

Guatemala

Contributing firm

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1. Legal framework

National

Trademarks in Guatemala are governed by:

- the Industrial Property Law, enacted in November 2000; and
- the Industrial Property Law Rules.

International

In addition, Guatemala is a signatory to the following international treaties and conventions on trademark rights:

- the Inter-American Convention for the Protection of Trademarks and Commerce;
- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Central American Convention for the Protection of Industrial Property; and
- the Guatemala-France Bilateral Treaty for the Protection of Industrial Property and Trademarks.

2. Unregistered marks

Protection

Guatemalan law provides that trademark rights are acquired through registration only. However, an unregistered trademark may still enjoy certain other rights. A famous or well-known trademark benefits from the same rights and protection as a registered trademark. These include:

- the right to oppose a trademark registration requested by a third party;
- the right to request that a third party cease unlawful use of its trademark; and
- the right to seize counterfeit goods.

The owner of an unregistered trademark that is not well known can oppose the registration of a conflicting trademark by claiming a priority right

under an international treaty, provided the claim is made within the time limit set forth by that treaty.

Use requirements

As protection is available only for famous trademarks and is otherwise limited to priority rights under international treaties, proof of fame or a foreign application, rather than use, is required to establish rights in an unregistered mark.

3. Registered marks

Ownership

Any individual or entity, regardless of its nationality, domicile or activity, may own a trademark.

Scope of protection

Protected: Under Guatemalan law, a trademark can consist of any word or group of words, letters, numbers, monograms, figures, coats of arms, portraits, labels, emblems, prints, lines, colour combinations or geographical indications - as long as they do not create confusion as to the source of the goods. A trademark may also consist of the form, presentation or condition of the goods, their packaging or their means or points of sale, or other distinctive elements.

Not protected: The following constitute absolute grounds for refusal of registration:

- The mark is merely descriptive when used on or in conjunction with the goods or services;
- The mark comprises a utility device or constitutes the usual form of the product;
- The mark is derived from something that gives the product a functional advantage;
- The mark comprises a common or usual name for the goods or services in everyday, technical or scientific language;
- The mark comprises exclusively a sign, indication or adjective that may be used in commerce to describe a characteristic of

the goods or services, a translation of such into another language, an orthographic variation or the artificial construction of unregistered words;

- The mark comprises a single letter or digit, unless it is presented in a special and distinctive form;
- The mark is contrary to public policy or morality;
- The mark includes an element that offends or ridicules the people, religions or national emblems of any country, or an international entity;
- The mark may mislead the public about the geographical or cultural source, nature, manufacturing process, quality, quantity, suitability for use or other characteristics of the goods or services;
- The mark comprises a geographical indication that does not meet the requirements of law;
- The mark reproduces, wholly or partially, the coat of arms, flag, emblem, denomination or abbreviation of any state or international organization without the authorization of that state or international organization;
- The mark reproduces, wholly or partially, an official control or quality sign adopted by a state or public entity without the corresponding authorization;
- The mark reproduces legal tender (coins or bills) from any country, securities or other commercial documents, seals, stamps, tax stamps or any revenue stamp in general;
- The mark includes or reproduces medals, awards, diplomas or other elements that suggest awards in relation to the product or service, unless the award was actually received;
- The mark consists of a plant variety protected in Guatemala or abroad in relation to products identified by that plant variety; or

- The mark is a certification mark that was cancelled or is no longer in use due to the dissolution or disappearance of its holder for a period of 10 years.

