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## **Legal framework**

Trademarks are governed in Chile by the Industrial Property Law (19.039) (in force since September 30 1991, modified by Law 19.996, in force since December 14 2005), and Law 20.160 (in force since January 2007, regulated by Decree 236, published on December 1 2005 and amended by Decree 36 of May 23 2012). In February 2012 the Law for Standardising Trademark and Patent Applications (20.569) – which also implements the Trademark Law Treaty in Chile – came into force. Chile has been a member of the Paris Convention since 1991 and is a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Other free trade agreements containing IP chapters, in particular with the

United States and the European Union, also apply.

## **Unregistered marks**

Unregistered trademarks grant their holders only the right to oppose a trademark application by a third party or to apply for the invalidation of the trademark registration in the following cases:

- when the unregistered trademark has been actually and effectively used in Chile prior to the application for registration made by a third party for the same or similar trademark for identical or similar goods, services or establishments in the same class or related classes, and the coexistence may create confusion; and
- where an unregistered trademark is famous or notorious and is registered abroad but not in Chile, and is identical or similar to a trademark requested in Chile to distinguish the same products, services and

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establishments, and the situation may result in confusion. This claim must be supported by evidence of fame or notoriety among the relevant consumer public in Chile.

Moreover, the Chilean Institute of Industrial Property (INAPI) may reject an application on the basis of an unregistered prior mark, provided that the existence of the unregistered trademark is publicly known to the extent that its renown does not require evidence.

If the owner of a famous unregistered mark is successful in an opposition or cancellation action, it has 90 days from the date of the decision to apply the mark in its own name. Failure to do so entitles any third party to file an application for that mark, with priority being given to the party whose application for registration was rejected as a consequence of the opposition or invalidation action.

### Registered marks

#### Ownership

Any person or legal entity, whether national or foreign, may apply for and own a trademark registration.

The representative requires a power of attorney which must be signed by the legal representative of the applicant's firm, but need not be notarised or legalised. It can be credited up to 60 days after the application has been filed.

#### Scope of protection

**Protected:** Any sign capable of graphic representation to distinguish products, services and industrial or commercial establishments can be protected. Such signs can consist of words, letters, numbers, drawings or colour combinations. Phrases related to publicity or advertising may also be registered, provided that they are associated with a registered trademark. Sound trademarks are allowed if they are represented graphically and are accompanied by the filing of a sound recording. Trademarks consisting of letters or numbers must be represented by a characteristic drawing that gives distinctiveness to the letter or number. Geographical indications and appellations of origin, as well as certification and collective trademarks, are also protectable.

**Not protected:** The following may not be registered as trademarks:

- coats of arms, flags or any other symbols, names or initials of any state or international organisation, or state public service;
- technical or scientific denominations in respect of the object for which they are destined, plant variety denominations, common international denominations recommended by the World Health Organisation and those indicative of therapeutic action;
- the name, pen name or picture of any natural person, except if consent is given by that person, or his or her heirs if deceased. However, the name of a historical celebrity may be registered if at least 50 years have elapsed since his or her death and the registration does not affect the personality's honour. Names of persons cannot be registered when this constitutes an infringement of the signs described in the fifth, sixth and seventh points below;
- reproductions or imitations of signs of official guarantee or control stamps adopted by a state without its authorisation, and reproductions or imitations of medals, diplomas or honours granted in national or foreign exhibitions whose registration is requested by someone other than the person who obtained them;
- expressions or signs used to indicate the kind, nature, origin, nationality source, destination, weight, value or quality of the products, services or establishments, those of general use in trade to name a certain kind of product, service or establishment, and those that exhibit no innovative feature or that describe the products, services or establishments to which they must be applied. However, signs that are not inherently distinctive may be registered if they have acquired distinctive character through their use in the country;
- signs that may induce error or deceit with regard to the source, quality or kind of product, service or establishment;
- signs that are identical to other marks, or that graphically or phonetically resemble other marks that have been registered abroad for the same products,

services or commercial and/or industrial establishments in a manner likely to create confusion, provided that the prior marks enjoy fame and notoriety;

