NEWS

Descriptive trademarks in foreign languages

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When we talk about descriptive trademarks, we refer to those signs that are exclusively made up of denominations that directly inform the consumer about one or several of the essential characteristics of the products or services that they distinguish. Paragraph e) of article 135 of Decision 486, prohibits the registration of this type of signs because such denominations are necessary for the identification and publicity in the market of the products or services they distinguish, therefore, an exclusive right cannot be granted on them since it would be affecting the interest and the right of other competitors, consequently, they must remain in the public domain. In this regard, the Andean Court has established that *“one of the methods to determine whether a sign is descriptive, is to ask the question “how” is the product to be registered, so that if the answer spontaneously provided -for example, by an average consumer- is equal to the designation of that product, there will be place to establish the descriptive nature of the denomination”.*[1]

On the other hand, in relation to trademarks consisting of names in a foreign language, as established by the Andean Court, words that are not part of the common knowledge are considered fantasy signs, and consequently their registration as trademarks is appropriate.[2] Likewise, in order to determine when a denomination in a foreign language is common knowledge, the same Court has established, among others, the following cases:

- When it is commonly used in connection with the products or services to be identified.
- When it shares a common root or phonetic similarity with its Spanish translation.

And it is here where a question arises, what rules apply in the case of signs consisting of foreign language names that are also descriptive? To solve this question, we can cite a real case, referring to the application for registration of the trademark SmallRig to identify products in class 09 of the International Classification [3]. In the first instance, the Directorate of Distinctive Signs of Indecopi, by means of Resolution No. 0062-2020/DSD-INDECOPI, refused ex officio the registration of said sign on considering that it was subject to the prohibition of registration established in paragraph e) of article 135 of Decision 486, considering the following:

"In effect, the sign applied for registration is made up of the term SmallRig, which in its translation into Spanish means SMALL EQUIPMENT [4], which refers to the accessories that are used with the products that are intended to distinguish with the sign applied for, in turn, the referred term is known in the market as that accessory that is used as a support for cameras".

The holder filed an appeal in which he pointed out, among others, the following arguments:

- That the term Rig was not a root and bears no similarity to its Spanish translation, which would be EQUIPO.
- That after a search for said term in web pages of different stores specialized in the sale of products of class 09, no results were found.

Then, by Resolution No. 2046-2020/CSD-INDECOPI, the appeal was declared well founded, stating that indeed the translation of the term in English *Rig*, would not be likely to be understood by the consumer public, because it has no common root, nor phonetic similarity with its translation into Spanish, nor was it a term frequently used in the Peruvian market, so it will be perceived as a fantasy sign.

What we notice in this case is that the first instance of INDECOPI analyzed the sign in question based on the rule of descriptive signs, which was later corrected by the second instance by applying the rule of signs with a denomination in a foreign language, a methodology that is much more appropriate in these cases, because although the translation into Spanish of a foreign language denomination may be descriptive, if it is not part of the common knowledge, it would not be informing about the characteristics of the identified product or service and it would not be used by the consumer in a spontaneous way to designate them, so it must be considered as a fantasy denomination that is subject to an exclusive right.

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1 Pre-judicial Interpretations 27-IP-2001 and 336-IP-2015

2 Pre-judicial Interpretations 73-IP-2021

3 Class 09: Stands adapted for cell phones; cell phone cases; telepointers; extendable arms for selfie sticks [handheld monopods]; lens hoods for photographic lenses; bags for cameras and photographic equipment; special cases for photographic apparatus and instruments; camera cases; camera tripods; tripods for cameras; chargers for electric accumulators; cords for cellular telephones; cases for photographic apparatus; smartphones; special bags for laptops; shutters [photography]; feet for photographic apparatus; photographic viewfinders; cases for smartphones; computer peripherals; USB memory sticks

4 https://www.linguee.es/espanol-ingles/search?source=auto&query=small+rig