



Case law database regarding TRIPS. Introduction to TRIPS Case Law Digest and a representative example.

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Our TRIPS Standing Committee has collaborative projects with a number of entities and committees including external entities such as WTO. At this time, we are introducing one of these collaboration activities: TRIPS Case Law Digest. This project is to create a database including prospective case law collection, intended to be freely available, and can enable a more comprehensive analysis of existing jurisprudence, including the identification of conflicts, convergences, or other notable trends. We aim to create and maintain a collection of national jurisprudence which refers to or relies on TRIPS provisions when interpreting and applying domestic intellectual property law, in collaboration with partner institutions around the world, with strong assistance by the WTO. Once the collection has reached a critical mass, the WTO Secretariat will develop the appropriate means to make it available to users while recognizing the valuable contribution of participating partner institutions, notably AIPPI.

The collaboration started back in 2018. Our committee has discussed this project within our regular monthly telemeetings, sometimes inviting members from WTO including Antony Taubman, Director, Intellectual Property Division of the World Trade Organization and Wolf Meier-Ewert, Counsellor, Intellectual Property Division of World Trade Organization.

At the WTO, with the proposals and opinions from our committee, the WTO Secretariat has developed a prototype database and provided an opportunity to preview the development of the TRIPS Case Law Digest to our members during the 2019 AIPPI World Congress in London.

Currently, we are in the test phase, and internally, collecting representative case law from the members of the TRIPS SC.

In this article, we introduce one such representative case law.

A sample of case law being uploaded to the TRIPS Case Law Digest

Summary

The following is a summary of a decision rendered by a Mexican Federal Circuit Court on a trademark case by which Mexico recognizes expanded rights to a well-known mark considered as such in another Paris Convention party by referring, among other provisions, to Article 16 of the TRIPS Agreement. As explained at the end of the article, AIPPI is working with the WTO Secretariat on an initiative to collect national case law applying or interpreting the TRIPS Agreement from a plurality of jurisdictions.

As in many other jurisdictions, a trademark registered in Mexico generally is required to be used in the country in order to avoid cancellation by a third party seeking to register an equal or similar mark for equal or similar good or services. However, according to a decision from a Federal Circuit Court, this general rule does not necessarily apply when the trademark is recognized as well-known in another Paris Convention party.

In 1999, Colombian company “*Compañía Global de Pinturas, S.A.*” (CGP) obtained a registration for the trademark “PINTUCO” in Mexico to protect products pertaining to class 2 of the Nice classification, such as paints, varnishes, lacquers, colorants, dyes, and the like. In 2015, a domestic company, “*Pintucom S.A. de C.V.*” filed an application to register the mark “PINTUCOM” and design for equal products and initiated a cancellation action against “PINTUCO” arguing that it had not been used in Mexico during three years prior to the cancellation action as mandated by the Mexican Law.

CGP submitted, among others, documents accrediting that the trademark “PINTUCO” was recognized as well-known by the Superintendency of Industry and Commerce of Colombia, and that products covered by the trademark were exported to a Mexican company. The Mexican Institute of Industrial Property (MIIP) declared the trademark cancelled by considering that evidence was not enough to prove the use of the trademark, including the exportation of products to a Mexican company, as it did not mean that said products were available to consumers, and even though the trademark was well-known in Colombia it did not change the fact that no use in Mexico had been proven.

CGP appealed and the MIIP's decision was reversed in 2018 by the IP Specialized Federal Tribunal (IP SFT), which considered that by linking a plurality of the evidencing documents submitted by CGP it was possible to conclude that the trademark was indeed used.

Pintucom asked a Federal Circuit Court (FCC) to review the case. As a consequence, a final decision was rendered in 2019. Regarding the evidencing documents, the FCC partially agreed with the IP SFT by asserting that some of the documents it considered to reverse the IMPI's decision would demonstrate use of the trademark but clarified that the principle of territoriality should not be strictly applied in the case of well-known trademarks recognized by another Paris Convention party.

In its interesting ruling, the FCC explained that some trademarks achieve a level of notoriety in trade that goes beyond the borders of the country where trademark registration exists. The FCC referred to articles 6^{bis} and 10^{bis} of the Paris Convention and 16 of the TRIPS Agreement to emphasise that member states shall prohibit the use of a trademark that is likely to create confusion with a well-known trademark considered as such in another member country. In the FCC's opinion, this evidences the special protection that must be granted to trademarks holding the characteristic of being well-known, making clear that the strict application of the principles of territoriality and specialty might lead to abusive, illegal use and even bad faith registration of trademarks by third parties. According to the FCC, the purpose of the international provisions is to avoid both the registration and use of a trademark that may create confusion with a well-known trademark and acts of unfair competition that harm the consumer interests who might be misled with respect to the origin or quality of the relevant products.

As a consequence of the above considerations, the FCC established that disregarding that the domestic law requires use of a trademark within the Mexican territory, in the case of "PINTUCO", and independently that the same was recognized as well-known in Colombia and not in Mexico, use of the trademark could be accredited by evidencing acts of commerce, offers and publicity taken place in part in either Colombia or Mexico, as the relevant issue was to verify that the products protected by the trademark were commercialized between both countries.