



Trademarks

in 42 jurisdictions worldwide

Contributing editors: Joseph Nicholson and Stuart Sinder

2010



Published by
Getting The Deal Through
in association with:

Adams & Adams
Advokatfirman Lindahl KB
Anderson Mori & Tomotsune
ARS-Patent Intellectual Property Law Firm
Attorneys-at-Law Juridia Ltd
Barger, Piso & Partner
Berkemeyer Attorneys & Counselors
Bird & Bird LLP
Bolet & Terrero
Cabinet Beau de Loménie
Cabinet Enpora
Cavelier Abogados
Christophi & Associates
Delacour Dania Law Firm
Di Blasi, Parente, Vaz e Dias & Associados
Dr Asbóth, Dr Krajnyák and Partner Law and Patent Office
Duany & Kresalja Estudio de Abogados
E Blum & Co AG
Fullard Mayer Morrison Inc
Gowling Lafleur Henderson LLP
Hammonds LLP
Henry Davis York
Hoet Peláez Castillo & Duque
Inttl Advocare
Kalikova & Associates Law Firm
Karanović & Nikolić Law Office
Kenyon & Kenyon LLP
Kims and Lees International Patent and Law Offices
Lee and Li – Leaven IPR Agency Ltd
Malamis & Malamis
Olivares & Cia
Patpol
PBC Partners
Pittaluga & Associates
Romero Pineda & Asociados
Seligsohn Gabrieli & Co
Società Italiana Brevetti (SIB)
Stevenson, Wong & Co
Strachan Partners
Studio Legale SIB
Thompson Associates
Winkler Partners
YükselKarkınKüçük Law Firm



Trademarks 2010

Contributing editors:
Joseph F Nicholson and
Stuart J Sinder
Kenyon & Kenyon LLP

Business development manager
Joseph Samuel

Marketing managers
Alan Lee
Dan Brennan
George Ingledew
Edward Perugia
Robyn Hetherington
Dan White
Tamzin Mahmoud
Ellie Notley

Subscriptions manager
Nadine Radcliffe
Subscriptions@
GettingTheDealThrough.com

Assistant editor
Adam Myers

Editorial assistant
Nick Drummond-Roe

Senior production editor
Jonathan Cowie

Chief subeditor
Jonathan Allen

Senior subeditor
Kathryn Smuland

Subeditors
Ariana Frampton
Charlotte Stretch

Editor-in-chief
Callum Campbell

Publisher
Richard Davey

Trademarks 2010
Published by
Law Business Research Ltd
87 Lancaster Road
London, W11 100, UK
Tel: +44 20 7908 1188
Fax: +44 20 7229 6910
© Law Business Research Ltd
2009

No photocopying: copyright
licences do not apply.
ISSN 1745-4638

The information provided in this
publication is general and may not
apply in a specific situation. Legal
advice should always be sought
before taking any legal action based
on the information provided. This
information is not intended to create,
nor does receipt of it constitute,
a lawyer-client relationship. The
publishers and authors accept
no responsibility for any acts or
omissions contained herein. Although
the information provided is accurate
as of October 2009, be advised that
this is a developing area.

