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Asociación Interamericana de la Propiedad Intelectual
Inter-American Association of Intellectual Property
Associação Interamericana da Propriedade Intelectual

SUBMISSION TO THE STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS ON TRADEMARKS

Introduction

ASIFI, one of the first organizations of Intellectual Property, was founded as a not-for-profit organization in 1964. The creation of **ASIFI** was the result of the concerns and work of 25 Intellectual Property practitioners from 17 countries in America. Today, **ASIFI** has over 1000 members coming from 46 countries of America, Europe, Asia and Africa.

ASIFI is an organization of practitioners with the most varied tendencies and profiles, including inventors, artists, trademark owners, attorneys, agents, students, professors, all of which share the common denominator of being defenders of Intellectual Property Law. **ASIFI** is an organization that welcomes practitioners from all over the world involved in the creation, conservation and defense of Intellectual Property rights.

ASIFI's main objectives are: (i) bringing together concerned professionals to study, disseminate and develop Intellectual Property laws and to coordinate and harmonize such laws in the Americas; (ii) advising governments and inter-governmental entities in the countries of the Americas regarding revision and harmonization of Intellectual Property regimes; and (iii) fostering relationships with other organizations concerned with the importance of Intellectual Property rights.

Since its foundation **ASIFI** has been recognized by **WIPO**, and its predecessor **BIRPI**, and currently occupies a place as a permanent observer at **WIPO**'s assemblies. It is in such capacity that **ASIFI** now presents the following comments pertaining to the Trademark issues to be discussed during the twenty-fourth session of the Standing Committee on the Laws of Trademarks, Industrial Designs and Geographical Indications (“**SCT**”).

Trademarks and the Internet

On August 31, 2010 **SCT** published Paper SCT/24/4, which contains existing information in the area of Trademarks and the Internet, including in particular a summary of recent developments regarding Trademarks and the Internet (Annex D), WIPO Joint Recommendation Concerning Provisions on the Protection of Marks and other Industrial Property Rights in Signs on the



Asociación Interamericana de la Propiedad Intelectual
Inter-American Association of Intellectual Property
Associação Interamericana da Propriedade Intelectual

Internet (Annex II) and an update on the domain name-related activities of WIPO (Annex III).

Having taken note of the contents of Annex I and III, **ASIPI** is of the initial position that amendments to the 2001 Joint Recommendation contained in Annex II might, indeed, be desirable to address some of the recent developments set out in Annex I and even in Annex III.

ASIPI believes that it is of utmost importance to try to find a balance between the liability limitations sought by Internet Auction Sites and Search Engines and the rights of trademark owners when dealing with trademark infringements and sale of trademarks as keywords respectively. In Latin America, these issues are only now being considered and, at that, only in some of the countries; therefore, it would be welcoming for the region to receive guidance from **WIPO** on such relatively novel issues.

ASIPI believes that it is equally important to establish an adequate policy pertaining to the treatment of trademark infringements in virtual worlds and social media. The exponential growth of these means of communication and interaction has facilitated the abuse and/or misuse of said tools, most often than not, to the detriment of Intellectual Property owners, and the remedies currently available are slow, expensive and/or ineffective.

Having participated in meetings of ICANN Intellectual Property Constituency (“IPC”), **ASIPI** commends **WIPO** for its participation in same and similar ICANN meetings. **ASIPI** believes that **SCT** should closely monitor and participate in the process of UDRP Policy Development to seek improvement in the handling of privacy and proxy registration of domain names, as well as to monitor the introduction of new gTLDs and ensure that firm balanced Rights Protection Mechanisms are created as ICANN continues to expand the DNS.

ASIPI has instructed its Information Technologies Committee to conduct studies on these issues, as they apply to Latin America, and hopes to be able to provide more defined positions and recommendations to **SCT** in the near future.

International Nonproprietary Names for Pharmaceutical Substances (INNs)

On August 31, 2010 **SCT** published Paper SCT/24/5, which outlines that the currently applicable procedure for circulating information concerning the publication of new lists of proposed and recommended INNs is by way of paper circular and, in addition, by an e-mail alert to all offices of **SCT** members and to **SCT** observers that have subscribed to the **SCT** Electronic Forum.

Paper SCT/24/5 further includes a proposal to discontinue the sending of paper circulars concerning newly available lists of proposed and recommended INNs and, for that purpose, use solely electronic communications under the **SCT** Electronic Forum, but that a paper circular would be sent to national and regional trademark offices each time that the WHO Secretariat transmits to **WIPO** a CD-ROM containing the new cumulative list of INNs.



Asociación Interamericana de la Propiedad Intelectual
Inter-American Association of Intellectual Property
Associação Interamericana da Propriedade Intelectual

Having considered the contents of Paper SCT/24/5 and noting that, indeed, there is an increasing trend to replace paper by electronic communications, **ASIPI** recommends adopting the proposal outlined in paragraph 7 of Paper SCT/24/5.

Protection of Names of States

On July 7, 2010 **SCT** published Paper SCT/24/2, which explains that in its twenty-first session **SCT** determined the need to prepare a draft questionnaire concerning the protection of official names of States against registration and use as trademarks. Such draft questionnaire was reviewed and revised during **SCT**'s twenty-second and twenty-third sessions, and a final approved version has been circulated among Member States.

ASIPI did not consider appropriate to submit a completed questionnaire but, instead, directed its Trademark Committee to gather relevant information on the subject matter, as it pertains to Latin America, with the aim to prepare an adequate position paper that would complement the findings of **SCT**'s questionnaire. **ASIPI** shall submit such paper as soon as it is completed, but shall look forward to discuss Paper SCT/24/6 (presumably containing the questionnaire results) during the twenty-fourth session.

Final Remarks

Globalization is no longer a word used to describe the future, it is a reality, it is happening now. The growth of communication technologies, including the Internet, has been too rapid for the countries' laws and regulations to adapt to the chances that such growth has brought.

ASIPI believes that today, more than ever, it is imperative to concentrate our efforts in harmonizing the treatment and protection of Intellectual Property and in creating a more dynamic method of dealing and resolving emerging issues on a global scale.

ASIPI vows to increase its efforts to assist **WIPO**, and **SCT** in particular, develop guidelines and policies that will adequately address current concerns and issues.

Juan E. Vanrell
Secretary
ASIPI