

## Latin America IP Update

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### Argentina

#### Possible switch of the chronological order for substantial patent examination

The Argentine Patent Office would be considering issuing a Resolution in the near future, according to which, it would be possible to switch the chronological order for substantial examination between two patent applications.

Therefore, it would be advisable to request an early publication and pay the examination fee for those applications of interest to speed up the granting procedure, as the switch in the chronological order for substantial examination would only be possible for those applications that have already been published and for which the examination fee has already been paid.

### Mexico

#### .mx domain extension is available

**As from September 1<sup>st</sup> until October 31, 2009** there is an initial registration stage, within which an **.mx domain extension is**

**available for any applying person or organization**, provided that the domain name is not reserved (due to the pre-registration or other technical reasons).

**The criterion applied in this new phase is governed on a *first come, first served* basis, i.e., priority is given to the one who applies for the domain registration first.**

NIC Mexico reopened the registration of .mx country code top-level domains (ccTLC), which had been suspended for over a decade. The sunrise period (\*) for re-registration started in May and ended on July 31, 2009. During that period, second-level domains (e.g. .com.mx, .net.mx, .edu.mx, etc.) registered until March 1, 2009 were blocked and only their owners had the priority to apply for the identical top-level-domain .mx.

Furthermore, from August 1<sup>st</sup> to August 31, 2009 a Waiting Period was in place, within which the applications for .mx domains were processed and the remaining blocked domains were unblocked.

(\*) The **Sunrise Period** provided priority to the owner of second-level domains, which had been registered before March 1, 2009.

## Peru

### Multi-class TM applications now possible

The Peruvian TM Office (INDECOPI) now allows the possibility of applying for a trademark in several classes of goods and/or services by filing just one application.

Even though one application is possible, the official fees have to be paid for each class.

Peru signed a Commercial Agreement with USA; which entered into force last January. In this agreement, Peru assumed the obligation to sign the Trademark Law Treaty (TLT), whose main aim is the harmonization and simplification of the requirements to obtain and conserve trademarks.

For this reason, Decree No. 1075 was recently issued in order to amend certain dispositions included in the national legislation and adapt them to the ones included in the Trademark Law Treaty.

The multi-class application is one of the most important modifications that this decree has included.

From our experience in regional filing, it is highly advisable to file separate applications for each class of interest, considering the fact that if the application receives an office action and/or third party oppositions to any of the classes involved, the complete filing procedure will be held up until the removal of said obstacle.

Other Latin American countries where multi-class applications are possible:

- Chile: classes corresponding to goods (1-34) have to be filed separately from the ones corresponding to services (35-44), this means that if your interest is in several classes for both types, goods and services, you will have to file separate multiclass applications for each group.
- Uruguay: same proceeding as in Peru.

## Argentina

### New Decree for Protecting Geographical Indications and Appellations of Origin.

On May 18, Decree No. 556/2009 regarding Geographical Indications (GIs) and appellations of Origin (A.O.) of Agricultural Products and Foodstuffs, that rules Law 25.380 –modified by Law 25.966–, was published in the Argentinean Official Gazette.

The main provisions determine the requirements and procedures for the recognition of GIs and A.O. of Agricultural Products and Foodstuffs, standing out the role of the Argentine Patent and Trademark Office (INPI) in the filing procedure and its cooperation with the GI registry in order to avoid the duplicity of exclusive rights which have not the same cause of origin on behalf of different holders.

The registration is voluntary and open to those who have or own a legitimate interest, included also GIs. and A.O. from foreign countries.

The decree also establishes the limits of the GIs and/or A.O.'s right of use, being compulsory the use and maintenance of the granting conditions to keep the validity of the registration

## Guatemala

### Adoption of the 9<sup>th</sup> Edition of the Nice Classification

The Official Newspaper in Guatemala published on June 22<sup>nd</sup>, decision 443-2009 taken by the Ministry of Economy, which enables the TM Office to use the 9<sup>th</sup> Edition of the Nice Classification to distinguish goods and services for the registration of trademarks.