Printed and distributed by
Encompass Print Solutions
Tel: 0870 897 3239

Law
Business
Research

Global Overview Joseph F Nicholson <i>Kenyon & Kenyon LLP</i>	3
Australia Donna Short and Hazel Larkin <i>Henry Davis York</i>	5
Austria Peter Israiloff <i>Barger, Piso & Partner</i>	10
Bolivia Juan Ignacio Zapata <i>Bolet & Terrero</i>	14
Brazil José Carlos Vaz e Dias and Daniel Pitanga <i>Di Blasi, Parente, Vaz e Dias & Associados</i>	20
Canada James H Buchan and Jennifer McKay <i>Gowling Lafleur Henderson LLP</i>	25
China Julia Zhong <i>Lee and Li – Leaven IPR Agency Ltd</i>	31
Colombia Luz Clemencia de Páez <i>Cavelier Abogados</i>	37
Cyprus Christophoros Christophi and Andrea Christodoulidou <i>Christophi & Associates</i>	42
Denmark Johnny Petersen and Lisbeth Elmgaard <i>Delacour Dania Law Firm</i>	46
El Salvador Marcela Mancía Dada and José Roberto Romero Mena <i>Romero Pineda & Asociados</i>	51
Finland Hanna-Maija Elo <i>Attorneys-at-Law Juridia Ltd</i>	56
France Aurélie Marie <i>Cabinet Beau de Loménie</i>	61
Germany Richard Dissmann <i>Bird & Bird LLP</i>	65
Greece Alkisti-Irene Malamis and Aristeidis Papathanasiou <i>Malamis & Malamis</i>	69
Hong Kong Angus Forsyth <i>Stevenson, Wong & Co</i>	75
Hungary András Krajnyák <i>Dr Asbóth, Dr Krajnyák and Partner Law and Patent Office</i>	80
India Prietika Siingh <i>Inttl Advocare</i>	84
Israel Nahum Gabrieli <i>Seligsohn Gabrieli & Co</i>	91
Italy Fabrizio de Benedetti and Pier Luigi Roncaglia <i>Società Italiana Brevetti (SIB) / Studio Legale SIB</i>	96
Japan Yasufumi Shiroyama <i>Anderson Mōri & Tomotsune</i>	100
Korea Yoon Bae Kim <i>Kims and Lees International Patent and Law Offices</i>	104
Kyrgyzstan Omurgul Balpanova and Aisulu Chubarova <i>Kalikova & Associates Law Firm</i>	108
Malaysia Benjamin J Thompson <i>Thompson Associates</i>	111
Mexico Sergio L Olivares Jr <i>Olivares & Cia</i>	116
Mozambique Élio Teixeira <i>Adams & Adams</i>	122
Nigeria Olusola Mesele <i>Strachan Partners</i>	125
Paraguay Patricia López Moreira and Mirta Miyasaki <i>Berkemeyer Attorneys & Counselors</i>	130
Peru Rosa María Kresalja Santos <i>Duany & Kresalja Estudio de Abogados</i>	134
Poland Bartłomiej Kochlewski, Sławomira Piotrowska and Anna Zakrocka <i>Patpol</i>	140
Romania Nicoleta Tarchila and Anca Bianu <i>Cabinet Enpora</i>	146
Russia Elena Solovyova <i>ARS-Patent Intellectual Property Law Firm</i>	150
Serbia Dragomir Kojić <i>Karanović & Nikolić Law Office</i>	154
South Africa Allison Williams (Gibbs) <i>Fullard Mayer Morrison Inc</i>	158
Sweden Henrik Wistam and Merit Berlips Persson <i>Advokatfirman Lindahl KB</i>	164
Switzerland Brendan Bolli, Barbara Gehri and Felix Locher <i>E Blum & Co AG</i>	169
Taiwan Peter J Dernbach <i>Winkler Partners</i>	174
Turkey Gökhan Gökçe <i>YüksekKarkinKüçük Law Firm</i>	178
United Kingdom Chris McLeod <i>Hammonds LLP</i>	184
United States Joseph F Nicholson <i>Kenyon & Kenyon LLP</i>	189
Uruguay Martin Pittaluga P and Fernanda Alonso D <i>Pittaluga & Associates</i>	195
Venezuela Margaret Rieber and Patricia Hoet Limbourg <i>Hoet Peláez Castillo & Duque</i>	199
Vietnam Duong Thanh Long and Bui Ngoc Duong <i>PBC Partners</i>	204

El Salvador

Marcela Mancía Dada and José Roberto Romero Mena

Romero Pineda & Asociados

1 Ownership of marks

Who may apply?

Any person or entity can apply for a mark in El Salvador, regardless of nationality, domicile or establishment.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

A trademark may consist of words or sets of words, including names of people, letters, numbers, monograms, figures, pictures, labels, shields, printings, fringes, lines and stripes, sounds, scents or combinations and dispositions of colours, as stated in our Trademark Act and in the Trademark Law Treaty (TLT), which was ratified by El Salvador. Trademarks may also consist of the form, presentation or preparation of products, or their packages or envelopes, or the corresponding means or premises of expended products or services (trade dress). Geographic indications may also be protectable as trademarks.

