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Modifications to the Peruvian Law of Trademarks, Legislative Decree No. 1397

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On September 07th, 2018, the Legislative Decree No. 1397 modified the Legislative Decree No. 1075, approving various provisions regarding food products; industrial design; precautionary measures; patents; procedural variations among others, modifying the Legislative Decree No. 1075, which approve additional provisions to Decision 486 of the Commission of the Andean Community.
Among the novelties, we can mention the inclusion of geographical indications and not guaranteed traditional specialties as constituent elements of the industrial property (article 3 of Legislative Decree 1075).

In addition to protecting traditional recipes, the methods of production and/or transformation that correspond to the traditional practice applicable to a product or food; the modification will contribute in giving a greater added value to the product during its stage of commercialization, production or transformation, directions that must be specifically informed to the consumer; providing the national trademark authority - INDECOPI the necessary competencies for its protection and regulation.

On the other hand, the division of industrial design applications is accepted, in two or more applications, being that the national office may require that the division include more than one design. In that sense, each divisional application will benefit from the filing date and, if applicable, from the priority date.

Regarding the modifications to the provisions related to the registration of invention patents, the following sections were modified:

- Claims (Article 29° D.L. 1075): At the time of submitting the application, you must indicate the claims that will be processed in the fractional application and those that will remain in the application initially filed. Fractioning will not be admitted in case the fractional request includes the same claims or scope that is intended to be protected in the claims of the initially filed application.

- Notification of the patentability examination (Art. 29-A° D.L. 1075): The National Trademark Office notifies the applicant of the second or subsequent patentability tests when it contains new elements to the contents of the previous patentability exams, independently of whether the conclusion stated is reiterated or not. If the conclusion of previous examinations is reproduced without new elements being included, there is no obligation to notify.

- Oppositions (Art. 31° D.L. 1075): You must indicate the date of payment of the official fees, being that only two (02) business days for its correction will be granted.

- End of the opposition phase (Art. 31-A° DL 1075): Once the deadlines for the opposition to support their arguments have expired and the applicant proceeds with the opposition, the end of the opposition phase is declared, even if said actions have not been carried out by the parties.

- Inventions, industrial designs and layout designs of integrated circuits developed during employment or service relationships (Article 36° D.L. 1075); Inventions, industrial designs and layout designs of integrated circuits made in education and research centers (Art. 37 ° DL 1075) and Reinvestment for research (Art. 38 ° DL 1075): All references to "inventions" are added to "Industrial designs and layout designs of integrated circuits".

- Action review (Art 131 ° DL 1075.) and Appeal (Art 132 ° DL 1075.) Is added to the action review and appeal cannot be based on the modification of the specification, claims or drawings.

Another important amendment that is added is that the National Trademark Authority now has the possibility that, within its scope of investigation, it may demand *ex officio* - through a precautionary measure or resolution that puts an end to the instance - the adoption of measures that prevent the continuation of acts of infringement of intellectual property rights of third parties, modifying in the same way the expiration of precautionary measures, which will now expire with the decision that definitively resolves the procedure, unless the complaint had been declared unfounded in first instance, in which case they expire with the issuance of said pronouncement.

In the same sense, the articles relating to the determination of the sanction in infringement proceedings are modified, establishing the new discretionary power of the administrative authority to apply or not the established criteria (among them the real illicit benefit, the probability of detection, second offense, among others) to determine the penalty and/or fine.

Regarding the procedural modifications, from the date on which the file is in the status of being resolved, the parties may not submit additional evidence, and once the administrative procedure has been exhausted, the briefs submitted to question the validity or the foundations of such resolutions by the parties will not proceed, in administrative instance.

In the same context, adhesion to appeals is possible at the moment of answering; as well as it establishes that the notification made in the last domicile fixed by the parties produces full effects, even when it is alleged that the same no longer belongs to them or because there has been a change of representative. Also there’s a new obligation for the administrative authority to issue a report in cases of crimes against industrial property, before the Public Ministry issues an accusation or opinion, for which a period of five (05) business days is granted.

Finally, it is established that the use of the denomination "registered trademark", "MR" or other equivalent is prohibited along with signs that do not have registration with the competent authority, including the right to initiate a procedure of infringement of trademark rights by the administrative authority.

This newsletter is informative and does not replace the legal advice for specific cases. If you need more information, do not hesitate to contact our Intellectual Property Department.

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