

## WHAT IS 'GENUINE INTEREST'?



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It is important for a brand to know when to demonstrate an interest in Andean opposition proceedings. Article 147 of the Andean Regulation says that during opposition proceedings, the owner of or applicant for a trademark previously filed in any of the Andean community countries (Ecuador, Colombia, Bolivia and Peru) has the right to file an opposition against any similar or identical trademark applied for in another Andean country.

It is important to determine whether 'genuine interest' is a static or a continuous act: is it enough just to apply for the trademark in the country where the opposition has been filed, or it is also necessary for the application to be maintained until the opposition is resolved.

This issue was raised in a recent case before the Peruvian Patent & Trademark Office (INDECOPI). It concerned an Andean opposition against a Peruvian application for registration, based on the grounds that an already registered Colombian trademark was identical to the applied-for Peruvian brand. In order to prove the Colombian owner's genuine interest in the Peruvian market, he applied to register his trademark in Peru at the same moment as filing the opposition.

Recently, this application was declared abandoned, because the opposer would not be able to publish the mark in the *Peruvian Gazette* in due course.

For this reason, INDECOPI's Distinctive Marks Commission declared the opposition unacceptable, on the basis that the abandonment of the Peruvian application meant that the interest requirement was not met.

The opposer filed an appeal and INDECOPI's Intellectual Property Board overturned the first instance decision, ordering the Distinctive Marks Commission to rule on the opposition case.

The Board's ruling is very useful for delimiting exactly the requirements of Article 147 of Decision 486. Genuine interest is proved only and exclusively at the filing date of the application of registration in the country where the opposition is carried out, whatever the future of the application.

It is justified because the opposition questions a specific fact: the registration of a trademark that could affect a third-party interest, whether it has been registered or previously filed. On the other hand, the text of Decision 486 says nothing about the future of the application used to prove genuine interest.

The Intellectual Property Board correctly stated that: "In the case of the second condition, the norm states that the application, which demonstrates the genuine interest of the opposing party, must be filed at the same time

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as the Andean opposition. We can note from the aforementioned norm that it does not state any additional condition; therefore, the fate of the application for registration (if it is denied, rejected or abandoned) would not determine the acceptability of the Andean opposition. In this sense, genuine interest must be considered demonstrated merely by filing an application of registration identical to the trademark that is the basis of the opposition, covering the same products or services."

Finally, the ruling is an excellent precedent for intellectual property attorneys, because it clarifies the issues related to the filing of the Andean oppositions, specifying that genuine interest is exclusively proved when the relevant application is filed. This is healthy for the purposes of administering justice as well as for developing the market.

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