

Latin America IP SME Helpdesk

Challenges & Opportunities LA

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INTERNATIONAL
IP SME HELPDESKS



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INTELLECTUAL PROPERTY ADVICE FOR YOUR BUSINESS

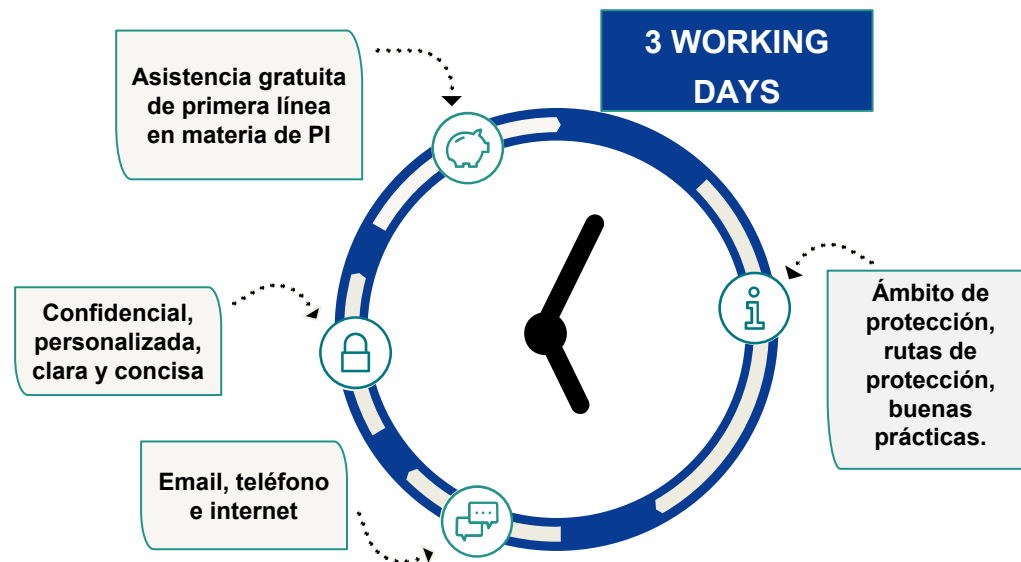


Six EU-funded helpdesks offer free resources to your small or medium-sized business to help you manage your intellectual property.

SERVICES FOR SMEs



FIRST LINE OF ASSISTANCE



ONLINE RESOURCES



Country and sector factsheet



Guides



Case studies



Training modules



Trainings and Events



Online and Face-to-face

SMEs and BSOs

**Capacity and
resources
development**

Fairs and events

Local experts

**Local and regional
focus**

Contacts

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Website & social media

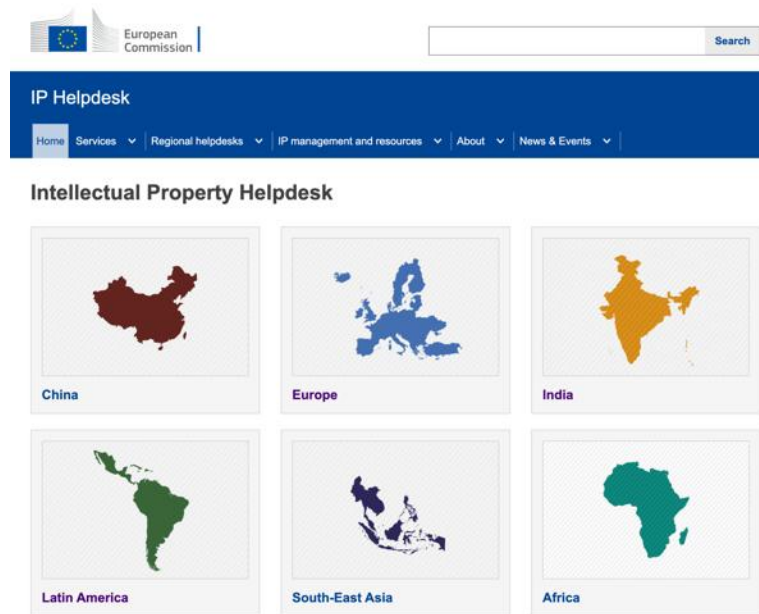
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The keys to protecting Intangible Assets?