The following may not be protected and registered as trademarks for intrinsic reasons if:

- it consists of the usual or current form of the goods for which registration is sought, or their packaging, or a form that is necessary due to the nature of the goods or services;
- it consists of a form that gives a functional or technical advantage to the goods or services for which registration is sought;
- it consists of a common or usual name, term or designation of the goods or services in usual, technical, scientific or commercial language;
- it serves in trade to describe a characteristic of the goods or services;
- it is a simple, isolated colour;
- it is a letter or digit separately considered, unless represented in special and distinguishing form;
- it is contrary to morality or public order;
- it includes elements that offend or ridicule people, ideas, religions or national symbols of any country or international organisation;
- it could mislead or cause confusion as to the geographical origin, nature, method of manufacture, qualities, aptitude for use or consumption, amount or some other characteristic of the goods or services;
- it totally or partially reproduces or imitates the coat of arms, flag, emblem, denomination or abbreviation of denomination of any state or international organisation, without express consent;
- it totally or partially reproduces or imitates an official sign of control or guarantee adopted by a state or public organisation, without express consent;
- it reproduces currencies or bills of legal tender, titles or other documents, seals, stamps or fiscal stamps;
- it includes or reproduces medals, prizes, diplomas or other elements that suggest the goods or services have won an award, unless such an award has in fact been granted to the applicant or to its cause and this is duly credited;

- it consists of the name of a protected vegetal variety in El Salvador or abroad; or
- it is a certification mark whose registry is to expire, was annulled or cancelled, or has been left unused by dissolution or disappearance of its owner. In such cases, no use or registration would be allowed within 10 years of the respective cancellation, annulment, dissolution or disappearance.

Additionally, a trademark may not be protected and registered if upon examination, the Registrar of trademarks determines that it violates third-party rights – for example, if:

- it is identical or similar to a third party's registered mark or the subject of an application for goods or services related to those protected by a registered or pending mark, when that use may cause confusion;
- it has visual, phonetic, olfactory or conceptual similarity to a third party's mark or distinctive sign registered or filed previously, for goods or services related to those protected by a registered mark or one that is the subject of an application, where this may cause confusion;
- it is likely to cause confusion because it is identical or similar to a third party's trade name or emblem already used in El Salvador for similar commercial activities;
- it constitutes a full or partial reproduction, imitation, translation or transcription of a third party's well-known mark and that use may cause confusion or a risk of association with the third-party's mark, or take unjust advantage of the notoriety of the well-known sign. The goods and services covered by the proposed registration need not be identical or similar to those identified by the well-known mark, but there must exist some connection between the respective parties' goods or services;
- it affects a third party's personality rights or consists, fully or partially, of a third party's name, signature, title, pseudonym or image, unless the third party or his or her heirs expressly grant consent;
- it affects the right to the name, image or reputation of a local, regional or national collective, unless consent is properly granted;
- it is likely to cause confusion with a pre-existing protected appellation of origin;
- it is likely to infringe a third party's copyright or industrial property rights, unless consent is granted; or
- it has been applied for in order to perpetrate or consolidate an act of unfair competition.

3 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

The registration procedure takes approximately six to eight months if no office action arises and its typical cost per mark in each class is

approximately US\$500 to US\$600. Cost can vary depending on the length of the notice for publication, which mandatorily lists the goods or services covered. Since El Salvador ratified the TLT, multiclass applications may now be filed. However the official fee charged by the Trademark Office per mark in each class if a multi-class application has been filed is still the same as if a single application were filed. At this time multi-class applications are treated as individual class applications, so no real benefit is obtained from them at present.

4 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

Whatever is the current Nice Classification of Goods and Services. The ninth edition is currently in use. One can claim a limited list of goods or services (or both) or the class heading or an extensive list of goods or services (or both) that fall within the class of interest.