- trademarks that are identical or similar to prior well-known Chilean registered trademarks, requested for different classes, however related, if the registration could affect the interests of the owner of the well-known trademark;
- signs that are identical to, or that graphically or phonetically resemble in a confusing manner, other trademarks that are already registered or have validly been applied for earlier marks in the same class, or that have effectively been used in Chile prior to the application date. INAPI may allow coexistence agreements, provided that they do not affect the prior rights of third parties or cause consumer confusion;
- the shape or colour of either products or containers, and colours themselves;
- protected geographical indications and appellations of origin; and
- signs that are contrary to public order, morality and good behaviour, and the principles of fair competition and business ethics comprised therein

## Procedures

### Examination

Each application is subjected to an examination to determine whether it meets the formal requirements, including whether the application specifies the goods or services of the Nice Classification for which registration is sought. INAPI notifies the applicant of any changes required. The applicant has 30 working days to file the necessary corrections. Failure to do so means that the application will be deemed abandoned. Where there are no formal objections or where these objections have been timely corrected, the application is accepted for further prosecution and published in the *Official Gazette* within 20 working days for opposition purposes.

### Opposition

Any interested party may file an opposition within 30 working days of publication. The opponent may base its opposition on any of the grounds to reject an application provided by the law.

### Further prosecution

Upon expiration of the 30-day opposition period, the head of INAPI conducts a substantive examination of the application. Any objection shall be notified to the applicant together with any opposition. The applicant shall have a non-extendable term of 30 working days from notification to contest INAPI's objections and any opposition. The head of INAPI may request evidence supporting any factual claim by the applicant; the evidence must be filed within a 30-working day period, renewable once. Thereafter, INAPI issues a first instance resolution, which the applicant or the opponent may appeal before the Industrial Property Court within 15 working days.

The applicant may divide the application at any time during the prosecution before the final decision in order to overcome official objections or oppositions at first instance. Such division can take place during appeal proceedings before the second instance decision. However, divisional applications are subject to the same official fees as new applications.

Decisions of the Industrial Property Court may be appealed before the Supreme Court.

### Registration

Applications that have passed the formal and substantive examinations and are unopposed, or that have overcome any objections and/or opposition by a final decision, are accepted for registration. Rights holders have 60 working days from that date to pay the registration fees. The registration shall be for an initial period of 10 years, renewable indefinitely for consecutive periods of 10 years.

A granted registration can be divided during the prosecution of a cancellation action or during an appeal against a decision in a cancellation action

### Removal from register

**Cancellation actions:** Registration granted to signs deemed unprotectable by the Industrial Property Law may be cancelled on the basis that prohibitions for granting registration were ignored. Such actions must be filed within five years counted as from the registration date.

However, there is no time limit for filing a cancellation action against a mark registered in bad faith. A cancellation action is heard at first

instance by the head of INAPI and at second instance by the Industrial Property Court. In some circumstances, decisions of the Industrial Property Court may be appealed before the Supreme Court.

**Revocation:** Revocation on the basis of non-use is not available in Chile as the law does not make use a requirement for the maintenance of a mark's validity or renewal of a registration.

### Timeframe

From the time of filing, it takes approximately:

- eight months for an unopposed application to proceed to registration;
- 18 months for an opposition procedure to reach a first instance decision (and a further 24 months for an appellate decision to issue);
- 20 days for a renewal for being accepted;
- two weeks to record mergers and changes of name;
- two to three years for a cancellation action at first instance, six months to a year at second instance and about eight months if a further recourse is filed before the Supreme Court; and
- three months for renewals.

### Searches

Searches for identical trademarks (registered or applied for) are available online and free of charge at [www.inapi.cl](http://www.inapi.cl). Free searches for previously requested trademarks or registered identical trademarks that coincide in their first part to, or contain, the trademark searched for are also available online for all classes. Searches cover trade names and slogans, but only the verbal description of graphic marks. The databases cover the past 30 years.

### Enforcement Complexity

The enforcement of a trademark requires that the trademark be registered in Chile. The actions available consist of border measures, criminal actions and civil actions.

**Border measures:** These are regulated by TRIPs and must be followed by actions in the relevant courts. When properly supported, border measures are effective in most cases.