→ Understand it is a **continuous process** in which it is necessary to:

- ◆ Identify the relevant assets
- ◆ Register the relevant assets
- ◆ Use/manage those assets
- ◆ Defend/Enforce those assets

→ All steps in the process **must be in alignment.**

→ Territory is an essential element to consider

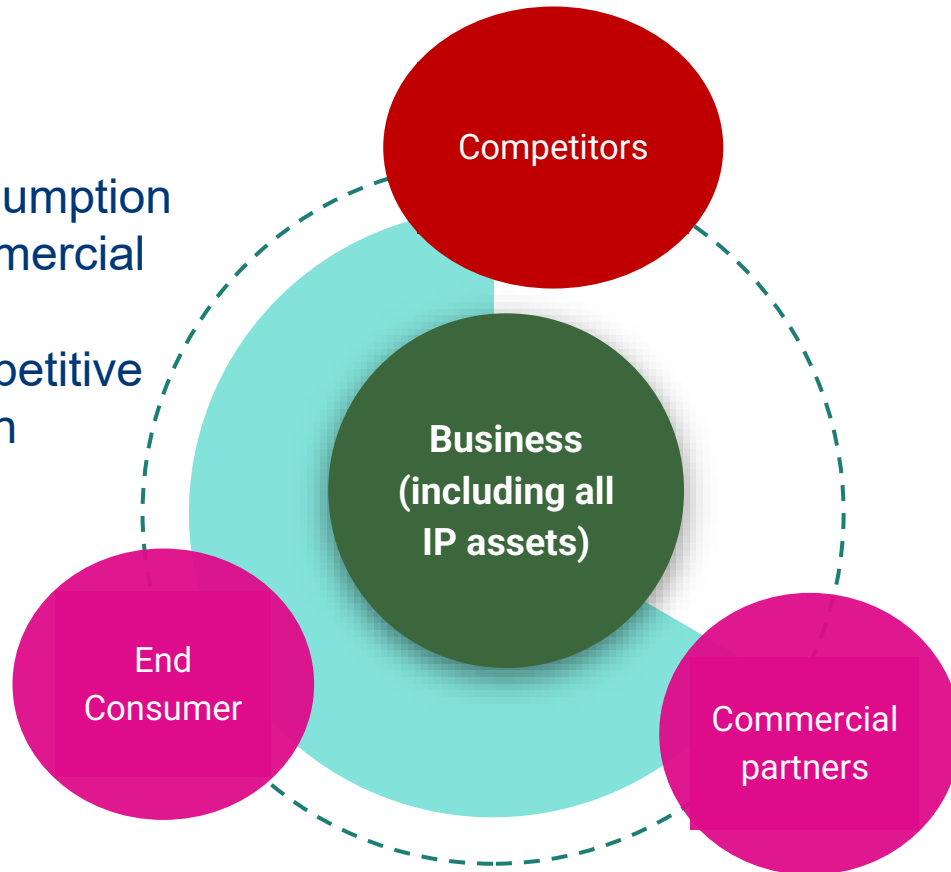
→ Sensitive to time

Managing Protection in practice

- *Registering the relevant IPRs*
- *Maintaining the existence of the relevant IPRs*
- *Considering the role the relevant IPRs play in each commercial relationship being negotiated or established in the relevant territory*
- *Registering agreements with INPI when needed (license)*
- *Registration of TM & copyrights with Customs authority*
- *Monitoring the relevant IPRs in the relevant market*
- *Taking action when needed*

When IPRs become relevant?

