mail

On the other hand, the Regulation presents an innovation in infringement procedures of industrial property rights. The main modification consists of INDECOPI's prerogative of notifying any precautionary measures by e-mail to temporary deposits authorized by SUNAT, without having to notify the domicile of these warehouses.

Any merchandise that enters the territory by an importer is stored in the private warehouses of the importing companies or in the warehouses of the national port company (ENAPU), where the merchandise is kept and under custody by SUNAT (Customs).

If the goods are counterfeit or imitates the trademark of a third party, this fact constitutes an infringement of trademark law and the holder of the brand can denounce the infringer before the INDECOPI.

It should be noted that SUNAT is generally aware of these events because the owner and the products are registered at the voluntary registration of trademarks of SUNAT (Customs). This voluntary registry is obtained by a request that the entrepreneur applies to SUNAT, in which it declares the ownership of the mark, by attaching images of its goods. Thus, if counterfeit products arrive, SUNAT will have to compare them with the images of the original products included in the application. Through this procedure, the authority may recognize the counterfeit merchandise and may even retain it in Customs to prevent it from entering the Peruvian market.

Supposing that any counterfeit merchandise arrives in the territory and it remains in custody in some of the private warehouses authorized by SUNAT. What happens if the authority becomes aware that the merchandise trying to be entered is counterfeit? SUNAT will notify the owner of the trademark, who will subsequently file a trademark infringement complaint after collecting images of said merchandise as evidence. The owner may request a precautionary measure in order to seize and immobilize the alleged counterfeit goods, the referred caution is ordered before the Direction of Distinctive Signs.

The mentioned Regulation enables now INDECOPI agents to notify these precautionary measures via e-mail provided by the warehouses, specifying the type of precautionary measure to be complied with and the identification of the merchandise on which it falls.

Previously, in order to issue any precautionary measures, INDECOPI had to issue a resolution ordering the seizure and immobilization of the merchandise and notifying it at the warehouse address, but this procedure will no longer be necessary because INDECOPI has been empowered to do so via email.

Likewise, in the event that the e-mail of the warehouse is not available, INDECOPI may request in writing that the temporary deposit should indicate the e-mail in which it must be notified, within a period of (05) working days, upon notice of imposing the sanctions established in the Law, by impeding the functions of the competent national authority.

Finally, although the referred legislation has simplified procedures, such as the communication of precautionary measures by electronic mail, in other cases, there has been no substantial change, as in the terms to fulfillment of the trademark applications

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