

MULTICLASS MARKS

BACKGROUND: THE MONOCLASS TRADEMARKS

In Decision 344 appeared a new restriction that is introduced with said decision. According to “Article 87 .- The application for registration of a trademark must be filed with the competent national office, shall cover a single class of goods or services and meet the following requirements ...” This means that the sign on which is applied for the granting of a registration, should fall on the products or services of a single class, that is, with a monoclase trademark, it is possible to apply for the registration of a trademark for goods and services belonging to a single class of the Nice Classification (International Classification of Goods and Services for the Registration of Marks), which consists of 45 classes, 34 classes for products and 11 classes for services.

EXAMPLE

An individual with a business of threads, rugs and carpets, that would like to register trademark ABC for these three products of his business, he must file three applications for registration: one for threads (Class 23), one for rugs (class 24) and an additional one for carpets (Class 27).

MULTICLASS MARK

Faced with the traditional monoclase mark, the modernity in trademark law has brought with itself the multiclass registration, that since decision 689, allows a single application for registration of a trademark for goods and services belonging to several classes.

“Decision 689: f) Article 138: To allow the establishment of a multi-class registration of trademarks.”



The changing of the Mono-class system to Multi-class derives from the obligation undertaken by Peru in the APC to sign the Trademark Law Treaty of 1994. For this, the applicant must expressly indicate the products and/or services desired to claim, which will be designated by their names and grouped according to the classes of the International Classification.

Multiclass application can then be split into two or more divisional applications, in which case the Authority will assign a new docket number to the divisional application, which will nevertheless retain the filing date of the original application and the benefit of priority, if corresponds. The division may be requested at any time of the procedure for trademark registration. Similar to the system to divide an application for registration, the holder of a trademark already registered claiming several goods and/or services, is conferred the possibility of splitting the registration into two or more divisional registrations. The divisional registration will be governed by the requirements applicable to the division of trademark applications.

Continuing the above mentioned example, with the old system the merchant would be allowed to apply in the same time the registration of trademark ABC for classes 23, 24 and 27.

COMPARED LEGISLATION

Let's see how this issue is regulated in some nations and treaties:

Trademark Law Treaty (TLT): "Article 3, a) Any Contracting Party may require that an application contain some or all of the indications or elements:

XV: The names of products and/or services for which registration is sought, grouped according to the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belong and presented in



the order of the classes of that Classification.”

Industrial Property Law of Chile: “Article 23 - Each mark can only be requested for specific and determined products or services, with the indication of the class or classes of international classification to which they belong ...”

Uruguay Trademark Law: Article 32 - Once applied for the registration of a trademark the number of products or services for which protection was sought may not be increased, even in the same class, but it may be limited the object of protection by eliminating classes, products or services.”

Industrial Property Law of the Dominican Republic: Article 761 – it will be considered as the date of filing, its receipt by the National Office of Industrial Property, provided that It contain at least the following elements:

d) A list of the goods or services for which the mark is desired to protect, and an indication of the classes to which the products or services correspond.”

The Community Trademark Law of the European Union has included in its registration procedure that ... “A Community trademark application can cover the 42 classes of the International Classification, if desired, by paying an additional supplement from the 3rd class requested. The first three classes are included in the cost of the application.”

Industrial Property Law of Mexico: “Article 93 .- The trademarks will be registered in relation to goods or services determined according to the classification established by the regulations of this Law. Any doubt about the class to which corresponds a product or service, shall be resolved ultimately by the Institute.” This rule does not refer to a single class to register so it is understood that there may submit multiclass applications.

As it can be appreciated, the mono-class legislation was inconsistent with current



trends in registering trademarks, that were directed to submit multiclass registrations before the national offices.

As shown, in some regulations it is stated the possibility of registering a sign for more than one class (Chile, Uruguay, Dominican Republic, European Union, TLT) and in others the law is silent, so it is assumed the consent to perform such registration. It is possible, in our view that the community lawmakers have tried to limit, with this measure, the accumulation of the same sign for a certain number of classes avoiding the non-use by others of the sign in different classes. If that was its meaning, evidently it was a higher limit for applicants of lesser financial power.

LICENSE OF USE

The trademark owner can use and dispose of it having the power to assign or allow its use by a third party through a license, likewise it can prevent third non authorized parties the use of the trademark.

Under the provisions of Article 154 of Decision 486 of the Andean Community Commission, the right to exclusive use of a trademark is acquired only through registration with the competent national office of each country, which in Peru is INDECOPI. This registration also gives its owner the right to proceed against any third party that without your consent perform the following acts:

- a) To apply or use the trademark or a distinctive sign identical or similar on products for which the trademark is registered; on products related to services for which it is registered, or on containers, wrappers, packaging of such products.
- b) To eliminate or modify the trademark for commercial purposes after it has been applied or placed on products for which the trademark is registered; on products linked to the services for which the mark is registered, or on packaging , wrappers, packaging or packaging of such products.