The following constitute relative grounds for refusal:

- The mark is identical or similar to an earlier trademark which is registered or pending registration for identical or similar goods or services;
- The mark is identical or similar to an earlier trademark which is registered or pending registration for different goods or services, when there is a risk of confusion or association;
- The mark may cause confusion with an earlier registered commercial name, where the owner of that commercial name deals regularly in identical or similar goods or services to those for which registration is sought;
- The mark, wholly or partially, constitutes a reproduction, imitation, translation or transcription of a famous or well-known mark, irrespective of the goods or services, where such use would cause confusion or create a risk of association, take unfair advantage of the renown of the famous mark or diminish its distinctive character;
- The mark infringes a third party's right of publicity, in particular the name, signature, nickname, image or portrait of someone other than the applicant, unless that person has authorized such use;
- The mark affects the name, fame, image or reputation of a local, regional or national collective, unless the applicant has obtained authorization;
- The mark constitutes a reproduction or imitation, in whole or in part, of a protected certification mark;
- The mark infringes a third party's copyright or industrial property right; or
- The mark can be used to commit or consolidate an act of unfair competition.

4. Procedures

Examination

When a trademark application is submitted, it undergoes two types of examination. The first is a formal examination, to ensure that the application complies with all formal requirements. If the application is in order, a novelty examination will be conducted; this involves a database search to determine whether the application conflicts with an existing trademark that is already registered or pending registration.

Opposition

Once the novelty examination has been completed and the registrar of trademarks is satisfied that no conflicting trademarks exist, the trademark will be published three times for opposition purposes. The opposition period is two months from the date of first publication.

Registration

If no oppositions are filed within this two-month period, or if all oppositions are successfully overcome, the registrar will issue a payment order to the applicant. Upon payment of the fee, the registrar will issue the trademark title. The registration period is 10 years from the registration date.

Cancellation/surrender

A trademark owner can cancel a trademark registration, in whole or in part, at any time. It can also limit the scope of protection by filing a request to limit the goods or services covered by the trademark. In both cases the trademark owner need only submit a written petition to the registrar. The only formal requirement for this petition is that the signature be notarized.

Revocation

One of the many changes introduced by the Industrial Property Law is the cancellation action for non-use. Although use of a trademark is

required in order to maintain the registration, the law also grants a five-year grace period before this requirement becomes effective. Thus, as the law was enacted in 2000, no cancellation action for non-use can be brought before November 2005. Once this grace period has elapsed, any interested party can request cancellation of a trademark for non-use. In order to succeed, the petitioner must prove that the registered trademark has not been used for at least five years. How much use is required to avoid cancellation remains to be seen.

A request for cancellation can be filed:

- as a response to an objection raised by the registrar;
- as a response to an opposition filed by a third party;
- as a defence against an annulment action; or
- as a defence against an infringement action.

Any interested party may also request cancellation of a trademark registration if the mark has become generic since registration.

Invalidation

Under the Industrial Property Law, the registrar cannot cancel a registration on its own initiative. However, where a trademark should not have been registered due to the existence of absolute grounds for refusal at the time of registration, the state can request the cancellation or annulment of the trademark registration.

Any interested party can also request that a trademark registration be declared invalid if it infringes the rights of third parties. As well as the relative grounds for refusal discussed in section 3 above, the law specifies the following additional grounds for invalidation:

- The registration was obtained on the basis of false or inaccurate information;
- The owner is or was an agent, representative, client or distributor of a foreign trademark owner and has registered the mark without its consent;

- The trademark infringes a famous mark; or
- The trademark owner knew or ought to have known of a conflicting trademark, due to its business or activity.

The annulment of a collective or certification trademark must be declared in full. A collective or certification mark can be annulled if:

- the rules for use of the trademark are contrary to morality or public policy;
- the trademark was granted without fulfilling the requirements on the rules for use of the trademark; or
- use of the trademark contravenes legal principles or applicable rules in a way that undermines its function.

5. Enforcement

Complexity

Although, in theory, the law provides for a simple and swift oral procedure for the enforcement of trademark rights, in practice this procedure can be complicated and slow, primarily because many judges lack the necessary expertise to handle trademark matters. The law sets out several different precautionary measures which will be granted by the courts in most infringement cases. Many of these measures achieve the desired goal of stopping the infringing acts. Unregistered rights can be tougher to enforce, not because they are subject to different procedures, but rather because for most judges, it is harder to understand rights that arise from something other than registration. Hence, they are more reluctant to grant precautionary measures, which are ultimately as important as the final sentence and can simplify the procedure if granted and enforced.