5 Conflicts with other trademarks

Are applications examined for potential conflicts with other trademarks? What is the procedure followed by the Trademark Office?

Yes. Applications are examined after filing to determine whether they fall in the criteria discussed in question 2. Once the application meets all formalities, an examining attorney conducts his examination based on his criteria and on a printed report of the Registry's database which reflects similar or identical marks, or both, that may be considered an obstacle. If the mark passes the examination, it is admitted and a notice for publication is served to the applicant or its local counsel.

6 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a challenge on grounds of non-use?

Use of a trademark does not need to be claimed for the granting of registration. Proof of use would be submitted, however, as a defence if a cancellation action for non-use has been filed in a mercantile court by a third party. No use is required for granting the renewal of a registered mark.

A cancellation action for non-use can be filed if the mark has not been used for five years after its registration date. This figure was reintroduced in 2006 and, considering that the law is not retroactive, the first cancellation actions for non-use would not be filed until 2011. Our Trademark Law allows total or partial cancellations of trademarks. Partial cancellations may be filed just for those goods or services, or both, that are not in use and the mark will remain in force for all those other goods or services (or both) that are being used.

7 Appealing a denied application

Is there an appeal process if the application is denied?

Yes. Upon denial of an application there are three recourses: revision, revocatory and appeal.

Revision recourse

Revision recourse is filed before the registrar who issued the resolution three days after the denial resolution has been served. A hearing is held at the Registry of Intellectual Property, attended by the registrar and the applicant or its local counsel.

Revocatory recourse

If the revision recourse's verdict is not favourable, during the revision hearing the applicant can verbally file a revocatory petition. A new

hearing will be held with the chief registrar, who will issue a verdict within eight days after the hearing is closed.

Appeal

If the verdict of the revision petition is not favourable, the applicant can file an appeal in writing before the Directorship of the Registry, within 30 business days. Upon admission of the appeal, the directorship will give the parties 10 days to file the evidence. Afterwards the Directorship will issue its verdict.

8 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

Yes. Any third party that has a legitimate interest over a mark and considers that such right can be affected by an application can oppose its registration.

The procedure is as follows:

- Once the notice is published in the Official Gazette, any interested party can oppose within two months after the first publication.
- The opposing party is granted two months for filing evidence, after filing the opposition.
- The Registry examines the opposition and if it complies with the legal formal requirements it is admitted.
- Once the opposition is admitted, the applicant is served and granted two months to answer the opposition.
- Once the opposition is answered, the Registry will rule either accepting or rejecting it.
- An appeal can be filed against such a resolution.

A trademark can be cancelled through a judicial action as follows:

- For the judicial district of San Salvador, the action is filed at the Complaint Distribution Office, which will send it to one of the five mercantile courts within a week. For other judicial districts, the action shall be filed before a court with mercantile jurisdiction.
- Once the complaint is received by the mercantile court, it is examined and, if it complies with all the legal formal requirements, it is admitted. If requested by the plaintiff, the court can issue a notice to the Registry of Intellectual Property ordering that the cancellation action filed should be recorded. The recording would freeze any assignment of the mark. It is at the discretion of the mercantile judge to request the plaintiff to render a judicial bond to cover any damages to the defendant, should the claims not be sustained. Up to this point the procedure is ex parte and normally takes one to three months. If the plaintiff disagrees with the bonded amount, he can file an appeal.
- Once the judicial bond is filed, the defendant is served and granted three days to answer the complaint. If there is no answer, a request can be made to the judge to continue the trial without any further service of resolutions until the final verdict is issued. If he answers, the defendant is considered as party to the case. All this takes about one month.
- Both parties are then served with a resolution opening the process to an evidence phase that occurs within eight days.
- A final verdict is issued either cancelling the mark or denying cancellation.
- An appeal can be filed against the final verdict.

9 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration?

Trademarks are protected for 10 years and are renewable every 10 years. The law governs trade names, emblems (house marks) and expressions or signs of commercial advertising, all of which are pro-

tected indefinitely once registered, subject only to the existence of the mark, goods or services, or both, or company they refer to.

