

## Trademark Opposition in the Andean Community

### ✓ Background

Trisk Motor AG., a German SME producing spare parts for vehicles, is introducing its business in the Latin American market. In order to do so, they registered their trademark **“TriskMotor”** (Wordmark) in Peru, Argentina and Brazil within Class 12 of the Nice Classification.

On the other hand, Auto Pirámide S.A., a company from Ecuador devoted to the commercialization of national spare parts for vehicles, with great success across the country, filed an application for the registration of the wordmark **“TryssMotor”** in Ecuador to identify goods within Class 12 of the Nice Classification.

As soon as the trademark application was published by the IEPI (Ecuadorian Trademark Office), the IP lawyers of Trisk Motor detected it and informed their clients about a possible likelihood of confusion between the two marks.

### ⚙️ Actions taken

The IP lawyers recommended the German company to file an Andean opposition against the Ecuadorian application based on the priority of their trademark registration in Peru.

The IP experts informed the German company that CAN (Andean Community of Nations) legislation entitled them to oppose against confusingly similar trademark applications in the other member countries based on their Peruvian trademark. The requirements to be able to file this opposition are: applying for a National trademark in Ecuador and proving that you have a legitimate interest in entering this market.

Even though the company could also oppose invoking priority or notoriety of the brand, the advantages of the Andean opposition are evident as it does not have a deadline to file it nor, in the latest case, does it require to prove the reputation of the brand, which usually requires a long process of researching and collecting evidences.

For this Andean opposition to be admitted, it is necessary to:

- Certify the trademark rights by means of a copy of the trademark certificate or by a copy of the decisions that conferred the trademark in any member country; and
- Prove real interest in the member country market where the opposition is filed by filing a trademark application for exactly the same basis of the opposition mark.

Taking this into consideration, Trisk Motor filed an Andean Opposition against Ecuadorian application for **“TryssMotor”** (Wordmark) in Class 12 based on its registration in Peru for **“TriskMotor”** (Wordmark) in Class 12. Moreover, the German company filed an application for **“TriskMotor”** (Wordmark) in the same Class before the IEPI.

### 📊 Outcome

As a result the National IP Office admitted the opposition and refused the registration of TryssMotor in Ecuador to Auto Pirámide S.A.. In addition, IEPI granted the registration for the trademark **“TriskMotor”** to the German company, who was able to exploit its trademark by signing a license agreement with a distributor in Ecuador.

### 📖 Lessons learned

- Trademark owners are responsible for enforcing their own trademark rights, including the monitoring of third parties' applications and competitor's behaviors. Monitoring your trademark with the support of IP experts will give you the chance to dispute the registration of another trademark.
- The CAN does not provide for a regional trademark such as the European Union Trademark. However, registering in one of the CAN member countries (Peru, Colombia, Bolivia and Ecuador) will provide you with a minimum level of protection, allowing you to oppose any trademark applications that could be confusingly similar to yours. Thus, a cost-efficient strategy should take into account this possibility if you are not interested in investing in the rest of the member countries in the short-medium term.