- Enabling consumption
- Enabling commercial relationships
- Enabling competitive advantage through exclusivity



Consumption in practice



Torres



Commercial relationships in practice



- Sales of goods (ecommerce, retailers, etc)
- Distribution agreements
- Agency agreements
- Franchise agreements
- License agreements
- Manufacturing agreements
- Supply agreements
- Joint Ventures
- Collaborations (other companies, influencers)

Competitive advantage in practice

**To own what
others want in
commercial
exclusivity**



Competitive advantage in practice II

Exclusivity in IP means *control over a proprietary right.*

→ *others cannot use IPR without owners consent*

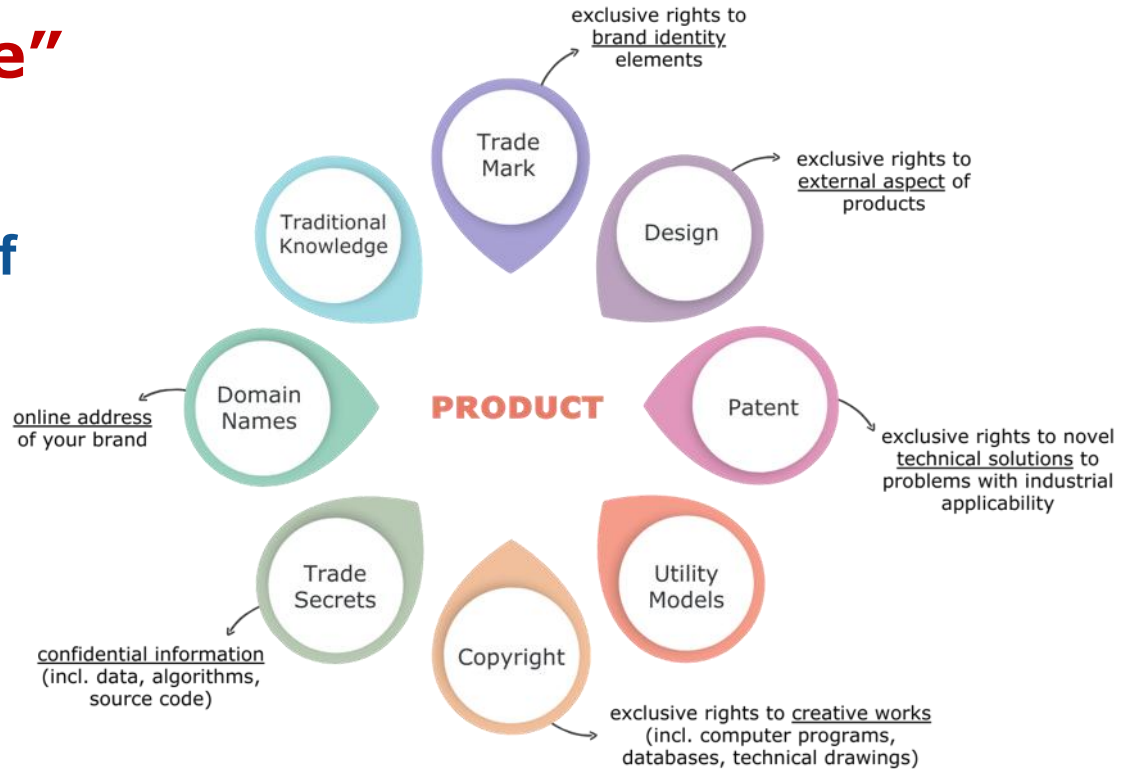
**◆ make, use, sell, import, export, reproduce,
distribute, display**

Exclusivity may need to be defended

When an the **infringer** (some that may be a party to a contract with the IPR holder, a competitor, or a total stranger) **uses** owned **IPR** **without authorisation** in the relevant territory of commercial interest where the relevant IPR exists.