The Nice Classification is up-dated every five years, the current being the ninth, since 2007.

Other Latin-American countries/jurisdictions that are part of the Nice Agreement are: **Argentina, Barbados, Cuba, Dominica, Jamaica, Mexico, Saint Kitts & Nevis, Santa Lucia, Suriname, Trinidad & Tobago and Uruguay.**

Other Latin-American countries/jurisdictions using the Nice Classification are: **Bolivia, Brazil, Chile, Colombia, Costa Rica, Ecuador, El Salvador, Guatemala, Guyana, Haiti, Honduras, Netherlands Antilles, Nicaragua, Panama, Paraguay, Peru, Saint Vincent & The Grenadines and Venezuela.**

## FAQ'S

### Is it mandatory to obtain a local certified translation of the Priority Certificate in Uruguay?

Yes, Decree Nr. 11/100, Article Nr. 8, dated January 2000 establishes the obligation to obtain the translation of the Priority Certificate from a local certified translator. If this requirement is not fulfilled, the consequence is the loss of the priority right.

For this reason, whenever we receive the order to file a patent application in several LA countries, first we analyze and develop the most cost-efficient strategy for our clients, and if Uruguay is included, we send the Priority Certificate first to this country for its translation, and afterwards we can use this translation for the other LA countries of interest to clients. The Uruguayan certified translator is provided with the Spanish translation of the application text in order to be able to use it as a basis for his work.

## Did you know...?

### Confrontation between Bolivia and Peru over the typical costume for "La Diablada" dance

The use of the typical costume for "La Diablada" dance by the Peruvian candidate, in the Miss Universe Beauty Pageant recently carried out in The Bahamas, provoked the Bolivian people as they considered it an unlawful appropriation of their cultural heritage.

"UNESCO acknowledges the right of "La Diablada" as part of the Oruro Folklore (...)



"La Diablada" is red, yellow and green (colors of the Bolivian flag) and its essence is in Oruro\*", stated the representative of the Oruro Folklore Association.

Currently, Bolivia is threatening to take the issue before the Hague International Court and the World Intellectual Property Organization.

The Peruvian people argues back alleging that this dance belongs to the Andean area, originally from the city of Puno\*.

We will have to see how this confrontation develops, especially if any exclusive right would be given to Bolivia regarding the aforementioned dance, and how this would affect its cultural diffusion.

\*Oruro is a city in Bolivia with a population of over 215,660 (2001), located equidistant between La Paz and Sucre at approximately 3710 meters above sea level. It is the capital of the department of Oruro.

\*Puno is a city in southeastern Peru, located on the shore of Lake Titicaca. It is also the capital city of the Puno Region and the Puno Province.

## Regulatory Affairs News

### Argentina

#### Suspension of all pharmaceutical products containing Nimesulide

On September 7<sup>th</sup> 2009, the Official Gazette N° 31.731 published ANMAT Provision N° 4430/2009 regarding the suspension of marketing and use throughout the national territory of all pharmaceutical products containing Nimesulide as an Active Pharmaceutical Ingredient (API) alone or in combination, in all dosage forms.

Among others, some of ANMAT's statements within the Provision are as follows:

- Since 1999-2000, liver failure has been associated with the use of Nimesulide in several high health surveillance countries. For this reason, in some of these countries, the marketing of the active ingredient was suspended and drug products containing Nimesulide were withdrawn from the market due to liver failure and death. The cases mentioned by ANMAT are Spain and Finland in 2002.
- That in September 2007, the EMEA recommended restricting Nimesulide use time in addition to withdrawing from the market all the packaging with over 30 film tablets. By the same year, Ireland had suspended the commercialization of products containing this active ingredient.
- That the Department of Pharma surveillance of ANMAT has received requests from professional associations and other institutions for the recall of the active principle Nimesulide.