- c) Manufacturing labels, containers, wrappers, packaging or other materials that reproduce or contain the trademark, as well as to sell or store such materials;
- d) Commercial use of a sign identical or similar to the trademark for products or services where such use could cause confusion or a risk of association with the owner of the registration. In case of use of an identical sign for identical goods or services it shall be presumed there is a risk of confusion.
- e) Using in trade a sign identical or similar to a well-known trademark in respect of any goods or services, where they would cause to the owner of the registration an unjust economic or commercial harm because of a dilution of the distinctive force or of the commercial or advertising value of the trademark, or owing to unfair exploitation of the prestige of the mark or of its owner.
- f) Use publicly a sign identical or similar to a well known mark, even for non commercial purposes, where such use could cause dilution of the distinctive force or of the commercial or advertising value of the trademark or unfair exploitation of its prestige.

Indeed, the right on a trademark has two dimensions, one positive, under which the trademark owner can use and dispose of it having the power to assign it or allowing its use by a third party through a license and a negative dimension that is the faculty of the owner to prohibit non authorized third parties use of the trademark.

Related Information

Article 162 of Decision 486 of the Andean Community Commission indicates that “the owner of a registered trademark or in process of registration may license to one or more parties the use of the trademark. It must be registered with the competent national office any license of use of the trademark. Failure to register shall render the license invalid with respect to third parties.”



The license has been defined by the Andean Court of Justice as:

“That for which the owner of the trademark (licensor) cooperates with another company (licensee) in order to expand the production and distribution activities of products bearing the corresponding trademark. In this contractual relationship gives the licensor authorizes the licensee to apply and use the trademark on the corresponding goods, that is, the licensor gives the licensee the right to use the mark.”

The principle of territoriality of trademarks

In addition to the aforementioned, it is worth to underline that the industrial property rights born in the member countries of the Andean Community by an administrative act of granting of the competent administrative authority that in the case of Colombia is the Superintendence of Industry and Commerce . Consequently, legal protection and practicing of right is bounded to the territory of the country where the respective concession is granted, so that protection cannot be extended beyond the territory of the State concerned. From this derives then the so-called principle of territoriality in Industrial Property.

According to Article 154 of Decision 486 of the Cartagena Agreement Commission, “The right to exclusive use of a trademark shall be acquired by its registration before the competent national office.”

Regarding the territoriality of the trademark, the Andean Court of Justice has ruled that “The general rule in trademark law is that the exclusive right granted to the owner of a trademark should be limited to the territorial scope wherein the trademark law is applied. This territorial connotation also makes that trademarks registered abroad cannot enjoy the right of exclusivity in a particular country.”

Under the principle of territoriality of trademarks, an owner of a trademark, for example, in Brazil, has no means to oppose an application for registration of a



trademark in Colombia.

Notwithstanding the foregoing, the owner of a trademark granted abroad may oppose the registration of a trademark in Colombia, in the events mentioned in paragraphs d) and h) of Article 136 of Decision 486 of the Andean Community.

Related Information

Decision 486, Article 157

“Third parties may, without consent of the owner of the trademark, use in the market its own name, address, pseudonym, a geographical name or any other indication concerning the kind, quality, quantity, intended purpose, value, place of origin or time of production of its products or of the rendering of their services or other characteristics thereof, provided this is done in good faith, does not constitute use as a trademark, and such use is confined to identification or information purposes only and is not likely to create confusion over the source of the goods or services. The registration of a trademark does not confer on its owner the right to prohibit a third party from using the trademark to announce, even in advertising using brand comparisons, offer for sale or advertise the existence or availability of lawfully trademarked goods or services, or from advertising the compatibility or suitability of spare parts or accessories that may be used with goods bearing the registered trademark, provided that such use is in good faith, is confined to the purpose of informing the public and is unlikely to lead to confusion over the corporate origin of the goods or services concerned.”

In order to protect the rights of third parties, Article 136 of Decision 486 states that those signs, amongst others:

“That are identical or similar to a distinctive sign of a third party that, given the circumstances their use would result in a likelihood of confusion or mistaken association where the applicant is or was a representative, distributor or a person



expressly authorized by the owner of the protected sign in a member country or abroad” may not be registered as trademarks

That consist of a total or partial reproduction, imitation, translation, transliteration or transcription of all or part of a well-known sign belonging to a third party without regard to the type of product or service to which it shall be applied, the use of which would lead to a likelihood of confusion or mistaken association with that party, taking unfair advantage of the prestige of the sign; or weakening its distinctive force or its use for commercial or advertising purposes. “