10 The benefits of registration

What are the benefits of registration?

The only way to have benefits for a trademark is through a registration, since El Salvador is a first-to-file country. The mere use of a mark does not generate any rights. Registered marks grant the following benefits:

- the right to execute legal actions against third parties that reproduce, apply, adhere or fix the mark in any way, as long as it is identical to the registered mark, on the goods for which it has been granted (on their packaging, bottles, etc) or on other goods that have been manufactured, modified or treated by services for which the mark was registered;
- the right to execute legal actions against third parties that suppress or modify the mark for commercial uses after its owner or an authorised person has applied, adhered or fixed it on the goods;
- the right to execute legal actions against third parties for the manufacturing of labels, bottles, packaging and other analogue materials that reproduce or contain the mark, and against those who commercialise them;
- the right to execute legal actions against third parties who refill or reuse commercial purpose bottles with packaging bearing the mark;
- the right to execute legal actions against third parties who use in commerce an identical or similar trademark for any products or services when such use can create confusion or a risk of association with the owner of the registered trademark, under the understanding that if the use of identical trademarks for identical goods or services is made, a legal presumption of confusion will be enforced;
- the right to execute legal actions against third parties who publicly use an identical or similar trademark, even if the use is without commercial purposes, when such use can cause dilution of the distinctive force of the trademark, its commercial value of publicity value, or an unfair advantage of its reputation;
- in the case of licensed goods, the right to take legal actions against third parties who use such goods to commercially associate them with the owner's advertising, promotions, trademark or establishment; and
- the right to take legal actions against any analogue act that may affect the ownership over the trademark.

11 Assignment

What can be assigned?

All the rights derived by the ownership of the trademark may be assigned. Trademarks with goodwill and without goodwill may be assigned.

The owner of the mark is allowed to assign some or all the goods or services protected by a mark and reserve the rights over the goods or services (or both) not assigned. Prior to partial assignment, the registrant must follow a trademark division procedure to separate under different registrations the goods or services to be assigned.

Trade names can only be transferred along with the company or the establishment that uses it or with the part of the company or establishment that uses it.

12 Assignment documentation

What documents are required for assignment and what form must they take?

The required documents are the assignment documents executed by both parties, duly notarised and legalised by the nearest Consulate of El Salvador or alternatively, by apostille.

13 Validity of assignment

Must the assignment be recorded for purposes of its validity?

Yes. According to the Trademark Law all changes of name, assignments, changes of domicile and others must be recorded against each mark.

14 Security interests

Are security interests recognised and what form must they take?

Yes. It is not, however, common practice in El Salvador to guarantee financial activities such as loans, because there is no legal regulation to that end.

15 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Use of marking symbols is not mandatory. However, if the owner wishes to use marking, '®' or '™' or other symbols indicating that a trademark is registered are perfectly acceptable.

16 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The following legal actions can be taken:

Close of borders to infringing goods

This action can be effected by petitioning the Customs Authority to close the borders to probable imports of counterfeited goods. The Authority will deny entrance to the country to such goods at land, port and airport borders and will notify the petitioner, granting him or her 10 days to file a complaint before a mercantile court or a court with mercantile jurisdiction.

Criminal actions based on trademark infringement

By filing a complaint before the General Attorney's Office, an investigation is initiated. Once the investigation is completed, a justice of the peace (JP) can issue a seizure order, in which all counterfeited products bearing the trademark are put at the judge's disposal. After three different hearings before three different judges, a verdict is issued. If the counterfeiting party is found guilty, the products are destroyed or donated, after de-labelling.

Unfair competition action

If a party is deviating clientele, diluting a trademark, etc, an unfair competition action can be filed before a mercantile court. Such an action will result in the prohibition of the unfair competition conduct and can include preliminary injunctions against infringing goods.

17 Procedural format and timing

What is the format of the infringement proceeding?