“Defence in practice”

requires the existence of
**right, generally through
registration**



Registration may not be enough for the existence of the relevant IPRs

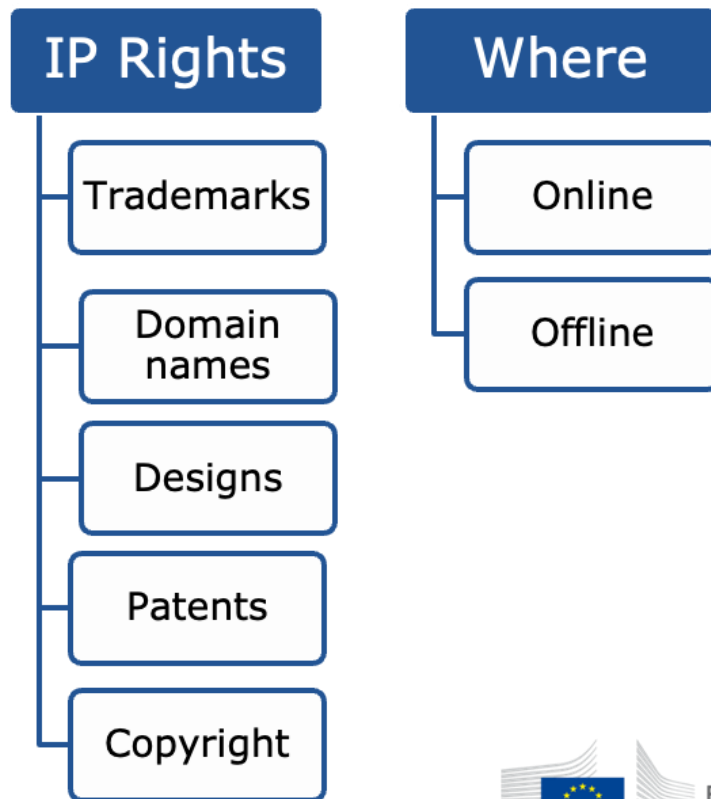
→ Renewals

→ Obligations of use

→ Declarations of use

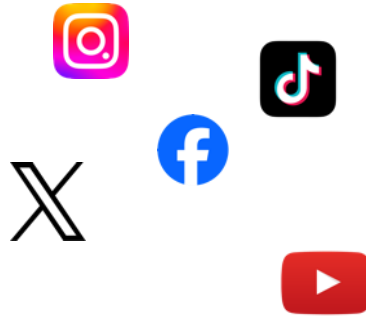
Keeping an eye open

By monitoring what is
happening with proprietary rights



Market watch (online)

Monitors mentions, keywords, hashtags and uses of your IPRs on social media, marketplaces, and search engines



Market watch (offline)

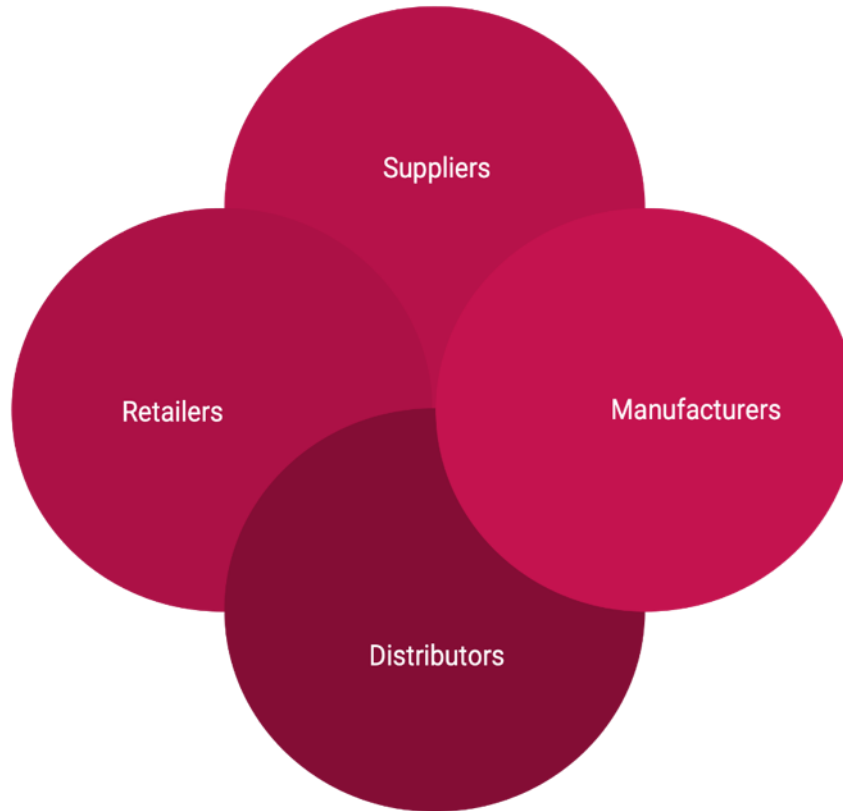
Monitors unauthorised use of your IPRs in the physical world