- That although ANMAT imposed limitations on the dosage and duration of treatments through the Controlled Surveillance Program, the Administration still received reports that confirmed the use of higher doses and longer treatment time than those authorized, which means that professionals who prescribed the drug have not accepted the restrictions regarding the use and dosage of this product, with the consequence that potentially preventable adverse events were still occurring.

For these and other reasons mentioned in the Provision, ANMAT stated that the laboratory holders of marketing authorizations of drug products containing Nimesulide (alone or in combination with other drugs) shall, within a maximum period of 30 calendar days from the date of the provision (02.09.09), proceed to recall all products and to certify this by the National Institute of Drugs (INAME in Spanish) through supporting documents.

## Search News

### New Design TM search available in Latin American countries.

We have recently improved our search services by including design TM availability searches in some Latin American countries such as Argentina, Brazil, Chile, Colombia, Cuba, Ecuador, El Salvador, Guatemala, Mexico, Nicaragua, Panama, Peru, Paraguay and Venezuela. The normal delivery term is between 7 to 15 working days, depending on the countries and the amount of TMs involved.

For further information please contact our search partner, IP Services GmbH, at [mail@ipservices.eu](mailto:mail@ipservices.eu) or visit its website at [www.ipservices.eu](http://www.ipservices.eu).

## About us

We are glad to announce the creation of the Sub-commission for Domain Names as part of the Argentine IP Association (AAAPI in Spanish).



Estela De Luca, one of our IP Lawyers, specialized in Domain Names Infringement, who actively urged the need to create this Sub-commission, has been named its secretary.

The first meeting was held on August 5<sup>th</sup>. The aim of this special Sub-commission is to evaluate the problems concerning domain names and bring about important changes in its policy in order to reduce the number of trademark infringements.

We congratulate Estela for this achievement and we will keep you informed about further developments.

## Upcoming events!

### AIPPI – Forum & ExCo 2009

When? October 10<sup>th</sup> – 19<sup>th</sup>  
Where? Buenos Aires, Argentina  
Who? Mariano Municoy - IP Lawyer  
[mariano.municoy@moellerip.com](mailto:mariano.municoy@moellerip.com)

*As this meeting is held in Buenos Aires, Argentina, where our main office is located, you are very welcome to visit us and get to know our team. We are right in front of the Convention Center.*

Please contact us at [mail@moellerip.com](mailto:mail@moellerip.com) to schedule an appointment.

### VPP – Autumn Meeting 2009

When? October 22<sup>nd</sup> – 23<sup>rd</sup>  
Where? Münster, Germany  
Who? Gerardo Messerer - Partner  
[gerardo.messerer@moellerip.com](mailto:gerardo.messerer@moellerip.com)

### ASIPI – Annual Meeting 2009

When? October 25<sup>th</sup> – 28<sup>th</sup>  
Where? Lima, Peru  
Who? Dagmar Messerer – Partner  
[dagmar.messerer@moellerip.com](mailto:dagmar.messerer@moellerip.com)

### LAV – Autumn Meeting 2009

When? December 1<sup>st</sup> – 3<sup>rd</sup>  
Where? Hamburg, Germany  
Who? Peter Cremerius  
Sales & Marketing Manager  
[peter.cremerius@moellerip.com](mailto:peter.cremerius@moellerip.com)

### Misprints

Last issue we informed you about the existing Latin American countries that are members of the PCT. Unfortunately, because of a typing error, **Cuba** was missing. Please find below the corrected answer to the FAQ:

### Which Latin American countries are already members of the Patent Cooperation Treaty?

Brazil, Colombia, Costa Rica, Chile, **Cuba** Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Mexico, Nicaragua and Peru.

*For further information about the updated overview of the PCT in Latin America you can find the complete article **Patent Cooperation Treaty in Latin America** at [www.moellerip.com](http://www.moellerip.com).*



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**Great thanks for their contribution to:**

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**and to our Latin American colleagues!**

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## Disclaimer

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