



European
Commission

Case Study: Trade Mark Registration in Chile

LATIN AMERICA
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✓ Background

The Spanish SME Tortillas Bravas, S.L. owned the word trade mark LA GRAN BRAVA in Spain.

The company decided to register this trade mark abroad too, in particular in Germany, the United Kingdom, the United States of America and Chile.

Registration in the first three countries was easily obtained with a single application for the international registration of trade marks through the Madrid System. However, the Spanish company had to file a separate national application in Chile, since this country is not a contracting party to the Madrid System.

First, Tortillas Bravas conducted a prior trade mark search in the database of the Chilean Intellectual Property Office (INAPI) and found a brand that could represent a risk for the application: the trade mark GRANDES BRAVOS, a similar sign registered for the same product and services. After some research, they figured out that said trade mark had not been used in the market for more than 5 years. Hence, they decided to apply for the registration of the trade mark LA GRAN BRAVA, hoping the earlier unused trade mark would not hold back the success of the application.

No oppositions were lodged by the owner of the trade mark GRANDES BRAVOS during the proceedings. Nonetheless, the INAPI found the trade mark GRANDES BRAVOS itself and, therefore, communicated Tortillas Bravas that their application would be rejected on the grounds of risk of confusion with an earlier trade mark.

⚙️ Actions taken

Tortillas Bravas consulted a local IP expert. The expert suggested not filing a cancellation action against GRANDES BRAVOS since in Chile there is no obligation to use a registered trade mark. She also suggested the following possible options:

- Modify the trade mark to reduce the risk of confusion and file a new application. In this case, a logo should be added to the trade mark to ensure distinctiveness (word + logo). Moreover, only those products and services that would be surely introduced into the Chilean market by Tortillas Bravas should appear on the list.
- Start administrative proceedings against INAPI's resolution, arguing that there is no risk of confusion and hoping that the INAPI agrees.

The Spanish SME chose the first option.

📊 Outcome

The new trade mark application, including the logo and a reduced list of goods and services, was successful and Tortillas Bravas were able to commercialise their products in Chile with full trade mark protection.

📖 Lessons learned

Get familiar with local particularities. Although the Chilean intellectual property system is largely aligned with that of European countries, Chile is pending accession to the Madrid System, the WIPO treaty that enables the international registration and management of trade marks worldwide.

In Chile, a trade mark cannot be cancelled on the grounds of non-use. Real and effective use is currently not a legal requirement for its validity. However, Chile is currently considering introducing trade mark cancellation on this ground. Please consult our [News](#) section.

The INAPI examines relative grounds for refusal on its own initiative. Consequently, they can reject a trade mark application based on an earlier trade mark, even if the owner has not lodged an opposition.

Seek local IP advice to determine how to proceed according to your circumstances. A Chilean IP lawyer could have warned the Spanish SME about the substantive and procedural differences. Another registration strategy could have been set to ensure the acceptance of the trade mark application on the first try.

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