- *More challenging to do*
- *IP firms offer detective or inspection services*
- *Customs (only TM & ©, including software)*



Keep an eye out for the supply chain

- FORMAL RELATIONSHIPS
- CONTRACTS
- SPECIFIC CLAUSES



- Product design and assembly.
- Quality control.
- Inventory management during production.

(formal) relationships in practice



ZARA havaianas



Barbour x Crocs

- Sales of goods (ecommerce, retailers, etc)
- Distribution agreements
- Agency agreements
- Franchise agreements
- License agreements
- Manufacturing agreements
- Supply agreements
- Joint Ventures
- Collaborations (other companies, influencers)

(informal) relationships in practice

- In Negotiation
- Commercial agreements not formalised in writing
- Deals that fell through

How?

- *Subscription services (**IPRs monitoring**)*
- *Through your IP lawyer*
- *Marketplace registration (e.g. **Amazon Brand Registry**)*
- *Social media management tools*
- *Google ads*
- *Customs registration*

Unauthorized use detected?


Where?

- **INPI registry** → *opposition (reputed®/well-known mark?)*
- **Social media, marketplace** → *complaint with platform*
- **Domain names** → *UDRP; .BR Policy*
- **Google ads** → *trademark, counterfeit, copyright complaints*

Unauthorized use detected?

Next steps:

- **Pre-litigation** → *cease-and-desist*
- **Litigation** → *Courts*
- + *Preliminary Injunctions*




European Commission

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FACTSHEET

1. Customs in Brazil:
An overview
2. Protecting your trade marks:
First step
 - A. Benefits of trade mark registration
 - B. Registering your trade mark in Brazil
 - C. Identifying your registered trade mark in the course of trade
3. Prior steps: Informing authorities
 - A. Inspection request to COANA
 - B. Registering your IPR with the NDCC
4. Border measures
 - A. Administrative proceedings
 - B. Judicial proceedings
5. Enforcing your unregistered trade marks
6. Glossary
 - A. Unfair competition
 - B. Famous and well-known marks
7. Related links and additional information

Using Customs to Enforce Your IPRs in Brazil



1. Customs in Brazil: An overview

Customs and border protection are essential and useful tools to fight counterfeiting (see Glossary) throughout the Latin American region. Due to its geographical extension, which covers borders with 10 countries in South America, Brazil is unsurprisingly a key country in the international route of counterfeit products in South America. In 2019 alone, the [Brazilian authorities](#) managed to detain and seize over € 275 million in counterfeit goods, which mostly comprise tobacco (35 %), electronics devices (11 %), clothes (7 %) and toys (4 %).

In 2019, the National Council for Combating Piracy and Crimes against Intellectual Property (CNCP) attended various international meetings in order to exchange experiences, achievements and goals related to the combat of piracy, and signed memorandums and treaties with various public authorities and private sector organisations.