The format and timing of a criminal procedure against the infringement of a trademark are as follows:

- a complaint is filed before the General Attorney's Office;
- the General Attorney's Office examines the complaint and can issue an office action, dismiss it or order an investigation (one month);
- once the investigation is concluded, the General Attorney's Office requests from a JP the issuance of a seizure order, which is

Update and trends

Recently, El Salvador ratified the Trademark Law Treaty, which entered into effect in November 2008. One of the changes that this Treaty brings to Salvadorean Trademark Law is the filing of multi-class applications for trademarks. However, since this is a new procedure that has never been applied in our country, the Registry of Intellectual Property is not entirely certain: how to process the multi-class applications for the benefit of the applicant or apply a differentiated fee per additional class; how many certificates should be issued per class; how to designate the registration numbers depending on the number of classes; and other relevant issues. At this time they will issue separate certificates of registration per class for a multi-class application. In other words, even though a single multi-class application can be filed, each class is treated separately and as an individual procedure.

Also, if a single application for several classes (multi-class application) is filed and a third party brings an opposition against one of the classes, under the TLT the applicant can divide the application in order to defend the opposition and continue the registration process in the other classes. The same applies if a third party files

a cancellation action against a trademark registration. The owner of the registration can divide the multi-class registration and defend the mark in the class that is subject to the cancellation action.

Another amendment of the Trademark Law Treaty concerns the procedure for recording trademark owner name and address changes. The Trademark Office will no longer require proof of the changes. Instead, documentation such as extracts of the chambers of commerce, modifications to the incorporation documents or legalised declarations will only be required when the registrar considers it necessary. In this regard, the TLT provides that the Office can only request the documentary evidence when reasonable doubt exists as to the veracity of what is being said or requested. However, the TLT does not specify what reasonable doubt is, and this may allow the procedure to remain bureaucratic. On the other hand, in assignment proceedings, the Office will always require documentation to verify the assignment of a mark because it involves a change in ownership, which justifies greater monitoring so as not to leave the door open for fraud.

accompanied by the evidence gathered in the investigation (one month);

- once the seizure is made in the infringing party's establishment, the products are put at the judge's disposal and the District Attorney's Office, the plaintiff (victim) and the defendant are served a notice to attend the first hearing (one month);
- at the hearing the parties involved may file any evidence. In the first hearing the judge will only decide whether the actions taken by the General Attorney's Office are legal and whether the trial should continue to a second hearing. An opportunity to settle the case is granted by the judge to the parties;
- the second hearing is scheduled (one month);
- at the second hearing an instruction judge will review the evidence provided and will decide if the trial should continue to the public hearing;
- the public hearing is scheduled (one month);
- at the public hearing, all evidence is discussed, witness and expert testimony is taken and the judge issues the final verdict; and
- the judge then issues a resolution ordering the destruction or donation of the infringing goods.

The format and timing of a 'closing of borders' procedure against the infringement of a trademark are as follows:

- a complaint is filed before the mercantile court or a court with mercantile jurisdiction, requesting an order to close the borders to suspected infringing goods;
- the mercantile court admits the complaint and issues an order to the Customs Authority, to detain any products bearing the infringed mark and destined to other than the authorised distributor(s) (one month); and
- once a third party tries to import the products, the Customs Authority detains these and notifies the trademark owner, granting a 10-day term to file a complaint before the mercantile court for unfair competition or before a criminal court for trademark infringement.

The format and timing of an unfair competition action against the infringement of a trademark are as follows:

- for the judicial district of San Salvador, the action is filed at the Complaint Distribution Office, which will send it to one of the five mercantile courts within a week. For other judicial districts, the action shall be filed before a court with mercantile jurisdiction;
- once the complaint is received by the mercantile court, it is examined and if it complies with all the legal formal requirements it is admitted. If requested by the plaintiff, the court can issue preliminary injunctions, including the seizure of infringing goods. It

is at the discretion of the mercantile judge to request the plaintiff to render a judicial bond to cover any damages to the defendant, if the claims are not sustained. Up to this point the procedure is ex parte and normally takes one to three months. If the plaintiff disagrees with the bonded amount, he or she can file an appeal;

- once the judicial bond is filed, the defendant is served and granted three days to answer the complaint. If there is no answer a request can be made to the judge to continue the trial without any further service of resolutions until the final verdict is issued. If he or she answers, the defendant is considered as a party to the case. All this takes about one month;
- both parties are then served with a resolution opening the process to an evidence phase lasting eight days;
- a final verdict is issued either declaring the existence or non-existence of unfair competition acts and ordering the destruction or donation of infringing goods (after de-labelling), or the return of the goods; and
- an appeal can be filed against the final verdict.