Registration grants the trademark owner, among other things, the exclusive right to use the mark. Therefore, where anyone violates this right by

unlawfully using an identical or similar trademark, the owner is entitled to demand that the infringement cease and in many cases to receive damages. This includes the right to prevent the import of infringing goods. Under Guatemalan case law, the following actions, among others, constitute either a violation of a trademark right or an unfair competition action related to IP rights:

- any act that may create confusion as to the source of goods or services, or cause dilution of a mark;
- registration of a mark that cannot be registered by law; and
- unauthorized use of a trademark owner's labels, containers or any packaging or presentation methods, or of copies, imitations or reproductions that may create confusion as to the source of the goods or services.

The following, among others, are considered criminal violations of IP rights:

- the introduction onto the market, sale, solicitation, warehousing or distribution of goods or services protected by a registered mark, or the counterfeiting of a registered mark in relation to identical goods or services;
- the use in trade of a third party's registered commercial name or publicity slogan;
- the introduction onto the market, sale, solicitation, warehousing or distribution of trademarked goods or services that have been altered in some way;
- the use, offering for sale, warehousing or distribution of trademarked goods or services after a cease and desist order has been issued;
- the manufacture of labels, containers or other packaging that reproduces or bears a registered mark;
- the reuse of any wrapping, container or other packaging that bears a registered trademark;
- the use or exploitation of a third party's commercial secret; and

- the use of a false denomination of origin, even if the true origin is displayed or if it is used in connection with expressions such as ‘like’, ‘type’, ‘imitation’ or similar.

The remedies available to a trademark owner include the following:

- cessation of the infringing acts;
- seizure of the infringing goods, including wrapping, containers, packaging, printed materials, marketing materials or any materials used in connection with the infringement, and the equipment used to commit it;
- prohibition against the import of such infringing goods, materials or equipment;
- any measure needed to prevent the continuation or repetition of the infringement, including the destruction of all infringing goods, materials and equipment; and
- the suspension of any permits needed to import, distribute, sell or commercialize the goods in question.

Timeframe

Due to the multiple remedies and appeals available, it can take some time to conclude a trial, whether civil or criminal and whether the mark is registered or not. In many cases trials drag on for years before being finally resolved.

6. Ownership changes – legalization requirements

As Guatemala does not recognize legalization by apostille, documents must be legalized by the local Guatemalan consulate. When seeking to register a change of ownership or name, two documents must be legalized: the assignment or change of name certificate and the power of attorney.

7. Areas of overlap with related rights

In Guatemala, as in most countries, trademark law overlaps with copyright law in many cases. Copyright and trademark law are essentially different in nature, but they do overlap in many instances. Remedies may be different, but trademark infringement can also constitute copyright infringement. Creations enjoy copyright protection regardless of their artistic merit: a creation need only be original to enjoy protection under Guatemalan copyright law. When a creation is used as or in connection with a trademark, any reproduction thereof constitutes both a trademark and a copyright infringement.

8. Online issues

In 1992 the Internet Assigned Numbers Authority delegated the administration of the country-code top-level domain ‘.gt’ to a local university (Universidad del Valle de Guatemala). Guatemalan domain names fall under the following sub-domains:

- ‘.com’ (commercial activities);
- ‘.edu’ (educational institutions);
- ‘.net’ (free use);
- ‘.gob’ (Guatemalan government bodies);
- ‘.org’ (free use);
- ‘.mil’ (military institutions); and
- ‘.ind’ (individuals).

When it comes to dispute resolution, the local administrator has made arrangements with the World Intellectual Property Organization so that its Arbitration Centre will handle all disputes arising from the use of the ‘.gt’ top-level domain in accordance with the Internet Corporation for Assigned Names and Numbers’ Uniform Dispute Resolution Policy. This includes IP-related matters.