The CNCP also provides educational campaigns and Brazilian society has begun to accept the idea that piracy is illegal and that it results in losses and a high social cost to Brazil. However, in spite of such efforts, a report made in 2015 estimated that 69 % of Brazilians admit to having bought fake products. The most desirable counterfeit goods in the Brazilian market are clothes (39 %), accessories (24 %), footwear (22 %), electronics (17 %) and fragrances (14 %) (source: SPC Brazil report 2015).

Most counterfeits available in Brazil come from Asia, Paraguay and Argentina. To prevent these products from being imported and subsequently distributed in Brazil, the National Customs Office plays an essential role in representing the first obstacle to the entry of counterfeits in the national market.

The effectiveness of customs measures in Brazil strongly relies on the proactivity of right holders: this guide will provide you with practical information, methods and strategies to protect you from counterfeiters.

Counterfeiting is well-known and broadcast in the media due to the volume of seizures and cases brought to justice in Brazil. This activity affects mostly trade marks, and to a lesser but also relevant extent, it affects industrial designs, as well as other intellectual property rights, including patents. For this reason, the Brazilian procedure to register a trade mark and its importance are specifically detailed below.



European Commission

Case-study

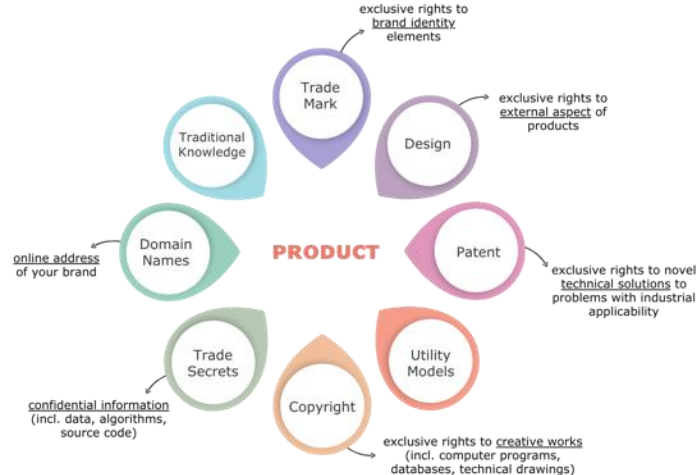
Points to remember

- Why IPRs?
- How to acquire IPRs ownership in the country of destination?
- How to use IPRs to create economic value?
- How to defend and enforce IPRs in the face of an unauthorised use?



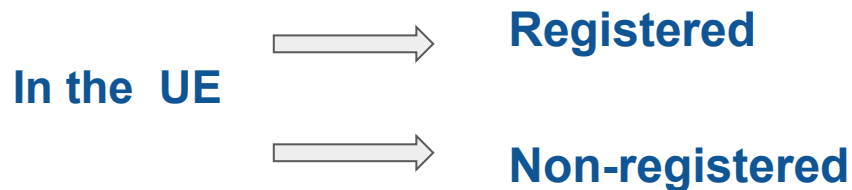
A Belgian fashion company is launching a new collection incorporating monograms into textiles. And it is beginning negotiations with a Peruvian company to distribute the collection in Peru.

What type of exclusive rights could it have to attract the interest of potential local partners and end consumers in the destination?



The design as an exclusive right

El diseño confiere a su titular un derecho exclusivo sobre el novedoso aspecto (externo) de un producto o su empaquetado.



An unregistered design in the EU is very **time-sensitive**, as it is only valid for three years from the date of its first public disclosure.

¿How to acquire this IPR (design) in Perú?