18 Burden of proof

What is the burden of proof to establish infringement or dilution?

To determine infringement, the trademark owner must prove the ownership of the mark and its use by the unauthorised party.

To determine dilution, the trademark owner must prove the public use of the identical or similar mark, even if the use is not for commercial purposes, if such use can cause dilution of the distinctive force of the trademark and its commercial or advertising value is affected, or if an unfair advantage is earned from its use.

19 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The trademark owner can bring a criminal complaint and seek a remedy.

A licensee must report the infringement to the trademark owner and request him to initiate enforcement actions. If 30 days lapse without reply, the licensee becomes authorised by law to initiate such actions.

20 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

No.

21 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

There are no discovery devices used for obtaining evidence. All evidence is filed during the evidence phase granted in the judicial procedure, in which the parties may review the content of the evidence filed.

22 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

At the trial level for a criminal infringement action, the typical time to reach a verdict is six months to one year.

At the trial level for an unfair competition action, the typical time to reach a verdict is six months to one year.

At the appeal level of a final verdict for both criminal and mercantile actions, the typical time is six months to one year.

23 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The typical range of costs associated with a criminal infringement action is US\$10,000 to US\$20,000, depending on its complexity.

The typical range of costs associated with a cancellation action, unfair competition action, etc, is US\$15,000 to US\$25,000.

24 Appeals

What avenues of appeal are available?

In the mercantile circuit

An appeal may be filed against the final verdict. The appeal is filed before the mercantile court, which admits it and sends the file to the civil chamber, which in turn will grant six days to file arguments and 10 days to file evidence. Afterwards the civil chamber issues the final verdict.

In the criminal circuit

An appeal can be filed against the final verdict of any of the hearing verdicts. Once it is admitted, a hearing is scheduled. If one of the parties offers to file evidence, they will do so at the hearing and the verdict of the appeal will be issued at that time.

25 Defences

What defences are available to a charge of infringement or dilution, or any related action?

A party charged for trademark infringement or dilution, can argue in its defence:

- prior ownership of the trademark rights;
- innocent infraction; or
- statute of limitations.

26 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

Monetary relief can be requested for damages caused to the legitimate owner of the trademark.

Damages are estimated through any of the following criteria:

- based on the damages caused to the owner of the trademark owing to the infraction;
- based on the benefits that the owner would have earned, if the infraction had not taken place; or
- based on the price or fee that the infringing party would have paid to the owner of the trademark if a licence agreement would have been granted, or based on the price or fee of prior licence agreements granted to other parties.

In the cases of unfair competition, the mercantile judge is obliged by law to inform the General Attorney's Office of the final verdict, and the General Attorney's Office is obliged by law to initiate a criminal action based on trademark infringement.

Preliminary injunctive relief is available to protect evidence and trademark rights. Preliminary injunctive relief can include seizure of the infringing goods, packaging and labelling materials plus manufacturing apparatus, except for printing presses, which cannot be seized under any circumstances, according to the Political Constitution. Relief becomes permanent in the final verdict.

27 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Available ADR techniques are mediation, conciliation and arbitration. A special law regulates them but they are not commonly used. One of the main benefits is that arbitration must be conducted, and a decision reached, within a maximum of 90 days.



ROMERO PINEDA & ASOCIADOS
COMPAÑIA DE ABOGADOS

Marcela Mancía Dada
Jóse Roberto Romero Mena

marcela@romeropineda.com
jose@romeropineda.com

World Trade Centre Tower 1 Suite 305
Colonia Escalón
San Salvador
El Salvador

Tel: +503 2505 5555
Fax: +503 2505 5500
www.romeropineda.com

