

Venezuela

Standing on its own: Venezuela re-establishes its national IP system

Protecting domain names

In Venezuela, domain names are issued by and protected through the *Centro de Información de la Red de la República Bolivariana de Venezuela*. The registry provides protection for second-level domain names for the ‘.co.ve’, ‘.com.ve’, ‘.net.ve’, ‘.org.ve’, ‘.info.ve’ and ‘.web.ve’ extensions.

In a similar manner to trademarks, the registration of domain names is governed on a ‘first come, first served’ basis, with the particularity that registration of domain names is not subject to an administrative procedure, as trademarks are.

Sometimes it is unclear which extension should be chosen for registration. In order to decide, it is necessary to take into consideration the nature of the website and to bear in mind that in Venezuela, the most important extensions are ‘.com.ve’, ‘.co.ve’, ‘.net.ve’ (which represents the word ‘network’) and ‘.web.ve’, which is designed to be used for publicity purposes (specifically for non-permanent campaigns).

Therefore, when considering the registration of a trademark, it is vital to consider not only registering high-level domains such as ‘.com.ve’ and ‘.net.ve’, but also protecting your trademark by using domain name protection to complement trademark protection.

Trademark owners can register all possible extensions and redirect them all to one webpage by using the same domain name server. This additional protection prevents a third party from threatening the brand identity by using a third-level extension for derogatory purposes.

Trademark infringement carried out through the use of domain names is common. Although the Internet Corporation for Assigned Names and Numbers Dispute Resolution Procedure is available, the Venezuelan national registry sets down requirements for domain name registration which, in most cases, are also used by the host provider.

In practice, conflicts between trademarks and domain names, as well between domain names, have been

resolved by the correct use of such requirements – the host provider usually agrees to shut down the conflicting website. Even if the rights holder does not instigate court proceedings, the host provider is considered to be responsible for allowing or cooperating with an infringement.

Therefore, trademark owners should also consider broader protection using the domain name system.

New regulations on trademark and patent filings

Recently, Venezuela has become more independent in terms of IP rights, specifically in relation to trademarks and patents. This is because in September 2008 the Venezuelan Patent and Trademark Office (VPTO) reinstated the enforceability of the Industrial Property Law 1955. The 1955 law applied until Decision 486 of the Andean Community of Nations came into force during the 1990s.

As a result, the VPTO has issued new regulations governing the filing process; rights holders should bear the new regulations in mind when preparing a global filing programme. One VPTO notice stated that trademark applications shall be accepted only if they are submitted with all documents established by the law, including priority documents and power of attorney; previously, the late filing of these documents was allowed.

In light of the above, in order to comply with the new regulations, all trademark, slogan and commercial name applications must be accompanied by the following:

- a phonetic search (denominative trademark);
- a graphic search (graphic trademark);
- a search of figurative and phonetic elements (complex trademarks); and
- a power of attorney (if the power of attorney comes from abroad, it must be notarised and certified by apostille or legalised by the Venezuelan consulate; if it has been granted in a language other than Spanish, it must be translated by a Venezuelan certified translator).

Since the reinstatement of the Industrial Property Law, the VPOT has also ordered that all applications must comply with both local and international classifications. Applications may be subject to reclassification where an international class falls into more than one local class.

In this respect, the local classification is the same local classification as is used in the United States, but with the particularity that instead of filing a single application indicating the international classification and the corresponding local classes, in Venezuela, it is necessary to submit as many applications as the number of local classes corresponding to each international class.

In light of such requirements, the filing of trademarks takes more time than previously. Thus, this should be taken into consideration when a filing programme is based on the Paris Convention or a specific filing date is needed.

Dealing with the lack of border measures

Although the Industrial Property Law does not include the border measures and other enforcement procedures and remedies which were available under the Andean Community of Nations regime, trademark owners can still employ effective remedies against the commercialisation of counterfeit products.

On one hand, the Customs Law provides that the National Integrated Customs and Tax Administration Service (SENIAT) shall, at the request of the competent IP authority, prevent the clearance of goods suspected of violating IP rights held in Venezuela or derived from an international agreements to which Venezuela is a party. At this time, Customs shall notify the owner, importer or consignee of the goods so that it can choose whether to initiate the corresponding legal actions (eg, obtaining provisional or final measures, or requesting the

imprisonment of the people involved in the illegal activity).

However, SENIAT has issued the Administrative Order on the Enforcement of IP Rights in the Import and Transit of Goods through Customs. The purpose of this administrative order is to regulate the actions taken by the authorities and by rights holders in case of the infringement of validly granted IP rights.

For this purpose, a verification procedure is available, according to which SENIAT is empowered to request documents from the consignee – for example:

- documents attesting approval by the rights holder;
- a transfer or licence document; or
- a distribution or purchase contract for the goods.

In the event that the consignee fails to provide the required documents, SENIAT officials shall proceed to retain or seize the goods and make the appropriate notifications to both the consignee and the rights holder. Both parties then have 10 days in which to initiate the actions deemed necessary.

A lack of action by the parties does not constitute the end of the procedure; on the contrary, if no actions have been initiated by the deadline, SENIAT officials shall order the confiscation of the goods for the purpose of destruction, except for goods which can be donated, in which case any identifying trademark or design belonging to the rights holder must be removed before donation.

Although the administrative order establishes that, for the purpose of customs control and facilitating the clearance of counterfeit goods, SENIAT may establish a registry of importers of IP assets, which should be organised together with the chambers and associations where rights holders may be grouped, as yet no such registry exists. It is hoped that SENIAT will improve its services in the near future.



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