- Formal Registration registration request to National IP Office

Internationalization of the Design - time-sensitive (12 months from first disclosure)

Specific features of the country of destination - territoriality (no rights for unregistered designs)

- Legal Requirements:

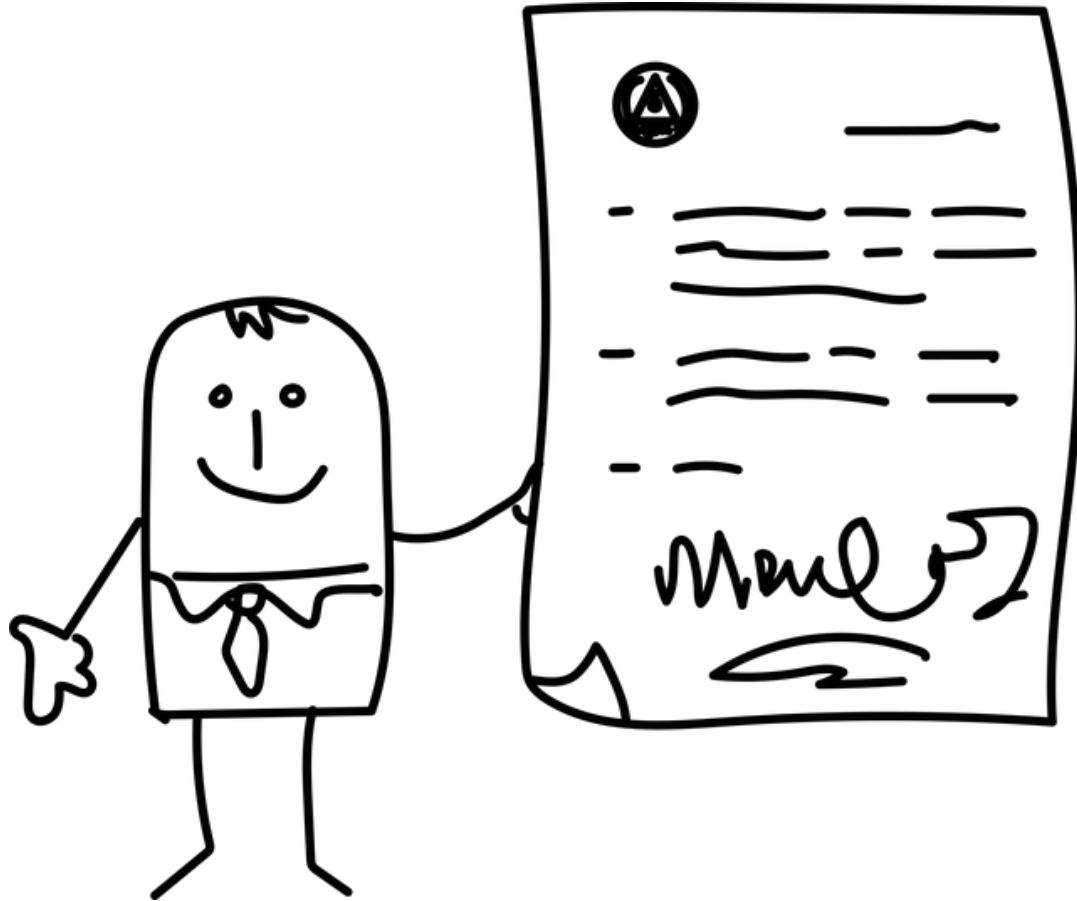
- External appearance,
- novel,
- Original
- Industrial applicability
- Not excluded by law (Designs that are purely functional (no ornamental value).

Three-dimensional elements, such as the shape of a product;

Two-dimensional elements, such as the ornaments, figures, lines, or colors of the combination of elements

- The Peruvian company, with which they negotiated, launched a collection with a **very similar monogram**.

Is there a violation of the Belgian company's (design) right?



No formal contract has been signed, although that is not the biggest problem here.

- **Registration and Defense** - There is no infringement where the right does not exist.
- **Registration and Commercial Use** - Where there is no right, there is no incentive for potential business partners (distributors in this case) to enter into a contractual relationship (since the contract is not able to guarantee them exclusivity against third-party infringements/unauthorised uses).





Italian company register a word trademark and a figurative trademark (logo) in Colombia, where they signed a Franchise agreement with a local partner.



¿How to acquire this IPR (TM) in Colombia?