**Criminal actions:** Criminal actions are available before the ordinary criminal court with

jurisdiction over the area where the offence was committed. These actions are open mainly when an unauthorised third party is using in bad faith a trademark that is identical or similar to another that is already registered, for products, services or establishments that are identical or related to those protected. In order to be in a position to initiate criminal actions, it is necessary that the registered trademark bears in a visible form the words 'Marca Registrada' ('Registered Trademark'), the initials 'MR' or the symbol ®. The penalties consist of a fine and the confiscation of the products bearing the forged trademark. The court shall decide how to dispose of the tools and materials used to commit the infringement by ordering either their destruction or their distribution to charitable institutions.

**Civil actions:** Civil actions are prosecuted before the ordinary court that has jurisdiction over the defendants' address. Such actions are available against any kind of violation of a registered trademark. The object of civil actions is to put an end to the infringement, to obtain indemnification for damages and to adopt the necessary measures to prevent the infringement from continuing. Compensation for damages may be established taking into account one of the following options in accordance with the rights holder's choice:

- the profits that the rights holder failed to receive as a consequence of the infringement;
- the profits that the infringer would have received as a consequence of the violation; or
- the price of a licence, taking into account the value of the infringed rights and the contractual licences that may have already been granted.

If the rights holder so desires, compensation for damages may be calculated according to the general rules of the Civil Code, which are much more complex. Preliminary and precautionary measures are contemplated in the case of civil actions.

### Timeframe

The competent criminal court may order seizure of the products bearing the infringing sign and of the elements directly used to imitate the

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registered trademark immediately after filing the complaint. The time to obtain this relief will depend on the court's criteria and on the quality of the evidence filed by the complainant.

According to the new Procedural Criminal Code, final decisions in criminal cases should take no longer than one year and a maximum of two. It is also possible to obtain an earlier settlement of the case by using the alternative reparatory agreements accepted by the court. Civil actions take around two years at first instance and a further two years at second instance. While a decision is pending, it is possible to take preliminary or precautionary measures based on the merits of the case and the quality of the evidence rendered. Criminal actions are much more common than civil ones. The Chilean courts are becoming more familiar with trademark cases, so the quality of the decisions is improving.

### **Ownership changes and rights transfers**

Assignment of a trademark must be executed by means of a document signed by the parties involved. In case of a change of name, the official documents must be certified by the proper local authorities. Licence agreements must be executed in the same way as assignment agreements.

The recording of assignments, changes of name and licences with INAPI is not compulsory. However, if these are not recorded, they will have no legal effect against third parties.

### **Related rights**

While the law does not refer specifically to cumulative protection of trademarks and copyright, a graphical or combination trademark can be protected under copyright law provided that it has an artistic value.

### **Online issues**

Network Information Centre (NIC) Chile, the manager of the '.cl.' domain, follows an alternative dispute resolution policy in relation to '.cl.' domain names that is similar to the Uniform Dispute Resolution Policy of the Internet Corporation for Assigned Names and Numbers. Under NIC Chile's rules and policy, rights holders may claim for:

- cancellation of the domain name based on prior application or registration or

infringement of their trademark rights, within 30 days of the domain name registration; or

- revocation of the domain name based on prior application or registration of a trademark or other arguments, as from 30 days after the domain name registration. [WTR](#)

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Non-traditional marks registrable?
Yes/No   	Yes 	Sound marks 
Unregistered rights		Opposition
Protection for unregistered rights?	Specific/increased protection for well-known marks?	Can a registration be removed for non-use? Term and start date?
Yes 	Yes 	Yes: 30 days. 
Removal from register		
Can a registration be removed for non-use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
No 	No 	Yes 
Enforcement		
Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
Yes: but only for registration, opposition or cancellation procedures. Infringements go to ordinary courts. 	No 	Yes: in civil actions. Actions on merits must be filed within 10 days. 
Ownership changes	Online issues	
Mandatory registration for assignment/licensing documents?	National anti-cybersquatting provisions?	National alternative dispute resolution policy (DRP) for local ccTLD available?
No: but necessary for enforcement against third parties. 	Yes: implicit. 	Yes 

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Sergio Amenabar is principal counsel at Estudio Villaseca. He graduated from the Chilean Catholic University and was granted the title of lawyer by the Supreme Court. Mr Amenábar was president of the Inter-American Association of Industrial Property from 1994 to 1997 and of the Chilean Association of Industrial Property from 1990 to 2003. As principal counsel, he leads the administrative, contractual and litigation practice of the firm. Mr Amenábar has been professor of industrial property on the business law master's at the Catholic University and Gabriela Mistral University.