- **Formal Registration request to either National IP Office or WIPO**
- **Legal requirements**
 - **Distinctiveness**
 - **Legality and Morality** - Marks that are **contrary to public order, morality, or misleading** (e.g., about origin, quality, or characteristics) are not allowed.
 - **Availability** - The trademark must not **conflict with prior rights**, including: Earlier registered trademarks, Well-known or famous marks (even if not registered), Commercial names or trade names in use, Appellations of origin or geographical indications
 - **Lawful Use of Signs** - The sign must not: consist of flags, coats of arms, or symbols of states or international organizations (Art. 135, Decision 486); Include names or likenesses of individuals without authorization; Be identical or similar to religious or official symbols

- **Use Intent** - The applicant must declare an intention to use the trademark in commerce. Actual use is not required at filing but becomes relevant for maintaining the registration (non-use for 3+ consecutive years may lead to cancellation).



Franchise agreements are governed under **general contract law** and **commercial law**, particularly under the **Commercial Code** and **Civil Code**.

Although the franchise agreement itself is not subject to registration, the **trademarks licensed through the franchise must be duly registered** with the **Superintendence of Industry and Commerce (SIC)**.

It seemed like everything was in place ...

Colombia company decides to give the **logo a makeover** without asking the trademark owner.

Italian company calls for mediation as stipulated in the contract with the local partner.

Colombian company argues the contract **is not enforceable as it was not registered with the local authority.**

Is there a violation of the Italian company's right?

The use of a registered trademark in a way that has not been authorised in the contract constitutes an infringement of said right.

Although it is **recommended** to record the **franchise/license agreement** with SIC for opposability against third parties, it is also **recommended not mandatory for it to be enforceable between the signatories**.

Key Lessons for IP Strategy Success

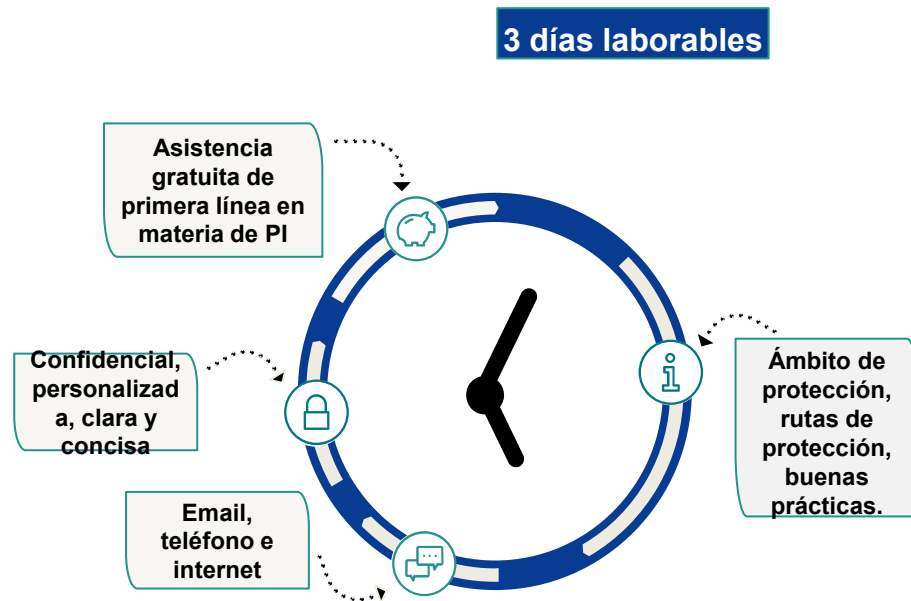
Align your IP strategy...

- **Register:** Secure IPRs in target markets to establish legal rights.
- **Use:** Ensure consistent use of the registered IPR to maintain exclusivity.
- **Monitor:** supply chain and market to reveal unauthorised uses.
- **Defend:** enforce IPRs to protect against infringement.

Takeaway

- A cohesive IP strategy drives business success and safeguards brand value.

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